



KENYA INDUSTRIAL
PROPERTY OFFICE
(KIPO)

MINISTRY OF TRADE
AND INDUSTRY

Guide to Patenting

in

Kenya

INTRODUCTION

Patents Fuel Progress

Where would the world be without inventions and innovations? At a backward stage of Industrial Development without doubt. Technological progress and economic strength in any modern nation, Kenya being no exception, depends greatly on the ability of its nationals to be creative and innovative and be aggressive in the promotion of trade both at home and abroad. Patents play a major role in the stimulation of inventive activity.

Patents offer inventors monopolies on their creations for specific periods, and thus provide incentives for research and development. Without the possibility of patent protection, many people might not take the risks or invest the time and money involved in devising and perfecting new products. For example, our society would have benefitted greatly were we to have protected products such as the *kiondo* and even certain vaccines for livestock diseases produced in Kenya.

It is important that new products become available on the market continuously, otherwise without them the economy would quickly stagnate.

But patents do more than keep creative wheel spinning. They are also a means of technological exchange. Each patent document describes a new aspect of a technology in clear and specific terms and is available for anyone to read. Patents are made public specifically to promote the sharing of knowledge. As such they are vital resources for entrepreneurs, researchers, inventors, academics and others who need to keep up with development in their fields.

Purpose of this Guide

This booklet explores the two main ways patents may be important to you the inventor, business person or researcher as a source of protection and of information. This guide is designed to be your introduction to patents and patent procedures, and to outline how you can use the resources of the Kenya Industrial Property Office to further your business or research venture.

It is not, however, a comprehensive text on patent laws. Nor is it a substitute for the professional advice you may need from registered patent agents to assist you in protecting your invention.

For more detailed information on patent procedure, consult the Industrial Property Act, Cap. 509 of 1989 revised in 1991 and Industrial Property Regulations of 1993, all available from the Government Printer, Haile Selassie Avenue, Nairobi.

Who we are: The Kenya Industrial Property Office

The Government Department responsible for granting patents in Kenya is the Kenya Industrial Property Office (KIPO). KIPO is housed at Kenya House, Koinange Street in Nairobi.

**Address: Director,
Kenya Industrial Property Office,
P.O. Box 51648,
NAIROBI.**

**Telephone: 332648, 332336-9
Fax: 219430**

KIPO offices, by mid 1995 will be moved to Posta Sacco Plaza, 8th, 9th, and 16th floors situated at the junction of Uhuru Highway and University Way, Nairobi.

What Can You Patent?

Yes: Protection of inventions in any field of Technology.

Examples: A product or process in the following main sections of technology.

- (a) Human Necessities: Agriculture, foodstuff, tobacco, personal or domestic articles, health and amusement.
- (b) Performing operations and transporting: separating, mixing, shaping, printing and transporting.
- (c) Chemistry and metallurgy.
- (d) Textiles and paper.
- (e) Fixed Constructions: Building, earth moving and mining.
- (f) Mechanical engineering, lighting, heating, weapons, blasting including engines or pumps and engineering in general.
- (g) Physics: Instruments and nucleonics.
- (h) Electricity.

No: There are exceptions. The following are not regarded as inventions for patent protection:

- Discoveries or findings that are products or processes of nature where mankind has not participated in their creation (including animals, plants and micro-organisms).
- Scientific and mathematical methods and theories.
- Schemes, e.g. investment or insurance schemes.
- Business methods e.g. credit or stock method.
- Computer programmes.
- Rules for playing games (the games equipment may be patentable).
- 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 or apparatus for use in any of those methods or;
- Mere presentation of information.

Note, also that some inventions are not patentable under the Industrial Property Act. They are:—

- Plant varieties, but not parts thereof or products or biotechnological processes.
- Inventions contrary to public order, morality, public health and safety, principles of humanity, and environmental conservation; and
- Any other inventions that may be declared non-patentable by the Minister.

What are the Requirements for Patentability?

There are three major requirements for an application for issue of patent:—

- (a) Novelty.
- (b) Inventive step.
- (c) Industrial application.

(a) NOVELTY

To be granted a patent, the invention must be new. This means that it must not have been described sufficiently to enable the invention to be understood, by word of mouth, use, in any printed publication, or in any other way, anywhere in the world before a first application is made for a patent. This type of novelty is known as absolute novelty.

