

The Industrial Property Act (Chapter 509)

19 of 1989,
75/1990,
45/1991.

Commencement: 2nd February, 1990

An Act of Parliament to provide for the promotion of inventive and innovative activity and to facilitate the acquisition of technology through the grant and regulation of patents, utility models, rationalization models and industrial designs and for connected purposes

Part I Preliminary

Short Title

1. This Act may be cited as the Industrial Property Act.

Interpretation

2. In this Act, unless the context otherwise requires—

“application” means an application for the grant of a patent, utility certificate and registration of an industrial design under this Act, and “applicant” shall be construed accordingly;

“ARIPO” means the African Regional Industrial Property Organization;

“ARIPO Protocol” means the protocol on patents and industrial designs adopted at Harare in December, 1984;

“court” means the High Court;

“Director” means the director of the Industrial Property Office appointed under section 4;

“examiner” means an examiner appointed under section 4;

“industrial design” has the meaning assigned to it in section 72;

“industrial property rights” means patents, certificates for industrial designs, rationalization certificates and utility certificates issued under this Act;

“International Bureau” means the International Bureau of the World Intellectual Property Organization established by the convention signed at Stockholm on the 14th July, 1967;

“innovation” means utility models, rationalization models and industrial designs and any other non-patentable creations or improvements that may be deemed as deserving of specified industrial property rights;

“invention” means a new and useful art (whether producing a physical effect or not), process, machine, manufacture or composition of matter which is not obvious, or any new and useful improvement thereof which is not obvious, capable of being used or applied in trade or industry and includes an alleged invention;

“inventor” means the person who actually devises the invention and includes the legal representative of the inventor but does not include a person to whom an invention has been communicated either within or outside Kenya;

“licence contract” means any contract by which a party grants permission to another person (whether or not a party) to do any of the acts referred to in section 36 in respect of an invention for which industrial property rights have been granted or an application is pending or in relation to utility models and industrial designs;

“licensee” means a licensee under a contract registered or deemed to have been registered under this Act;

“licensor” means a party to the licence contract who grants the permission;

“Minister” means the Minister for the time being responsible for the supervision of the Office;

“Office” means the Industrial Property Office established under section 3;

“Paris Convention” means the Paris Convention for the Protection of Industrial Property, of 20th March, 1883 as last revised;

“Patent Co-operation Treaty” means the Treaty of that name signed at Washington on the 19th June, 1970;

“rationalization model” has the meaning assigned to it in section 83;

“priority date” means the date of the earlier application that serves as the basis for the right of priority provided for in the Paris Convention;

“self-replicable matter” means any matter possessing the genetic material necessary to direct its own replication by way of a host organism or in any other indirect way;

“Tribunal” means the Industrial Property Tribunal established under section 118;

“utility model” means any form, configurations or disposition of elements of some appliance, utensil, tool, electrical and electronic circuitry, instrument, handicraft mechanism or other object or any part of the same allowing a better or different functioning, use, or manufacture of the subject matter or that gives some utility, advantage, environmental benefit, saving or technical effect not available in Kenya before and includes micro-organisms or other self-replicable material, herbal as well as nutritional formulations which give new effects.

Part II Administration

Establishment of the Office

3.—(1) There shall be established under the directions of the Minister an office to be known as the Kenya Industrial Property Office.

(2) The functions of the Office shall be—

- (a) to examine application for, and grant, industrial property rights;
- (b) to screen technology transfer agreements and licences;
- (c) to provide patent information to the public; and
- (d) to promote inventiveness in Kenya.

Appointment of Officers

4. There shall be—

- (a) a Director of the Industrial Property Office who shall exercise the powers and perform the duties assigned to the Director by this Act and shall be responsible for its administration; and
- (b) such examiners and other officers as may be necessary for carrying out the provisions of this Act.

Seal

5. There shall be a seal of the Office and impressions thereof shall be judicially noticed.

Part III Patentability

Meaning of “Invention”

6.—(1) For the purposes of this Part, “invention” means a solution to a specific problem in the field of technology.

(2) Subject to subsection (3), an invention may be, or may relate to, a product or a process.

(3) The following shall not be regarded as inventions for the purposes of patent protection—

(a) discoveries or findings that are products or processes of nature where mankind has not participated in their creation (including animals, plants and microorganisms) and scientific and mathematical methods and theories;

(b) schemes, rules or methods for doing business, performing purely mental acts or playing games, and computer programmes;

(c) methods for treatment of the human or animal body by surgery or therapy, as well as diagnostic methods; except products, in particular substances or compositions, for use in any of those methods; or

(d) mere presentation of information.

Patentable Inventions

7. An invention is patentable if it is new, involves an inventive step and is industrially applicable.

Novelty

8.—(1) An invention is new if it is not anticipated by prior art.

(2) For the purpose of this Act, everything made available to the public by means of written disclosure (including drawings and other illustrations) or by oral disclosure, use, exhibition or other non-written means shall be considered prior art provided that such making available occurred before the date of the filing of the application or, if priority is claimed, before the priority date validly claimed in respect thereof.

(3) For the purpose of the evaluation of novelty, an application for the grant of a patent or a utility model certificate in Kenya shall be considered to have been comprised in the prior art as from the filing date of the application, or if priority is claimed, as from the date of its validly claimed priority, to the extent to which its content is available, or is later made available, to the public in accordance with this Act or in accordance with the Patent Co-operation Treaty.

(4) A disclosure of the invention shall not be taken into consideration if it occurred not earlier than twelve months before the filing of the application and if it was by reason or in consequence of—

(a) acts committed by the applicant; or

(b) an evident abuse in relation to the applicant or his predecessor in title.

Inventive Step

9. An invention shall be considered as involving an inventive step if, having regard to the prior art relevant to the application claiming the invention, it would not have been obvious to a person skilled in the art which the invention pertains on the date of the filing of application or, if priority is claimed, on the priority date validly claimed in respect thereof.

Industrial Application

10. An invention shall be considered industrially applicable if, according to its nature, it can be made or used (in the technological sense) in any kind of industry, including agriculture, fishery and services.

Non-Patentable Inventions

11. The following shall not be patentable—

(a) plant varieties as provided for in the Seeds and Plant Varieties Act, but not parts thereof or products of biotechnological processes;

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(b) inventions contrary to public order, morality, public health and safety, principles of humanity, and environmental conservation; and

(c) any other inventions that may be declared non-patentable by the Minister.

Temporary Exclusion from Patentability

12. Inventions concerning certain kinds of products or processes for the manufacture of those products, may, by notice in the Gazette, be excluded from patentability for not more than ten years except that any such exclusion may be extended for further periods, each period not exceeding ten years.

Patents Relating to Living Matter

13.—(1) If an invention concerns a microbiological process or the product thereof and involves the use of a micro-organism or self-replicable material which is not available to the public and which cannot be described in the patent application in such a manner as to enable the invention to be carried out by a person skilled in the art, the invention shall only be regarded as being disclosed if—

- (a) a culture of the micro-organism or other self-replicating material has been deposited with a recognized national depository institution in Kenya not later than the date of filing of the application;
 - (b) the application as filed gives such relevant information as is available to the applicant on the characteristics of the micro-organism or other self-replicating material; and
 - (c) the depository institution and the file number of the culture deposit are stated in the application.
- (2) The information referred to in paragraph (b) of subsection (1) may be submitted—
- (a) within a period of sixteen months after the date of filing of the application or, if priority is claimed, after the priority date; or
 - (b) up to the date of submission of a request for early publication of the application; or
 - (c) within one month after the Director has communicated to the applicant that a right to inspection of the files exists.
- (3) The deposited culture shall be made available upon request of any person having the right to inspect the files.
- (4) If a micro-organism or other self-replicating matter deposited ceases to be available from the institution with which it was deposited because—
- (a) the micro-organism or other self-replicating matter is no longer viable; or
 - (b) for any other reason the depository institution is unable to supply samples,

and if the micro-organism or other self-replicating matter has not been transferred to another depository institution recognized for the purposes of this Act, from which it continues to be available, an interruption in availability shall not be deemed to have occurred if a new deposit of the micro-organism or other self-replicable matter originally deposited is made within a period of three months from the date at which the depositor was notified of the interruption by the depository institution and a copy of the receipt of the deposit issued by the institution is forwarded to the Office within four months from the date of the new deposit stating the number of application or of the national patent.

- (5) A new deposit shall be accompanied by a statement signed by the depositor indicating that the newly deposited micro-organism or other self-replicable matter is the same as originally deposited.
- (6) If a deposit is not accepted or if the deposited material is no longer available from the depository institution and a re-deposit does not or could not remedy the unavailability, such unavailability shall not affect the patentability of the invention of the applicant or patentee provided the requesting party entitled to receive a sample certifies its identity with the material used in the invention obtained as the invention or with the originally deposited material, as the case may be.
- (7) If a patent is deemed invalid because the patentee can no longer provide a sample of the deposited material, such invalidity shall not be retroactive.
- (8) The duration of a patent involving micro-organisms or other replicable matter shall be as provided under this Act for other patents or as long as the patentee can provide samples of the deposited material, whichever comes first.

Part IV
Right to Inventions and Naming of Inventor

Right to a Patent

- 14.**—(1) Subject to this section, the right to a patent shall belong to the inventor.
- (2) If two or more persons have jointly made an invention the right to the patent shall belong to them jointly.
- (3) If and to the extent to which two or more persons have made the same invention independently of each other, the person whose application has the earliest filing date, or if priority is claimed the earliest validly claimed priority date that leads to the grant of a patent, shall have right to the patent.
- (4) The right to a patent may be assigned or may be transferred by succession.
- (5) Sections 90 to 93 shall apply *mutatis mutandis* to contracts assigning the right to a patent.

Unauthorized Application Based on Invention of Another Person

15. Where the applicant has obtained the essential elements of the invention which is the subject of his application from the invention of another person he shall, unless authorized by the person who has the right to the patent for the latter invention to apply for the patent or own the patent, be obliged to assign to such person the application or, where the patent has already been granted, the patent right.

*Invention Made in Execution of Commission or by Employee or During Development
Projects or on the Basis of Living Material Collected in Kenya*

16.—(1) Where an invention is made during the validity of a contract whose expressed object is research in Kenya and in which the inventive activity and improvements of the employee has been foreseen, or is implied by the very nature of the functions performed under the contract the invention shall belong solely to the employer.

