

THE ENFORCEMENT OF INTELLECTUAL PROPERTY RIGHTS IN KENYA:

A COMPARATIVE APPROACH

BY

KARANI MC. RACHAEL

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APPROVAL

I MR.,Lubega Farouq certify that I have supervised and read this study and that in my opinion ; it conforms to acceptable standards of scholarly presentation and is fully adequate in scope and quality as a dissertation in partial fulfillment for the award of degree of bachelors of law of Kampala International University.

Sign.....

MR. FAROUQ LUBEGA

Date.....

DEDICATION

This work is dedicated to my hero, my dearest Dad who has made me believe that I can achieve anything which I put my mind to, and who also taught me the art of caring enough.

DECLARATION

I declare this dissertation a personal effort and that it has never been presented for any award of diploma or degree program. No part of this publication may be reproduced, stored in retrieval system or transmitted in any form or by any means electronic, mechanical, photocopying recording or otherwise without either prior written permission of the author.

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Date



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LIST OF ACRONYMS

1. ARIPO (AFRICA REGIONAL INDUSTRY PROPERTY ORGANISATION)
2. ACA – ANTI-COUNTERFEIT-AGENCY.
3. GATT (GENERAL AGREEMENT ON TRADE AND TARRIFS).
4. IPRS (INTELLECTUAL PROPERTY RIGHTS)
5. IT (INFORMATION TECHNOLOGY)
6. KAM (KENYA ASSOCIATION OF MANUFACTURERS)
7. KECOBO (KENYA COPYRIGHT BOARD)
8. KEMRI (KENYA MEDICAL RESEARCH INSTITUTE)
9. KIPO (KENYA INDUSTRIAL PROPERTY ORGANISATION)
10. KRA (KENYA REVENUE AUTHORITY)
11. MCSK (MUSIC COPYRIGHT SOCIETY OF KENYA).
12. TRIPS RELATED ASPECTS OF INTELLECTUAL PROPERTY AGREEMENT).
13. ULRC (UGANDA LAW REVIEW COMMISSION)
14. UNECA (UNITED NATIONS ECONOMIC COMMISSION FOR AFRICA)
15. UNBS (UGANDA NATIONAL BURAE OF STANDARD)
16. UPRS (UGANDA PERFORMING RIGHTS SOCIETY)
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- iv. Copyright Act, 2001 Laws of Kenya.
- v. Copyright Act, 1953 Laws Of Uganda
- vi. Copyright And Neighboring Rights Act, 2006 Laws Of Uganda)
- vii. Criminal Procedure Code Act Cap 75 Laws of Kenya.
- viii. East Africa Order in Council, 1897.
- ix. English Copyright Act, 1842.
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- xv. Trademarks Act Cap 217 Laws Of Uganda.
- xvi. Trademarks Act, 2010 Laws of Uganda.

ABSTRACT

This research dissertation mainly dealt with the general objective and specific objectives of the study problem which is; the enforcement of intellectual Property Rights in Kenya; A comparative approach. The research sought to make a comparison between the enforcement mechanisms in Kenya comparing it closely with the enforcement mechanisms in Uganda and finally showing which jurisdiction is better placed in enforcing intellectual property rights and what can be learnt from whom.

Chapter one outlined the mode in which the study was carried out. It addressed key issues on the research methodology including the significance of the study, research objectives, research questions, hypothesis, literature review and documentary analysis

Chapter two of the study examined the enforcement laws of intellectual property rights in Kenya. It outlined the relevant parliamentary laws which concern enforcement of IPRS critically analyzing the spaces that needs to be filled for efficient enforcement and also identifying the challenges encountered in the implementation of the provisions on the enforcement laws in the effort to curbing intellectual property rights law infringement in Kenya .This chapter also looked at the enforcement mechanisms of the intellectual property laws with specific reference to administrative measures put forth to ensure effective enforcement of this rights in Kenya and evaluating how adequate or effective they are. In addition the chapter also covered the role of the police, judiciary, rights holders and the public as well in an effort to ensure effective enforcement of intellectual property rights in Kenya.

Chapter three of the research covered an overview of the laws applicable in Uganda, the enforcement methodology and challenges faced in such enforcement. Chapter four of this research contains data analysis of the field work and explains the challenges hindering effective enforcement of IPRS both in Kenya and Uganda. The chapter also makes a detailed comparison of enforcement mechanisms of intellectual property rights between Kenya and Uganda and lastly established which system is more advanced and what can be learned from each other in a bid to effectively enforce IPRS.

Lastly chapter five made final conclusions and recommendations on how enforcement can be improved in both jurisdictions.

CHAPTER ONE

1.0 Introduction

This research topic is an investigation into the Intellectual property rights and how they are enforced in Kenya. Intellectual property rights, herein referred as IPRS, are property rights in something intangible and protect innovations and reward innovative activity¹. The researcher will focus on the areas of copyright, trademarks and patents and how they are enforced in Kenya followed by an examination into areas requiring reforms. The researcher further aims at coming into a comparison between the enforcement mechanism in Kenya comparing it with other jurisdictions and for this case Uganda in particular in an effort to see if any of the system is more advanced than the other and if so look at what can be done to improve the system that lags behind.

1.1 Background of the study

Intellectual property rights are property rights in something intangible and protect innovations and reward innovative activities.² They have history going back to centuries. For instance, the first patent law to protect inventions was passed in Venice in 1474, during the renaissance.

Another early patent law was the English statute of monopolies of 1624; it was amended several times but remained in force until 1977 when Britain adopted the standards of the European patent convention.³

However, by modern standards, these laws were highly deficient. Patent systems in many countries lacked disclosure requirements, incurred very high costs in filling and processing applications and afforded the patentees very little protection. The pressure for an international intellectual property rights regime spearheaded by investors and industrialists started growing in the late 19th century. Starting with the 1873 Vienna congress, there was a series of meetings to create an international intellectual property rights regime. This finally resulted in the ratification by eleven (11) countries of the Paris convention, which is the international union for the protection of industrial property. It was the first attempt at the harmonization of

¹ U.S Council for international business a new MTN: Priorities for intellectual Property (1985) at pg . 3

² Us council international business anew MTN: priorities for intellectual property (1985) at pg3.

³ Bentham j, 'an introduction to the principles of morals and legislation (edited by j. H. burns & hlhart(970) pg 30-31.

patent laws. It covered industrial property including patents and trademarks.⁴ It did not cover copyright which was covered in the 1886, Berne convention on the protection of literary and artistic works.⁵ This convention covers most countries in the world including Kenya and Uganda.

The names of these two early multilateral instruments reflected the distinction that was drawn between patents and trademarks as industrial property, while the domain of the author and the artist was protected by copyright. With the dawning of the technological era, the boundaries between industrial blurred and the inclusive term intellectual property became commonly used to refer to results of human endeavor protected by the law.⁶

During the 1970s and 1980s, multinational corporations in the USA and Japan felt that the existing **IPRS** regime was not stringent enough to protect their business interests. They lobbied their countries for the inclusion of **IPRS** in the general agreement on trade and tariffs (**GATT**) negotiations hence the signing of the trade related aspects of intellectual; property rights (**WTO**) member states in 1994. Unlike other United Nations instruments where states can opt out, **TRIPS** is compulsory for member states. It also has a mechanism for sanctions for non compliance. Given the importance of trade in the creation of wealth, all countries find themselves having to domesticate the provisions of **TRIPS** which therefore form the basis of **IPRS** in all countries Kenya and Uganda included⁷.

Intellectual property laws in Kenya, like others are inherited from the colonial era. On becoming a British colony in 1897, Kenya became subject to British common law, doctrines of equity and statutes of general application, the 1897 east Africa order in council extended the application of the 1842 English copyright Act, the international copyright (musical compositions) Act of 1888⁸, The amended copyright Act passed in 1956 was extended to Kenya by 1963 order in council. This was superseded by the copyright Act Cap 130 of the laws of Kenya which came into operation in April 1966, and was amended in 1975,⁹1982¹⁰ and 1989¹¹ agreement that is by December 1999.

⁴ Article 1(2) of the Paris convention

⁵ Resource book on trips pg 38

⁶ ibid

⁷ Wekesa m & sihanya b, intellectual property rights in Kenya, konrad Adenauer Stiftung pg 5

⁸ Jw chege, copyright law and publishing in Kenya, Kenya literature bureau, Nairobi (1978).

⁹ Act no.5 of 1975

¹⁰ Act no.5 of 1982

¹¹ Act no 4 of 1989

In 1998/1999 the Kenya industrial property office (KIPO), since renamed to the Kenya industrial property office (KIPI) initiated procedures to review the 1989 industrial properties Act to fulfill the country's obligations as under TRIPS. The first patent in Kenya was registered in 1912 using the laws of England. Until 1989, Kenya's industrial property system was dependent on England's so that patents registered there were also registered locally without being examined. KIPO was created in 1990 with the mandate of examining, granting and registering IPRS under the industrial properties Act and the trademarks Act. As a member of the WTO and a trips signatory, Kenya was obligated to amend the Act. This came into effect when in June 13th 2001 parliament passed the industrial property Act.¹²

Like Kenya, Uganda was also a British colony and as a result inherited British laws too. At independence, Uganda inherited the then existing British intellectual property system. Including whole pieces of legislation. This situation continued until the late 1980s and the early 1990s when changes began to occur. The period 1990 to-date has been marked by changes in the intellectual property legal system, mainly as a consequence of international obligations that were themselves result of Uganda being signatory to a number of international treaties, conventions and agreements. One such agreement is the world trade organization (WTO).

In April, 1994, Uganda signed the agreement establishing WTO and ratified the same in October 1994, by 31st December, 1994, the country had fulfilled all the conditions necessary to become a founder member of the WTO. By virtue of being a signatory to the WTO, the country is bound to fulfill specific obligations that have a bearing on its domestic legislation. Thus, the legal regime with regards to commercial laws was affected, particularly legislation pertaining to the trade related aspects of intellectual property (TRIPS) which covers all the main areas of intellectual property, copyrights and trademarks included.¹³

The first copyright Act of Uganda was based on the United Kingdom's Act and commenced operation in Uganda in 1953.¹⁴ The Act was revised to align it with the provisions of trips, of which Uganda is a signatory and copyright in Uganda is now governed by the Copyright and Neighbouring Rights Act, no 19/2006.

¹² (edited by) M.wekesa & B.sihanya, Intellectual Property Rights in Kenya, konrad adaneur stiftung pg 2-pg7

¹³ Wangwe, S et al, Country case study for study 9: institutional issues for developing countries in intellectual property, policy making and enforcement, economic and research foundation, Dar es salaam, Tanzania pg 2-3.

¹⁴ Uganda law review commission: a study report on Copyright and Neighbouring rights law (2004), law com pub.9 of 2004.

Uganda's trademark law was initially adopted from the United Kingdom's trademark act of 1938;¹⁵ the trademark Act cap 217 which was melded from this law commenced on the 1st January, 1953. The trademarks bill of 2008 was first read on 2nd September, 2008, it was eventually passed into law and the premier law on trademarks on Uganda is now the Trademark Act 2010.

1.2 Statement of the problem

Taking a close look of the legal system in Kenya, there is no question about the existence of intellectual property laws in the country and especially on the regulation and enforcement of trademarks, copyrights and patents. Kenya has further complied with various international conventions and agreements that advocate for the protection of intellectual property rights a good example being the Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPs)¹⁶. Further there is also a well-established institutional and administrative framework for safeguarding intellectual property rights.

However despite all the above, Kenya is facing an alarming increase in trade in counterfeit products, piracy and infringement in technology. For instance, in the year 2007 during the first East African intellectual property rights conference; Member States shared on the impacts of counterfeit trade in their economies. It was estimated that the region losses US\$ 20 million in taxes to counterfeiting and piracy and infringement in technology with Kenya being the lead¹⁷. Therefore the question that begs to be answered is whether the laws put forth to curb infringement of intellectual property rights in Kenya are effective and whether they are achieving the intended purpose. If not what has not been done and what needs to be done forms the basis of the research topic.

1.3 Purpose of the study

The research will be made in an effort to make a case study of how intellectual property law is being enforced today in Kenya comparing it closely with the system in Uganda and the challenges the two jurisdictions are facing.

¹⁵Uganda law review commission: a study report on intellectual property rights-trademarks and service marks (2004), law com pub. No 15 of 2004.

¹⁶ World Intellectual Property Organisation Website at www.wipo.int/trademark/htm.

¹⁷ International chamber of commerce (2007) "counterfeiting cost east Africa \$20 million in lost taxes", at <http://www.icc-ccs.co.uk/bascap/articleid=73>.

Therefore the main purpose of the study will be to find out how such infringement of intellectual property rights can be combated through lawful enforcement and also looking into methods of creating awareness of these rights to the general public and to set out clearly the procedures to be followed in enhancement of these rights.

1.4 Objectives of the study

1.4.1 General objective

To discuss the ways in which IPRs are enforced in Kenya and whether the modes of enforcement are adequate and what can be done to improve on the methods of enforcement then compare the mode of protection of the same with other jurisdictions and especially Uganda.

1.4.2 Specific objectives

- i. To examine the existing legal framework for protection of IPRS in Kenya.
- ii. To examine the existing administrative frame work of protection of intellectual property rights in Kenya.
- iii. To compare the enforcement mechanisms with other jurisdictions and especially Uganda and find out which system is more advanced and what can be learnt from whom.
- iv. Propose recommendations on how enforcement of rights can be improved in both jurisdictions

1.5 Research questions.

- i. How is the existing legal framework in view of enhancing enforcement of IPRS in Kenya?
- ii. How is the existing administrative framework of enhancing IPRS in Kenya?
- iii. Which system is more advanced in the enforcement of IPRS between Kenya and Uganda and what can be learned from the other?
- iv. Is there adequate awareness by the general public about intellectual property rights?

1.6 Hypothesis

- (i) To show the weakness in the existing legal framework that combat infringement of intellectual property rights and how they can be improved to solve the problem.

- (ii) To show the weakness in the existing administrative framework and what can be done to improve the administrative framework
- (iii) To show that there is inadequate public awareness in regard to intellectual property rights which has been a challenge to its enforcement.
- (iv) To show that there is the inadequacy of the legal remedies available to the aggrieved once his or her rights have been infringed upon.

1.7 Scope of the study

The study focuses on the three main Intellectual property rights; Copyrights, trademarks and patents. The study will review the protection systems of these rights and further compare to some extent the regimes of Kenya and Uganda to see which regime is more effective.

1.8 Significance of the study

- (i) To enable owners and would be owners of rights to have access to knowledge about their rights and how they can protect them.
- (ii) To show the deficiencies in areas that can be improved by law makers and also give recommendations as to how such protection can be strengthened in both Kenya and Uganda.
- (iii) It will help other researchers to further research taking as the point of reference concerning similar headings.

1.9 Literature Review

The researcher looks at materials in various forms either in written form, electronically or otherwise relating to the topic of discussion. A lot of literature exists as pertain intellectual property rights in both Kenya and Uganda and the mode in which they are enforced. The literature will be reviewed in the context of the relevant laws and the enforcement mechanisms. In doing this, the researcher will demonstrate the gaps within the literature which the research seeks to address.

The researcher also looks at some of the views expressed by other researchers, articles, journals of law, text books, magazines and legislative laws among others.

The world intellectual property organization (WIPO) handbook defines intellectual property as creations of the mind which include things like literary and artistic works , any symbols , names , images , designs and sound used in trade. Intellectual property rights are usually awarded to people over creations of their mind.¹⁸

¹⁸ Davis j Intellectual Property Law, 3rd Edition ,Core Text Series, Oxford pg 1.

On the other hand *Bernard Sihaya* states that Intellectual Property is the protection, promotion or recognition of the work of the mind through rewards, incentives as well as legal mechanism for enforcement or indication of the rights in the case of infringement¹⁹.

Further, *Andrew Gowers*²⁰, In his book, talks about the general principles of IPRs he defines the rights to include copyright, trademarks and patents among others, the mode in which they offer protection, the offences committed from violation of such protection, and the penalties that accrue from such practices.