To be granted a patent say for a door lock you must be the original inventor of the lock (or the assignee of the inventor). And it must be the first such door lock in the world.

What is more, you cannot obtain a valid patent in Kenya if your invention was made public before you filed the application. There is, however a 12 month grace period. If it is disclosed publicly, you can still file in Kenya within the twelve months following that disclosure.

How do you establish whether an invention is novel?

Novelty is assessed by carrying out searches in existing printed publications. These publications may include previous patent specifications. It is highly desirable to have a search carried out in instances where patents in foreign countries are required. This

is because foreign patent applications are costly and the possibility of obtaining strong patents should be properly assessed.

(b) INVENTIVE STEP (OR NON-OBVIOUSNESS OR INVENTIVE INGENUITY)

To be patentable, your invention must be a development or an improvement that would not have been obvious beforehand to workers of average skill in the technology involved. You cannot offer an electric door lock that is merely a bit faster or stronger than others and that any door lock designer could easily come up with. Your door lock must elicit a "why-didn't-I-think-of-that" reaction from other designers in the field.

You may obtain a patent for an improvement to an existing patented invention, but keep in mind that the original patent may be in force. Hence, manufacturing or marketing the product with your improvement would probably be an infringement. This situation is often resolved by agreement between the patentees by granting licences to each other.

The requirement that an invention be new makes it essential that, before an application for a patent is made, the invention must be kept secret.

(c) INDUSTRIAL APPLICATION (OR UTILITY)

A valid patent cannot be obtained for something that does not work, or that has no useful function. If your door lock does not work, it will fail the utility test.

The Industrial Property Act also requires that for an invention to be patentable, it must be capable of being applied in Industry or Agriculture. Therefore for you to get a patent for your invention, the invention must be useful on a practical level.

Registered Patent Agents

Preparing and prosecuting following through on a patent application is a complex task. Prosecution involves corresponding with the Industrial Property Office, making any necessary amendments to the application and fixing the legal scope of the patent protection. All this requires broad knowledge of patent law and office practice-knowledge that you can expect from a specialist known as registered Patent Agent.

The drafting of any patent specification is a highly specialized task. An inadequate specification can result in the loss of all rights in the invention.

A trained patent agent can save you from many headaches caused by such things as a poorly drafted patent that inadequately protects your invention. Hiring such an agent is mandatory for foreign applicants. Although hiring of a patent agent by local patent applicants is not mandatory, it is highly recommended that in complex application inventors have one.

Beware of unregistered patent agents; they are not authorized to prosecute applications and are not subject to the office discipline. A list of patent agents is kept in the Kenya Industrial Property Office.

The patent agent's fees are not regulated by the office. You and your agent should agree on fees before work on your application begins.

Once you have appointed a patent agent, the office will correspond with no one else except the Agent regarding the processing of your application. You may, however, change patent agents at any time.

The office can provide you with a list of registered agents, but cannot recommend any particular one to you.

Who May Apply for a Patent?

Only the inventor or another person or body to whom he has assigned his rights to the invention, may apply for a patent. There may be more than one inventor in respect of a single invention, and they may be joint owners of a patent application or patent. In the case of an inventor who is an employee, it is often an implied or specified term of employment that inventions be assigned to the employer.

Irrespective of the terms of an employment contract, no inventor is obliged to assign an invention to an employer if the invention was not made within the scope and course of the inventor's employment.

An invention can be owned jointly in equal shares between an employee and his employer where an invention results from both the personal contribution of the employee and resources supplied

by the employer. In such case the employer has an exclusive right to a licence of exploitation and the employee shall have the right to a fixed remuneration.

When to Apply for a Patent

In Kenya, patents are given to the first inventor to file an application. Therefore, it is wise to file as soon as possible after completing your invention, in case someone else is on a similar track. Even if you can prove that you were the first to conceive of the invention, you lose the race if a competing inventor files before you do.

On the other hand, filing too soon, while you are still developing your invention, may mean omitting essential features from the application. You may then have to reapply, adding to your expenses and risking possible patents disputes.

It is imperative also, not to advertise, display or publish information on your invention too soon. Public disclosure of your invention before filing will make it impossible to obtain a valid patent.

There is an exception in Kenya if the disclosure was made by the inventor, less than twelve months before filing. Most other countries require filing before use or written disclosure anywhere.

How is a Patent Application Made?