- (2) Inventions made without any relation to an employment or service contract and without the use of employer's resources, data, means, materials, installations or equipment shall belong solely to the employee or person commissioned.
- (3) In the absence of an express term to the contrary, inventions made by the employee or person commissioned which do not come within the provisions of subsection (1) and which result from both the personal contribution of the author and the resources, data, means, materials, installations or equipment of the employer shall be owned jointly in equal shares and the employer shall have exclusive right to a licence of exploitation and the employee or person commissioned shall have the right to a fixed remuneration.
- (4) The exploitation of the subject of the patent shall be started by the employer within one year from the date of the patent grant, failing which the invention shall become the exclusive property of the employee or person commissioned.
- (5) The employer may also apply for a patent in another country provided the fixed remuneration is guaranteed to the employee or person commissioned.
- (6) In the absence of an agreement to start the exploitation of the patent or during such exploitation, either of the joint owners on an equal footing may exercise his right of preference within the period provided under this Act.
- (7) This section shall also apply, where relevant, directly or indirectly to governmental and other organizations.
- (8) The advantages given to the employee by subsection (4) shall not be reduced by contract.

Naming of Inventor

17. The inventor shall be named as such in the patent unless in a special written declaration addressed to the Director he indicates that he wishes not to be named and any promise or undertaking by the inventor made to any person to the effect that he will make such declaration shall be without legal effect.

Part V **Application, Grant and Refusal of Grant of Patent**

Application

- 18.—(1)** An application for a patent shall be filed with the Director and shall contain—
- (a) a request;
 - (b) a description;
 - (c) one or more claims;
 - (d) one or more drawings (where necessary); and
 - (e) an abstract.

- (2) Where the applicant's ordinary residence or principal place of business is outside Kenya, he shall be represented by an agent who shall be a citizen of Kenya admitted to practice before the Office.
- (3) The request shall state the name of, and prescribed data concerning, the applicant, the inventor and the agent, if any, and the title of the invention; and where the applicant is not the inventor the request shall be accompanied by a statement justifying the applicant's right to the patent.
- (4) The appointment of an agent shall be indicated by the designation of the agent in the request or by furnishing of a power of attorney signed by the applicant and where subsection (2) applies, the agent shall be designated in the request.
- (5) The description shall disclose the invention and the manner and process best known to the inventor of using it, in such full, clear, concise and exact terms as to enable any person having ordinary skills in the art to make and to use and to evaluate the invention and that description shall include any drawing and relevant deposits as in the case of micro-organisms and self-replicable material which are essential for the understanding of the invention.
- (6) The claim or claims shall define the matter for which protection is sought and shall be clear and concise and fully supported by the description.
- (7) The abstract shall merely serve the purpose of technical information; in particular, it shall not be taken into account for the purpose of interpreting the scope of the protection sought.
- (8) The details of the requirements with which the application must comply shall be prescribed by the regulations made under this Act.

Unity of Invention

19.—(1) The application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept.

(2) The regulations shall contain rules concerning compliance with the requirements of unity of invention under subsection (1).

Amendment and Division of Application

20.—(1) The applicant may amend the application, provided that amendment shall not go beyond the disclosure in the initial application.

(2) The applicant may divide out from the application one or more applications (hereinafter referred as the "divisional applications") provided that each divisional application shall not go beyond the disclosure in the initial application.

Right of Priority

21.—(1) The application may contain a declaration claiming the priority as provided for in the Paris Convention of one or more earlier national, regional or international applications filed by the applicant or his predecessor in title or of the state party to the Paris Convention.

(2) The Director may, at any time after the expiration of three months from the filing of an application containing the declaration, require that the applicant furnish a copy of the earlier application, certified as correct by the Office with which it was filed or, where the earlier application is an international application filed under the Patent Co-operation Treaty, by the International Bureau.

Information Concerning Corresponding Foreign Application Grants

22.—(1) At the request of the Director, made within one year of the date of filing the application, the applicant shall furnish him with the date and number of any application for a patent or another title or protection filed by the applicant with a national industrial property office of another country or with a regional industrial property office (in this Act referred to as foreign application), relating to the same invention as that claimed in the application filed with the Director.

(2) The applicant shall, at the request of the Director, furnish him with the following documents relating to one of the foreign applications—

(a) copies of any communication received by the applicant concerning the results of any search or examination carried out in respect of the foreign application;

(b) a copy of the patent or other title of protection granted on the foreign application; and

(c) a copy of any final decision rejecting the foreign application or refusing the grant requested in the foreign application.

(3) The applicant shall, at the request of the Director, furnish him with a copy of any decision invalidating the patent or other title of protection granted to the applicant on the basis of the foreign application.

(4) The applicant shall, at the request of the Director, furnish him with copies of any communication received by the applicant concerning the results of any search or examination carried out in respect of any foreign application other than the one referred to in subsection (2).

(5) The documents furnished under this section shall merely serve the purpose of facilitating the evaluation of novelty claimed in the application filed with the Director or in the patent granted on the basis of that application.

(6) The applicant shall have the right to submit comments on the documents furnished under this section.

(7) The details of the requirements under this section shall be prescribed by the regulations.

Payment of Fees

23. The application shall be subject to the payment of the prescribed fees.

Withdrawal of Application

24. At any time before the grant of a patent or the notification of rejection of the application or of refusal to grant a patent, the applicant may withdraw the application.

Filing Date: Examination of Application as to Form, etc

25.—(1) The Director shall accord as the filing date the date of receipt of the application, provided at the time of receipt, the documents filed contain—

- (a) the name of the applicant;
- (b) a part which on the face of it appears to be a description; and
- (c) a part which on the face of it appears to be a claim or claims.

(3) If the Director finds that the application did not, at the time of receipt, fulfil the prescribed requirements, he shall invite the applicant to file the required correction.

(4) If, the applicant complies with the invitation referred to in subsection (3), the Director shall accord as filing date the date of receipt of the required correction otherwise he shall treat the application as if it had not been filed.

(5) Where the application refers to drawings which in fact are not included in the application, the Director shall invite the applicant to furnish the missing drawings and if the applicant complies with the invitation, the Director shall accord as the filing date the date of receipt of the missing drawings otherwise he shall accord as the filing date the date of receipt of the application and shall treat any reference to the drawings as non-existent.

(6) Where no invitation under subsections (3) and (5) was sent to the applicant and the applicant nevertheless files a correction pertaining to any of the requirements under subsection (1) to his application the director shall accord as filing date the date of receipt of the correction, provided that the correction was received within thirty days from the date of the application.

(7) Where the request is accompanied by the statement on the right to the patent, the Director shall send a copy of the statement to the inventor and the inventor shall have the right to inspect the application and to receive, at his own expense, a copy thereof.

(8) The Director shall cause an examination to be carried out as to whether there are any of the following defects with respect to the application—

- (a) the request does not comply with the requirements of subsection (2) and the rules pertaining thereto;
- (b) the description, the claims and, where applicable, the drawings do not comply with the physical requirements prescribed by the regulations;
- (c) the application does not contain an abstract;
- (d) the applicant has not complied with a request of the Director under section 22; or
- (e) the fees referred to in section 23 are not paid as provided in the regulations.

(9) If the Director finds any of the defects referred to in subsection (8), he shall invite the applicant to remedy such defects provided that any corrections made to the application shall not be such that they would require a change of the filing date and if the applicant does not comply with the invitation, the application shall be rejected by the Director.

(10) Unless the application is to be the subject of an international-type search under section 26, the Director shall cause an examination to be carried out as to whether the application appears to comply with the requirement of unity of invention prescribed by section 19 and the rules pertaining thereto.

(11) If the Director is of the opinion that the requirement of unity of invention may not have been complied with, he shall invite the applicant to restrict or divide the application; and if the applicant does not comply with the invitation the application shall be rejected by the Director.

(12) The details of the requirements and the procedure under this section shall be prescribed by the regulations.

International-Type Search

26.—(1) The Director may direct that any application found in order as to form be the subject of an international-type search.

(2) When a direction under subsection (1) is made, the Director shall invite the applicant to pay the prescribed fees; and if the applicant does not comply with the invitation, the application shall be rejected by the Director.

(3) Upon receipt of the report on the international-type search the Director may request the applicant to furnish him with a copy of any document cited in the report and if without lawful reason, any copy is not furnished within the prescribed time limit, the application shall be rejected.

(4) If it is apparent from the report on the international-type search or from the refusal to establish the report, that the subject of the application or of any claim or claims is not an invention, the director shall reject the defective application or consider the defective claim or claims to be withdrawn, as the case may be, unless the applicant satisfies him that the subject of the application or claims constitutes an invention.

(5) If it is apparent from the report on the international-type search or from the refusal to establish the report, that—

(a) the description, the claims or, where applicable, the drawings do not comply, in whole or in part, with the prescribed requirements to such an extent that no meaningful search could be carried out; or

(b) the application does not comply, in whole or in part, with the requirement of unity of invention prescribed by section 19 and the rules pertaining thereto; or

(c) the invention claimed in the application obviously does not fulfil the requirement of novelty, the Director shall reject the application unless the applicant either satisfies him that the requirements have been fulfilled or amends or divides the application so as to comply with the requirements.

(6) The details of the requirements and the procedures under this section shall be prescribed by the regulations.

Examinations as to Substance

27. The Minister may, by order published in the Gazette—

- (a) direct that applications for patents relating to a specified field or specified technical fields shall be the subject of an examination as to substance; and
 - (b) add further technical fields to those covered by a direction as aforesaid or remove any technical field from the scope of the direction.
- (2) If, in the opinion of the Director, the subject matter of an invention for which a patent is sought falls within a technical field covered by the terms of a direction made under subsection (1), he shall cause an examination to be carried out as to whether the following conditions are fulfilled—
- (a) the claimed invention is patentable within the meaning of the sections dealing with patentability and industrial application;
 - (b) the claimed invention is not excluded from protection under the sections dealing with prohibition by law and temporary exclusion from patentability; and
 - (c) the description and the claims comply with the requirements prescribed by section 18 (3) and (4) and the rules pertaining thereto.
- (3) For the purposes of the examination under subsection (2), the Director may transmit the application, together with all relevant documents to the authority designated in the regulations for a preliminary examination as to the patentability of the claimed invention.
- (4) The authority referred to in subsection (3) shall establish a report on the conclusions of its examination and shall transmit it to the Director and to the applicant.
- (5) Where, taking due account of the conclusions of any report referred to in subsection (4), the Director is of the opinion that any of the conditions referred to in subsection (2) are not fulfilled, he shall notify the applicant accordingly and invite him to submit his observations and, where applicable, to amend his application.
- (6) Where, despite any observation or amendment submitted by the applicant, the Director finds that any of the conditions referred to in subsection (2) are not fulfilled, he shall refuse the grant of patent and notify the applicant accordingly.
- (7) The details of the requirements and the procedure under this section shall be prescribed by the regulations.