From the above definitions it is therefore clear that the enforcement of intellectual property rights is well included in the definition of intellectual property rights, and therefore we cannot talk of intellectual property rights without mentioning their enforcement, this shows the significance of the research study.

On the other hand, Professor *Odek* states that in relation to intellectual property rights, enforcement refers to the process of compelling recognition, compliance and respect of the intellectual property rights conferred by patent, trademark, industrial designs, copyright or other categories of intellectual property²¹.

In emphasizing the importance of enforcement of intellectual property rights *Michael P. Ryan*²² argues that intellectual property is a valuable asset in today's global trading world, but if rights in intellectual property cannot be adequately enforced, the value of such rights and the incentive to trade in them is greatly diminished. This brings us to the issue of enforcement of the intellectual property rights which forms the basis of our study.

Additionally, In support of proper enforcement mechanism, *Robert Sherwood*²³ argues that the ability to judicially safeguard intellectual property assets makes these assets valuable instrument for national economic growth and when parties are secured in the belief that their intellectual property assets can be protected through judicial action, these assets become magnet for investment of funds and hence economic growth. Generally Robert tries to emphasize on the importance of enforcement of intellectual property rights which form the

¹⁹ Bernard Sihaya Intellectual Property Law teaching Material University of Nairobi, Faculty of Law

²⁰ Gowers Review of intellectual property; Andrew Gowers, Google Books nmt.

²¹ Otieno Odek (2005) *Enforcement of Intellectual Property Rights in Kenya op. cit*

²² Micheal Ryan (2002) Interim Report on Judicial Capacity Regarding Intellectual Property Enforcement and Dispute Settlement, Intellectual Property Institute, 2002.

²³ Robert Sherwood (1997) "Intellectual Property Systems and Investment Simulation: The rating systems in eighteen developing countries," 37 IDEA 261, 268.

basis of the research study however he does not state the modes of enforcement of this assets in order to make them economically beneficial.

In addition, Peter Gumbal argues that having the proper legal framework and enforcement mechanisms in place is useful in combating intellectual property rights infringement.

The basis of the protection of intellectual property rights is premised in the Constitution of the Republic of Kenya 2010. Under Article 40(5) of the Constitution of Kenya 2010, the state has a duty to support, promote and protect the intellectual property rights of the people of Kenya. It can therefore be said that Article 40(5) of the Constitution of Kenya 2010 forms the basis of intellectual property laws in Kenya. It is however worth noting that the Constitution of Kenya, 1963 did not provide for protection of the intellectual property rights.

Allan Tuli discusses the provisions of the Constitution of Kenya, 2010 relating to intellectual property²⁴. He focuses on the protection of intellectual property rights the study will be guided by the argument presented by Allan Tuli that the constitution forms the backbone of intellectual property rights in Kenya. The study will further seek to find out any other provisions of the Constitution of Kenya, 2010 that deals with recognition and promotion of intellectual property rights. This is to demonstrate the constitutionalism of intellectual property rights in Kenya.

Ben Sihanya argues that the Kenyan legal system addresses intellectual property rights infringement under two major tenets of law: criminal law and civil law²⁵. He further argues that criminal law is enshrined in the Pena Code Cap 63 whereas the civil part is encompassed in the tortuous and contractual liabilities. However, he does not discuss as to which tenet between the two is more effective and efficient in curbing IPRS infringement in Kenya. The research thus seeks to fill this gap, as it demonstrates which tenet between the two offers the best environment to combat such infringement.

²⁴ Allan Tuli (2014) The Constitution Framework For the Protection of Intellectual Property Rights in Kenya, at www.academia.edu(accessed on 24/07/2014)

²⁵ Ben Sihanya, "Intellectual property confronts counterfeiting in Africa," *op. cit.*

Ben Sihanya also discusses the institutional profile in intellectual property and innovation²⁶. He points out some of the institutions charged with the responsibility of enforcing anti-counterfeit laws for example KIPI. However he neither addresses other administrative measure employed in Kenya to enforce anti-counterfeit laws and infringement on technology nor does he point out the challenges faced by these institutions.

Similarly *Prof Otieno Odek* also discusses the tribunal charged with the responsibility of enforcing infringement on technology but does not point out the weaknesses in the operation of the tribunal²⁷. This study will go ahead to identify all the administrative measures put forth to curb such infringement and whether this administrative measures are adequate to infringement on innovations being one of the intellectual property right infringement practice.

Additionally *Mugisha Gregory*²⁸, in his article talks of the police efforts as an enforcement body of copyright law as one of the first steps to fight cyber crime. This is relevant in that copyright infringement is mostly as a result of cyber crime; however this article is limited by the fact that this department is not sufficient to control the infringement in Kenya or Uganda which involves illegal copying of books or music and movies which does not involve the cyber crime department.

Further, *The anti counterfeit Agency*²⁹ which created the anti counterfeit *Act 2003* which has the Slogan “ Enlighten , Enforce, Eliminate” has tried to create awareness to Kenyans about counterfeited goods with the enforcement of intellectual properties of the owners. However the anti counterfeit Act is limited in that little has been done in addressing the fight against counterfeiting in Kenyan which can be attributed to among others, low drive by governments in fighting counterfeits, corruption, weak institution capacity and capabilities of legal enforcement, ignorance of consumers and lack of public awareness.

In relation to this the fight against counterfeit would require strengthening of the judiciary which is not addressed by the Act. This is based on the notion that a weak judicial system is makes local industries to shy away from pursuing judicial remedies where their products are

²⁶ Ben Sihanya, “Combating Counterfeit Trade in Kenya,” in MoniWekesa and Ben Sihanya (eds) *Intellectual property Rights in Kenya*, Konrad Adenauer Stiftung ,Sports Link Limited and authors publishers, Nairobi at http://www.kas.de/wf/doc/kas_18323-1522-2

²⁷ Odek Otieno (2005) *Enforcement of Intellectual Property Rights in Kenya*, op. cit.

²⁸ Establishment of a Cyber department in Uganda police By B/C ASP MUGISHA GREGORY, 20/05/2009

²⁹ The August 11th 2011 the fourth “E Engagement Vis viz Trademark and enforcement in Kenya.

counterfeited due to fear of liability where such cases fail this may be attributed to the fear that in case the judge is compromised they are liable and have to pay for damages caused by counterfeit products.

Additionally, In an article published in the African Intellectual Property Law Practice and policies (*AFRO-IP*)³⁰, A Kenyan lawyer critically analyses **Sec. 55** of the Industrial Property Act which deals with the enforcement of rights of a patent holder and which provides, that the owner of a patent has the right to enforce by means of injunction and collecting damages. Further, *Sec 55 (c) (i)* provides for provisional rights that can be enforced against someone infringing a claim of published application provided that the infringer has “actual knowledge that the invention he was using was the subject matter of published application”. In addition *Sec 42* is to the effect that publication of an application will occur only after **18 months** from the filing date. The effect of these two provisions being that a patent applicant has no legal right he can enforce for 18 months after the filing date.

However we find that in other jurisdictions for instance in America it is possible to request for early publication but there is no such provision in Kenya. He states that this is frustrating in instances where the patent law does nothing to help the inventor and this makes majority of the inventors shy away from registration. Therefore the law needs reform to ensure that a patent holder has a remedy for infringement before the lapse of 18 months before publication.

In conclusion the research will quote *Bernard Sihanya*³¹ where he states that, the importance of IPRS in innovation induces its roles in providing rewards and incentives and that Unless a good invention or creation is protected, it is easily lost to free loading or rent seeking competitors that are in a better position to commercialize the product or service. From the foregoing therefore we can conclude that, adequate provisions on protection of intellectual property is a necessary step in securing the interests of the innovators and in reducing infringement, piracy and counterfeiting as well as turning innovations into assets with real market, cultural and social value.

³⁰ Observation of Patent lawyer in Kenya a Frustrating Law ;16th May, 2013 .afro-ip.blogspot.com.

³¹ Ben Sihanya, “Intellectual property confronts counterfeiting in Africa,” *op. cit.*

1.10 Methodology

1.10.1 Introduction

This section describe the research design, study population, sampling, procedure and sample size, data sources and collection instruments, data processing and data analysis.

1.10.2 Research design

In an attempt to properly address the research objectives and questions, the study will adopt qualitative methodology and partly quantitive approach. This gives room for flexibility and for an in-depth focus on the study being conducted since the data that will be obtained is in form of words rather than in numbers³².

The reason for these approach is that it will provide an accessibility to reliable and valid sources of information from members of the community, judicial offers, police officers, among others.

1.10.3 Study population

In finding out the enforcement of **IPRs** the researcher intends to interview several professionals including but not limited to advocates, law lecturers, judges, police officers and also members of the public.

1.10.4 Sample design

Sampling; a sample is a smaller group obtained from the accessible population. sampling is very important in qualitative research because we cannot study everyone. In this research, purposive sampling technique will be used; hence the researcher will use his knowledge of sampling to select his class of interviewees and use of particular laws and articles relating to the enforcement of intellectual property rights.

This mode will be preferable since it is free from bias and therefore each unit or potential respondents have equal chances of being included in the sample size.

1.10.5 Data collection method

The researcher intends to use both primary and secondary data collection methods.

³²ibid. p.140.

1.10.6 Secondary Data Collection Method

Document Reviews/Content Analysis

Documents are a major and useful source of data for social research. For this study, the researcher will analyze national documents which provide for the enforcement of intellectual property rights protection and will include; The Copyright Act Cap 130 of the laws of Kenya, The Trademark Act Cap 506 (Amended in 2002), The Anti-counterfeit Act 2008, The Industrial Property Act 2001, text books literatures, Periodicals, Journals articles, Magazines, Publications posted on internet and Newspaper Articles. Through examining these documents and other texts, the overall picture of the study will be drawn. .

1.10.7 Primary Data Collection.

Interviews

Interviewing is described as '*a conversation with a purpose*'³³. With the selection of interviews as a method of data collection, the researcher will take into consideration that the respondents have the experience in a given phenomenon under investigation.

Both structured and semi structured interviews will be used. Structured form of interview is one that takes place with respondents known to have been involved in a particular experience³⁴, while with the unstructured interview method, there are no specified set of questions, nor are the questions asked in any specific order, there are no schedules as well³⁵. This type of interview can be useful because the respondents are able to give accounts of their experiences, opinions and feelings in their own way. The task of the researcher will be to probe for further details and ask for clarifications whenever necessary³⁶.

³³ Kahn and Cannell (1957) the dynamics of Interviewing: *Theories, techniques and cases*. New York. p.149.

³⁴ Merton, R. K. & Kendal P. L (1946) 'The Focused interview' *American journal of Sociology*, 51(1946) 541-557. Payne, G and Payne, J (2004) *Key concepts in Social research*, Sage Publication London. P.541-557.

³⁵ Donald, A.D (1983) 'Mail and other self-administered Questionnaires' *In Hand Book of survey Research*, ed Peter H. Rossi, James D. Wright, and Andy B. Anderson (Orlando, Fla: Academic Press.

³⁶ Payne, G and Payne. J (2004) *Key concepts in Social research*, Sage Publication London. P.132.

1.10.8 Reviews

Primary data method will entail interviews, face to face interviews with judicial officers, police officers ,prosecutors, judges, rights holders and members of the public.

Secondary data collection shall be collected through documentary reviews and existing publication on the enforcement of intellectual property rights.

1.10.9 Anticipated problems

The researcher anticipates some problem before she completes the study. These includes

(i) **Difficulties in interviewing key informants.** Key informants such as advocates and court clerks have tight schedules. However the researcher will endeavor to book appointments with key informants that she intends to interview. She will also make good use of her law lecturers who will be her first hand respondents.

(ii) **Financial constraints:** This will limit the researcher on interviewing specific respondents in certain places due to limitation of movements. The researchers intends to be sponsored majorly by her patents, relatives and close friends so as to address all financial changes including printing, typing , transport among others.

(vii) **Lack of adequate literal sources.** In adequate of literal sources in interviews may lead to wastage of time since the researchers will not know what to look for from the interview. To cub this problem the researcher shall endeavor to utilize available literature maximally and even opt for other source such as interacting in aiding completion of the study comprehensively.

(iv) **Time.** Time allocated to complete the study will be minimal since the researcher will be studying too. This will restrict the researchers who is likely to conduct the research inadequately with limited time to collect data and resources.

To curb this problem the researcher intends to create more free time to sacrifice and dedicate this time to conduct the study without interfering with her academic work.

1.10.10 Ethical issues

In order to conduct the study, the researcher intends to abide by the norms and legislation of conducting a study. This will include;-

- i) The researcher intends to obtain permission and approval from respective persons in location where the research shall be conducted
- ii) The researcher shall assure all respondents of protection of their identity and confidentiality in all statement made by respondents before conducting the study.
- iii) Before interviewing respondents, the investigator shall first request for consent by expressing the need for conducting the study.

1.11 Chapterisation

Chapter one outlines the mode in which the study is carried out. It addresses key issues on the research methodology including the significance of the study, research objectives, research questions, hypothesis, literature review and documentary analysis.

Chapter two generally examines the enforcement laws of intellectual property rights in Kenya. It outlines the relevant parliamentary laws which concern enforcement of IPRS critically analyzing the spaces that needs to be filled for efficient enforcement and also identifying the challenges encountered in the implementation of the provisions on the enforcement laws in the effort to curbing intellectual property rights law infringement in Kenya .This chapter also generally answers the second objective of the study, it looks at the enforcement mechanisms of the intellectual property laws with specific reference to administrative measures put forth to ensure effective enforcement of this rights in Kenya and evaluating how adequate or effective they are. In addition the chapter also looks at the role of the police, judiciary, rights holders and the public as well in an effort to ensure effective enforcement of intellectual property rights in Kenya.

Chapter three covers an overview of the laws applicable in Uganda, the enforcement methodology and challenges faced in such enforcement

Chapter four generally covers the findings of the research showing clearly showing whether the objectives of the study were satisfied. ,the chapter also covers the comparison of enforcement of intellectual property rights between Kenya and Uganda and lastly establishes which system is more advanced and what can be learned from each other in a bid to effectively enforce IPRS.

Lastly chapter five contain the conclusions and recommendations on how enforcement can be improved in both jurisdictions.

CHAPTER TWO

2.0 EXAMING THE EXISTING LEGAL AND INSTITUTIONAL FRAMEWORK ON THE ENFORCEMENT OF INTELLECTUAL PROPERTY RIGHTS IN KENYA.

2.1 The Constitution of the Republic of Kenya, 2010.

The Constitution of Kenya, 2010 provides for the protection of intellectual property rights in Kenya. On this vein it is trite to note that the constitution of Kenya, 1969 did not capture concerns on innovation and intellectual property protection.

Sections 70 and 75 of the Constitution of Kenya, 1969 only provided for substantive property guarantees limited to real property as opposed to technological innovations, cultural innovations and intellectual property. However in 2010, there was a paradigm shift which resulted in the promulgation of the Constitution of Kenya, 2010, for the first time in Kenya's history, intellectual property norms were constitutionalised

First, Article 260(c) of Constitution of Kenya, 2010 included intellectual property in the definition of "property." Secondly, Article 40(5), obliges the State to support, promote and protect the intellectual property rights of the people of Kenya.

In the same breath, Article 69(1) (c) and (e) mandates the State to protect and enhance intellectual, property, traditional or indigenous knowledge of biodiversity and the genetic resources of the communities and protect genetic resources and biological diversity.

Article 11(1) of the Constitution of Kenya, 2010 further recognizes culture as the foundation of the nation and as the cumulative civilization of the Kenyan people and nation. It mandates the state to promote all forms of national and cultural expression through literature, the arts, traditional celebrations, science, communication, information, mass media, publications, libraries and other cultural heritage; recognize the role of science and indigenous technologies in the development of the nation; and promote the intellectual property rights of the people of Kenya.

It is my observation therefore that the Kenyan constitution of 2010 came as a blessing to intellectual property rights holders as by making such broad provisions on the protection and

observation of intellectual property rights in the constitution shows that Kenya has awoken the giant of intellectual property rights in the country, additionally this shows a strong commitment toward enhancing the enforcement of intellectual property rights.