A patent application is made by filing a patent specification together with the necessary forms, and application fees at the Kenya Industrial Property Office in Nairobi. The patent specification includes the request, a description of the invention, one or more claims, drawings or formula where necessary for a clear understanding of the description, and an abstract.

A patent application consists of specification and often drawings or formulae and an abstract. The abstract is a brief summary of about a hundred and fifty words of the content of the specification. The specification comprises:

- (a) A clear and complete description of the invention and its usefulness;
- (b) Claims which define the boundaries of patent protection.

Your specification must be so clear and complete that it will enable anyone with average skill in the technology to make or use the invention.

Information you specify as protected by your claims cannot be used freely (copied, manufactured or sold) by others until the patent expires. Information not protected by your claims can be used immediately by anyone.

The challenge is to draft the claims so that your invention is defined broadly enough to provide maximum protection against potential infringers, while at the same time being sufficiently specific to identify your invention and distinguish it from all prior inventions.

Assisting Your Patent Agent

You can assist your agent to obtain the strongest possible patent and avoid unnecessary costs by providing him or her with the right information. Carefully prepare a statement covering the following points:

- (a) Subject matter of the invention.
- (b) A broad description of the invention.
- (c) Objectives of the invention—its main practical advantages over existing practices or products.
- (d) The “preferred practice” that is, the most appropriate use of your invention giving details of at least one practical application (for example, if you invented a new knitting machine, you should specify what items, such as stockings, sweaters, bags, etc; the machine makes best. You should also mention normal variations to be expected, e.g. how many stockings in a batch of 10,000 knitted by your machine will be defective).
- (e) Features of the invention that are new and distinguish it from what has come before. State these features regardless of whether they may be patented.
- (f) The scope of the invention—the materials, compositions, conditions, etc, used to obtain good results.
- (g) Limitations. (Can one obtain satisfactory results throughout the given range of the invention, or are there exceptions?)
- (h) Results of laboratory or commercial tests illustrating both preferred practice and the conditions under which one could expect unfavourable or hazardous results.

- (i) Lists of relevant patents or technical articles you have already found in any literature search including full details such as name of inventor, number of patent, country and date of issue, or name of periodical and date. Indicate the similarities and differences of practices or products relevant to your invention.
- (j) An indication of any disclosure you have made.
- (K) Your name, address and citizenship.
- (l) All countries in which you would like to file for a patent.

Filing your Application

Filing a patent application means preparing a formal application together with a written request (see Appendix I asking the Director to grant you a patent).

You must pay the prescribed filing fee and submit the following:

- (a) Request.
- (b) Description.
- (c) Claims.
- (d) Drawings.
- (e) Abstract.

Do not submit models or specimens of the invention unless the Director requests for them.

Once accepted for filing, your application is assigned a number and filing date, and you will be informed of these. This is not grant of a patent. It simply means your application will be published 18 months after the filing date. Kenya follows a "first-to-file-rule". Where two or more applications claiming the same invention are filed, only the earliest filed application has the right to be patented, regardless of whether the inventors or applicants are identical or not.

Requesting Examinations

Your application will not automatically be examined simply because you have filed it. You must formally request for preliminary examination and search and attach the examination fees. This request must be made within 3 years of the Kenyan filing date, otherwise your application will be regarded as

abandoned. If this happens, you may request for reinstatement through a petition to the Director and the payment of a prescribed late fee.

Why would you file and not automatically request examination? Perhaps you need time to assess the feasibility or marketability of your invention. Filing gives you some protection of your invention without having to fully commit yourself to the patent procedure. Your competitors will likely be wary of infringing on your invention after your application is published because you could seek retroactive compensation in the event that you are granted a patent.

However, if you do not request for examination within 3 years period, anyone will be able to freely make, use or sell the product or processes described in your application.

Once you have requested for examination you will probably be eager to see results quickly. Remember that patent examiners consider cases in the order in which they are received. Therefore, the sooner you request for examination, the quicker it is to process your application.

Filing Prior Art and Protests

Patent applications are made public 18 months after their Kenyan filing date, or an earlier foreign filing date if applicable. Anyone else may raise questions about the patentability of your invention or one of its claims by filing what is known as "Prior Art"—information that might cause the patent examiner to reject one or more of your claims. The prior art can be patents or published material that has a bearing on the case. An explanation of how the information is pertinent is also required.