Grant, Registration and Publication of Patent

28.—(1) Unless the application has been rejected under sections 25 and 26 or a patent has been refused under section 27, a patent shall be granted and issued to the applicant in the form specified in the regulations.

(2) Any granted patent under subsection (1) shall be registered in the register.

Register of Patents

29.—(1) The director shall maintain a register in which shall be recorded all patents granted, numbered in the order of grant, and, in respect of each patent, where appropriate, its lapse for non-payment of annual fees and all transactions to be recorded by virtue of this Act.

(2) The register may be consulted by any person, and the person may obtain extracts therefrom, under the conditions prescribed in the regulations.

(3) The details concerning the register shall be prescribed by the regulations.

Appeals

30. The applicant may appeal to the Tribunal against any decision by which the Director accords a filing date, rejects the application, treats the application as if it had not been filed, considers any of the claims to be withdrawn or refuses to grant a patent.

Part VI
International Applications

Interpretation of Part

31. For the purposes of this Part, “international application” means an international application filed in accordance with the Patent Co-operation Treaty and the regulations established thereunder.

Functions of the Kenya Industrial Property Office

32.—(1) The Office shall act as a receiving office where an international application is filed with it and the applicant is a national or a resident of Kenya.

(2) The Office shall act as a designated office in the case of any international application in which the country is designated.

(3) A patent in respect of which Kenya is a designated state granted by ARIPO by virtue of the ARIPO Protocol shall have the same effect in Kenya as a patent granted under this Act unless the Director communicates to ARIPO, in respect of the application thereof, a decision in accordance with the provisions of the protocol that if a patent is granted by ARIPO that patent shall have no effect in Kenya.

Unsearched or Unexamined International Applications, etc

33.—(1) Where an international search report is not established or relates to only one or some of the claims of the international application, the Director shall reject the international application or consider withdrawing any claim or claims not covered by the report, as the case may be, except to the extent that the applicant satisfies him that the refusal to establish the report in whole or in part was not justified.

(2) Where the international search report relates to only one or some of the claims due to the applicant's refusal to pay additional fees, those parts of the international applications which consequently have not been searched shall be considered withdrawn unless the applicant satisfies the director that the invitation to pay the additional fees was not justified.

(3) Where an international preliminary examination report with respect to an international application has been communicated to the Director the following paragraphs shall apply—

(a) where, in the case of lack of compliance with requirement of unity of invention the international preliminary examination report indicates that the international preliminary examination was carried out on restricted claims, or was carried out on the main invention only, those parts of the international application indicated as not having been the subject of international preliminary examination shall be considered withdrawn unless the applicant pays the prescribed fee or satisfies the Director that the invitation of the international preliminary examining authority was not justified; and

(b) where the international preliminary report states, with respect to the entire international application or one or some of its claims only, the opinion that the defects exist, the international application or the claim or claims, as the case may be, shall be considered withdrawn unless the applicant satisfies the Director that the defects do not exist.

(4) If it is apparent from an international search report or an international preliminary examination report that an invention claimed in an international application obviously does not fulfil the requirement of novelty, the director shall not grant a patent upon the application

unless the applicant either satisfies him that the requirement has been fulfilled or amends the claims in a way that fulfils the requirement.

Provisional Protection of Published International Application

34.—(1) Relief may be sought in respect of acts committed before the grant of the patent but after the date of international publication was effected in English.

(2) Where the international publication was effected in a language other than English, subsection (1) shall apply provided that the applicant had transmitted an English translation of the international publication to the infringer and only in respect of acts committed by the latter after he had received the translation.

Part VII

Rights and Obligations of the Applicant or the Owner of the Invention

Rights and Obligations

35.—(1) The applicant or the owner of the patent shall have the following rights—

- (a) to be granted the patent, where the relevant requirements under this Act are fulfilled;
- (b) after the grant of the patent and within the limits defined in section 16, to preclude any person from exploiting the patented invention in the manner referred to in section 36; and
- (c) to conclude licence contracts, as provided for in Part XIII and subject to the obligations referred to in subsection (2).

(2) The applicant or the owner of the patent shall have the following obligations—

- (a) to disclose the invention and the manner and process best known to the inventor of using it, in such full, clear, concise and exact terms as to enable any person having ordinary skills in the art to make and to use and to evaluate the invention;
- (b) to give information concerning corresponding foreign application and grants;
- (c) to work the protected invention in Kenya within the time limits;
- (d) to pay fees to the Director, as prescribed in this Act and the regulations, subject to the sanctions provided for therein; and
- (e) in connection with licence contracts and contracts assigning patents or patent applications, to refrain from making abusive provisions referred to in section 27.

Rights of Owner of Patent

36. The owner of the patent shall have the right to preclude any person from exploiting the protected invention by any of the following acts—

- (a) when the patent has been granted in respect of a product—
 - (i) making, importing, offering for sale, selling and using the product; or
 - (ii) stocking such product for the purposes of offering it for sale, selling or using the product;
- (b) when the patent has been granted in respect of a process—
 - (i) using the process; or
 - (ii) doing any of the acts referred to in paragraph (a), in respect of a product obtained directly by means of the process.

Scope of Protection

37. The scope of the protection shall be determined by the terms of the claims; nevertheless, the description and the drawings included in the invention may be used to interpret the claims.

Limitation of Rights

- 38.—(1)** The rights under the patent shall extend only to acts done for industrial or commercial purposes and in particular not to acts done for scientific research.
- (2) The rights under the patent shall not extend to acts in respect of articles which have been put on the market in the country by the owner of the patent or with his express consent.
 - (3) The rights under the patent shall not extend to the use of articles on aircraft, land vehicles or vessels of other countries which temporarily or accidentally enter the airspace, territory or waters of the country.
 - (4) The rights under the patent shall be limited by the provisions on the patents term.
 - (5) The rights under the patent shall be limited by the provisions on compulsory licences for reasons of public interest or based on interdependence of patents and by the provisions on State exploitation of patented inventions.
 - (6) The rights of the patent shall not extend to variants or mutants of living forms or replicable living matter that is distinctively different from the original for which patent were obtained such mutants or variants are deserving of separate patents.

Part VIII Term of Patent and Annual Fees

Term of Patent and Extension

39.—(1) Subject to subsection (2), a patent shall expire at the end of the seventh year after the date of the filing of the application and may be extended for ten years.

- (2) On the request of the owner of the patent, or of a licensee, made not more than twelve months and not less than one month before the expiration of the patent under subsection (1), and on payment of the prescribed fee, the director shall extend the term of that patent for a period of five years, provided that the owner or licensee proves, to the satisfaction of the director—
- (a) that the invention which is the subject of the patent is being worked in the country at the date of the request; or
- (b) that there are legitimate reasons for failing so to work the invention.
- (3) On the request of the owner of the patent, or of a licensee, made not more than twelve months and not less than one month before the expiration of the patent under subsection (2), and on payment of the prescribed fee, the Director shall, subject to that subsection, extend the duration of the patent for a further period of five years.
- (4) If the Director does not reject the request referred to in subsections (2) and (3) within six months after its receipt, he shall be deemed to have extended the term of the patent as requested.
- (5) The owner of the patent or a licensee may appeal to the Tribunal against any refusal to extend the term of the patent under subsections (2) and (3).
- (6) For the purposes of this section the invention is worked if the protected product is permanently or regularly used in the manufacture of the product covered by the protection in order to market the product under reasonable commercial and market conditions either directly or by the patentee or his successor in title or licensee, in quantities that amount to effective industrial exploitation under satisfactory conditions as to quantity and price.

Annual Fees

- 40.**—(1) In order to maintain the application or the patent, an annual fee shall be paid in advance to the director starting with the second year after the date of the filing of the application.
- (2) A period of grace of six months shall be granted for the payment of the annual fee upon payment of a surcharge whose amount shall be fixed by the regulations.
- (3) If an annual fee is not paid in accordance with this section the application shall be deemed to have been withdrawn or the patent shall lapse automatically and the related information shall fall into the public domain and the lapse of the patent shall promptly be published by the Director.
- (4) Within six months from the expiration of the period of grace referred to in subsection (2), any interested person may, upon payment of the prescribed fee, request the Director to restore an application that is deemed to have been withdrawn, or a patent that has lapsed, by virtue of subsection (3).
- (5) If the Director is satisfied that the failure to pay the annual fee was due to *force majeure* and all annual fees due have been paid, he shall make an order restoring the application or the patent, as the case may be.
- (6) Where a patent is restored, no proceedings may be brought by virtue of the patent—
- (a) with respect to any acts performed after the lapse of the patent and before the date of the order for restoration; or
- (b) with respect to any acts performed after the date of the order for restoration in relation to articles imported into Kenya, or manufactured therein, after the lapse of the patent and before the date of the order for restoration.

Part IX
Change in the Ownership and Joint Ownership of Applications and Rights

Change in Ownership of Applications, etc

41.—(1) All contracts assigning applications or patents shall be in writing and shall be signed by the parties thereto otherwise they shall not be valid.

(2) Any change in the ownership of an application or a patent shall be recorded in the patent register in accordance with, and on payment of prescribed fee and after the change have been recorded, any document evidencing the change in ownership shall not be admitted in any proceedings as evidence of the title of any person to an application or a patent, unless the court otherwise directs.

Joint Ownership of Applications and Patents

42. In the absence of any agreement to the contrary between the parties, joint owners of an application or a patent may, separately, transfer their shares in the application or the patent, exploit the protected patent and preclude any person from exploiting the patent but may only jointly grant permission to any third person to do any of the acts referred to in section 26.