2.2 The Copyright Act, Cap, 130 Of The Laws Of Kenya, 2001.

Copyright protects original expressions which are embodied in a tangible material, fixed form or medium³⁷. Copyright in Kenya is governed by the Copyright Act 2001. The Act contains the law regarding Copyright protection in Kenya. It was passed in the year 2001 and came into force in 2003.

Section 22 of the Copyright Act provides for the works that are eligible for copyright protection and this includes: literary works, musical works, artistic works, audio-visual works, sound recordings and broadcasts. Further section 22 of the Act provides that for any of the aforementioned to be eligible for copyright protection, there should be demonstration of sufficient effort expended on making the work to give it an original character and the work should be written down, recorded or otherwise reduced to material form.

Copyright therefore does not protect the idea, information or concept *per se* but rather the expression of those ideas³⁸.

The Act further provides for the economic rights of the copyright owner and these include the exclusive right to authorize other persons to publish, produce, reproduce, distribute, perform, broadcast, communicate, make derivative work, rent or do any act in relation to that work.

The law on Copyright Act highlights two major offences, namely infringement of copyright work and authentication of copyright work. Infringement of copyright works is defined under **Section 35** of the Act and arises where a person other than the copyright owner, licensee or assignee, makes for sale, distributes imports or has in his possession contrivances used for making infringing copies without the authority of the owner.

On the other hand Authentication of copyright works is stipulated under **Section 36** of the Copyright Act. It arises where a copyright owner, licensee or assignee offers for sale any copyright works without authentication stickers. The police are the enforcers of this section

³⁷ BenSihanya (2007) "Copyright law, Teaching and Research in Kenya," *East Africa Law Journal*, Nairobi

³⁸ Ben Sihanya (2007) "Copyright law, teaching and research in Kenya," *East Africa Law Journal*, Nairobi

and bestowed with powers to confiscate any works (sound recordings and movies) without the authentication device.

The Act also provides specific administrative mechanisms for enforcement of copyright and related rights which will be discussed later in chapter 3. The Act also contains provisions for both civil and criminal sanctions for copyright infringement which include among others damages, injunctions, and Anton pillar orders.

Civil liability

The rights holder may under sec. 35 sue the infringer and claim relief by way of damages, seek an injunction, delivery up of infringing works, pay reasonable royalties as well as request for the destruction of infringing works.

Any person whose rights are in imminent danger of being infringed or are being infringed may institute civil proceedings in the commercial court for an injunction to prevent the infringement or prohibit the continuation of the infringement. The grant of such injunction shall not affect their claim for damages in respect of losses they sustain as a result of said infringement.³⁹

Additionally a person who sustains damage because of infringement of their rights may claim damages against the person responsible for such infringement whether they have been prosecuted successfully or not.⁴⁰ The aggrieved party may pray for general and exemplary or punitive damages. In a claim for general damages, the courts will be satisfied with evidence of the infringement and award such a sum that will restore the plaintiff in the position they would have been if no infringement occurred. Where the defendant is proved to have consciously planned and carried out the infringement, court may on top of awarding General damages award punitive or exemplary damages.

A right owner may also make an ex-parte application and court may in chambers make an order for the inspection of or removal from the infringing person's premises the infringing materials which constitute evidence of their infringement.⁴¹ These are known as Anton pillar

³⁹ Ibid section 35(1) & (3)

⁴⁰ Ibid section 35(4)

⁴¹ Ibid section 35(2)

orders, the infringer may also be ordered by court to make an account accounting for the profits they have made from the infringement of a copyright and surrender the same to him/her.

Examples of civil remedies granted in Kenya can be seen from the following cases:

In *Microsift Vs Migroskill* ⁴² in this case the defendant was found to have infringed on the plaintiff's copyright by selling, offering for sale and distributing software without authority of the owner and was awarded ksh.250, 000,000 as damages.

Additionally in *Anternative Meda Ltd Vs Safaricom* ⁴³, , alternative media sued safaricom for using their artwork without their authority. The court ruled in favour of the plaintiff and awarded them damages, and further stopped Safaricom from using the said artwork and ordered them to withdraw the infringing works from the market.

Further In *Pahh Odaho Abour Vs Coluour Print Ltd \$ Textbook Centre* ⁴⁴ the high court issued an exparte order restraining the defendant from printing, selling or distributing a book entitled "white highlands no more" – a modern political history of Kenya. The plaintiff was also granted anton pillar orders which allowed for the preservation of the evidence as provided for under sec.35 of cap 130.

Criminal liability

Sec.38 of Cap 130 creates the mode of enforcement of criminal offences which includes, making for sale, or hire of infringing copies, offering for sale, selling, hiring or other commercial distribution of infringing works, possession or infringing works possession of contrivances that can be used for making infringing copies among.

Sec.36(6) also makes it an offence to sell works that require an authentication device without one, and any person who is maker or is found in possession of fake authentication device is guilty of offence and is liable for a fine of a maximum of KES. 800,000/= or a term not exceeding 10 years or both.

The Act further provides that any person found guilty of any offence specified in the Act will be liable to a fine not exceeding Kenya Shillings Four Hundred Thousand (Kshs. 400,000/=) (approximately US\$4,800) or imprisonment for a term not exceeding six (6) years for a first

⁴² [HCC 8337 1999]

⁴³ civil case 263 of 2004

⁴⁴ 2002, unreported

offender and in any other case to a fine not exceeding Kenya Shillings Eight Hundred Thousand (Kshs. 800,000/=) (approximately US\$9,500) or imprisonment for not exceeding ten (10) years or both.

For example, In one case heard in Eldoret court in Kenya , an accused person was found guilty of copyright infringement and sentenced to six months in prison without an option of the fine⁴⁵. While in a broadcasting infringement case two persons were found guilty by a Nairobi Court and fined each 400,000/= or six months in prison⁴⁶.

The Copyright Act in a bid to enhancing enforcement of IPRS also establishes the Kenya Copyright Board (KECOBO) whose mandate is the overall administration and enforcement of copyright and related rights in Kenya. Some of its mandate includes,: Directing ,coordinating and overseeing the implementation of the laws and international treaties and connections to which Kenya is a party that relate to copyright and neighboring rights, Licensing and supervising the activities of collective management, Enlightening and informing the public on matters relating to copyrights ,Maintaining an effective data bank on authors and their works and Devising promotion , introduction and training programs on copyright and related rights to ensure constant improvement and effectiveness

To this end, the board has established an enforcement department which consists of the legal and enforcement units. The legal unit currently consists of five legal counsels who have been appointed as copyright prosecutors under sec.43(1) and eight police officers from the Kenya police appointed under sec. 39 as copyright inspectors. Sec.39 is to the effect that only the Kenya copyright board may appoint the copyright inspectors.

The Kenya copyright board has worked together with individual rights holders associations such as the recording industry association of Kenya (Riak) as well as major companies such as Microsoft, multi choice Kenya, adobe auto desks among others.

The Kenya copyright board also receives complaints and carries out the relevant investigations before carrying out raids and confiscating the infringing copies before prosecuting the matters in court. Once the matter has been determined as per the court orders, the Kenya copyright board then destroys the infringed materials.

⁴⁵ Issue 7,A quarterly publication of the copyright board enforcement of copyrights and related rights. Info"copyright.go.ke

⁴⁶ Issue 7,A quarterly publication of the copyright board enforcement of copyrights and related rights. Info "copyright.go.ke.

Bearing in mind that initially the administration of copyright had traditionally been done under the Attorney General Chambers office of the register general. The appointment of the above mentioned board therefore indicates an intention to have a fully fledged office administering copyright outside the attorney generals chambers which will improve the administrative enforcement mechanism.

However it would be trite to note some of the limitations of the Copyright Act that hinders effective enforcement of copyrights in Kenya. One of the challenges is lack of sufficient funds; we find that fines levied on infringers are shared equally by the Kenya copyright board and the Kenya revenue authority. To some extent it can be assumed that this provision is meant to provide an incentive to both institutions in order to effectively prosecute copyright infringers but however the reality indicates that this incentive scheme has not worked because, generally, the levels of fines levied on offenders, and the number of prosecutors is too low⁴⁷.

Additionally **KECOBO** established under the copyright Act is a positive step towards countering piracy, however research confirms that it is completely overwhelmed by the magnitude of the problem and there is no sense of achievement on its part. for instance, while the board is mandated by the statute to prosecute infringers of copyright, it has to date successfully prosecuted only very few cases over the last (8) eight years since it was established. The board is mainly overwhelmed by the challenge ahead of it due to human resource incapacity⁴⁸.

In addition, the bigger challenge facing Copyright enforcement in Kenya is absence of different minimum fines and civil remedies. Damages are based on the quantity seized by **KECOBO** or the compliant during a raid which usually bears no consonance with the quantity already sold by the infringer based on sales records or in the warehouses. Therefore copyrights owners seeking to enforce their rights in Kenya may end up feeling that they are not adequately compensated.

2.3 The Trademarks Act Cap 506 (Amended In 2002)

Sec. 2 of this Act defines a trademark as a distinctive sign or indicator used by an individual , business organization or other legal entity to identify that the products or services to consumers by distinguishing its products or services from those of other entities.

Trademarks in Kenya are registered by Kenya intellectual property institute (KIPi) and administered by its managing director but the substantive law protecting trademarks owners in Kenya is the Trademark Act Cap 506.

The Act has elaborate provisions against the infringement of trademarks and how such infringement is dealt with. Sec 7 and 8 of the trademarks Act outlaw the use of registered trademark by any other person other than the proprietor or a registered user of the trade mark.

Acts of infringement under these section include the use of an identical or similar marks so as to deceive or cause confusion in relation to any goods subject to the trademark and in the process passing off the goods as subject to the trademark or importing a reference to some person having the right either as proprietor or as licensed user.

The Act further provides that the application of any other trade mark in a manner likely to injure the reputation of the trademark constitutes an infringement.

Additionally counterfeiting which includes inference of goods in a way that lowers their value and selling them under another's trade mark also constitutes an infringement of the trademarks under the Act. Sec. 58 of the Act defines counterfeits as forgery of registered trademarks without owners consent and with intention to deceive it further provides a fine of ten thousand shillings or imprisonment not exceeding 5 years.

Trademarks which are not registered under the trademark Act are protected by the Penal code. The Act provides that counterfeiting under such trademarks is a misdemeanor attracting a general fine or imprisonment for misdemeanors.

The Act under sec 5 clearly gives the effectiveness of registering trademarks; this is because unregistered trademark is not protected under the Act. sec 14 prohibits the registration of defective mark while sec. 15 prohibits the registration of identical and resembling trademarks. Therefore products and services likely to deceive consumers or cause confusion or resembling existing trademarks do not qualify and will not be registered.

The main challenge facing enforcement of the Trade marks Act in Kenya is that, the Act being the most frequently used legislation in Kenya to deal with trademarks protections and infringements; it has the poorest provisions of the penalties against counterfeits products. This is because ten thousand Kenya shillings (KES. 10,000) as a fine is too little such that anybody can afford it and it is not different at all to counterfeiters both manufacturers and distributors.

Additionally there are often some inconsistencies in the examination in trade mark prosecution, which often lead to delays and sometimes in additional expense to overcome refusals or disclaimers that are not consistent with the law.

Another challenge in trademark enforcement is that the law provides that infringement actions must be pursued in the high court as court of first instance. This is problematic because there is general lack of capacity in handling and appreciating Intellectual property matters in addition to the backlog of other types of cases before these courts.

In addition the official fees payable at the trademarks and patent office are also considerably high and among the highest in the continent, particularly for foreign applicants which has been prohibitive for some clients when thinking of seeing intellectual property protection in Kenya.

2.4 The Anti-Counterfeit Act 2008.

This Act came into force in 2008 establishing an Agency and a strong legal framework to prevent counterfeit goods.⁴⁹ Sec 5 of the Act establishes its functions which are mainly to combat counterfeit products trade in Kenya, ensure effective enforcement on the law on counterfeits and more so encourage foreign organizations union in the aim of defeating counterfeiting.

Part IV of the Act provides for inspection of goods suspected to be counterfeits products , additionally Sec. 23 (i) gives an inspector power to enter at any reasonable time to a premise to inspect goods with or without a search warrant and seize or detain counterfeit goods.

⁴⁹ Sec 3 of the Anti counterfeit Act 2008

Sec.32 makes it an offence to poses counterfeit, manufacturer counterfeits, and exhibit and distribute them for the purpose of trade.

Further *sec 35 (i)* provides for conviction to imprisonments for a term of five years or to a fine in respect of each article or item involved in the particular act of dealing in counterfeit goods to which the offence relates is not less than three times the value of prevailing retail price of the goods or both.

However, the Act is also limited in various ways hence preventing effective enforcement, firstly the Act does not provide for a mandatory custodial irrespective of the flagrancy of the offence, secondly it does not provide for minimum penalties, the result therefore being that too much discretion is left in the hands of the court since as currently drafted, it is quite possible for a habitual offender to be sentenced to a lesser fine or jail term than a first offender.

Additionally the anti-counterfeit Act; 2008 does not establish a solid scheme for boarder enforcement procedures. There is only sec. 34 of the Act, which is to the effect that the owner of an intellectual property right may apply to the commissioner only when he has valid grounds for suspecting that the importation of counterfeit goods may take place. Further, the Act does not provide for the possibility to conduct border enforcement controls to exports and goods in transit.

In addition, there is a lot of deficiency in the civil enforcement area due to the duration of judicial procedures which are lengthy. For instance sec.34 (6) (b) (iii) of the anti-counterfeit bill, 2008 requires brand owners to sign an indemnity, which effectively indemnifies the anti-counterfeit agency's officers from just about everything and places a heavy obligation on brand owners for action of ACA officers which are completely beyond their control. This indemnity has caused many brand owners to simply walk away from enforcement in Kenya due to its breadth of scope.

Moreover the civil enforcement provisions of the anti-counterfeit Act 2008, should be further strengthened and a judicial reform should be proposed to establish special courts to determine IPRS disputes.

2.5 The Industrial Property Act, 2001.

Patent in Kenya is governed by the Industrial Property Act. A patent is a certificate granted to an inventor; it is also the right of exclusion⁵⁰. Patents may be granted for products or processes or both. Patent law grants exclusive rights (not necessarily a monopoly) for a limited period of time in respect of an invention in return for disclosure of the details regarding the invention⁵¹.

In Kenya, an invention⁵² is patentable if it is new, involves an inventive step, is industrially applicable or is a new use. An invention need not be complex for it to constitute an inventive step; it may be simple but not obvious Ben Sihanya argues that an invention must be reproducible. This means that one should be able to reproduce the product or process so that many can use it.

Patent infringement in Kenya can take two forms. First is where one counterfeits a process. Secondly, is where there is already a registered patent or a patent waiting to be patented and another person wants to patent the same kind of product.

Sec 36 of the Industrial Property Act provides that the owners of a patent has an exclusive right to make use , exercise and vend the invention and may preclude any person from exploiting the patented invention without his or her authorization like in making , importing , offering for sale and using the product or stocking for purpose of sale.⁵³

Just as in copyright infringement, remedies available in patent infringement are injunction and damages. This is as provided under section 106 of the Industrial Property Act. Criminal remedies are also available in patent infringement. Section 113 of the Industrial Property Act provides for a fine of not more than KES 50,000 and imprisonment of between 3-5 years.

Further, the industrial property Act provides for the establishment of Kenya Intellectual Property Institute (KIPI) and sets out its statutory functions as Granting original intellectual property rights, Screening technical transfer agreements and licenses, providing the public

⁵⁰ Sihanya (2007) "Patent law and practice in Kenya," in *International Review of Intellectual Property and Competition Law*, Vol 6/2007

⁵¹ *ibid*

⁵² According to section 21(1) of the Industrial Property Act, 2001 an invention means a solution to a specific problem in the field of technology.

⁵³ *ibid*

with intellectual property information for technical and economic development and, Promotion of inventiveness in Kenya.

The role of KIPRI in enforcing intellectual property rights in Kenya will be discussed in details later on in this chapter on the use of administrative measures to combat intellectual property infringement through administrative enforcement of IPRS.