Special Order Examination

Perhaps you have special reasons for wanting an early examination of your application. You expect imminent competition or you hope to establish a business once you have received protection for the invention. If your case is exceptional in this way, you may ask for advanced examination by means of a "Special Order" request, accompanied by a fee and an affidavit outlining reasons for the request.

Note, however, that patents are not usually granted earlier than 20 months after their priority date.

The Examiner's Task

The patent examiner will assess your application to determine whether it is in the proper format. The next step is a study of the claims and a search among prior patents and other technical literature to find what is most closely related to the features covered in your claims. The examiner will reject what is old, obvious or improper in your claims through a report to you or your agent.

Office Letter of Rejection

The examiner's search often results in the rejection of some claims. This is the result of patent agents drafting broad claims in an attempt to obtain the fullest possible protection. The examiner may discover previous patents or publications which show every feature of one or more claims in your application or the examiner may judge some claims to be obvious to a person having ordinary skill in the field. The examiner's rejection will be in a report or letter called a "Patent Office Action". The Action may reject your whole application or only some claims, or it may demand other changes in your application.

Responding to Rejection

If the examiner rejects some of your claims, do not despair, you may respond to the objections as long as you do so within the period specified in the Patent Office Action. Your patent agent must send the response, called the "amendment letter", to the Director.

The response may ask the Director to amend your application by changing or cancelling some claims, or adding new claims. You must meet or overcome each objection raised by the examiner.

Helping Your Agent With Amendments

Your agent will carefully study the Office Action to help you decide whether to abandon your application now, thus avoiding further expenses. If you decide to continue, you may be able to help prepare the amendment letter. You are in the best position to know the practical details of your invention, and can point out its novel features and advantages, as compared with others cited in the Office Action. If you want to make changes to your

invention, inform your agent promptly. He or she may recommend filing a new application in accordance with Patent Office rules, to obtain the full protection you need.

Reconsideration by the Examiner

On receiving your response, the examiner will study it and prepare a second Office Action. This may be a "notice of allowance" telling you that you will be granted a patent. Or it may be a call for further amendments. This exchange of office actions and responses may be repeated until the examiner allows your application or states that the Action is final.

Appealing

If the examiner makes a final rejection of your application, you still have the right to appeal to the Director by requesting that the Director review the examiner's rejection. The review is conducted by the Patent Appeal Committee, a special committee of senior officials in the office. If you wish, you can appear before this committee.

If the Director rejects your appeal and refuses to grant a patent, you may take your case to the Tribunal and from there to the High Court of Kenya and Appeal Court of Kenya respectively.

Re-examination of a Granted Patent

You have been granted a patent! Wonderful! you still may have hurdles to overcome. After issue, the Director or a third party may ask that one or more claims of your patent be re-examined. This can happen at any time during the term of your patent. The request must be based on "prior art" documents, i.e. written descriptions of the invention that are available to the public. The Director may appoint a re-examination board which will issue a certificate cancelling, confirming or amending your patent claims as appropriate. You may appeal decisions that cancel or amend claims to the Industrial Property Tribunal. You cannot, however, appeal to the Director's refusal to set up a re-examination board.

Re-issue and Disclaimer

If you own a patent that inadvertently contains omissions or mistakes you may apply to have it reissued within four years of its issue to broaden or amend its claims, or you may apply for a

disclaimer any time after issue to narrow the scope of some or all of the claims of your patent.

Filing a Second Application

You may, within a year, file a second application on your invention and receive the same filing date as before. This allows you to make some minor modifications to your application while retaining the early date, provided you did not use the first application as a basis for filing abroad.

Your first application must not have been refused, withdrawn, abandoned or made public.

Summary of Steps to Obtain a Patent in Kenya

- (a) Find a patent agent.
- (b) Do a preliminary search (if there is an existing patent, consider ending the process now).
- (c) Help your agent prepare a patent application.
- (d) File your application.
- (e) Request examination.
- (f) Examiner does search for prior patents and studies claims.
- (g) Examiner either approves or rejects application.
- (h) Respond to examiner's objections and requirements.
- (i) Examiner reconsiders and either approves or calls for further amendments.
- (j) If final decision is rejection you may appeal.
- (k) If final decision is approval then a patent is granted.

Applying for a Patent Outside Kenya

Obtaining a Kenyan patent does not protect your invention in another country. If you wish such protection, you will have to apply for foreign patents.