Part X
Utility Models

Persons Entitled to Obtain a Utility Model Registration

43.—(1) Any person who makes a new model shall be entitled to obtain a utility model certificate, provided, however, that employees of the Office shall not be entitled to obtain a utility model registration during their employment at the Office except in the case of inheritance or bequest.

(2) If two or more persons make a model, the right to obtain a utility model registration shall be jointly owned.

Unregistrable Models

- 44.** Models falling under any of the following categories shall not be registrable—
- (a) discoveries, scientific theories and mathematical methods;

- (b) models which are liable to contravene public order or morality or principles of humanity, or to injure public health or which are contrary to environmental conservation;
- (c) aesthetic creations;
- (d) schemes, rules and methods of performing mental acts, playing games or doing business, and programs for computing;
- (e) presentations of information;
- (f) acts done privately for non-commercial purposes, except acts done for educational or instructional purposes and whose intention is to be put to use but one which have the potential for commercial application; or
- (g) acts done for experimental purposes relating to the subject matter of the utility model.

Requirements for Utility Model Registration

45.—(1) Any person who has made a model which can be utilized in industry, agriculture, education services or environmental conservation and which relates to shape, structure or assemblages of articles shall be entitled to obtain a utility model registration thereon, except in the case of the following models—

- (a) models which were publicly known or publicly worked in Kenya prior to the filing of the utility model registration application; or
- (b) models which were described in a publication distributed in Kenya prior to the filing of the utility model registration application.

(2) In case a person having an ordinary technical knowledge in the field to which such model belongs could easily have made the model on the basis of a model prior to the filing of a utility model registration, a utility model registration shall not be granted in respect of that model.

Instances Where Utility Models not Registrable

46. Where a model for which a utility model registration application is filed with a model or an invention described in the specification or drawings originally appended to another application for a utility model registration or a patent and where such other application was filed prior to the utility model registration application concerned and was published for opposition or was laid open to public inspection after the filing of the utility model registration application concerned, a utility model registration shall not be granted for the first mentioned model; provided, however, that this provision shall not apply in cases where the inventor of the other application and where, at the time of filing of the other application for a patent or a utility model registration are the same person.

Presumption of Novelty

47.—(1) If a registrable utility model falls under any one of the following categories it shall be deemed to be novel at the national level provided that the utility model registration application is filed within six months of the applicable date—

- (a) when a person having the right to obtain a utility model registration by conducting an experiment thereon, publishing the model in printed matter, or presenting it in writing at a research meeting held by a scientific organization;
 - (b) when a person having the right to obtain a utility model registration has unintentionally caused his model to fall under section 45 (1);
 - (c) when a person having the right to obtain a utility model registration has caused his model to fall under the terms of section 45 (1) by displaying his model at an exhibition held by the Government or local public entity, or by those who have obtained approval from the Government or the local entity;
 - (d) when a person having the right to obtain a utility model registration has caused his model to fall under the terms of section 45 (1) by displaying his model at an exhibition held in a foreign country with the approval of the Government; and
 - (e) when a person having the right to obtain a utility model registration has caused the model to fall under the terms of section 45 (1) by displaying the model at an international exhibition held in a foreign country.
- (2) Any person who desires the application of subsection (1) shall submit, simultaneously with the utility model registration application, a written statement to that effect to the Director, to whom he shall also submit, within thirty days from the filing date of the utility model registration application, a document verifying the relevant facts.

First File Policy

48.—(1) The applicant is entitled to obtain a utility model registration for the same model only; provided, however, that where two or more applications relating to the same model are filed on the same date, only the person agreed upon by all the applicants may obtain a utility model registration for the model and, if no agreement is reached or no consultation is possible, none of the applicants shall obtain a utility model registration for the model.

- (2) Where a utility model application concurs with a patent application for the same contents, subsection (1) shall *mutatis mutandis* apply.
- (3) Where a utility model application or patent application, both contents of which are identical, is invalidated or withdrawn, such application shall, for the purposes of subsection (1), be deemed never to have been made.
- (4) A utility model application or patent application by a person who is not the inventor nor the successor in title to the right to obtain a utility model registration or a patent registration shall, for the purposes of subsections (1) and (2) be deemed to be a utility model application or a patent application.
- (5) The director shall order the applicants to report the result of the consultations prescribed under subsection (1), designating an adequate time limit; and if the report is not made within the designated time limit, the applicants shall be deemed not to have concluded an agreement within the meaning of subsection (1).

Application for Utility Model Registration

49.—(1) Any person who desires to obtain a utility model registration shall submit a request to the Director stating the following matters—

(a) the name, proof of nationality, domicile or place of business or name of institution (in case of utility model for educational or instructional purposes) of the applicant for the utility model registration (in case of a juristic person, the name of its representative to be included);

(b) the name and domicile or place of business of the agent, in case an agent is designated;

(c) the date of the submission;

(d) the title of the model; and

(e) the name and domicile or place of business of the innovator.

(2) A specification and, if necessary, drawings which set forth the following items shall be appended to the request—

(a) title of the model;

(b) brief explanation of the drawings;

(c) detailed explanation of the model; and

(d) scope of the utility model registration claim.

(3) In a detailed explanation of the model, the purpose, construction, function and effect of the model shall be described so as to be easily practised by any person having an ordinary knowledge in the technical field to which the model belongs.

(4) Within the scope of the utility model registration claim of subsection (2), the matter to be protected among those matters described in the specification may be set forth in a single claim or two or more claims clearly and concisely.

One Model for One Application

50. An application for utility model registration shall relate to a single model.

Conversion of Application

51.—(1) An applicant for a patent may convert his application into a utility model application; provided, however, that this provision shall not apply after thirty days from the transmission of the examiner's first decision that the patent application (excluding the thirty days period counted from the filing date of the patent application) is to be rejected.

(2) Where the conversion is carried, the utility model application shall be deemed to have been filed on the date of filing of the application for the patent registration; provided, however, that this provision shall not apply where the new utility model application converted is another application for a utility model.

(3) Where such conversion is carried out, the application for the patent shall be deemed to have been withdrawn.

(4) An application may not be converted under subsection (1) more than once.

Registration of Establishment of Utility Model Right

52.—(1) A utility model right shall come into force upon registration of its establishment.

(2) The owner of a utility model right shall have the right exclusively to produce, use, sell, import or distribute the articles of registered utility model commercially or industrially.

(3) Where a registered utility model would utilize or be in conflict with another person's registered utility model, patented invention or registered design, and if the latter were filed prior to the filing date of the utility model application concerned, the owner of the utility model right or exclusive licensee or non-exclusive licensee shall not commercially work his registered utility model without the consent of the owner of the earlier utility model right, patentee or owner of the design right.

Acts Deemed to be Infringement

53. Acts of manufacturing, using, selling, importing or distributing commercially the things to be used exclusively for the manufacture of the product relating to a utility model registration, shall be deemed to be an infringement of the utility model right or an exclusive licence.

Non-Exclusive Licence due to Working prior to Registration of Demand for Invalidation Trial

54.—(1) When a person to whom this section applies has in good faith, been commercially working a model or invention in Kenya or been making preparations thereof, prior to the registration of a demand for trial to invalidate a registered utility model or a patent, such a person shall have a nonexclusive licence on the utility model right or on the exclusive licence at the same time when the utility model registration or the patent was invalidated, within the scope of the purpose of the business at the time the demand was made—

- (a) the original owner of the utility model right, where one or two or more utility model registrations granted for the same model has been invalidated;
 - (b) the original patentee, where a model registered as a utility model and a patented invention are the same and the patent has been invalidated; or
 - (c) in the cases referred to in paragraphs (a) and (b), a person, who has an exclusive licence or a nonexclusive licence and has obtained registration thereof on the invalidated utility model right or patent right, prior to the registration of demand for invalidation trial.
- (2) A person who has obtained a non-exclusive licence in accordance with subsection (1) shall pay a reasonable remuneration to the owner of the utility model right or the exclusive licence.

Non-exclusive Licence after Expiration of Term

55.—(1) When a patent right under an application filed prior to or on the filing date of a utility model registration application conflicts with the utility model right under the utility model registration application and the term of the patent right has expired, the original patentee, owner of the design right and their exclusive or non-exclusive licensee shall, to the extent of the original right, have a non-exclusive licence on the utility model registration; provided, however, that registration shall not be required in case where the original licence was effective without registration.

(2) An exclusive licensee and a non-exclusive licensee on the basis of the original patent right or design right under subsection (1) shall pay a reasonable remuneration to the owner of the utility model right.

Compulsory Licensing

56. The provisions of compulsory licensing shall be similar to those applied to patents.

Terms of Utility Model Right

57.—(1) The term of the utility model right shall be five years from the date of the publication of the application in case where this is published, and five years from the date of registration in case where there is no publication; provided, however, that such term shall not exceed twelve years from the filing date of the utility model application.

(2) When a utility model registration is granted to a lawful applicant, the term of five years shall run from the following date of publication of the application that was filed by unentitled person.

(3) When a utility model registration is granted to a lawful applicant, the term of five years shall run from the following date of publication of the application that was invalidated.

Trial for Granting Non-Exclusive Licence

58.—(1) The owner of a utility model right, exclusive licensee or non-exclusive licensee may, if he desires to obtain a non-exclusive licence demand a trial for granting nonexclusive licence in case the other person refuses to grant a licence without due reasons or in case he is not able to obtain the grant of licence.

(2) Where a person who has granted a non-exclusive licence under subsection (1) requires working of the registered utility model of the person to whom the non-exclusive licence has been granted, and if the latter refuses to grant a licence without due reasons or if it is not possible to obtain a licence from the latter, the former may demand a trial for the grant of non-exclusive licence.

Remuneration in Respect of Compulsory Licence

59.—(1) A non-exclusive licensee under the provision of section 58 shall pay a reasonable remuneration to the owner of the utility model right, the patentee, the owner of the design right or the exclusive licensee.

(2) A non-exclusive licensee under subsection (1) may work the registered utility model, patented invention or registered design upon payment of the remuneration thereof or by making a deposit thereof if payment is not possible due to causes beyond his control.

