

Kenya's Journey towards a Harmonized IP Legal Regime

According to the U.S. Chamber International IP Index 2020 (the "**IP Index**"), Kenya is one of the best-scoring economies in the region, ranking 41st of 53 global economies. Aside from recognizing the steady progress that the country is making in improving the national IP environment, the IP Index also casts a spotlight on some of the weaknesses that stifle the investment potential of the Kenyan economy. One of the weaknesses identified is the country's weak and backlogged judicial system.

The Draft Intellectual Property Bill, 2020

In considering some much needed legal reform, the Presidential Task force on Parastatal Reforms (2013) proposed that the three Intellectual Property agencies namely: the Kenya Industrial Property Institute (**KIPI**), the Kenya Copyright Board (**KECOBO**) and the Anti-Counterfeit Authority (**ACA**) be merged into one Government Owned Entity (**GOE**). The Taskforce made this proposal upon finding that the functions undertaken by the three agencies complement each other.

The three entities presently have different mandates in so far as protection and enforcement of intellectual property rights (**IPRs**) are concerned in Kenya. These institutions have long been raising concerns about limited resources, such as inadequate workforces and budgetary challenges, which undermine their effectiveness in service delivery.

To simplify and fortify the IP legal regime, a Task Force on the Merger comprising staff from KIPI, ACA, KECOBO, the Ministry of Industrialization, Trade and Enterprise Development, and with assistance of a drafting expert from the Kenya Law Reform Commission (**KLRC**) drafted the Intellectual Property Bill, 2020 (the **Bill**).

The benefits of merging

The establishment of a single, unified body, known as the Intellectual Property Office , Kenya (IPOK) set up to handle all IP matters ranging from protection to enforcement would enhance coordination and create a one-stop shop for all IP-related issues. This would, in turn, promote seamless collaboration, increase the efficiency and effectiveness of their service delivery.

Some of the countries with one unified IP legislation are Rwanda and Burundi. Conversely and interestingly, many of the most advanced economies with impressive regulations on Intellectual Property such as the United States of America, the United Kingdom and Germany do not have singular statutes.

Proposed Changes

The Bill proposes to introduce protection for geographical indications, establish a specialized court with jurisdiction over all intellectual property matters, provide guidance on well known marks, introduce the concept of hypothecation of registered trademarks by a deed of security or a charge and expressly capture the concept of exhaustion of trade mark rights its relevant exceptions.

Concerns and gaps

Although the move by the government is highly commendable, the current drafting of the Bill contains vital gaps that if left unaddressed would threaten the practical application of the legislation.

The existing statutes

For starters, the Bill seeks to merge provisions already existing in the Trademarks Act Cap. 506 of the Laws of Kenya, the Industrial Property Act No. 3 of 2001, the Copyright Act No. 12 of 2001, and the Anti Counterfeit Act No.13 of 2008, but fails to highlight whether it seeks to repeal the statutes that are already in existence.

Delineation of administrative roles and offices

The proposed merger also brings in several dynamics and potential confusion between the mandates of each arm of Intellectual Property Administration noting that a Director General will oversee the IPOK.

As the Bill proposes to abolish the individual entities through the merger, there is a need to establish offices with specialized functions such as the Registrar of Copyright, the Registrar of Trademarks and Registrar of Patents, Designs and Utility Models to administer the respective Copyright, Trade mark and Patent + Designs functions under the Acts. The general position of a Director General is not sufficient.

It is also necessary to have the Bill cater to issues around staffing to enable expedient turnaround of matters noting that IP matters tend to require urgent attention. Sector specific concerns may also not be adequately addressed by having one large IP office.

The Intellectual Property Tribunal

The Bill establishes an Intellectual Property Tribunal (the **Tribunal**). The Tribunal has original and appellate civil jurisdiction over all contentious IP issues in Kenya.

However, the Bill fails to stipulate whether the establishment of the Tribunal ousts the jurisdiction of the High Court for original matters. Currently Section 53 of the Trade Marks Act provides an option to go before the High Court or before the Registrar. The Bill proposes to give the Tribunal both original and appellate civil jurisdiction to hear all matters referred to it.

Given the high likelihood of the Tribunal being located in Nairobi, major concerns arise around access to justice for parties with issues arising outside of Nairobi who will have limited access to the Tribunal.

That said, there is benefit in having a specialized court for IP matters, not least to develop jurisprudence on all aspects of IP enforcement, which is what the Tribunal will be.

Patent Protection

The Bill does not include software under "computer implemented interventions," that are eligible for patent protection. This is a gap in the Bill because computer implemented inventions can be implemented in hardware or software and innovators should not be discriminated against based on their choice.

Genetic resources

The Bill provides that the IPOK has the mandate to protect genetic resources from waste. This seems to be related to the Protection of Traditional Knowledge and Cultural Expressions Act No. 33 of 2016 (the **Protection of Traditional Knowledge Act**). There are however no provisions in the Bill on how the IPOK will exercise this

mandate. This is similar to the Protection of Traditional Knowledge Act itself, which seems to have no structures and regulations put in place for its implementation.

Division of trade mark applications

The Bill does not cater for the division and merger of trade mark applications. This provision is necessary because Kenya follows a multi-class system. An applicant should be allowed to submit an application to divide a trade mark application at any time from the date of filing the application until the time the examiner approves the mark for publication.

An applicant should also be allowed to submit an application for the division of a trade mark application with the Registrar during opposition proceedings, concurrent use, or interference proceedings.

Despite the remaining gaps and uncertainties, the Bill represents a significant and commendable step towards developing and strengthening the regulation of IPRs in Kenya.

Having recently been presented to the public for submissions, the Bill is currently with the Ministry of Industrialization, Trade and Enterprise Development (the **Ministry**) for their review on the initial comments and submissions received from the public.

Please do not hesitate to contact [John Syekei](#) or [David Opijah](#) if you have questions or queries relating to this article.