Suppose for example, you have invented a vaccine against East Coast Fever in cattle and hope to cover the market in countries where the vaccine may be in demand. You will probably want a patent not only in Kenya, but also in most countries in Africa

where East Coast Fever is a major cattle killer and the vaccine can be used to control the disease. You might also want a patent in other countries in the world where East Coast Fever is prevalent. Otherwise, someone in one of those countries might copy your invention and market it in competition with you.

You may apply for a foreign patent through Kenya Industrial Property Office (KIPO) under:—

- (i) Patent Co-operation Treaty (PCT) administered by WIPO in Geneva, Switzerland covering about 73 countries as per July, 1994. A single application is sufficient to cover those 73 countries (*see* Appendix II) for the list of countries under PCT).
- (ii) ARIPO (African Regional Industrial Property Organization) in Harare, Zimbabwe to cover 12 African countries, listed in Appendix III.
- (iii) OAPI (African Intellectual Property Organization) for African French speaking countries, situated in Yaounde in Cameroon covering 14 countries.
- (iv) EPO (European Patent Office) in Munich, Germany covering 17 countries in Europe under the European Patent Organization.
- (v) Apply through KIPO to any country not covered in the above organizations.

When you are applying for a patent in a foreign country, you have to abide by the patent laws of that country. Bear in mind that these laws may differ from Kenyan Laws.

In some countries, for example you lose the right to a patent if your invention is disclosed before the filing date. (Remember in Kenya there is an exception i.e. you can still apply for a patent within 12 months from the date of disclosure). This is not the case in most other countries.

Many countries require that your patented invention be manufactured or otherwise worked in that country within a certain period, usually three years. In some places you may have to allow some other company or an individual manufacture your invention. (This is called granting a compulsory licence).

Convention Priority

Many countries, like Kenya belong to the Paris Convention for the protection of Industrial Property, a treaty that allows you to invoke what is called "convention priority". This means that your filing date in one member country will be recognized by all the others provided you file on those countries within a year of first filing. For example, if you filed in Kenya on 1st January, 1994, you could file up to one year later in most countries (1st January, 1995) and still be accorded the same rights as if you had filed there in 1994.

Under the Paris Convention you can file an application abroad and then in Kenya. The office will recognize the earlier filing date as your convention date if you claim "Convention Priority" *within six months* of the Kenya filing date. The Kenyan filing date must be within 12 months of the convention date. However, your application will be published 18 months after your convention date, not your filing date in Kenya.

Note that being granted a patent in one country may bar you from obtaining one in another if you delay too long in filing for the second patent. That is, if your invention is patented and therefore public in the United States, it will not be considered "new" in Kenya and vice-versa. You must file your various applications all within one year in order to receive the benefits of "convention priority" in the other countries.

The Patent Co-operation Treaty (PCT)

Application for a foreign patent within Kenya is made possible through a treaty called the Patent Co-operation Treaty (PCT), administered by the World Intellectual Property Organization (WIPO) in Geneva. It provides standardized international filing procedure. As per July, 1994 there were 73 members to the Treaty (*see Appendix II*). Under the PCT, you may file for a patent in as many as 73 member countries through a single application filed in Kenya.

This procedure is simpler than filing separate applications and enables you to defer costs. For example, instead of filing in the language of each country and paying, within a year of first filing, all translation, filing and agent's fee, you can file in one language and have up to 20 or 30 months to pay some of these fees. This gives you more time to raise capital, conduct market studies, etc.

When you file under the PCT, you will get a "prior art" search, which checks your application against other applications and patents, and a preliminary examination with an opinion on the patentability of your invention. This is no guarantee of a patent. Local patent offices in the countries to which you apply reserve the right to conduct their own examinations, but they often accept the preliminary examination report. This means you will receive a fairly reliable indication of whether it is worthwhile to seek multiple patents in foreign countries before fees are due.

Your application for foreign patents filed under PCT through Kenya Industrial Property Office must be in English. You may also be required to provide for translation into the language of the designated countries in those countries. Eighteen months after filing, your application will be made available to the public. Local patent application is followed within 12 months by international application under the PCT, with "national phase" commencing at 20 or 30 months. The International Bureau publishes the PCT application after 18 months from the date of filing.

Only nationals and residents of Kenya can file under the PCT in Kenya.