Effect of Registration of Non-Exclusive Licence

60.—(1) When a non -exclusive licence has been registered, it shall be effective against any person who subsequently acquires the utility model right or exclusive licence or any person who subsequently establishes a pledge on the utility model right or exclusive licence.

(2) A non-exclusive licence shall be effective against a person who has established a right of pledge prior to its registration.

(3) The transfer, modification, extinguishment or restriction on disposal of a non-exclusive licence or the establishment, transfer, modification, extinguishment or restriction on disposal of a pledge relating to a non-exclusive licence shall not be effective against any third party unless it is registered.

Invalidation of the Registration of Utility Model

61.—(1) If a utility model registration falls under any of the following categories it shall be invalidated by trial—

- (a) where a utility model right has been granted in violation of the provisions of this Act;
- (b) where a utility model right has been granted to a person who is not entitled to succeed it, or to a person who has misappropriated such a right; or
- (c) where, after registration of a utility model, the owner of the utility model right has become a person who is for any other reason no longer eligible to enjoy utility model rights.

Registration in Utility Model Register

62.—(1) A utility model register shall be kept at the Office in which any one of the following shall be recorded—

- (a) the establishment, transfer, extinguishment or restriction on disposal of a utility model right;
 - (b) the establishment, maintenance, transfer, modification, extinguishment or restriction on disposal of an exclusive or non-exclusive licence; and
 - (c) the establishment, transfer, modification, extinguishment or restriction on disposal of a pledge upon a utility model right or an exclusive or non-exclusive licence.
- (2) Other matters relating to registration which are not provided for in this Act shall be prescribed by the Minister.

Issuance of Utility Model Registration Certificate

63. When the establishment of a utility model right has been registered the Director shall issue a utility model registration certificate to the owner of the utility model right.

Utility Model Gazette

64. The Director shall publish the utility model gazette, and the matters to be described in the utility model gazette shall be prescribed by the Minister.

Registration Fees

65.—(1) A person who wishes to register a utility model right or an owner of the utility model right or any person who files a request or initiates other proceedings shall pay registration fees, publication fees, examination fees or other official fees; provided, however, that this provision shall not apply to utility model rights or utility model registration applications belonging to the Government or to a trial for invalidation which is initiated by the examiner.

- (2) An interested party may pay registration fees, publication fees, examination fees or other official fees on behalf of the person liable to pay.
- (3) Where an applicant fails to pay the publication fees within the time limit by which the payment for registration of establishment of utility model right is to be made, such an application shall be deemed to have been abandoned.

Request for Examination of an Application

- 66.**—(1) The utility model registration application shall be taken up for examination only when there is a request for the examination thereof.
- (2) When a utility model registration application has been filed, any person may make a request for examination to the director within two years from the filing date thereof.
 - (3) A request for examination of an application shall not be withdrawn.
 - (4) If no request for examination thereof is made within the prescribed period, the utility model registration application concerned shall be deemed to have been withdrawn.

Rejection and Notification of Reasons for Rejection

67.—(1) An examiner shall, in case a utility model registration application falls under any one of the following categories make a decision to reject it—

- (a) where an application is not registrable; or
 - (b) where an application is filed by a person who cannot succeed to rights to obtain a utility model registration or who has misappropriated such right.
- (2) An examiner shall, when he intends to render a decision of rejection recognizing that an application has fallen under subsection (1), notify the applicant of the reasons and give him an opportunity to submit a statement of his arguments, designating a time limit, for the submission.

Demand for Trial

68.—(1) A trial may be demanded for the matters prescribed in any of the following, unless otherwise provided for in this Act—

- (a) trial to invalidate a registration under the provisions of this Act;
 - (b) trial to confirm the scope of utility model right;
 - (c) trial to grant a non-exclusive licence;
 - (d) trial to obtain permission to correct; or
 - (e) trial to invalidate the permission to correct.
- (2) Only the interested party or the examiner may demand a trial for invalidation.

(3) Only the interested party may demand a trial prescribed under paragraphs (a) to (e) of subsection (1).

Limitation on Trial

69. Where a registered utility model is granted for a model which has been described in a publication distributed prior to the utility model registration application or for a model which could be easily made by a person having an ordinary technical knowledge in the field to which such invention belongs, a trial to invalidate the utility model registration shall not be demanded after five years from the date of the establishment of the registration of the utility model right.

Trial Decision on Remuneration

70. A trial under the section 68 shall include a decision on remuneration.

Appeals

71.—(1) Any person who objects to the examiner's decision or the trial decision may file an appeal within thirty days from the transmission of the examiner's decision or the trial decision and in that case, no trial may be demanded against the trial decision concerning the remuneration or costs only.

(2) The person who appeals against the decision shall submit his demand in writing to the Director, stating the following particulars—

- (a) name or title, proof of nationality and domicile or place of business of the applicant and his representative or, in case of a juristic person, the name of its representative;
- (b) date and number of the application;
- (c) title of the model;
- (d) date of rendering examiner's decision;
- (e) identification of the trial case;
- (f) purpose of and reasons for the demand; and
- (g) grounds of appeal and supporting evidence.

Part XI
Industrial Designs

Definition of an Industrial Design

72.—(1) For the purposes of this Act, “an industrial design” means any composition of lines or colours or any three dimensional form whether or not associated with lines or colours, provided that such composition or form gives a special appearance to a product of industry or handicraft and can serve as a pattern for a product of industry or handicraft.

(2) The protection under this Act shall not extend to any thing in an industrial design which serves solely to obtain a technical result.

Registration of Industrial Designs

73.—(1) Any creator of an industrial design or his successors in title shall have the exclusive right to exploit the design, to sell or cause to be sold for commercial or industrial purposes the goods in which the design is incorporated, subject to the conditions of this Act, without prejudice to the rights conferred by any other written law.

(2) The following shall not be registered as industrial designs—

(a) works of sculpture, architecture, painting, engraving, enamelling, embroidery and photography and any other inventions of purely artistic nature;

(b) inventions contrary to public order, morality, public health and safety, principles of humanity, and environmental conservation;

(c) designs whose features correspond to or are determined by the functions to be performed by the products; or

(d) designs that consist solely in a change in the colour of designs already known.

Deposit and Publication of Industrial Designs

74.—(1) Any person wishing to deposit an industrial design shall send to the director—

(a) a declaration of deposit;

(b) an unstamped power of attorney, if the applicant is represented by an agent;

(c) on pain of annulment of the deposit, a sealed package containing two identical copies of a representation or specimen of the design.

(2) The deposit may consist of between one to one hundred designs, which shall be numbered from first to last and any design above one hundred shall not be considered as validly deposited under the terms of this Act.

(3) A written statement drawn up by the Director shall note each deposit, specifying the date and the time the documents were handed over.

(4) A copy of the written statement referred to in subsection (3) shall be given to the applicant.

(5) The Director shall register the deposit after having ascertained that it is in due form and in accordance with the requirement of this Act, and shall send a certificate of registration to the applicant.

(6) The legal date of the registration shall be that of the deposit.

(7) In the event either of a material error not entailing annulment of the deposit or of failure to pay the required fees, a period of two months shall be granted to the applicant in order to rectify his deposit, and the period may be extended upon legitimate request by the applicant or his agent.

- (8) The rejection shall be declared by the Director.

Duration, etc. of Certificate of Registration

75.—(1) Subject to subsection (2), the duration of protection conferred by a certificate of registration for an industrial design shall expire at the end of the fifth year following the date of deposit of the application for registration.

(2) The registration of a design may be renewed for two further consecutive periods of five years upon payment of a renewal fee the amount of which shall be fixed in the prescribed manner.

(3) The renewal fee for an industrial design shall be paid within the twelve months preceding expiration of the period of registration.

Renewal, etc. of Registration of Industrial Designs

76.—(1) Where the protection granted to an industrial design has not been renewed due to circumstances beyond the control of the owner of the design, the latter or the persons entitled may apply for its restoration against payment of the requisite renewal fees, as well as of a surcharge whose amount shall be fixed in the prescribed manner, within a period of six months from the date upon which the above-mentioned circumstances ceased to exist and, at the latest, within a period of one year from the date upon which renewal was due.

(2) The application for the restoration for the above-mentioned industrial design, together with documents proving payment of the fees and surcharge mentioned in subsection (1), shall be sent to the Director and shall contain a statement of the grounds on which the owner or the persons entitled consider the restoration justified.

(3) The Director shall examine the reasons referred to above and shall either restore the design or reject the application if it does not consider the grounds valid.

(4) Restoration shall not entail prolongation of maximum duration of the industrial design.

- (5) Restored designs shall be published by the Director in the prescribed form.

Specifications, Drawings, etc

77.—(1) The specifications, drawings and specimen of registered industrial designs shall be kept by the Office where they shall be communicated upon request.

- (2) Specimens of industrial designs shall be kept in the Office for a period of eight years and may be examined by any interested person.
- (3) After publication any person may obtain an official copy of the specifications, designs and specimens.
- (4) Subsections (1), (2) and (3) shall apply to official copies furnished by applicants seeking to avail themselves of the priority of an earlier deposit and to the documents enabling certain applicants to claim the priority.
- (5) The applicant for registration seeking to avail himself abroad of the priority of his deposit before registration of the industrial design may obtain an official copy of his application.

Publication of Details of Industrial Designs

78.—(1) The Director shall publish the following details for each industrial design granted—

- (a) the number of the industrial design;
- (b) the name and address of the owner of the design;
- (c) the name and address of the creator of the design, unless he has requested not to be mentioned on the certificate of registration;
- (d) the name and address of the agent if there is one;
- (e) the date of filing of the application;
- (f) mention of priority, if priority has been validly claimed;
- (g) the date of registration of the design.
- (h) the title of the design.
- (2) The Director shall establish and determine the conditions of publication of the specification of the model, any specimens or designs and the claims.

Reproduction of Industrial Designs

- 79.**—(1) The Director shall reproduce the designs deposited at the Office.
- (2) Proof of the reproduction shall be at the disposal of the public at the Office.
- (3) Proof regarding publication of the application shall be given to the applicant or his successors in title, as well as to any party engaged in legal proceedings concerning the design.

Donation of Industrial Designs

80. Where designs have not been claimed by their owner within two years following the expiration of the period of protection, they shall be donated to an educational or research or cultural institution determined by the Minister.