2.6 International Instruments

In the bid to effectively enforce intellectual property laws in Kenya, Kenya complies with various international instruments which she has ratified. This is strengthened by Article 2 (6) of the Constitution of Kenya, which is to the effect that any treaty or convention ratified by Kenya forms a part of the laws of Kenya. Kenya has ratified various treaties which contains provisions on the effective enforcement of IPRS, These include:

- Agreement on Trade Related Aspects of Intellectual Property Rights, Apr.15, 1994.⁸²
- Madrid Agreement Concerning the International Registration of Marks (June 26, 1998).
- Patent Cooperation Treaty, June 19, 1970
- Berne Convention for the Protection of Literary and Artistic Works, September 9, 1886.
- Paris Convention for the Protection of Industrial Property, March 20, 1883.
- WIPO Copyright Treaty, December 20, 1996.

In conclusion therefore, It is my findings that in Kenya there exist well established legal framework which is aimed at ensuring effective enforcement of intellectual property rights and which includes, the Copyright Act Cap 130, The Trademarks Act Cap 506, the industrial property Act 2001 and the Anti-counterfeit Act 2001. It was also the research finding that the Constitution of Kenya, 2010 constitutionalizes the intellectual property law by bestowing upon the state the responsibility to support, promote and protect intellectual property rights. Additionally the study also found out that in the bid to ensure effective and maximum enforcement of IPRS, Kenya has ratified various international instruments which are also aimed at combating IPRS infringements.

Therefore we can confidently say that there is no question as to the presence of an elaborate legal framework in place in Kenya for ensuring effective enforcement of IPRS. However we find that most of the laws are faced with challenges when it comes to implementations and

therefore needs reforms and amendments in order to fill the loopholes that we have already discussed above on the limitations of the various legislations. The answers to the said limitations will be seen later in chapter five of this study.

2.8 ADMINISTRATIVE ENFORCEMENT MECHANISM OF INTELLECTUAL PROPERTY RIGHTS IN KENYA.

This part of the research discusses the enforcement mechanisms of the intellectual property laws with specific reference to administrative measures put forth to ensure effective enforcement of this rights in Kenya and evaluating how adequate or effective they are. In addition this chapter will also look at the role of the police, judiciary, rights holders and the public as well in an effort to ensure effective enforcement of intellectual property rights in Kenya. Consequently, this chapter will also address the main challenges encountered by the enforcement agents in a bid to have a smooth enforcement mechanism of intellectual property laws in Kenya.

2.8.2 The role of the managing director of the Kenya industrial property in ensuring effective enforcement of IPRS in Kenya.

In discharging and implementing the functions of the Kenya Industrial Property Institute, the Managing Director makes the decisions to grant or not to grant industrial property rights. He also makes the decisions to register or refuse to register technology transfer agreements and licenses. The reason for this exercise is to ensure that industrial property rights which were registered earlier are not infringed.

The Managing Director also conducts opposition hearings against industrial design applications whenever an application to register a design is objected⁵⁴. In the discharge of these functions, decisions are made. These decisions determine the nature and extent of claims recognized with regards to patents, utility models, industrial designs and technovations.

One of the decisions made by the Managing Director of KIPI in Kenya is in the matter of *Industrial Design Application No. KE/D/2009/00940* entitled “Juice Bottle” in the name of Malplast Industries Ltd. In this case, the managing director rejected an application for industrial design citing that the dog bottle was a substantial reproduction of the monkey bottle

⁵⁴ Opposition hearings happen where person wishes to oppose the registration of the trade mark in Kenya.

which had already been registered. The managing director further went ahead to lay down the criteria for establishing novelty in designs, and stated that, "*In assessing the novelty of a design against a prior design there are certain areas that must be looked at to distinguish the design in a suit against the one cited as the prior art. Each of these elements that are subjective in nature will be looked at individually; Are the differences "immaterial details"? ,Are the differences merely in features which are variants commonly used in trade? ,Does the design possess individual character? ,Does the design have a visual impact and/or an overall impression distinctive from that of the prior art?*"

This shows that in discharging his duty as stated above, the Managing Director protected the existing industrial design against any form of infringement.

2.8.3 The Role of the Registrar of Trade Marks

The Register of trademarks presides over matters involving specific aspects of trade marks in Kenya. This includes trademarks searches, screening of trademarks licenses, assignment of trademarks and general advisory opinions on registrability of Trade Marks.

The Registrar can also preside over opposition hearings and has power to award to any party such costs as he may consider reasonable. The Registrar can also direct how parties are to be compensated. Any such order may be by leave of the Court or a judgment thereof maybe be enforced in the same manner as a judgment or order of the Court to the same effect⁵⁵.

To this end the Registrar of Trade Marks has made several decisions that have greatly influenced the protection of Trade Marks, in a way that has increased vigilance in combating counterfeit trade in Kenya. Of particular significance is the registrar's decision in the case of *Stripes Limited v. Hair Zone Inc*⁵⁶. Where the Registrar of trademarks addressed the controversial issue of protection of well-known marks in Kenya. In his ruling, the registrar pointed out that being a well-known mark is not an expressly stated ground for refusing registration of an unregistered or a registered mark he further noted that, under sections 14 and 15 of the Trade Mark Act, a well-known mark may be a ground to disentitle a mark to protection in a court of justice and that an applicant attempting to register a well-known mark may be prohibited on the ground of likelihood to deceive or confuse the purchasing public. The registrar stated that unlike in the normal opposition case under section 14 and 15 of the Trade Marks Act, the burden of proving the existence of reputation and goodwill and whether

⁵⁵ Section 45(1) of the Trade Mark Act

⁵⁶ Trade Mark Opposition Case No. 50148 for TMA No. 50149.

a mark is well known in Kenya lies with the proponent that the mark is well known. The Registrar ruled that in order to determine whether a mark is well known in Kenya, guidance shall be taken from the Joint Recommendation Concerning Provisions of the Protection of Well-known Marks⁵⁷.

Such decisions are very significant and have underlined the function of trademarks as a distinguishing guise and left no doubt that the registrar has a duty to the public to ensure that they are not deceived into buying products erroneously believing them to be what they are actually not.

However it should be noted that the office of the registrar of trademarks limits effective enforcement in that he is also the chief administrator of KIPi, the Registrar of Trade Marks and the secretary to the Board of KIPi. This poses a major challenge in proper discharge of his duties. For purposes of efficiency and professionalism, the Managing Director may not be able to satisfactorily discharge his professional duties to the optimal capacity expected of him due to his several responsibilities.

2.8.4 The Kenya copyright board (KECOBO)

The Copyright Act in a bid to enhancing enforcement of IPRS established the Kenya Copyright Board (KECOBO) whose mandate is the overall administration and enforcement of copyright and related rights in Kenya. Some of its mandate includes.: Directing ,coordinating and overseeing the implementation of the laws and international treaties and connections to which Kenya is a party that relate to copyright and neighboring rights, Licensing and supervising the activities of collective management, Enlightening and informing the public on matters relating to copyrights ,Maintaining an effective data bank on authors and their works and Devising promotion , introduction and training programs on copyright and related rights to ensure constant improvement and effectiveness

To this end, the board has established an enforcement department which consists of the legal and enforcement units. The legal unit currently consists of five legal counsels who have been appointed as copyright prosecutors under sec.43(1) and eight police officers from the Kenya police appointed under sec. 39 as copyright inspectors. Sec.39 is to the effect that only the Kenya copyright board may appoint the copyright inspectors.

⁵⁷ As adopted by the Assembly of the Paris Union and the General Assembly of WIPO on 10th to 29th September 1999

The Kenya copyright board has worked together with individual rights holders associations such as the recording industry association of Kenya (Riak) as well as major companies such as Microsoft, multi choice Kenya, adobe auto desks among others in a bid to raise awareness of intellectual property rights to members of the public.

The Kenya copyright board also receives complaints and carries out the relevant investigations before carrying out raids and confiscating the infringing copies before prosecuting the matters in court. Once the matter has been determined as per the court orders, the Kenya copyright board then destroys the infringed materials.

2.8.5 The Anti-counterfeit Agency

The anti-counterfeit agency (ACA) was established under the anti-counterfeit Act 2008 as a state corporation with the mandates to enlighten and inform the public on matters relating to counterfeiting, combat counterfeiting, trade and other dealings in counterfeit goods, devise and promote training programs to combat counterfeiting and co-ordinate with national, regional or international organisation involved in combating counterfeiting.

The anti-counterfeit agency deals with various legal actions concerning counterfeit cases reported to the agency. Most of these cases are reported by various sectors badly hit by counterfeit activities. This includes manufacturers, importers, traders and even the consumers. The law states that when found guilty, the counterfeiters are legible to a fine five times the value of goods or not less than fifteen years in prison.

In discharging its functions, we find that the Anti-counterfeit Agency is faced with major challenges, one, the Anti-Counterfeit Agency cannot effectively handle counterfeit cases because of its limited power as they have to seek court's directions in counterfeiting disputes. In addition, they do not have the ability to prosecute cases that they have initiated as under section 30 (1) of the Anti-Counterfeit Act, the Attorney-General appoints public prosecutors for the purposes of counterfeiting cases and therefore the role of the prosecution lies under the office of the attorney general .They therefore end up forwarding the case to the appointed public prosecutor who has no facts on the case.

Additionally, the Anti-Counterfeit Agency has no powers to settle disputes out of court. Currently the court cases are taking too long to be resolved. A better legal framework for disposing smaller cases would therefore enhance the turnaround time, including saving on

unnecessary costs when it comes to settling such cases else, If such powers can be vested to the Anti-Counterfeit Agency then this would expeditiously dispose counterfeit cases.

For efficient enforcement the agency can borrow a leaf from Tanzania where the Fair Competition Commission⁵⁸ is given powers to settle matters out of court, impose fines and destroy counterfeit goods. Indeed most of the counterfeit cases in Tanzania are resolved administrative approach.

2.8.6 Border Measures as an Administrative Action to Enforce intellectual property Laws

Another form of administrative action employed in Kenya to curb infringement of IPRS and especially counterfeit trade is border measures. Border measures are those actions taken by the local customs authority regarding goods under their control in particular but not exclusively at the exit and at the entrance of goods in the internal market⁵⁹. Article 51 of the TRIPs Agreement requires Member States to enable a right holder, who has valid grounds for suspecting that the importation of counterfeit trade mark or pirated copyright goods, to lodge an application in writing with the competent authority, administrative or judicial for the suspension by the customs authorities of the release into free circulation of such goods.

Kenya is a member of the World Trade Organisation and as such bound by the Article 51 of the TRIPs Agreement. In implementing the same, the Kenya Revenue Authority (KRA) has set up a specific unit to deal with counterfeits and smuggling, called the Anti-Counterfeits and Smuggling Unit. This unit is charged with the task of ensuring that no counterfeits or smuggled items are imported to Kenya.

They also seize suspected products at the ports of entry and prosecute importers this is as provided for under the East Africa Community Management Act, 2012 which is to the effect that the Commissioner of Customs is given powers to compound cases where an importer of prohibited goods admits offence in writing. In this case the goods are forfeited and the

⁵⁸ The Fair Competition Commission (FCC) is an independent government body established under the Fair Competition Act, 2003 (No. 8 of 2003), to promote and protect effective competition in trade and commerce and to protect consumers from unfair and misleading market conduct. The ultimate goal of the Act is to increase efficiency in the production, distribution and supply of goods and services.

Commissioner imposes a fine on the importer. This fine is half the value of Goods or USD 10,000.

However, border measures in Kenya have also faced a number of challenges. First, the law on border measures is inadequate. Section 34 of Anti-Counterfeit Act, 2008, provides for border enforcement mechanisms by stating that the owner of an intellectual property right may apply to the Commissioner only when he has valid grounds for suspecting that the importation of counterfeit goods may take place.

It is my argument that these provisions do not establish a solid scheme for border enforcement procedures as the law is silent on border enforcement measures as far as exports and goods in transit are concerned thus creating a loophole for counterfeiting trade in exports and goods in transit.

Secondly, the commissioner can only take action after receiving a complaint from the right owner who suspects importation of counterfeit goods. This shows that if the right owner is not aware of the illegal importation then the counterfeit goods will be allowed into the country.

Thus to enhance effectiveness on the border measures ,border information sharing is necessary. This information should be supplied not only by the rights owners but also institutions charged with the responsibility of enforcing intellectual property laws.

Custom risk assessment tools can also be employed to enhance border measures. For example, given the great differences in prices between authentic and counterfeit products, a system can be set up to flag up any imports of certain products that fall below a certain declared value. The Custom risk assessment approach has been employed by the U.S Government. This has enhanced their border and homeland security⁶⁰ and may also be implemented in Kenya.

2.8.7 Industrial Property Tribunal

The Industrial Property Tribunal (IPT) is also charged with the responsibility of enforcing intellectual property rights in Kenya. It is established under Section 113 of the Industrial

⁶⁰ U.S Customs and border protection (2012-2016) Border Patrol Strategic Plan at http://www.cbp.gov/sites/default/files/documents/bp_strategic_plan.pdf (assessed on 4/9/2014)

Property Act. The main functions of the tribunal are hearing and determining appeals where provision is made for appeals from the decisions of the Managing Director under the Industrial Property Act and exercising the other powers as conferred on it by the Industrial Property Act⁶¹.

In exercise of its jurisdiction and powers, the IPT has rendered several landmark decisions particularly on the standard of protection of Industrial Designs where it has sought to widen public space for innovation. For instance, in the case of *Power Technics Limited v. Power Engineering International Limited*, the Requestor, Power Techniques Limited filed a request under Section 106 of the Industrial Property Act seeking an injunction to prevent infringement of its registered Industrial Design No. 296. In its Statement of Case, the Requestor stated that it had designed Sectionalized tapered columns for street lighting sometime in 1998 and supplied them to various customers in Kenya and Tanzania. It was alleged that the Respondent had infringed the Industrial Design No. 296 by making, manufacturing and selling similar or identical streetlights. The Respondent's reply was that the Requestor's invention in Design No. 296 was not obvious, as it did not involve any inventive step having regard to what was common knowledge at the date of the application.

The Industrial Property Tribunal found that the Respondent had not infringed the design expunged Industrial Design No. 296 from the register stating that the evidence showed that tapered Sectionalized street poles were in existence in Kenya and elsewhere prior to Design 296 being registered. The Tribunal concluded that the evidence on record left no doubt that the invention embodied in Design 296 was in the public domain well before it was registered.

In carrying on its duty of enforcing IPRS, the IPT experiences challenges in their operation.

First, the location of the tribunal is an issue. Out of the 47 counties in Kenya, the Intellectual Property Tribunal only sits in Nairobi County. This means that any person desiring to litigate before it in any other part of the country must travel to the city. Obviously, the cost implications of this are high thus low incentive to right owners.

Secondly, the sittings of the tribunal are discretionary as it sits at such times as it may appoint. In practice the Tribunal's sittings are not as frequent and consistent as they should be. There is no known calendar of sittings of the Tribunal and neither do the Tribunals have a fully equipped and functional registry that administers matters before it. Instead the Tribunal

⁶¹ The Industrial property tribunal has powers to confirm, set aside or vary the order or decision in question, exercise any of the powers which could have been exercised by the Managing Director in the proceedings in connection with which the appeal is brought and make such orders as to costs as it may deem fit

operates with a secretary who must be a legal officer and who therefore administers the Tribunal's matters. The discretion to decide when to sit coupled with the fact the members are not employed on a full time basis greatly affects their capacity and commitment to the proper functioning of the Tribunal and this in turn impacts on the quality of rulings and decisions of the Tribunals. Lastly, the tribunals do not have a law reporting system for cases decided by it. The lack of a systemic law reporting system mainly hinges on the poor resource allocation to the institute and negatively impacts on the certainty of the law and affects the confidence of litigants who litigate before it.

2.8.8 Role of industry organizations

There are several industry organisations in Kenya consisting of various rights holders who deal with enforcement of their members' rights and offer work with the Kenya copyright board. Together they identify the areas where there is rampant infringement of copyright and provide the information to the Kenya copyright board to investigate and prosecute.