Your application made in Kenya under the PCT automatically qualifies for a normal national filing for a Kenyan Patent if you have designated Kenya.

What Does "Protection" Mean?

Patent Infringement

Patent Infringement would occur if someone made, used, or sold your patented invention without your permission in a country that has granted you a patent, during the term of the patent.

If you believe your patent is infringed, you may sue for damage in the tribunal. The defendant may argue that infringement did not occur, or may attack the validity of your patent. The tribunal will determine who is right basing its decision largely on the language of the claims. If what the defendant is doing is not within the wording of any of the claims of your patent, or if the patent is declared to be invalid for any reason, there is no infringement.

Protection Before Grant

When you obtain a patent in Kenya, you will be able to sue infringers for all damages sustained after the grant of your patent. Also after grant, you may sue for reasonable compensation for infringements that occurred in Kenya from the date your application was made available for public inspection (18 months after filing) to the date of grant.

Trade Secrets

You may be tempted to protect your creation by simply keeping its information secret and selling it to a willing buyer. The information is then known as a trade secret. You will run into problems, however, if another person independently invents the subject matter of the trade secret. There is nothing to do to prevent that person from using it, applying for a patent or publishing the information.

Patent Marking and "Patent Pending"

The Industrial Property Act does not require that patents be marked as "patented". However, marking an article as patented when it is not is against the law.

You may wish to mark your invention "Patent Applied For" or "Patent Pending" after you have filed your application. These phrases have no legal effects but may serve as warnings to others that you will be able to enforce the exclusive right to manufacture the invention once a patent is granted.

Fees

There are four kinds of fees you must pay to obtain a patent:

To file a patent application, process the application and grant of a patent requires the applicant to pay certain fees. The main fees are for filing, search, examination (*see* Fee Schedule Appendix IV).

Yearly maintenance and renewal fees are required to maintain an application or a patent in force respectively.

Maintenance and renewal fees encourage applicants and patent holders to re-evaluate the economic value of their applications and patents on a yearly basis. Owners of valuable patents who are benefiting from the patent system must pay these fees or their patent rights will expire before the maximum 20 years. On the other hand, owners of inactive patents may choose not to pay

maintenance fees, thus letting the patent lapse and enabling others to use freely at an earlier date the technology described in those patents.

Maintenance fees apply to applications filed after 2nd February, 1990, and annual renewal fees to all patents granted after that date and to all patents registered before that date under the repealed Patent Registration Act, Cap. 508, and are in force. For applications, you must pay these fees annually, starting before the second anniversary of your filing date in Kenya. To maintain a patent granted after 2nd February, 1990, you must pay annual renewal fees, starting before the first anniversary of the issue date. If you do not pay these fees, your applications will become abandoned or your patent will lapse.

Marketing and Licensing

Marketing Your Invention

Now that you have taken steps to protect your brainchild, you will want to decide the best way to market it and make a profit. You have a number of options including giving into business yourself, licensing the invention or selling your patent.

Setting up your own business allows you to retain full control of your invention, but means you assume all the risk.

With a licence, you grant one or more companies or individuals the right to manufacture and sell your invention in exchange for royalties. The licence can apply nationally or to only a specific geographic region. However, if you have not obtained protection in a certain country, your invention can be used freely by anyone there, even if you are protected elsewhere.

By selling your patent, you give up all rights as inventor, but you could gain an immediate lump sum of money without having to worry about whether the product is a commercial success.

It is important to keep invention secret until your first patent application is filed, in order to preserve your rights to file later in most foreign countries.

Help with Marketing

The Kenya Industrial Property Office cannot help you with marketing, but you can seek assistance from private business organizations and other government agencies.

.KIPO has no control over both public and private organizations that you may require to assist you in promoting or commercializing your invention. You seek advice and guidance from institutions such as:—

- Department of Industry.
- Department of External Trade.
- Investment Promotion Centre.
- Kenya Association of Manufacturers.
- Kenya National Chamber of Commerce and Industry.
- Kenya National Federation of Jua Kali Associations.
- Private Manufacturers.
- National Council of Science and Technology.
- Other Business Enterprise Associations.
- Commercial Banks.

If you wish to make your patent available for sale for licensing you can publish your intention through the Intellectual Property Journal. This is a good way of reaching potential inventors, since many business people, researchers and others will consult this publication to keep in touch with new technology.