Rights Conferred by Registration of Industrial Designs, etc

81.—(1) Registration of an industrial design shall confer upon its registered owner the right to preclude third parties from the following acts—

- (a) reproducing the industrial design in the manufacture of a product;
- (b) importing, offering for sale and selling a product reproducing the protected industrial design; or
- (c) stocking of such a product for the purposes of offering it for sale or selling it.
- (2) The rights conferred by the registration of an industrial design shall extend only to acts done for industrial or commercial purposes and shall not extend to acts in respect of a product embodying the protected industrial design after the product has been lawfully imported or sold in Kenya.
- (3) An industrial design in respect of which Kenya is a designated state registered by ARIPO by virtue of the ARIPO Protocol shall have the same effect in Kenya as an industrial design registered under this Act unless the director has communicated to ARIPO, in respect of application therefor, a decision in accordance with the provisions of the protocol that if a registration is made by ARIPO that registration shall have no effect in Kenya.

Transfer and Assignment of Industrial Designs

- 82.**—(1) Rights subsisting in an industrial design shall be transferred in whole or in part.
- (2) Acts involving transfer of ownership or the grant of the right of exploitation or the assignment of such right, pledge or cancellation of a pledge in respect of a design shall, on pain of nullity, be established in writing.
- (3) The acts mentioned in the subsection (2) shall not be enforceable against third parties unless they have been entered in the special register of designs kept by the Director.
- (4) The Director shall furnish to any person who so requests a copy of the entries in the special register of industrial designs, as well as the state of entries concerning industrial designs which are the subject of a pledge or a certificate establishing the absence of such entries.
- (5) In the absence of any provision to the contrary between the parties, joint owners of a registered design may separately transfer their shares, use the design and exercise the exclusive rights conferred by this Act, but may only jointly grant a licence to a third party to exploit the design.

Part XII
Rationalization Models or Technovations

Interpretation of Part

83. For the purposes of this Part, “rationalization model” means any solution of a technical character or relating to a technical organization which is capable of use in a unit of the national economy but which does not have the characteristic of an invention or a utility model and which relates in particular to—

- (a) machines, installations and products;
- (b) methods of production; and
- (c) methods of measurements and verification.

Presumption of Novelty, etc

84.—(1) A rationalization model shall be considered new if it has not previously been submitted for registration by another person within the same unit of the national economy or if it has not been used in that unit.

(2) A rationalization model may be based on the invention or adaptation of a known solution to the needs of a unit of the national economy.

(3) Rationalization models which cannot be used independently of each other shall be regarded as forming part of one model.

(4) Where a rationalization model submitted to a unit of the national economy is the same as one which has previously been submitted to the same unit by another person but which was not accepted for use at the time, the person who made the earlier submission shall be considered the author.

Certificate to Author of Rationalization Proposal

85.—(1) A rationalization certificate shall be issued to the author or co-authors of a rationalization proposal which has been accepted for use.

(2) The rationalization certificate shall be issued by the unit of the economy in which it is applied and any such certificates issued shall be reported to the director for registration in the register of rationalization models.

(3) Where it has been established that the subject of a rationalization model is protected in Kenya, the rationalization certificate shall be declared invalid at the request of the interested party.

Register of Rationalization Models

86.—(1) The Director shall maintain a register in which shall be recorded all rationalization certificates registered under section 85.

(2) The register may be consulted by any person, and any person may obtain extracts therefrom under the conditions prescribed in the Regulations.

Part XIII Contractual Licences

Rights of the Licensee

87.—(1) In the absence of any provision to the contrary in the licence contract, the licensee shall be entitled to do any of the acts referred to in section 36 in respect of the invention, utility model and industrial design without limitation as to time, in the whole of Kenya and in any field of use of the invention, utility model or industrial design.

(2) In the absence of any provision to the contrary in the licence contract, the licensee may not grant permission to any third person to do any of the acts referred to in section 36.

Rights of Licensor to Grant further Licences and to Use the Invention

88.—(1) In the absence of any provision to the contrary in the licence contract, the licensor may grant permission to any third person to do, and may himself do, any of the acts which constitute exercising rights of ownership.

(2) If the licence contract provides that such contract or the permission granted by it is exclusive, and unless it is expressly provided otherwise in the licence contract, the licensor may neither grant permission to any third person to do any of the acts referred to in section 36 and covered by the licence contract, nor do himself any of those acts, and the licensee shall be considered an exclusive licensee for the purposes of this Act.

Effects of Patent not Being Granted or Being Invalidated

89. Where, before the expiration of the licence contract, any of the following events occurs with respect to any application or patent referred to in that contract—

- (a) the application is withdrawn;
- (b) the application is finally rejected;
- (c) the grant of a patent is finally refused; or
- (d) the patent is finally declared invalid,

the court may make any order it deems reasonable under the circumstances for the repayment of the royalties, or the return of any consideration, paid or given under the contract, directly relating to any such application or patent.

Form of Licence Contracts

90. All licence contracts shall be in writing and shall be signed by the parties thereto otherwise they shall not be valid.

Petition for Registration

91.—(1) All licence contracts, including modifications thereof, shall be submitted to the Director for registration in the patent register.

- (2) A petition for registration may be made by any party to the contract.
- (3) The petition shall be accompanied by the documents prescribed by the regulations.
- (4) The petition shall be subject to the payment of the prescribed fee.
- (5) The Director shall issue to the applicant a receipt, which shall be proof of the fact of filing the petition and of the date on which it was filed; if no receipt is issued within fourteen days from the date of the petition, the petitioner may rely on other evidence to prove the fact and date.
- (6) Where—
 - (a) section 25 or subsections (2) to (4) of this section, and the rules relating thereto, have not been complied with; or
 - (b) the licence contract is unregistrable under section 92, the Director shall refuse to register the licence contract, stating full reasons for such refusal.
- (7) Before refusing to register the licence contract, the Director shall notify the petitioner and allow the parties—
 - (a) to submit any observations;
 - (b) to correct any defect in the petition; or
 - (c) to amend any term, or to correct any defect, in the licence contract that has been declared by the Director to be a term or defect precluding registration, within forty-five days from the date of the notification.
- (8) A licence contract shall be void if the registration has been refused by the Director in accordance with the provisions of this Act.

Prohibited Terms in Licence Contracts

92. The Director may refuse to register a licence contract if the effect of its terms is—

- (a) to permit or require the importation of technology from abroad when substantially similar or equivalent technology may be obtained on the same or more favourable conditions without importation from abroad;
- (b) to require payment of a price, royalty or other consideration which is disproportionate to the value of the technology to which the contract relates;
- (c) to require the licensee to acquire any materials from the licensor or from sources designated or approved by him, unless it is otherwise impossible, for all practical purposes, to ensure the reasonable quality of the products to be produced;
- (d) to prohibit the licensee from acquiring, or to restrict his acquisition of, any materials from any source, unless it is otherwise impossible, for all practical purposes, to ensure the reasonable quality of the products to be produced;
- (e) to prohibit the licensee from using, or to restrict his or her use of any materials which are not supplied by the licensor or by sources designated or approved by him, unless it is otherwise impossible, for all practical purposes, to ensure the reasonable quality of the products to be produced;
- (f) to require the licensee to sell products produced by him under the contract exclusively or principally to persons designated by the licensor;
- (g) to require the licensee to make available to the licensor without appropriate consideration any improvements made by the licensee with respect to the technology to which the contract relates;
- (h) to limit the volume of the products produced by the licensee with the help of the technology to which the contract relates;
- (i) to restrict or prohibit the export of the products produced by the licensee;
- (j) to require the licensee to employ persons designated by the licensor;
- (k) to impose restrictions on research or technological development carried out by the licensee to absorb or adapt the technology in connection with new products, processes or equipment;
- (l) to prohibit or restrict the use by the licensee of any technology other than the technology to which the contract relates;
- (m) to extend the coverage of the contract to technology not related to the use of the technology which is the main subject of the contract and to require consideration for such additional coverage;
- (n) to fix prices for the sale or resale of the products produced by the licensee with the help of the technology to which the contract relates;
- (o) to exempt the licensor from any liability consequent upon any defect inherent in the technology to which the contract relates or restrict such liability;
- (p) to prohibit or to restrict the use by the licensee, after the expiration of the contract, of the technology acquired as a result of the contract, subject, however, to any right of the licensor under the patent;
- (q) to require that disputes arising from the interpretation or performance of the contract be governed by a law other than the law of Kenya or that such disputes be brought before courts located in a country other than Kenya;
- (r) to establish the duration of the contract for a period which is unreasonably long in relation to the economic function of the contract, provided that any period which does not exceed the duration of the patent to which the contract relates shall not be regarded as unreasonably long;
- (s) to require the licensee to refrain from challenging the validity of the technology claimed by the licensor in relation to legal protection, infringement suits, and third party claims;
- (t) to restrict the licensee from entering into sales, representation or manufacturing agreements relating to

similar or competing technologies or products or to obtain competing technologies, when such restrictions are not needed for ensuring the achievement of legitimate interest, particularly including securing the confidentiality of the technology transferred or best effort distribution or promotional obligations;

(u) to prevent the licensee from adapting the technology to local conditions or introducing innovations in it or change to alternative inputs, or which require the licensee to introduce unnecessary designs or specification changes, if the licensee makes adaptations on his own responsibility and without using the licensor's name, trade or service marks or trade names, and except to the extent that this adaptation unsuitably affects those products, or the process for their manufacture, to be supplied by the licensor, his designates, or his other licensees, or to be used as a component or spare part in a product to be supplied to his customer;

(v) to impose acceptance of additional technology, future inventions and improvements, goods or services not wanted by the licensee;

(w) to impose restrictions on territories, quantities, prices, customers or markets arising out of patent pool or cross-licensing agreements or other international technology transfer interchange arrangements which unduly limit access to new technological developments or which would result in an abusing domination of an industry or market with adverse effects on the licensee, except for those restrictions appropriate and ancillary to co-operative arrangements such as co-operative research arrangements;

(x) to impose restrictions which regulate advertising or publicity by the licensee except where restriction of such publicity may be required to prevent injury to the licensor's goodwill or reputation where the advertising or publicity makes reference to the licensor's name, trade or service marks, trade names or other identifying items;