A good example is the recording industry association of Kenya (RIAK) which has been very instrumental in identifying the hotspots for unauthorized commercial use of copyright works and their members are enjoying the benefits of a good enforcement system.

2.8.9 Amnesty

The Kenya copyright board has in recent past worked with various organizations to create awareness and build respect for copyright and related rights in Kenya. This has been done via organizing campaigns during which users are given an opportunity to regularize their works and get discounts for purchasing genuine works.

During the amnesty period, the Kenya copyright board suspends any enforcement operations on the works until expiration of the amnesty campaign. This has proved successful and has been done with aid of other organizations such as adobe, and auto desk in the recent past.

2.8.10 Role of the police

The mission of the national police service is to uphold the law, maintain order and keep the peace by working in partnership with the community in order to protect, life, prosperity, prevent crime and disorder, detect and apprehend offenders among others. Copyright is a private right and therefore the state or other enforcement agents are under no legal obligation to initiate investigation and act on infringement on their own. It is therefore the right holders or the person whose rights have been infringed to lay a complaint to the police.

The police mandate on enforcement of copyrights in Kenya is seen under **sec. 39** of the Copyright Act which provides the board with powers to appoint copyright inspectors to conduct investigation and work closely with the police officers who are based at various stations.

The police officers gets their mandate from **sec.39 (a)** which is to the effect that a police officer may perform functions of a copyright inspector under the act.

Sec 40 empowers the copyright inspector to enter and search any premises within which infringement is suspected to be on going. upon such entry the police officer may, inspect articles appearing to be copyrighted works; inspect plant or copyright works; inspect plant or equipment used or intended to be used for production or manufacture the work; seize any article suspected of being infringing and documents that may be required at the proceedings, gather evidence and general scene management and issue an inventory of seized goods documents specifying items as soon as practicable.

Under **sec. 42** of the copyright Act; police are empowered to arrest without warrant any person suspected of committing an offence under the Act. This provision reinforces the general police power to enforce any law under **sec. 14** of the police Act.

Under the law the investigating officer is the custodian of exhibits. In cases investigated by **(KECOBO)** appointed copyright inspectors, the exhibits remain in their custody until the matters-are heard and determined.

2.8.11 The Anti Piracy Security Device,(ASPD)

The identification of copyright works and the distinction between the genuine copyright works and the infringing works especially in the film and music industry has been a major problem. This is made possible by the digital technologies which allow for perfect or wear perfect copies of the works.

In the year 2010 as per **sec. 36** of the copyright Act, the Kenya copyright board introduced the anti-piracy security device (ASPSD) in the form of a hologram and bar code sticker. This are affixed onto the audio or visual works before they are released to channels of commerce. Any works that are found to be without the ASPSD are presumed to be infringed.

However one of the biggest challenges facing implementation of ASPSD is the resistance of the same by various retailers of music and film, cds, dvds and vcds.

Secondly the rights holders have been reluctant to purchase the ASPD stickers due to the rampant levels of unauthorized commercial use of their works and the extra costs of the ASPD which makes their work more expensive.

However in 2011, the purchase price for the ASPD was reduced from ksh 10 to four (4) shillings and this has led to a significance increase in the sale of the ASPD stickers with more rights holders appreciating the importance of the same as a tool to fight unauthorized commercial use of their works.

2.8.12 Training and awareness creation:

The enforcement department is also involved in the training and awareness creation to ensure compliance and respect for intellectual property rights.

The Kenya copyright board has also developed several manuals and other training materials used to facilitate these session. The enforcement team also makes appearance on radio shows, have interviews of both the print and electronic media and engage the rights holders and users on social media such as twitter as well as face book.

Additionally the Kenya copyright board website also offers relevant material and regular updates as well as a quick responses system which handles online queries.

2.8.13 Judicial Authorities

Judicial authorities play a pivotal role in the general organization of modern societies. The more that role is efficient, the more stability will prevail and social tension diminishes. Under the modern scheme for copyright and related rights management, courts assume a subsidiary role in enforcement to administrative agencies.

Intellectual property cases are majorly brought to court as either criminal or civil cases depending on the nature of the infringement and offense committed. The difference between the two lies in the remedies available. Civil remedies include Anton Piller Order, injunction, damages and delivery up. In criminal the penalties are fines and imprisonment. The judiciary as the guardian of the law has therefore a constitutional prerogative to interpret and enforce all the laws of the land; in this vein the role of the judiciary and public prosecutors in the context of intellectual property is ;

- To guarantee the existence and the scope of the rights in the protected subject matter.
- To ensure that the rights can be property enforced and infringers punished.

- Through the successful conclusion of IPRS cases particularly cases of transnational crimes providing a strong disincentive to non-compliance of the environmental laws.
- The judiciary also provides access to the public and civil society to judicial procedures.
- Meeting out sentences, fines and orders for destruction of exhibits. This ensures punitive measures thus discouraging other would be offenders.

These two modes of judicial enforcement are faced by various challenges. The major challenge facing civil enforcement is the cost involved. Moreover, the remedies available are not adequate. Whereas injunction is preferred in intellectual property cases, most counterfeiters end up closing the businesses and opening another.

The challenges facing criminal enforcement of anti-counterfeit law is the penalties provided for. The Penal Code provides for a maximum of two years and unspecified fine. The Anti-Counterfeit Act does not provide for a minimum penalty thus leaving too much discretion to the court which can easily be abused.

CHAPTER THREE

3.0 INTELLECTUAL PROPERTY FRAMEWORK ON COPYRIGHTS, TRADEMARKS AND PATENTS, CURRENT ENFORCEMENT METHODOLOGY AND CHALLENGES FACED IN UGANDA.

3.1 Relevant Statutes and Governing Bodies

The legal instruments that govern copyrights, trademarks and patents in Uganda are: The copyright and neighboring rights Act. no. 19/2006, The trademarks Act 2010, Uganda National Services Registration Services Bureau Act, and the industrial property Act, 2006.

In Uganda there are a number of institutions (both public and private – but mostly public) that are responsible either directly or indirectly for intellectual property policy formulation, information dissemination, administration and enforcement but the key institutions in this regard are:

- i. The registrar general's office (ministry of justice)
- ii. Uganda national council for science and technology (operating under the auspices of the ministry of finance, planning and economic development).
- iii. Uganda law reform commission (ulrc) and
- iv. Uganda National Bureau of standards⁶²

Apart from dealing with matters related to patents, the office of the registrar general is also empowered to handle intellectual property matters of other statutes apart from the patents Act, like, the trademarks Act.⁶³

The copyright and neighboring rights Act, 2006 provides that the minister may on the recommendation of the Uganda registration services bureau of Uganda appoint a registrar of copyright under section 41(1). Section 42 provides that the registrar's office shall be the national copyright information centre and the functions of the registrar are:

- i. Process applications for licenses to be issued by the minister
- ii. Register works and productions to be registered under the Act
- iii. Register collecting societies.
- iv. Give guidance to discipline collecting societies.
- v. Register assignments, licenses and transfers of copyrights.
- vi. Register copyright contracts relating to exploitation of rights;

⁶²Wangwe s et al, country case study for study 9: institutional issues for developing countries in ip policy making, administration and enforcement, Uganda pg 9.

⁶³ ibid

- vii. Provide copyright and neighbouring rights information service to the public users of copyright works
- viii. In collaboration with the collecting societies, advise government, on matters relating to copyright and neighbouring rights.
- ix. Perform any other duty or function relation to copyrights, neighbouring rights and collecting societies as may be necessary for better functioning of this act or as the minister may by regulation prescribe.

The Uganda registration services bureau also designates an office for a registrar of trademarks who shall maintain in their office a manual register of trademarks.⁶⁴

3.2 Enforcement Methodology

In order for a work to qualify for copyright protection, there are certain requirements which it has to meet which are: The work must be original, and is reduced to material form which implies that ideas are not protection but their expression.⁶⁵

Under section 6, ideas, concepts, procedures, methods or other things of a similar nature are not protected by copyright. Protection by copyright usually arises as soon as these conditions are met and is not subject to any formality as provided under section 4(2) of the copyright and neighboring rights Act.

Infringement of copyright or neighboring rights occurs where without a valid transfer license, assignment or other authorization, a person deals with any work or performance contrary to the permitted free use and in particular where that person permits another person to;

- i. Reproduce, fix, duplicate, extract, imitate or import into Uganda otherwise than their own private use.
- ii. Distribute in Uganda by way of sale, hire, rental or like manner or
- iii. Exhibit to the public for commercial purposes by way of broadcast, public performance or otherwise.

Further the use of a piece of work in a manner prejudicial to the honor or regulation of the author is also an infringement of the right of that owner's right.⁶⁶ Any person whose rights are in imminent danger of being infringed or are being infringed may institute civil proceedings in the commercial court for an injunction to prevent the infringement or prohibit

⁶⁴ Trademarks act, 2010 sections 1&2(1)

⁶⁵ Copyright andneighbouring rights act, 2006 section 4(1)

⁶⁶ Copyright and neighbouring rights act section 46

the continuation of the infringement. The grant of such injunction shall not affect their claim for damages in respect of losses they sustain as a result of said infringement.⁶⁷

Additionally a person who sustains damage because of infringement of their rights may claim damages against the person responsible for such infringement whether they have been prosecuted successfully or not.⁶⁸ The aggrieved party may pray for general and exemplary or punitive damages. In a claim for general damages, the courts will be satisfied with evidence of the infringement and award such a sum that will restore the plaintiff in the position they would have been if no infringement occurred. Where the defendant is proved to have consciously planned and carried out the infringement, court may on top of awarding General damages award punitive or exemplary damages.

For instance ,In *Uprs v.Mukubira fred*,⁶⁹ it was held that in assessing damages, court may take into account the amount in terms of royalties that the plaintiff would have charged the defendant if they had a licences or an agreement.

A right owner may also make an ex-parte application and court may in chambers make an order for the inspection of or removal from the infringing person's premises the infringing materials which constitute evidence of their infringement.⁷⁰ These are known as Anton pillar orders, the infringer may also be ordered by court to make an account accounting for the profits they have made from the infringement of a copyright and surrender the same to him/her.

Under section 47(1) of the copyright and Neighbouring Rights Act , a person who without the authorization or license from a right owner or their agent; Publishes, distributes or reproduces the work, Performs the work in public, Broadcasts the work, Communicates the work to the public, or, Imports any work and uses it in a manner which, were it work made in Uganda would constitute an infringement of copyright, commits an offence and is liable on conviction, to a fine not exceeding one hundred currency points or imprisonment not exceeding four years or both.

This is one of the provisions made under the Act for criminal sanctions against copyright infringers. Other provision is seen under section 47, section 48, 49 and also provide, for a fine, imprisonment or a combination of both for various offences.

⁶⁷ Ibid section 45(1) & (3)

⁶⁸ Ibid section 45(4)

⁶⁹ Miscellaneous application number 818 of 2003

⁷⁰ Ibid section 45(2)

3.3 Trade Marks

Under Sec. 2 of the trademarks Act, 2010 a trademark is defined to mean sign or combination of signs capable of distinguishing goods or services of one undertaking from those of others and is capable of graphic representation.⁷¹

There are certain general requirements that should be met before a trademark can be registered. Where the sign is not inherently capable of distinguishing goods or services, qualification for registration then depends on distinctiveness acquired through use.⁷²

The extent to which a trademark owner may prevent unauthorized use of trademarks which are the same as or similar to their trademark depends on various factors such as whether its registered, the similarity of the trademark involved, the similarity of the products and or services involved and whether the trade is well known.

For a trademark that has been registered, it is much easier for the owner to show their rights and enforce them through an action for infringement⁷³.

For trademarks that are considered to be well known, infringement may occur where they are used in relation to products or services which are not the same or similar to those for which the mark(s) are registered.

If a trademark has not been registered, common law jurisdictions offer protection for the goodwill of the business which attaches to unregistered trademarks through the tort of passing off.⁷⁴

Infringement of a trademark occurs where an unregistered proprietor of the trademark or a non registered user uses a mark identical which so resembles it that it is likely to deceive or cause confusion in the course of trade relations to any goods with respect to which it is registered. In *East African Tobacco Ltd v The Colonial Tobacco Co. Ltd*,⁷⁵ it was held that if a manufacturer sells goods in a get up which so nearly resembles that of another person so as to enable their goods to be sold as those of that other person, the manufacturer puts an instrument of fraud into the shopkeeper's hands and will be liable for infringement. Under section 36 of the trademarks Act, a person who not being the owner of trademark or its permitted user by registration infringes when they use a mark identical with or so nearly

⁷¹ Trademarks act, section 4(1) & (3)

⁷² Ibid section 4(2)

⁷⁴ Ibid

⁷⁵ (1939) EA pg. 6

resembling it as to be likely to deceive or cause confusion in the cause of trade in relation to any goods of the same description.

There are three criteria to determine similarity between signs and the presence of one is enough they are:

- i. Conceptual similarity, this is determined by comparing the sign with the prior sign. If there is artistic similarities or they the same meaning, then the requirement for novelty has not been met and the mark will not pass.
- ii. Visual similarity, if the physical appearance, for instance the design, of the two marks would appear similar to the average consumer, then the sign will not pass.
- iii. Phonetical similarity, this is considered by looking at the pronunciation of the two marks and if they sound similar, it shall not pass.⁷⁶ An example could be seen from the case of London *Overseas Trading co. Limited v. Raleigh Cycle co. Limited*,⁷⁷ the issue in question was whether the word 'lale' was phonetically identical to the word Raleigh and whether it would cause confusion. It was held by Dudley Mckisack that the word lale would be confused with Raleigh and if it were allowed registration, members of the public would be deceived into purchasing bicycles or parts which are connected to the applicants when they intended to purchase those that are connected with the opponents in the cause of trade.

Other instances of infringement may occur where a purchaser or owner of goods has undertaken to do the following but goes ahead and does so:

- i. Applying the trade upon is on the goods, the alteration and part removal regards to their state, condition, get up and packaging.
- ii. Where the trademark is on the goods, the alteration and part removal or part obliteration thereof.
- iii. Where the trademark is on the goods, the application of any other trademark to the goods and
- iv. Where the trademark is on the goods, the addition to the goods of any written material likely to injure the reputation of trademark.⁷⁸

⁷⁶ Ibid

⁷⁷ (1959) ea 102

⁷⁸ Ibid

Section 81 of the trademarks Act, provides that in addition to any respect of offences committed in an action for infringement, relief may be by way of damages, injunctions, accounts for profit or otherwise shall be available to plaintiff as in any other corresponding proceedings in respect of other proprietary rights and in that action, the court may give such orders as necessary to; Enable the plaintiff to obtain evidence of an infringement which they intend to adduce at the trial, Prohibit the defendant from removing their assets from the court's jurisdiction or otherwise wasting them, to the extent that those assets are necessary to satisfy the plaintiff's claim if they succeed at the trial.

Injunctions are granted to restrain further infringement while damages are awarded to enable the owner to recover financially what they lost as a result of the infringement and in the case of exemplary/punitive damages to punish the infringer and make an example of them. Delivery up on the other hand is where the defendant is ordered to take all the infringing material in his possession to the plaintiff for destruction or otherwise.⁷⁹

Trademarks can also be infringed via a common law tort known as passing off. Its origins lie in the tort of deception, however passing off does not depend upon any fraudulent intent by the defendant. The case of **Perry v. Truefit**,⁸⁰ laid down the basic underlying principle of a passing off action where it was stated that a man is not to sell his own goods under the pretence that they are the goods of another man....it protects the good will of unregistered trademarks in the case of infringement.

Passing off in Uganda is seen under Section 35 of the Trade marks Act , which is to the effect that nothing shall affect the right to an action against a person for passing off goods or services as the goods or services of another or the remedies in respect of the right action.