You may place a sale/licence notice in the Intellectual Property Journal free of charge, if you make your request when you pay your fee on the grant of your patent. At any time, afterwards you must pay a fee for this notice.

Abuse of Patent Rights

Compulsory licences may be granted to remedy what is called "abuse of patent rights." Such abuse can be considered only three years after grant of patent. Hindering trade and industry is considered as an abuse. Abuse situations include:—

- Not meeting demand in Kenya
- Hindering trade or industry in Kenya by refusing to grant a licence (if such a licence is in the public interest), or by attaching unreasonable conditions to such a licence.

—Using a process patent to unfairly prejudice production of a non-patented product, or allowing the patent on such a product to unfairly prejudice its manufacture, use or sale.

If someone applies for a compulsory licence because they believe that an abuse situation exists, you may be required to prove that you are not abusing your patent. In making a decision about such a situation, the Director tries to ensure the widest possible use of inventions in Kenya, maximum advantage to the patentee, and equality among licencees.

You may appeal decisions by the Director, on abuse to the Industrial Property Tribunal.

Corresponding with the Office

Business with the Kenya Industrial Property Office is normally done in writing. Address all correspondence to:

The Director,
Kenya Industrial Property Office,
P.O. Box 51648,
NAIROBI.

Telephone: 332648, 332336-9
Fax: 219430

Office situated at: Posta Sacco Plaza, junction of Uhuru Highway and University Way, 7th, 8th and 16th floors.

If you are enquiring about the status of your pending application, give its application number, your name and the title of the invention. If you have hired a patent agent, conduct all correspondences through that agent.

Arrange any personal interviews with patent examiners by appointment. This gives them time to review your application before seeing you.

Copies of patents are available at the office at a fee. If you are ordering patents cited in an examiner's report, state the number of the patent, country and any other identifying information you request.

The office will respond to all general enquiries. The office cannot, however:

- Advice you whether to file an application.
- Tell you whether your invention meets patentability criteria prior to your filing an application.
- Tell you whether or to whom a patent for any alleged invention has been granted.
- Advice you as to possible infringement of a patent.
- Act in any way as an enterpreter of Industrial Property Laws, or as a counsellor, other than in matters directly related to processing your application.

Appendix I: Patent Application Form

I.P. FORM NO. 1
Regulation 5

THE INDUSTRIAL PROPERTY ACT (Cap. 509)

The Director,
Kenya Industrial Property Office,
2nd Floor,
Kenya House,
Koinange Street,
P.O. Box 51648,
NAIROBI.

REQUESTING FOR A GRANT OF A PATENT

(The grant of a patent is requested by the undersigned on the basis of the present application)

I. Applicant's or agents reference (please insert if available).

II. Title of invention.

III. Applicant or applicants (*see note 2*).

Name (First or only applicant)

Country State

Address

Name (of second applicant, if more than one)

Country State

Address

IV. Inventor (*see note 3*).

(a) The applicant(s) is/are the sole/joint inventor(s) or

(b) A statement on I.P. Form No. 4 is/will be furnished.

V. Name of agent (if any) (*see note 4*).

VI. Address for service (see note 5).

VII. Declaration of priority (see note 6).

filing date

file number

.....
.....
.....
.....

VIII. The application claims an earlier date under section 21 (see note 7).

Earlier application or patent number

and filing date

IX. Check list to be filled in by applicant or agent.

A. The application contains the following number of sheet(s).

1. Request sheet(s).

2. Description sheet(s).

3. Claim(s) sheet(s).

4. Drawing(s) sheet(s).

5. Abstract sheet(s).

B. The application as filed is accompanied by:

1. Priority document

2. Translation of priority document

3. Request for search

4. Statement of inventorship and right of grant

X. It is suggested that Figure No. of the drawings (if any) should accompany the abstract when published.

XI. Signature.

NOTES:

1. This form, when completed, should be brought or sent to the Director, Kenya Industrial Property Office, together with the prescribed fee and two copies of the description of the invention, and of any drawings.
2. Enter the name and address of each applicant. Names of individuals should be indicated in full and the surname or family name should be underlined. The names of all partners in a firm must be given in full. Bodies corporate should be designated by their corporate name and the country of incorporation should be entered where provided. Full corporate details e.g. "a limited liability company incorporated in Kenya", trading styles, e.g. "trading as xyz company", nationality and former names, e.g. "formerly (known as) ABC Ltd." are *not* required and should *not* be given.
3. Where the applicant(s) is/are the sole inventor(s) or the joint inventor(s), the declaration to that effect at IV (a) should be completed and the alternative statement IV (b) deleted. If, however, this is not the case the declaration (a) should be struck out and a statement will then be required to be fixed upon I.P. Form No. 4.
4. If the applicant has appointed an agent to act on his behalf, the agent's name and address of his place of business should be indicated in the space available at V and VI.
5. An address for service in Kenya to which all documents may be sent must be stated at VI. It is recommended that a telephone number also be provided.
6. The declaration of priority at VIII should state the date of the previous filing and the country in which it was made and indicate the file number, if available.
7. When an application is made by virtue of section 21 and the appropriate section should be identified at VIII and the number of the earlier application or any patent granted thereon identified.

Appendix II: PCT Contracting States (73 countries as per 1st July, 1994)

<i>Americas (5)</i>	<i>European (33)</i>	<i>Africa (20)</i>	<i>Asia and the Pacific</i>
Barbados	Austria	Benin	Armenia
Brazil	Belarus	Burkina	Australia
Canada	Belgium	Cameroon	China
Trinidad and Tobago	Bulgaria	Central America Republic	Democratic People's Republic of Korea
United States of America	Czech Republic	Chad	Georgia
	Denmark	Congo	Japan
	Estonia (from 24 August 1994)*	Cote d'Ivoire	Kazakhstan
	Finland	Gabon	Kyrgyzstan
	France	Guinea	Mongolia
	Germany	Kenya	New Zealand
	Greece	Liberia (from 27 August 94)*	Republic of Korea
	Hungary	Madagascar	Sri Lanka
	Ireland	Malawi	Taji kistan
	Italy	Mali	Uzbekistan
	Latvia	Mauritania	Viet Nam
	Liechtenstein	Niger	
	Lithuania (from 5 July 1994)	Senegal	
	Luxembourg	Sudan	
	Monaco	Swaziland (from 20 September 1994)*	
	Netherlands	Togo	
	Norway		
	Poland		
	Portugal		
	Republic of Moldova		
	Romania		
	Russian Federation		
	Slovakia		
	Slovenia		

Designated Countries of ARIPO

The present ARIPO contracting States are:

1. Botswana
2. The Gambia
3. Ghana
4. Kenya
5. Lesotho
6. Malawi
7. Sudan
8. Swaziland
9. Uganda
10. Zambia
11. Zimbabwe

ARIPO Contracting State	ARIPO Contracting State	ARIPO Contracting State	ARIPO Contracting State
1. Botswana	2. The Gambia	3. Ghana	4. Kenya
5. Lesotho	6. Malawi	7. Sudan	8. Swaziland
9. Uganda	10. Zambia	11. Zimbabwe	

Schedule of Fees for Patents

A: KENYA PATENT APPLICATIONS

Item	Amount Local Applications KSh.	Foreign Applications US\$
1. Application for grant of Patent	2,500	75
2. Request to amend application before grant	2,500	80
3. Request for subsequent amendment before a grant	1,500	50
4. Application for authorization of agent ..	300	10
5. Application for admission of an agent ..	5,000	—
6. Annual renewal fee for patent agent ..	1,000	—
7. Withdrawal of an application	500	20
8. Request for examination and search or request for further search	5,400	400
9. International type search		
(a) Transmittal fee	600	
(b) International search fee	3,500	1,800
10. Request for substantive examination ..	4,500	280
11. Notice of opposition to application ..	1,500	70
12. Opposition to grant of patent	5,000	300
13. Certificate of grant patent	1,000	50
14. Opposition to award compensation to employee	5,000	150
15. Request for extension of term of patent	30,000	1,100

B: INTERNATIONAL APPLICATIONS

1. Transmittal fees	600 (US\$30	—
2. Fee for transmitting a priority document	.. 400 or (US\$20)	—
3. Request for national processing of an International application:		
(a) Where no translation is filed under Regulation 140 (2) (a) ..	3,000	100
(b) Where a translation is filed under Regulation 140 (2) (a) ..	—	150
4. Request for an International application to be treated as application under the Act, Regulation 140 (8)	3,000	100

APPENDIX V

A Procedural Flow of a Patent Application in Kenya