(y) to require payments or impose other obligations for continuing the use of industrial property rights which have been invalidated, cancelled or have expired recognizing that any other issue, including other payment obligations for technology, shall be dealt with by the appropriate applicable law and the terms of the agreement to the extent consistent with the law;

(z) to impose confidentiality after the expiry of the licence agreement or to impose unreasonably long period for secrecy following the commissioning of manufacturing facilities using the licensed technology, or to impose measures which limit technological learning and mastery, except those which relate to industrial property rights;

(aa) to impose requirements for payments even under conditions of *force majeure*;

(bb) to impose restrictions which prevent or hinder export by means of territorial or quantitative limitations or prior approval for export or export prices of products or increased rates of payments for exportable products resulting from the technology licensed;

(cc) to impose quality control methods or standards not needed or not wanted by the licensee, except to meet the requirement of a guarantee or when the product bears a trade mark, service mark or trade name of the licensor;

(dd) to require the licensee to provide equity capital or to allow the licensor to participate in the management of the licensee's business as a condition for obtaining the technology;

(ee) to restrict the licensee from taking measures that will enhance local technological capability and which are not prejudicial to the licensor's industrial property rights;

(ff) to restrict the use of local expertise in management and consultancy and any other positions;

(gg) to require the payment of royalty for patents granted outside Kenya or whose owner is resident, domiciled or established abroad and which does not have the priority provided for in a treaty to which Kenya is party;

(hh) to apply dissimilar conditions to equivalent transactions with other trading parties, thereby placing the licensee at a competitive disadvantage; or

(ii) to make the contract subject to acceptance of supplementary obligations which, by their nature or according to commercial usage, have no connection with the subject to such contracts.

Registration of the Contract and Issue of Certificate

93.—(1) “When the Director finds that the contract may be registered, he shall register the contract and issue a certificate of registration to the petitioner.

(2) If the Director fails—

- (a) to notify the petitioner of defects in the petition or of terms or defects precluding registration of the licence contract, within ninety days of the date of the petition; or
- (b) to notify the petitioner of his decision to refuse to register the licence contract, within ninety days from the date of the notifications,

the licence contract shall be deemed to have been registered and the Director shall issue a certificate of registration to the petitioner but if no certificate is issued within fourteen days from the expiration of the ninety days period, the petitioner may rely on other evidence.

(3) The registration shall take effect—

- (a) if the petition was made within sixty days from the conclusion of the contract, on the date of the conclusion of the contract; and
 - (b) in all other cases, on the date of the petition.
- (4) When the petition is corrected or the licence contract is amended the petition shall be deemed to have been made on the date when the correction or amendment was made.
- (5) The registration of the certificate shall state—
- (a) the name of the parties to the contract and of the licensee if he is not a party;
 - (b) the date of the petition;
 - (c) the date of the registration; and
 - (d) the registration number; all of which shall be published in the Gazette.

Remedies

94. An appeal against a decision of the Director may be made to the Tribunal by the petitioner within two months of his refusal provided that the grounds of such an appeal shall be limited to the following grounds—

- (a) that the decision of refusal contains no statement of the reasons for refusal;
- (b) that none of the reasons for refusal specified in the decision is a valid reason under this Act or was rightly applied to the petitioner or to the licence contract; or
- (c) that the procedure applied by the director was irregular and prejudicial to the rights of the petitioner.

Compulsory Licences for Non-Working and Similar Reasons

95.—(1) At any time after four years from the filing date of an application or three years from the grant of a patent, whichever period last expires, or one year after the working of a patent has been discontinued, any person may apply for a licence to exploit the licence on any of the following grounds—

- (a) that the patented invention, being capable of being worked in the country, has not been worked;
 - (b) that the existing degree of working of the patented invention in the country does not meet on reasonable terms the demand for the patented product on the domestic market or for the purposes of exportation;
 - (c) that the working of the patented invention in the country is being hindered or prevented by the importation of the patented product; and
 - (d) that, by reason of the refusal of the owner of the patent to grant licences on reasonable terms, the establishment or development of industrial or commercial activities in the country, or the adequate export from the country under the right market conditions, or environmental conservation efforts, are unfairly and substantially prejudiced;
 - (e) that products from the patented invention are not being made available to the public at a reasonable price.
- (2) Where the patented invention is a process, “patented product” in subsection (1) means a product obtained directly by means of the process.
- (3) A compulsory licence shall not be granted in respect of a patent if the owner of the patent satisfies the court that the patent has not been worked because of *force majeure*.

Compulsory Licences Based upon Interdependence of Patents

96.—(1) Where a patented invention cannot be worked without infringing rights derived from an earlier patent, the owner of the later patent may request the Tribunal at any time for the grant of a compulsory licence with respect to the earlier patent to the extent necessary for the working of his invention if the invention—

- (a) serves industrial purposes different from those served by the invention which is the subject of the earlier patent; or
 - (b) constitutes substantial technical progress in relation to the last-mentioned invention.
- (2) If the two inventions mentioned in subsection (1) serve the same industrial purposes, a compulsory licence may be granted under that subsection only on condition that a compulsory licence shall also be granted in respect of the later patent to the owner of the earlier patent if he so requests.
- (3) In this section, “earlier patent” means a patent granted on an earlier application or benefiting from an earlier validly claimed priority date, and “later patent” shall be construed accordingly.

Compulsory Licences for Products and Processes Declared to be of Vital Importance

97.—(1) The Minister may, by notice on the Gazette, direct that, for patented inventions concerning certain kinds of products, or processes for the manufacture of such products, declared in the direction to be of vital importance for the defence or the economy of the country or for public health, or scientific and technological advancement, or for environmental conservation compulsory licences may be granted.

(2) Compulsory licences with respect to any products or processes specified in the direction referred to in subsection (1) may be requested at any time after the grant of the relevant patent.

Preconditions to Grant of Compulsory Licences

98. A compulsory licence shall not be granted unless the person requesting the licence—

- (a) satisfies the Tribunal that he has asked the owner of the patent for a contractual licence but has been unable to obtain the licence on reason; or
- (b) offers guarantees satisfactory to the Tribunal to work the relevant invention sufficiently to remedy the deficiencies (or to satisfy the requirements) which gave rise to his request.

Grant and Terms of Compulsory Licences

99.—(1) In considering a request for a compulsory licence, the Tribunal shall decide whether a compulsory licence may be granted and shall then, if it decides in favour of the grant and taking into account any terms agreed by the parties proceed to fix the terms, which shall be deemed to constitute a valid contract between the parties and shall be governed by the provisions of contractual licences.

(2) In fixing the terms under subsection (1), the Tribunal shall ensure that the compulsory licence—

- (a) entitles the licensee to do any act mentioned in section 36, except importation;
- (b) does not entitle the licensee to grant further licences, without the consent of the owner of the patent;
- (c) is non-exclusive; and
- (d) provides for the payment to the owner of the patent of remuneration which is equitable with due regard to all the circumstances of the case.

Transfer of Compulsory Licences

100. A compulsory licence may be transferred only within the industrial undertaking in which the relevant invention is used, and no such transfer shall be valid until the consent of the Tribunal has been obtained.

Cancellation of Compulsory Licences

101.—(1) On the application of the owner of the patent, the Tribunal may cancel a compulsory licence if—

- (a) the licensee fails to comply with the terms of the licence; or
- (b) the conditions which justified the grant of the licence have ceased to exist;

so however that in the later case a reasonable time shall be given to the licensee to cease working the relevant invention if an immediate cessation would cause him to suffer substantial damage.

(2) On the application of the owner of the patent or the licensee, the Tribunal may vary the terms of a compulsory licence if new facts justify the variation and in particular (without prejudice to the generality of the foregoing) if the patentee has granted contractual licences on more favourable terms.

Registration of Grants, Cancellation or Variation

102. Where the Tribunal grants, cancels or varies the terms of a compulsory licence, the Tribunal shall inform the Director, who shall register without fee in the register the grant, cancellation or variation.

Licences of Right

103.—(1) The owner of a patent may request the Director to make an entry in the register to the effect that licences under the patent are to be available as of right.

(2) The request shall be notified by the Director to the licensees under the patent.

(3) Any licensee may, within the prescribed time limit, object to the entry requested, on the ground that the owner of the patent is, by the relevant licence contract, precluded from granting further licences.

(4) Where the Director receives no objection under subsection (3) or considers all objections made to be unfounded, he shall make the requested entry in the register and shall publish the entry.

(5) While a patent is the subject of an entry under this section, any person may require the owner of the patent to grant him a non-exclusive licence under the patent on terms which, in the absence of agreement between the parties, shall be fixed by the Tribunal.

(6) The amount of the annual fees with respect to a patent which is the subject of an entry under this section, falling due after the date of the entry, shall be reduced by half.

(7) The owner of the patent may at any time request the Director to cancel an entry under this section; and the Director shall cancel the entry after payment of the balance of all annual fees which would have been payable if no entry had been made.

(8) Section 101 shall apply *mutatis mutandis* where the terms of a licence granted under subsection (5) have been fixed by the court.

Part XIV
Exploitation of the Protected Invention by the Government or
by Third Persons Authorized by Government

Exploitation of the Protected Invention by the Government or by Third Persons Authorized by the Government

- 104.**—(1) Where a vital public interest, in particular, national security, education, environmental conservation, health or the development of vital sectors of the public economy requires that one or more acts be performed with respect to protected invention, the Minister may decide that the protected invention shall, even in the absence of the authorization of the owner of the right, be exploited by a Government agency or by a third person designated by the Minister, subject to the payment of remuneration to the owner of the right.
- (2) The Minister shall take this decision after consultation with the Director and after a hearing to which the owner of the right and any licensee, in particular, shall be invited.
- (3) Once the decision of the Minister has been taken, the director shall fix the amount of the remuneration to be paid to the owner of the patent, such remuneration being equitable with due regard to all the circumstances of the case.
- (4) The owner of the patent may apply to the court against the decision of the Director fixing the amount of remuneration; and the appeal shall not suspend the effects of the decision referred to in subsection (1).