However ,despite the availability of litigation remedies in Uganda, Trademark owners are however encouraged to avoid litigation most of the time because not only is it quite expensive and time consuming ,but it also takes a long time in this jurisdiction due to the backlog of cases in the judicial system. They are therefore advised to explore other options first. For example , writing a letter to the infringer to cease and desist informing them that they are infringing and to stop doing so and use alternative dispute resolution methods like arbitration or negotiation.⁸¹

⁷⁹ Ibid

⁸⁰ 1842

⁸¹ Ibid

Further, apart from the civil remedies mentioned above, criminal sanctions are also available as remedies for the infringement of trademarks. However, criminal sanctions are only imposed on serious offences like counterfeiting and the unauthorized use of identical marks knowingly.

4.4 Patents

In Uganda patents are governed by the industrial property Act 2014. Sec 2 of the Act defines a patent as the title granted to protect an invention.

For an invention to be protected under the Act it must involve an invent step, be new and be capable of being industrially applicable⁸².

Sec 38 of the Act is to the effect that the owner of a patent has the exclusive right to make use, exercise, and sell the invention exclusively and may prevent any person from exploiting, the patent without his or her authorization therefore any person who does any of the aforementioned acts infringes on the rights of the patent owner.

Sec 40 the Act further provides for the remedies to a patent owner who may seek an injunction, claim damages or claim compensation from the infringer.

⁸² Sec 10,11,12 of the industrial Property Act 2014.

CHAPTER 4

RESEARCH FINDINGS

4.0 Introduction

This chapter sampled the collected data on the enforcement of intellectual property rights protection both in Uganda and Kenya. Both primary and secondary data by use of qualitative and partly quantitative data was collected; this was done by use of unstructured interviews with the selected sample within Uganda. Additionally Documents were selected, studied and analyzed on existing legal frame works. The study also relied on reviewing the relevant records and surveys on enforcement of intellectual property rights especially in Kenya since it was difficult to collect primary data in Kenya bearing in mind the limited time in conducting the research.

4.1 Study population

A sample of thirty respondents was targeted and interviewed for the purpose of this research. Bearing in mind the various limitations encountered both financially in terms of time and otherwise this number of respondents was considered adequate for the research and able to provide an all informative insight to the researcher.

4.2 Sample size and sample selection technique.

The respondents were drawn from all walks of life with some being businessmen ,lawyers ,rights holders ,students, police officers and general members of the public. The researcher also conducted in depth interviews with key personalities such as Judges , musicians. and key members of Uganda performing Rights Society who were asked predetermined questions that the researcher considered most important in order to meet the objectives of the research.

4.3 Level of education

The respondent's level of education was considered in carrying out this research in order to determine the knowledge and awareness of enforcement of intellectual property rights. In the table below forty percent of the respondents hand A level certificates, thirty percent had diploma certificates, while fifteen percent had other academic credentials which they had to specify themselves for the research report to be inclusive of everybody.

Fig . 1

Level of education	Number of respondents	Percentage
A 'Level certificate	12	40%
Diploma certificate	8	30%
Degree graduates	5	15%
Others specified	5	15%

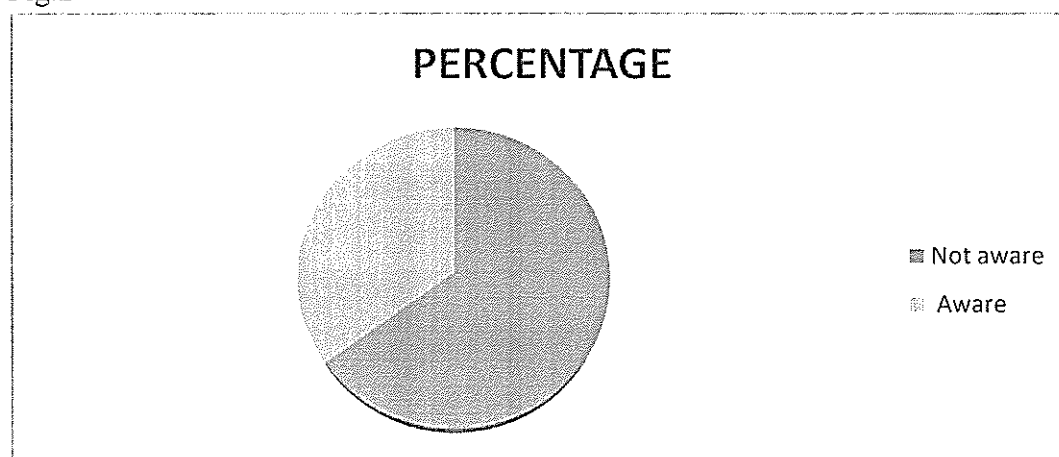
4.4 Data analysis

4.4.1 General Public awareness of intellectual property rights in Uganda.

The researcher found out that majority of the respondents did not know about the existence of intellectual property rights and laws in Uganda nor who is responsible for their enforcement. This was also noted by Hon. Justice Christopher Mandrama in an interview with the reseacher who noted that the major challenge hindering effective enforcement of intellectual property rights in Uganda was the lack of public awareness.

This information was presented on a pie chart to show the lack of the general public awareness on the existing legal framework, institution framework and general information on the enforcement of intellectual property rights. As shown below only 35 percent of the respondents were aware of intellectual property rights, how they are enforced and the impacts of infringements of the rights, while 65% of respondents were not aware. This was found to be as a result of technical nature of intellectual property rights and the laxity in the registrar general's department on creating public awareness on IPRS.

Fig.2



4.4.2 Lawyers and Judicial officers, Rights Holders and the Police on awareness of Intellectual property rights enforcement mechanisms.

This information in this section is represented via a graph.

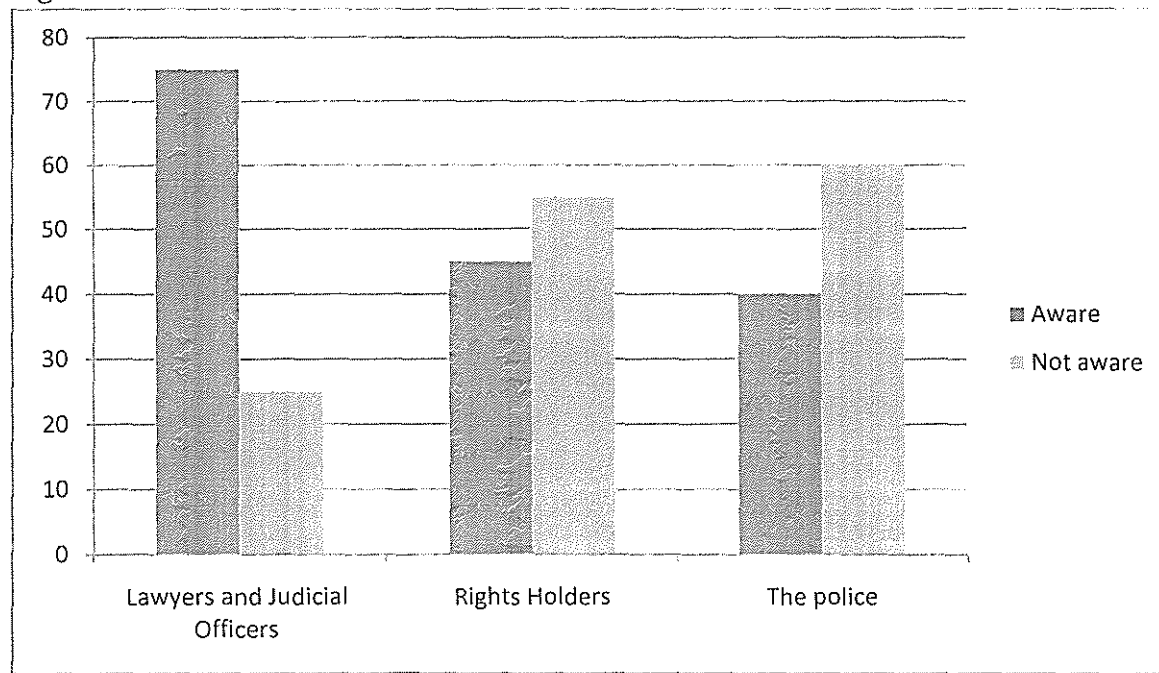
The findings reflected that 55 % of rights holders approached had no clear knowledge of what is protected and how they may benefit from such protection and therefore do not know when their rights are infringed and when to enforce such rights. The respondents did not also know about the existing legal framework for protection of their rights. The researcher observed that this was as a result of the lukewarm interest by government in popularizing the intellectual property rights legislation. This also means that enough has not been done to sensitize rights holders on matters to do with the law, its legal implications and economic advantages. However 45 % of the respondents were aware of the benefits of protection and how and where they can enforce their rights.

It was further the researchers finding that the only group of persons that seemed to understand what intellectual property Rights are and how they are enforced in Uganda are the Judicial officers and the Lawyers, some who also pointed out that the general public was generally unaware of IPRS enforcement or the legal framework in place for enforcement of such rights. It was encouraging to find out that 75% of the respondents were up to date on the intellectual property rights and their enforcement mechanisms and also the legal framework put in place for enforcement of the rights in Uganda. However, it was the researchers finding that some of the respondents approached had never dealt with any intellectual property cases.

On the other hand 25% of the lawyers approached had the knowledge of intellectual property rights but were not well conversant on the enforcement mechanisms put in place to ensure effective enforcement.

Altogether, it was surprising for the researcher to find out that the police officers who should be among the leading group on the enforcement of intellectual property rights only 40% had the knowledge of intellectual property rights and how they are enforced. 60% of the police officers had little or no knowledge at all about the existing legal framework of IPRS and some of the respondents even thought that intellectual property rights means piracy. The researcher however also found out that efforts are being made to create awareness to the police force on IPRS where the United Nations Educational, Scientific and Cultural Organization (UNESCO) is facilitating the Uganda Performing Rights Society to train officers cadets about intellectual property rights enforcement. As already noted the information was represented in a graph.

Fig 3.



4.4.3 Existing legal and institutional framework

The researcher found out that there is an existing legal framework in place in Uganda for the enforcement of intellectual property rights. Additionally there are also relevant institutions in place for the enforcement of the rights; a good example being the Uganda Registration Service Bureau and the Uganda Performing Rights Society, there is also in place the police and the judiciary who are also in place to facilitate enforcement.

In an interview carried out between the Researcher and Hon. Justice Hellen Obura, the honourable justice also categorically stated that the legal and institutional framework is in place for the enforcement of intellectual property rights in Uganda however what is really lacking is that this institutions are overstretched, underfunded and ill equipped to face up the task of addressing the question of intellectual property rights enforcement, she gave an example of the intellectual property Directorate which is within the URSB structure and which comprises of only eight professional staff responsible for IP throughout the country. She further noted that although branches have been opened in various regions of the country, the capacity of these offices are still low to address this challenge of enforcement.

Additionally ,She also noted that the regulatory framework and law reform process is slow, she lamented that to date Acts passed last year⁸³⁸⁴ do not have implementing regulations

⁸⁴ The Geographical Indications Act, 2013 and the Industrial Property Act, 2013

whereas legal frameworks for the protection of traditional knowledge, expressions of folklore and other issues bearing on IP such as unfair competition are yet to be considered by parliament.

The researcher also found out that despite the well established legal and institutional frameworks in Uganda there is very little coordination between the institutions. This is echoed by Prof. William Kakooza who cited numerous incidents of music piracy that have appeared in the local media recently but that no legal action was ever taken. He attributed this to ignorance of the law and the fact that there is a weak coordination between the registrar General's office and the outside agencies⁸⁵.

4.4.4 Challenges facing effective enforcement of intellectual property rights in Uganda

4.4.4.1 Civil remedies

It was the researchers finding that in Uganda there is lack of minimum fines and civil remedies available to rights holders whose rights have been infringed. Mostly damages are based on the quantity seized which mostly usually bears no consonance with the quantity already sold by the infringer based on sales record yet for instance the infringer might have made more sales than were actually recorded.

Therefore the researcher found out that the main challenge when it comes to the award of damages is attributed to failure of enterprises to keep proper books of accounts. An example could be seen from the case of *John Murray (Publishers) Ltd and others v George William Senkindu and Newstyles Bookshop*⁸⁶, court awarded UGX 10,710,00/= for the loss suffered and a further UGX 6,000,000 as damages for the injury by the defendants illegal copying and selling of the plaintiff's book "Introduction to Biology- 3rd Tropical Edition". The assessment was based on the value of the genuine books. The result is that the right holders end up feeling that they have not been adequately compensated as it is difficult to access the amounts the infringer has already sold.

Additionally the reseacher also established that Orders for search and seizure of infringing materials are susceptible to abuse an example could be seen from the case of *Uganda Performing Rights Society Ltd v Fred Mukubira*,⁸⁷ court refused to grant a temporary

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⁸⁶ HCCS No. 1018/1997

⁸⁷ HCCS No. 818/2003

injunction made *ex parte* by a sole assignee of musical works by various artistes. It however, allowed an Anton Pillar Order for inspection and seizure of infringing material.

4.4.4.2 Criminal cases and sentencing

It was also the study findings that another major challenge facing the enforcement of intellectual property rights in Uganda is how criminal intellectual property cases are handled. It was the researcher's finding that Criminal cases are mainly heard by magistrates' courts which are not courts of record thus making it hard to assess the effectiveness of courts in Intellectual property enforcement.

The researcher also established that in the Ugandan law, infringement of copyright is not a crime and that only a civil action can result from such infringement. This makes it difficult for courts to issue deterrent measures which should serve as examples to those who intend to infringe on such copyrights.

4.4.4.3 Evidential issues.

It was the study findings that Since registrations of IP rights are low, it is hard to prove infringement and this has been a challenge to enforcement in that most rights holders end up losing cases due to technicalities yet the financial loss caused is usually very high an example can be seen from the case of *Britannia Products (U) Ltd V Riham Biscuits Industries (U) Ltd*, the plaintiff who had not registered their trademark "Tariata" could not prove that the defendant's "Jariata" was confusingly similar and or deceptive of their mark. Had the plaintiff registered their trademark, they would have been presumed owners of the mark and the burden of disproving the likelihood of confusion or deception would have been on the defendant.⁸⁸

Further evidential issues arise from lack of experience on the bar in prosecuting IP cases leading to poor case structuring of IP litigation. In *Uganda Performing Rights Society V MTN (U) Ltd*⁸⁹, the plaintiff sued the defendant to recover royalties from a concert organized by the defendant at which members of the UB40 a UK band performed. The plaintiff claimed UB40 had assigned their rights to the Performing Rights Society of the UK. Court held that the plaintiff failed to prove that the UB40 members who had performed at the defendant's concert were the same members who assigned their rights to the UK Society.

⁸⁸ In *Anglo Fabrics and Ahmed Zziwa V. African Queen Ltd and Another* HCCS 632/2006, court found that the plaintiff's registration of the mark "MEKAKO" shifted the burden of proof that the mark was likely to cause confusion on to the defendant. The defendant had failed to discharge this burden and lost the case.

⁸⁹ HCCS No. 287/2010

Court also found that the plaintiff had relied on the media and the internet reports on the gate collections to support their claim for special damages. The evidence was held to be speculative and hearsay. Court further held that the plaintiff could have made applications for interrogatories, discovery and inspection to obtain actual evidence of gate collections.

4.4.4.4 Technology

It was also the researcher's findings that there is no legislation in Uganda which provides technological developments this is important because technological advancement is a major challenge that is faced in the enforcement of intellectual property rights and especially copyrights and trademarks. For instance, It is now possible to make copies with the same quality as the originals at low cost, in the same vein the infrastructure for producing CDs and tapes require low investment and allows great mobility. In addition, copies can be easily obtained from the internet without costs to users.

It was further the researchers findings that intellectual property infrastructure such as IT tools and automation services are still in the infancy in Uganda. Systems such as online filing of applications, electronic document management are still not available making it cumbersome for would be applicants to pursue registration of their rights at the same time reducing the level of efficiency at the IP office.

It was also the researchers findings that although internet use has clearly permeated the Ugandan business community, the legal infrastructure that would enable greater use of electronic commerce is not yet in place. Most companies have registered domain names but still move with caution with regards to full exploitation of opportunities offered by the internet age.

The researcher additionally found out that Uganda's counterfeit problem is mainly aggravated by its lack of adequate enforcement of the trademark laws, weak punitive measures that instead encourage trade of counterfeit products, lack of a specific institution charged with incriminating offenders and irregularities in the companies' registration office. More so, the institutions currently responsible for enforcing the trademark Act lack adequate capacity, skills and resources to effectively contain counterfeiting. They are: Uganda national bureau of standards (UNBS), Uganda revenue authority (URA) and Uganda police.⁹⁰ This is despite the dire effects of counterfeit products to trademark owners/manufacturers, a good

⁹⁰ Oecd 1998,pg3

example could be seen from the nice house of plastics which recorded a loss of revenue equivalent to 2 million toothbrushes in the year 2004, which nearly led to closure of the toothbrush factory. This resulted from an influx of counterfeit toothbrushes on the local market that were being sold for the same price as the genuine nice toothbrushes⁹¹.

4.4.5 Challenges Facing Enforcement of Intellectual Property Rights in Kenya

On this issue the researcher mainly used secondary data collection method to gather data and came up with the following findings as to the challenges that are facing effective enforcement of intellectual property rights in Kenya.

Same as Uganda Kenya's legal and institutional framework is in place and is even more advanced with Kenya having the Anti-counterfeit Act 2003 unlike Uganda which has not yet passed the anti –counterfeit bill, additionally the role of the Registrar in Kenya is effectively felt as he has such powers as to hear opposition and expungent proceedings, there is also the KECOBO which is the board that deals with the enforcement of intellectual property rights and also creating awareness to members of the public on how they can enforce their intellectual property rights. To crown it all the Kenyan government has shown its willingness to support the enforcement of intellectual property rights in the country by recognizing the rights in the Supreme law which is the constitution of the Republic of Kenya 2010. However even with such an admirable legal and institutional framework there are rampant cases of piracy, counterfeiting is the order of the day and also infringement in technology. The researcher therefore found the following as the main factors hindering effective enforcement of IPRS in the country.

It was the research findings that, It is no secret that the state, intellectual property offices and other government agencies that deal in intellectual property related areas is over stretched, under funded and ill equipped as it takes on the task of addressing all issues faced in the changing world of intellectual property. For instance, the public servants working in the intellectual property offices in Kenya are never more than 100 in number and yet they are expected to serve a country of close to 50 million inhabitants. These public servants are required to attend to the day- today administration of the secretariat, receive complaints, carry investigations, conduct raids, make arrests, prosecute cases in court, conduct awareness campaigns, train workshops, forums and seminars, liaise with, negotiations and formulation of intellectual property instruments and policies, among many more.

⁹¹ Nice house of plastics suffered record loss in 2004 due to counterfeiting which nearly caused the factory to be closed down. As a result, the job security of many employees of the company was threatened.

Additionally, it was the study finding that the ease in which music can be produced, published, transmitted, and copied over the internet and computer networks has created massive challenges in copyright protection and promotion and enforcement. Many websites offer music for sale through e-commerce, for example the purchase of actual music CDs and DVDs which are then delivered to the buyer and some sites enable consumers to download music at a cost, among others.

Further as was noted from the data collected in Uganda, despite having in place an adequate legal framework of intellectual property, the level of public awareness on intellectual property has remained low. Many people in government, industries, universities, research and development institution and the ordinary citizens and even would be beneficiaries cannot differentiate between, for example, patents, industrial designs and utility models for instance, people questioned why business names are registered at the attorney general's office, whereas for trademarks one has to go a different IP office do not have an idea of the difference between the two offices. This low level of awareness is a clear indication for the need of intellectual property education in the country.

Another major challenge is when it comes to trademark registration, the researcher found out that, at this moment in time, when one applies for a trademark, the Registrar of the trademarks does not consult with other registries, and especially with the registrar of companies, on the availability of the trademark as there is no interlink between registries. It is therefore possible that one might run into problems when he realizes that he or she has registered a trademark yet somebody else has registered a company with a similar name.

Additionally, Copyright offenders resist arrest from the police officers and in many cases may end up assaulting a police officer in the course of his or her duties.

Further, it was the researcher's findings that delay by the courts in hearing of an intellectual property case due to the lengthy time it takes to adduce evidence in court by the prosecution witnesses is a major hindering effective enforcement of the intellectual property rights in Kenya. Additionally storage of exhibit is also a challenge as they require a secure and large space especially for bulk confiscated items that must be produced in court as exhibits eg satellite, dishes, decoders, television set, dvd players, cds, dvds, computers etc.

Additionally the prosecution team also faces a number of challenges in the dispensation of their duties, lack of awareness of intellectual property laws, especially copyright legislation

by the copyright owners, users, infringers, judicial and police officers and the general public at large is a major challenge. Surprisingly the researcher established that there is Lack of prioritization of intellectual property matters by the courts as the offences are looked at as petty offences and can be dispensed with later.

Further, the burden of proving copyright infringement is often difficult partly because of the absence of well negotiated contracts between the copyright works owners and producers. Additionally same as Uganda the lack of effective criminal remedies lack the lack of maximum penalties which can act as deterrents for infringers of IPRS and potential infringers and also lack of deterrent minimum fines is a major challenge to enforcement.

It was also the researcher's findings that there is no solid scheme for border enforcement procedures as for instance the Anti-counterfeit Act does not provide for the possibility to conduct border controls to exports and goods in transit

Lastly the **basic** and most **major challenge** leading to poor enforcement of IPRS in Kenya is the disconnect between the production lines, the policies engagement and the absence of the will to enforce rights in the event of breach.

4.4.6 Comparison of the Regime and Enforcement of Copyright, Trademarks and patents In Kenya and Uganda

4.4.6.1 Similarities

Kenya and Uganda being former British colonial territories, they have similar laws because they both inherited much of it from the British. This is no different when it comes to intellectual property, particularly with regards to copyrights, patents and trademarks for the purposes of this study.

On becoming a British colony, the substance of British common law, the doctrines of equity and the statutes of general application were extended to the colony,⁹² in this case, Kenya and Uganda. The copyright Act of Uganda which commenced operation in Uganda in 1953 was based on the United Kingdom's Act.⁹³

For a while, this law was used to govern copyrights in the country, but since it had some issues that hindered proper protection of copyrights and it also needed to be aligned with the

⁹² Dr kameri-mbote p, intellectual property protection in Africa. an assessment of the status of the laws, research and policy, analysis on intellectual property rights in Kenya pg 5.

⁹³ A study report on copyright and neighbouring rights law. ugandalawreview commission, kampala Uganda (2004) law com pub no 9 of 2004 pg

trade related aspects of intellectual property rights agreement (trips) to which Uganda is a signatory, it was repealed and copyright in Uganda is now governed by the copyright and neighbouring rights Act, 2006. The copyright Act of Kenya was also based on the English Copyright Act. When the 1842 copyright Act of England was amended and passed in 1956, it was extended to Kenya by the 1963 order in council. The 1956 laws was superseded by the copyright Act cap 130 of the laws of Kenya which came into operation in 1996 which had more or less the same content. This law was amended in 1975⁹⁴, 1982⁹⁵ and again in 1989⁹⁶. These amendments were made to suit the law better to the Kenyan situation and aligning it with various international treaties. The most radical review of copyright law in Kenya happened in 2001 when the copyright act, 2001 was passed to modernize copyright law in Kenya and make it compliant with international treaties which Kenya is a signatory to, especially the trade related aspects of intellectual property rights (trips) agreement.⁹⁷

The same as Kenya, Uganda inherited copyright law from the British, they also inherited trademark law and patent law. Uganda's trademark was initially adopted from the 1938 trademark Act of the United Kingdom and came into force in 1964.⁹⁸ The trademark Law has however been amended to modernize it and make it complaint with international treaties to which Uganda is signatory, for instance, the trips agreement. Thus trademark law in Uganda is now governed by the trademarks Act 2010. Kenya's trademark Act also modelled off the British one and came into force in 1957. It has also undergone amendments to modernise it and align it with international treaties and agreements that Kenya is signatory to, like the trips agreement. It was last amended by the trademarks (amendment) Act of 2002.⁹⁹

Thus, as discussed above, not only do Kenya and Uganda have the same origins for their copyright and trademark and patent laws, they both have over the years amended their laws so that they are more modern and aligned with various international treaties and agreements to ensure better protection of the said rights. Another similarity that Kenya and Ugandan share in this particular area is that they are both signatories to some of the same international treaties relating to intellectual property. One of this is the Trade Related Aspects Of Intellectual Property Rights Agreement usually referred to as The Trips Agreement. The

⁹⁴ Ibid

⁹⁵ Ibid

⁹⁶ Ibid

⁹⁷ Ibid

⁹⁸ A study report on trademarks: Uganda law review commission kampala, Uganda (2004) law com pub no 15 of 2004.

⁹⁹ www.wipo.int/wipolex/en/kenyachapter506trademarket

Trips agreement took effect in January 1996. Unlike un conventions, all the agreements made under the world trade organisation (WTO) are automatically binding to member states. It introduced global minimum standards for protecting and enforcing nearly all forms of intellectual property rights (IPRS), including copyrights and trademarks and patents .The trips agreement requires all WTO members, with few exceptions, to adopt their laws to the minimum standards of IPR protection.

In addition to the minimum protection standards, the Trips agreement also introduced detailed obligations on the s enforcement of IPRS. All member states have to comply with these standards by modifying, where necessary, their national regulations to accord with the rules of the agreement.¹⁰⁰ Since Kenya and Uganda are both signatories to it, they have both strived to ensure that intellectual property laws are all in line with its provisons, copyright, trademark and patents included.

Kenya and Uganda are also members of the Regional intellectual property rights body, Africa Regional Intellectual Property Organisation, (ARIPO) whose headquarters are in Harare ,Zimbabwe. being members of ARIPO Kenya and Uganda benefits in enforcement of intellectual property rights within their jurisdictions since among others ARIPO aims at promoting harmonisation and development of intellectual property laws and matters related to them appropriate to the needs of its members and the region as a whole¹⁰¹.

Additionally Kenya and Uganda have both private bodies/collecting management organisations that exist to aid the enforcement of copyrights. An example in Uganda is the Uganda Performing Rights society,(UPRS) a society formed by authors to advance the cause of Copyright Administration in Uganda. An example in Kenya is the Music Copyright Society of Kenya (MCSK) which is a non –profit making collecting management organisation for authors, composer’s arrangers and publishers of musical works. Its main mandate is to collect royalties on behalf of its members and other affiliate collecting management organisations and distribute the same to them. It aims at building, mobilizing and supporting the musical fraternity within Kenya, integrating and enhancing their earnings from their work¹⁰².

¹⁰⁰ (edited by) sihanya b&wekesa m, intellectual property rights in Kenya, konradadanaeurstiftung, pg 6

¹⁰¹ Position paper, Uganda ,counterfeiting –implications on uganda’s trade marks owners and possible remedies pg6

¹⁰² www.mcsk.or.ke

Kenya and Uganda also face the similar challenges in enforcing intellectual property rights as shall be seen later in chapter 4 of this study. The rapid advancement of technology, counterfeiting and general ignorance by the public about intellectual property are just some of these challenges and because the two countries are in the same region, they both feel their effects.

4.4.6.2 Differences

One noticeable difference is with regards to public intellectual property administering organizations. Kenya seems to have more of them than Uganda does and they cover most areas that relate to intellectual property rights, copyrights, trademarks and patents and they operate with some degree of autonomy. In Uganda, these institutions are mainly located in the Attorney general's chambers.¹⁰³ In Kenya for example a section of the Attorney general's chambers handled copyrights but was more focused on the law reform aspect of it than the day to day administration which has since been handed over to the Kenya Copyright Board which was inaugurated in 2003 with an intention to delink it from the attorney general's chambers.¹⁰⁴ Between may 2003 and September 2008, the board worked under the department Of copyright in the Attorney General's chambers until it was moved to its own offices and new executive director, Dr.Marisella Ouma appointed.¹⁰⁵

The Kenya intellectual property office (KIPO) is another institutional organization which deals with enforcement of intellectual property rights in Kenya and which is lacking in Uganda. KIPO was formed in 1989 upon enactment of the Industrial property Act chapter 509 of the laws of Kenya .This Act was then repealed by the 2001 industrial property Act which conformed to the requirements of TRIPS and KIPO was renamed the Kenya industrial property institute (KIPI). KIPI has administration, technical which deals with patents, industrial designs, utility models and technovations and legal which deals with trademarks and service marks. The institute has staff strength of about eight three with technical legal staff holding at least a degree. Most of the work is processed using information technology (IT) equipment which the institution has invested heavily in and as of 2005; there was an ongoing process of getting the trademark information online.¹⁰⁶ Trademark forms and the fee

¹⁰³ Tumushabe g & naluwairo r, acode policy briefing paper no.9 of 2005

¹⁰⁴ Dr. Kameri mbote p, intellectual property protection in Africa: an assessment of the status of the laws, research and policy, analysis on intellectual property rights in Kenya pg

¹⁰⁵ www.copyright.go.ke

¹⁰⁶ Ibid

schedule among other things can be downloaded from KIPi's website.¹⁰⁷ Uganda unlike Kenya has no such institutions and their trademarks are usually registered at the Registrar of trademarks who is usually situated at the Attorney generals offices. Additionally Uganda has no body to oversee the enforcement of copyrights like the (KECOBO) in Kenya except the statutes which provides for modes of enforcement.

Additionally unlike Kenya where the registrar has powers to hear opposition and expungent proceedings, the same is not the case in Uganda where the registrars powers are limited to registering trademarks, patents, licences, assignment contracts among others but has no powers to hear and dispense such proceedings, which in one way or the other help in reducing intellectual property rights case backlog.

Additionally with regards to the protection of trademarks internationality we find that the two jurisdictions differ. Though Uganda is a member of some international agreements that relate to the protection of trademarks, she is not a member of the Madrid union (the Madrid agreement and the Madrid protocol) while Kenya is the Madrid agreement allows trademarks that are registered in one country to be registered in other countries and territories. Application under this system can be made under either the protocol or the agreement. The protocol which has been in operation since 2004 is more popular though because it has introduced a number of changes which significantly enhances its usefulness to trademark owners.¹⁰⁸ Kenya has in the process of amending the trademark law ensured that it gives effect to the provisions made under the Madrid system¹⁰⁹ and this increases the protection afforded to trademarks in the jurisdiction .If Uganda were a member of the Madrid system ,the advantage would be that after securing protection in Uganda ,one would file an international application designing member counties where protection is sought and the application would be searched by the international bureau for formalities and requirements and once the bureau is satisfied ,it register the trademark and notifies the designated states and publishes the application in a countries have the option to refuse and file a declaration to that effect within a year, then file objections stating their grounds.¹¹⁰

Further Uganda does not have the Anti-Counterfeit Act unlike Kenya , the legislation is of great importance in enforcement of the infringement of trademarks. For instance the Kenyan

¹⁰⁷ www.kipi.go.ke

¹⁰⁸ Marga p,intellectual property law 11,trademarks LLB IV lecture notes pg 28

¹⁰⁹ Dr.Kameri mbote p,intellectual property protection in Africa :An assessment of the status of the laws,research and policy ,Analysis on intellectual property rights in Kenya pg 8.

¹¹⁰ Ibid

Act establishes the anti-counterfeit Agency which mainly deals with the enforcement of trademarks in an effort to minimize anti-counterfeit trade, the Act also provided for both civil and criminal remedies as enforcement mechanisms.

Additionally in the year 2010 the Kenya Copyright Board introduced the Anti- Piracy Security Device (ASPD) which is affixed onto the audio visual works before they are released to channels of commerce. This helps to differentiate between genuine and counterfeit products. Uganda has on the other hand not adopted this method and is still lagging behind. This may be attributed to the inadequacy of technology.

Further it would also be important to note that Kenya copyright Act under sec 38 is to the effect that infringement of copyright is a crime. Offences such as making for sale infringed items, hiring infringed copies, or any other commercial distribution of infringing works and possession of contrivances that can be used for making infringing copies are criminal in nature and any person who is found in contravention of the same is guilty of the crime. However when it comes to Uganda there are no criminal enforcement mechanisms for infringements of copyrights and only civil remedies are available hence making it important for Ugandan legislature to urgently amend the law to include such criminal remedies.