Part XV
Surrender, Invalidation and Revocation

Surrender

- 105.**—(1) A patent, utility model or industrial design may be surrendered by its owner.
- (2) The surrender may be limited to one or more claims of the patent, utility model and industrial design.
- (3) The surrender shall promptly be recorded in the register and published by the Director and the surrender shall be effective only after it has been published.
- (4) If a licence has been recorded in the register, surrender of the patent, utility model and industrial design shall only be registered upon the submission of a declaration by which the licensee consents to the surrender, unless the latter has expressly waived this right in the licence contract.

Invalidation

106.—(1) Any interested person may, in proceedings instituted by him against the owner of a patent, utility model and industrial design or in proceedings instituted against him by the owner, request the Tribunal to invalidate the patent, utility model or industrial design.

(2) The Tribunal shall invalidate the patent, utility model and industrial design on any of the following grounds—

(a) that any of the conditions referred to in section 27 (2) were not fulfilled, that is—

(i) that the claimed invention is not patentable within the meaning of this Act;

(ii) that the claimed invention is not excluded from protection; or

(iii) that the description and the claims comply with the requirements prescribed by section 18 (3) and (4) and the rules pertaining thereto; or

(b) that the person to whom the patent was granted had no right to the patent, utility model and industrial design, provided that the patent has not been assigned to the persons who has the right to the patent.

(3) Where the provisions of subsection (2) apply only to some of the claims or some parts of a claim, those claims or parts of a claim shall be invalidated by the Tribunal.

(4) The Tribunal may require the owner of the patent to submit the patent for the purpose of examination, publications and other document showing the prior art which have been referred to either in connection with an application for a patent, utility model, and industrial design or other title of protection filed, for the same or essentially the same invention, by the owner of the patent, with any other national or regional industrial property office, or in connection with any proceedings relating to the patent or other title or protection granted upon such application.

(5) Notice of the request referred to in subsection (1) shall be served on any licensee under the patent, utility model and industrial design who shall be entitled to join in the proceedings in the absence of any provision to the contrary in the licence contract.

(6) Where, before or during the proceedings, it is alleged, or it appears to the Tribunal, that the right to the patent belongs to a person who is not a party to the proceedings, notice of the request referred to in subsection (1) shall be served on that person, who shall be entitled to join in the proceedings.

Effects of Invalidation

107.—(1) Any invalidated patent or claim or part of a claim shall be regarded as null and void from the date of the grant of the patent.

(2) As soon as the decision of the Tribunal is no longer subject to appeal, the chairman of the Tribunal shall inform the Director who shall register it in the patent register and publish it as soon as possible.

Revocation

108.—(1) A patent right shall be revoked if it is not worked within two years of being granted.

(2) A patent right may be revoked where the title does not correspond to its real subject matter.

(3) A patent may be revoked if it does not conform to the provisions of disclosure.

Part XVI Infringement

Acts Constituting Infringement

109. Subject to sections 38, 39 (5), 95, 97 and 98, any act specified in section 36 and performed by a person other than the owner of the patent and without the authorization of the owner of the patent, in relation to a product or a process falling within the scope of a validly granted patent, shall constitute an infringement of the patent.

Relief

110.—(1) On the request of the owner of the patent, utility model and industrial design, the Tribunal shall grant the following relief—

(a) an injunction to prevent infringement where infringement is imminent or to prohibit the continuation of the infringement, once infringement has started;

(b) damages; or

(c) any other remedy provided for in law.

(2) Infringement proceedings in relation to utility models shall be instituted by the Director on behalf of the owner.

Declaration of Non-Infringement

111.—(1) Subject to subsection (2), any person showing a legitimate interest may request the Tribunal to declare that the performance of any specific act does not infringe the patent and the owner of the patent and any licensee under the patent shall have the right to be defendant in the proceedings.

(2) No declaration under subsection (1) shall be made—

- (a) if the acts to which the request relates are already the subject to infringement proceedings; or
- (b) if the person making the request is unable to prove that he has previously demanded from the owner of the patent a written acknowledgment of the lawfulness of the acts referred to and that the owner of the patent has refused such demand or has failed to reply within reasonable time.

Threat of Infringement Proceedings

112.—(1) Any person threatened with infringement proceedings who can prove that the acts performed or to be performed by him do not constitute infringement of the patent, utility model and industrial design may request the court to grant an injunction to prohibit such threats and to award damages for financial loss resulting from the threats.

(2) The mere notification of the existence of a patent, utility model and industrial design shall not constitute a threat of infringement.

Criminal Proceedings

113.—(1) Any infringement of the patent shall constitute an offence.

(2) Such an offence shall be punishable by a fine not less than ten thousand shillings and not exceeding fifty thousand shillings or by imprisonment for a term not less than three years and not more than five years or to both.

Presumption of Use of Patented Process

114. If a patent relates to a process for the manufacture of a product showing novel features, the product shall, in the absence of the proof to the contrary be presumed to have been manufactured by that process.

Legal Proceedings by Licensee

115.—(1) Any exclusive licensee within the meaning of section 32 (2) may, by registered letter, request the owner of the patent to institute legal proceedings for a specific relief with respect to any infringement specified by the licensee.

(2) The licensee may, if the owner of the patent refuses or fails to institute the legal proceedings within three months from the request, after giving notice to the owner of the patent, institute such proceedings in his own name; and the owner of the patent may join in the proceedings.

(3) Even before the end of the three month period referred to in subsection (2), the Tribunal may, on the request of the licensee, grant an appropriate injunction to prevent infringement or to prohibit its continuation, where the licensee shows that immediate action is necessary to avoid substantial damage.

Burden of Proof

116. The burden of proof in matters relating to infringement of industrial property rights shall lie with those who claim their rights have been infringed and any proceedings using a reversal of the burden of proof shall be null and void under the provisions of this Act.

Part XVII
Industrial Property Tribunal

Appeals

117. Where under this Act provision is made for appeals from the decisions of the director, all such appeals shall be made to the Industrial Property Tribunal in accordance with the provisions of this Part.

Industrial Property Tribunal

118.—(1) For the purposes of hearing and determining appeals in accordance with section 117 and of exercising the other powers conferred on it by this Act, there is hereby established an Industrial Property Tribunal which shall consist of chairman and four members appointed by the Minister.

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- (2) The chairman of the Tribunal shall be a person who—
 - (a) has been a judge of the High Court of Kenya; or
 - (b) is and has been, for not less than seven years qualified and entitled to practise as an advocate.
- (3) The Tribunal shall sit at such times as it may appoint.
- (4) They shall be paid to the chairman and the members of the Tribunal such remuneration and allowances as the Minister may determine with the approval of the Minister responsible for finance.
- (5) The Minister shall appoint a public officer to be secretary to the Tribunal.

Powers of the Tribunal

119.—(1) The Tribunal shall have power to make any order for the purpose of securing the attendance of any person, the discovery or production of any document, or the investigation or punishment for any contempt of court, which the court has power to make.

(2) Upon any appeal to the Tribunal under this Part, the Tribunal may—

(a) confirm, set aside or vary the order or decision in question; or

(b) exercise any of the powers which could have been exercised by the director in the proceedings in connection with which the appeal is brought; or

(c) make such orders as to costs as it may think fit.

Appeals to Court

120.—(1) Any party to proceedings before the Tribunal may appeal in accordance with rules made under this Part from any order or decision of the Tribunal to the court.

(2) Upon the hearing of an appeal under this section, the court may—

(a) confirm, set aside or vary the order or decision in question;

(b) remit the proceedings to the Tribunal with such instructions for further consideration, report, proceedings or evidence as the court may think fit to give;

(c) exercise any of the powers which could have been exercised by the Tribunal in proceedings in connection with which the appeal is brought; or

(d) make such order as it may think just as to the costs of the appeal or of earlier proceedings in the matter before the Tribunal.

Assessors

121. The chairman of the Tribunal may appoint any person with special expert knowledge to act as an assessor in an advisory capacity in any case where it appears to the Tribunal that such knowledge is required for the proper determination of the case.

Rules

122. The Minister may make rules for regulating generally the practice and procedure of the Tribunal.

Reference to the tribunal by the Director

123.—(1) When any matter to be determined by the Director under this Act appears to him to involve a point of law or to be of unusual importance or complexity, he may, after giving notice to the parties refer the matter to the Tribunal for a general direction and shall, thereafter in relation to such matter, act in accordance with the general direction of the Tribunal or any direction substituted thereafter on appeal to the court.

(2) Where any matter has been referred to the Tribunal in terms of subsection (1), the director and the parties thereto shall be entitled to be heard by the Tribunal before any decision is made in such matter and may appear or be represented by an advocate.

Part XVIII
Miscellaneous Provisions

Regulations

124. The Minister may make regulations prescribing anything which under this Act is to be prescribed by the regulations and generally for the better carrying out of the objects and purposes of this Act or to give force or effect to its provisions or for its better administration.

Repeals

125. The Patents Registration Act and the United Kingdom Industrial Designs Act (hereinafter referred to as the “former patent laws”) are repealed.

Cap. 508. Cap. 510

Transitional and Saving Provisions

126.—(1) Where a patent has been registered in the country under the former patent laws and the privileges and rights conferred by the registration were effective immediately before the commencement of this Act then—

- (a) subject to the following paragraphs, the patent shall be treated in Kenya as if it had been granted under this Act;
 - (b) the patent shall expire as regards Kenya when those rights could have expired if this Act had not been enacted;
 - (c) the patent may be invalidated only where those privileges and rights could be declared as not having been acquired in the country if this Act had not been enacted;
 - (d) the certificate of registration, or a certified copy thereof, shall be admissible as *prima facie* evidence of the date and the fact of registration; and
 - (e) an action for infringement shall lie under this Act only if the alleged infringement occurred on or after the commencement of this Act, and in other case may be instituted and disposed of as if this Act had not been enacted.
- (2) So far as is necessary for the purposes of subsection (1), the register of patents under the former patents laws shall be maintained as nearly as may be, and shall be regarded and dealt with, as if it were part of the register under this Act.
- (3) Section 41 shall not apply to licence contracts and contracts assigning the right to a patent or assigning applications or patents, provided that the said contracts were concluded before the commencement of this Act and are submitted for registration under this Act.
- (4) Within twelve months from the commencement of this Act, the Attorney-General may, by order, make any further transitional or saving provisions (not inconsistent with this section) which appear to him to be necessary or desirable.