In addition Unlike Uganda, Kenya has widely incorporated information technology (IT) and the internet in the system to aid with the enforcement of intellectual property rights. The Kenya copyright Board (KECOBO) and Kenya industrial property institute (KIPI) are administrative bodies that deal with copyrights and trademarks in Kenya and they both have websites from which any information regarding the above mentioned rights can be obtained. One can download forms required for registration of trademarks and view laws both local and international that relate to trademarks inter alia from the KIPI website.¹¹¹ The same is also true with the KECOBO website from where one can register online and view a copy work database inter alia.¹¹² Uganda on the other hand has no such services and is yet to modernize services like registration by making them available online like Kenya has. The IT infrastructure such as IT tools and automation services are still in the infancy. Systems such as online filing of applications, electronic document management are still not available making it cumbersome for would be applicants to pursue registration of their rights at the same time reducing the level of efficiency at the IP office.

¹¹¹ www.kipi.go.ke

¹¹² www.copyright.go.ke

From the foregoing it is evident that Kenya is better placed than Uganda when it comes to enforcement of intellectual property starting from the inclusion of intellectual property rights in the Constitution ,to a well established legal and institutional framework ,improved technological ways of improving intellectual property laws generally and also in the enforcement department. Though Uganda has also managed to have an effective legal framework the researcher found out that the institutional framework is lacking as compared to Kenya mostly on the role of the police ,mechanisms of awareness creation to members of the public, no laws on counterfeits and poor technological advancement .therefore much more needs to be done by Uganda enforcement agents in order to ensure effective enforcement of intellectual property rights in the country with Kenya being a leading example.

CHAPTER FIVE

5.0 General conclusions and recommendations

5.1 Conclusions

In the course of the study, it has been established that both Kenya and Uganda have the relevant laws and some institutions in place that exist to protect intellectual property rights in their jurisdictions. It has also been established that both countries face similar challenges in the enforcement of intellectual property rights.

It has further been established that Kenya has invested substantially in intellectual property laws and institutions ¹¹³ and this has seen Kenya's intellectual property system improve a lot. However, more has to be done to ensure that the laws in place can be enforced by the existing institutions to the advantage of those who rely on them by addressing the challenges that hinder said enforcement and reducing their negative impact.

Uganda on the other hand has worked hard to ensure that the relevant laws required for protecting trademarks, patents and copyrights are in place and has even amended them to ensure they are modern. However; much more has to be done to make enforcement of intellectual property rights in Uganda easier.

5.2 Recommendations

5.2.1 Kenya

While Kenya provides a quite advanced legal and institutional framework to ensure IP protection, the study established that deficient enforcement of the existing IP legislation continues to be a serious challenge. Therefore, Kenya should take further actions to improve its IPRs protection and enforcement regime. The study provides a set of recommendations on the protection and enforcement of IPR in Kenya.

❖ Address deficiencies in criminal IP law and procedures

For instance as already discussed in the previous chapters the Kenya's Anti-Counterfeit Act, 2008, provides criminal measures. Section 35 stipulates in the case of a first conviction the offender will be jailed for a term not exceeding five (5) years or a fine of not less than three (3) times the prevailing retail price of the genuine product or both. In the case of a

¹¹³ Dr.kameri mbote p,property protection in Africa :An assessment of the status of the laws ,research and policy ,Analysis on intellectual property rights in Kenya pg 25

second/subsequent conviction, imprisonment for a term not exceeding fifteen (15) years or a fine not less than five (5) times the prevailing retail price of the genuine goods or both.

Additionally a person who obstructs an inspector in the discharge of his duties, fails to comply with the requirements of an inspector, fails to give assistance/information to an inspector or gives false information to an inspector, is liable to imprisonment for a term not exceeding three (3) years or a fine of Kenya Shillings Two Million (Kshs. 2,000,000/=) (approximately US\$24,000) or both.

The Act does not, however, provide for a mandatory custodial sentence irrespective of the flagrancy of the offence neither does it provide for minimum penalties, the result is that too much discretion is left in the hands of the court. As currently drafted, it is quite possible for a habitual offender to be sentenced to a lesser fine or jail term than a first offender.

The study therefore recommends that the fines be reviewed upwards to achieve deterrent minimum fines and further the law should be amended to introduce a mandatory custodial sentence for the third/subsequent offence of a minimum (2) years depending on the flagrancy of the offence.

❖ **Improve border enforcement**

As already discussed in chapter three, the Kenya Revenue Authority (Customs Department) has set up a specific unit to deal with counterfeits and smuggling, called the Anti-Counterfeits and Smuggling Unit. This unit is charged with the task of ensuring that no counterfeits/smuggled items are imported into the country, seizing suspected products at the ports of entry and prosecuting importers.

The Anti-Counterfeit Act, 2008, does not establish a solid scheme for border enforcement procedures. There is only section 34 of the Act, which states that the owner of an intellectual property right may apply to the Commissioner only when he has valid grounds for suspecting that the importation of counterfeit goods may take place. However, the Act does not provide for the possibility to conduct border enforcement controls to exports and goods in transit

The study therefore recommends that Kenya legislature Amends the Anti--Counterfeit Act, 2008, to introduce comprehensive border enforcement procedural rules and also amend the Anti--Counterfeit Act, 2008, to allow the Kenyan customs authorities to intervene in the cases of exportation and goods in transit.

❖ **Address deficiencies in the Copyright Act, 2001.**

In Kenya, piracy is widespread, estimated by the Kenya Copyright Board (KCB) to be upwards of 90% in virtually all kinds of copyright works¹¹⁴. The Copyright Act provides specific administrative and enforcement structures and mechanisms for copyright and related rights. It contains provisions for both civil remedies and criminal sanctions for copyright infringement however as already discussed one of the challenge facing copyright rights owners seeking to enforce their rights in Kenya is the absence of deterrent minimum fines and civil remedies as usually the damages are based on the quantity seized by the KECOBO or the complainant during a raid, which usually bears no consonance with the quantity already sold by the infringer (based on sales records or in the warehouses).

Additionally, duplicity and a generally unclear delineation of roles between the newly established Anti Counterfeit Agency and the Kenya Copyright Board have been reported, as both these bodies have powers to raid, cease and prosecute for copyright infringement.

The study therefore recommends an amendment of the copyright law to prescribe maximum penalties, which can act as a real deterrent for infringers and potential infringers and also introduce deterrent minimum fines. Secondly the copyright law should be amended to clearly delineate the respective roles of the Anti--Counterfeit Agency and the Kenya Copyright Board regarding raid, cease and prosecute powers for copyright infringement.

❖ **Grant powers to the ACA to settle matters out of court under the Anti-Counterfeit Act, 2008.**

Given the length it takes to try cases through the court, if ACA is given powers to settle cases out of court with a proper mechanisms- i.e. the consent of both the complainant and the person found with the counterfeit goods, and to destroy such goods and impose fines, this will not only fasten resolution of such cases but also generate the much needed revenue for ACA as ACA will get to retain the fines which will go towards financing its budget.

Therefore the study recommends the Amendment of the Anti--Counterfeit Act, 2008 to grant powers to the ACA to settle cases out of court and also the power to destroy counterfeit goods and impose fines.

¹¹⁴ Iseme Kamau & Maeme Advocates and Mohammed Muigai Advocates Consortium, Formulation of an EAC Policy on Anti-- Counterfeiting, Anti--Piracy and other Intellectual Property Rights

❖ Establish an inter-agency approach between the different Kenya Agencies administering and enforcing IP rights.

As already discussed, the administration and enforcement of IPRs in Kenya is the shared responsibility of the office of the Registrar General in the Attorney General's Chambers – under which the Kenya Copyright Board falls, the Kenya Industrial Property Institute (KIPI), Customs Department of the Kenya Revenue Authority and the Kenya Bureau of Standards (KEBS). As evidenced, Kenya has no shortage of institutions. What is largely lacking is coordination and information sharing among the various institutions. Therefore, an inter-agency approach to IP enforcement on both policy and operational levels is key to achieving comprehensive IP regimes this could be done through:-

Establishment of an inter-agency working groups at the national level under the guidance of the Anti-Counterfeit Agency to enhance collaboration, and communication in the enforcement and protection of intellectual property rights additionally a single liaison or point of contact in each institution/agency should be designated.

Secondly the enforcement agents could draft a Memorandum of Understanding (MOU) providing the rules of engagement to govern the inter-agency collaboration. Joint procedural manuals could also be helpful in facilitating the establishment of an inter-agency approach.

Thirdly there could be established an IPR Enforcement Committee to organize all inspectors under the Anti-Counterfeit Act for future training, communication, cooperation and coordination. Such Committee should be composed of persons who head the enforcement departments in the respective agencies.

Improving cross-border cooperation between Kenya enforcement authorities and international agencies or IP offices of foreign governments.

Encouraging customs and policy authorities to participate more fully in developing and using existing technical tools to collect and share information. Share information with the competent customs authorities including relevant information to better identify and target for inspection shipments suspected of containing infringing goods.

Promoting internal coordination among agencies, and facilitate joint actions by competent authorities responsible for the enforcement of IPR.

By Upgrading technical infrastructure and developing on-line network to allow competent authorities involved in the enforcement of IPR to rapidly exchange information on enforcement issues, including real time alerts information on suspect products, manufacturing sites, distribution routes and key sale points among others

Researching and making information available on technical tools and systems for prevention and investigation purposes (including tracking and tracing systems which help to distinguish genuine from counterfeit products).

Lastly by issuing documents for the implementation of IP rights such as handbooks and manuals and make them available to the law enforcement authorities.

❖ **Establish an inter-agency approach with private sector coordination.**

Effective cooperation between private and public authorities is a key element in combating counterfeiting and piracy. Therefore the study recommends that intellectual property enforcement agents should aim at promoting the establishment and maintenance of formal or informal mechanisms such as advisory groups that would facilitate engagement between the Kenyan agencies and right holders and other relevant stakeholders including organizers of trade fairs, transport and logistics companies, retailers and payment service providers.

Additionally they should undertake cooperative actions together with private sector to build strategies and to promote and spread successful private sector strategies.

Further the agents should cooperate with private stakeholders to build an electronic information exchange, an early warning system on counterfeit and pirated products and a well-functioning company registration system.

Futher this could be done through enhancing pre-seizure information sharing with right holders about samples of products and packaging to aid customs in determining whether goods are infringing. Consideration in participation in the Interface Public Members (IPM) database program of the World Customs Organization (WCO) to facilitate communication and information exchange between right holders and Kenyan customs authorities and to receive access to training and product information on the 'genuine/fake' database.

Consider the creation of a Kenyan Observatory on Counterfeiting and Piracy, with membership constituted of representatives from relevant governments, industries and other stakeholders. Such an Observatory could serve as platform to join forces and build coalitions

between representatives from national authorities and other stakeholders for mutual assistance. The tasks and activities of such an Observatory could include responsibility for helping to put effective policy recommendations in place and assisting the Kenyan public authorities in their policy, legal and enforcement work.

❖ Increase Public And Political Awareness Of Counterfeiting, Piracy and infringement on technology And The Associated Economic And Social Harm.

There is a need to increase public and political awareness and understanding of counterfeiting and piracy activities and the associated economic and social harm. It is important for consumers, right-holders and government officials to be aware of the counterfeiting problem, to understand the economic and social effects, and to know what concerned parties can do to combat counterfeiting and piracy and infringement on technology activities. The study therefore proposes the following recommendations:

Design joint campaign against counterfeiting between the private sector and the Kenyan Anti-Counterfeit Agency and other IPR enforcement agencies by continuing to participate actively in the “Fakes Cost More: I Buy Real” campaign.

Promote the adoption of measures to create and strengthen public awareness of the importance of respecting IP and the detrimental effects of IPR infringements.

Develop an overall communication strategy on enforcement-related activities including the use of new communication channels such as social networks and the design and development of an exclusive enforcement related website.

Design nation-wide awareness campaigns, which will educate the public and decision makers on the harms and costs of counterfeiting and piracy and raise awareness especially among young people to enable them understand what is at stake in IP.

5.2.2 Uganda

Since Uganda has very few public institutions that administrate intellectual property matters, the study recommends that the institutions should be adequately staffed and the staff should be trained with regards to the above intellectual property rights to ensure proficiency in enforcement and administration. Those that are already in existence should be improved and funded better to make them viable in the enforcement of copyrights, trademarks and other intellectual property rights.

Just as recommended for Kenya, an effort should be made to educate not only the public but also other stakeholders like the police, the judiciary and the Uganda bureau of standards on intellectual property. This will ensure that those who should benefit from them do so and those who are involved in enforcement and implementation of intellectual property laws know what they are doing.

Law enforcement personnel should also be trained to better deal with IP infringement cases from when the infringing goods are identified throughout the chain of evidence and subsequently to prosecution of the culprits. This is means to build capacity among institutions that are mandated with the responsibility of prosecuting crimes.

Unlike Kenya, Uganda does not yet have a counterfeit Act but there is an anti counterfeit goods bill waiting to be passed into law. Efforts should be made to pass this bill into law (after ensuring that it is entirely constitutional) as it will be a big help in the fight against counterfeit products

Cooperation should also be encouraged between the parties that are relevant in the fight against infringement of intellectual property rights , for instance, the police and Uganda revenue authority (URA) the URSB, the registrar's office all this institutions should establish an inter-agency mechanism to ensure effective co-ordinations between themselves.

Uganda also needs to invest in improving enforcement of intellectual property rights via the internet. Whereas it is possible to get registration facilities and other services for trademarks and copyrights online in Kenya, the same is not true for Uganda. An effort should therefore be made to do the same in Uganda.

Uganda should also embrace information technology (IT) in the enforcement of intellectual property rights and encourage technological education/development so that there will be people available who can keep up with the constant changes in the world of technology to help in the enforcement of copyrights, trademarks, patents and other intellectual property rights. On the same vein the Ministry of information technology must also be given a pivotal and more apparent role in the enforcement of this right reason being that anything pertaining to the field of IT is under the docket of this ministry and it should not therefore be sidelined in the process of policy formation regulation and enforcement.

Uganda should also endeavor to increase the institutions or bodies that deal with enforcement of intellectual property rights. For instance Kenya has the Kenya Copyright Board, the Anti-

Counterfeit Agency, the Kenya Industrial property Institute all in place to ensure effective enforcement of the IPRS. Uganda should therefore follow suit and not only establish such institutions but also ensure that they are adequately staffed and managed.

The study further recommends that the Copyright Act be amended to include the registration of Copyrights for effective enforcement and also make the infringement of copyright a crime as currently drafted the Act only provides for civil remedies.

5.3 CONCLUSION

The benefits that a more advanced intellectual property regime could generate for a country's economy are undeniable. It is an established fact that there is a close correlation between the effectiveness of IPR protection and a country's economic performance. IPR systems significantly affect every country's growth, FDI, employment capacities, innovation and overall competitiveness, and enable productivity and efficiency gains. Therefore putting in place a solid IPR protection and enforcement regime is thus critically important for a country to reach its prosperity potential.

The Kenyan government has shown increased awareness of the consequences of a lack of IP protection and of the importance of collectively fighting counterfeiting, piracy and infringement in technology. As seen from the study, the country has initiated legal and institutional reforms, as well as programs to educate the people about the risks of counterfeit products, piracy and other intellectual property rights infringements. Uganda on the other hand lags behind when it comes to the administrative framework and the issue of raising awareness to members of the public about intellectual property rights would say to Uganda that Kenya has created a good precedent and therefore it should follow suit bearing in mind that Kenya and Uganda being British colonies almost share the same legal framework as was discussed in the study.

Additionally as was seen in the study Combating counterfeiting, piracy and infringement in technology is a very challenging task, this therefore means that the task cannot be accomplished in isolation. Therefore protection of IPR should not solely be a priority of state authorities, but needs to be considered as a goal shared broadly by all sectors of society. As a result, public officials, international governmental organizations, industry and even consumers need to work together more closely to develop more creative and effective methods to fight this economic and societal problem.

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