1. Course title: GPR 411 Intellectual Property Law

2. Contact Hours: 45 hrs

3. Objectives of the Unit

This course is intended to impart to the student the following skills, knowledge, attitudes and values (SKAV) in IP:

1. Skills on application of IP theory, doctrine, rules to be competent lawyer scholar, litigant, disputant, corporate strategist, policy maker, policy implementer, administrator and general reader.
2. IP knowledge to appreciate conceptual and analytical, as well as practical parameters which undergird IP, innovation and technology transfer law, policy as well as transactions.
3. Attitudes to apply IP well to Kenya and African development challenges.
4. Values on how to apply IP skills and knowledge positively to Kenya’s development.

4. Expected Learning outcome(s)

Students should:

- Appreciate IP as an important tool for trade, entertainment and development;
- Appreciate the context in which IP, innovation and ToT law operate;
- Import appropriate attitudes and values as well as critical, creative, analytical and practical skills in IP; and,
- Be able to handle matters regarding IP, innovation and technology transfer as well as practical parameters which undergird IP innovation and technology transfer law, policy and transactions.
5. **Course content**
The following are some of the themes that constitute the content of Intellectual Property Law curriculum –

1. Introduction and Course Overview
2. Nomenclature and Conceptualisation of IP, Innovation and Transfer of Technology
3. The development of the TRIPs Agreement
4. Patent and Related Doctrines: Patentability

5. Trade Mark and Related Doctrines

6. 6A. Copyright and Related Rights
   6B. Copyrightability
   6B.10 Economic Rights and Limitations under the Berne Convention 1886 and the Kenya Copyright Act 2001
   6C. Infringement of Copyright

7. Folklore, Traditional Knowledge and Geographical Indications
   7A. Folklore or Traditional Cultural Expression (TCE), Traditional Knowledge (TK)
   7B. Geographical Indication (GI)

8. Utility Model & Industrial Design (Kenya)
   8A. Utility Model
   8B. Industrial Design and Design Rights

9. Trade Secret & IP as a Business Asset
   9A. Trade Secret or Technical Know-How and Confidential Information
   9B. IP as a Business Asset

10. 10A. Trade in Counterfeit Products and Parallel Importing
    10B. Technology Transfer in Health and Security in Africa

11. IP and Innovation Lawyering & Enforcement in Kenya

6. **Learning and teaching methods**
The learning and teaching methods include class lectures, discussions; Lecturer-student(s) consultations; use of teaching materials and notes; further research by students and lecturer outside class work; blog spot…
7. **Instruction materials and equipment**

These include:

1. Verbal communications in class- lectures
2. Course outlines (annotated)
3. Syllabus of issues
4. Use of notices
5. Direct lecturer-students communications (verbal)
6. Use of letters and advisory notes
7. Books, articles, cases and casebooks, CD’s and DVD’s. See also core texts (item 8 below).

The equipment and facilities include, black/chalk boards; white boards; LCD projectors; laptops; extension cables; internet; cell phones…

8. **Mode of assessment**

   1. Continuous Assessment  Tests (CATs) through course work assignments
   2. In class assessment
   3. End of semester examinations

9. **Core texts: Essential Books, Book Chapters and Journal Articles**

Currently there is no single standard textbook which appropriately addresses the concerns of intellectual property, innovation and technology transfer transactions in Kenya and Africa. Appropriate readings are indicated; and the basic are supplied, subject to the relevant copyright laws. Some good books include:

1. Prof Ben Sihanya scholar (forthcoming 2012) *Intellectual Property and Innovation in Africa: Transferring Technology for Sustainable Development Innovative Lawyering and Sihanya Mentoring*, Nairobi & Siaya (relevant chapters availed to students)


researcher at Max Planck Institute of IP, Germany. See also 4th ed, 1999 and 3rd ed, 1993).


**NB:** A summarized list of core reference and reading materials, books, articles are provided in every topic as per the course outline.

9. **Further reference and reading materials**

Most of the foregoing are very good guides even though their focus is UK, and to some extent European Union (EU), IP law.


(b) Arthur Miller & Michael Davis *Intellectual Property*. The foregoing three are very good sources of US IP law.


(d) Marisella Ouma & Ben Sihanya (2010) “[Access to Knowledge in Africa: The Role of Copyright:] ‘Kenya,’” a study under the auspices of the African Copyright and Access to Knowledge (ACA2K) project and International Development Research Centre (IDRC) Acacia Initiative for Africa and Shuttleworth Foundation Intellectual Property Rights programme in C. Armstrong, J. De Beer, D Kawooya, A Prabhala, T Schonwetter (eds) (This book was launched on Saturday, July 31, 2010 at the University of Cape town, South Africa July 31, 2010).


(n) Sihanya, Ben (2002) *Integrating Innovation and Intellectual Property into the Kenya Constitution*, Institute of Economic Affairs (IEA), Nairobi (also online)– [www.ieakenya.or.ke](http://www.ieakenya.or.ke)


Law in the Information Society Kluwer Law International, London, pp. 329-364 (This 37 page chapter is one of the mandatory readings; it captures most of the issues in the course; see also Sihanya (2009) “Combatting counterfeit trade in Kenya.”


NB: A summarized list of further reference and reading materials, books, articles are provided in every topic as per the course outline. These include articles by the relevant Kenyan, African, European and African authors, etc. especially writing on Kenyan and African IP.

There are numerous instruments on IP, innovation and ToT, the following are the basic:

**International Legal Instruments**

Berne Convention on Literary and Artistic Works, 1886  
Convention on Biological Diversity, 1992  
Draft International Code of Conduct on Technology Transfer (ended in a stalemate in 1985).  
Madrid Agreement on Registration of Trade Marks, 1891  
Paris Convention on the Protection of Industrial Property, 1883  
Protocol to the Madrid Agreement on the International Registration of Marks, 1989  
Trade Related Aspects of Intellectual Property Rights Agreement, including Trade in Counterfeit Goods, 1994 (TRIPs)  
Universal Copyright Convention, 1952

**Regional Legal Instruments**

Banjul Protocol on Marks, 1993 (came into force 1997)  

**National Legal Instruments**

Following are the basic Kenyan IP instruments. You may consult instruments from other (African) states.

Constitution of Kenya, 2010
Contracts in Restraint of Trade Act, Cap. 24
Copyright Act, Cap. 130. (Repealed)
Copyright Act No 12 of 2001
Copyright Regulations, 2004
Kenya Copyright Board Rules of Procedure
Industrial Property Act, 1989, Cap. 509 (covers patents, industrial designs, utility models, technovations…) (repealed)
Industrial Property Act of 2001
Industrial Property Regulations, 2002
Industrial Property Tribunal Rules, 2002
Law of Contract Act, Cap. 23
Science and Technology Act, Cap. 250.
Seeds and Plant Varieties Act, Cap. 326.
Trade Marks Act, Cap. 506 amended by the Trade Marks (Amendment) Act, 2002.
Trade Marks (International Registration) Rules, 2003
Copyright Act Cap 130 and 1989 (Cap 509) were used to determine various IP cases.
Thus, although repealed, they are important in appreciating the various court decisions.
Also see: Copyright and Neighbouring Rights Act, 2006 (Uganda); Trade Marks Act, 2010 (Uganda)

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Email: sihanya@innovativelawyering.com; sihanya@sihanyamentoring.com (use both)
url: www.innovativelawyering.com
# SYLLABUS OF ISSUES

<table>
<thead>
<tr>
<th>PERIOD</th>
<th>DATE</th>
<th>TOPICS</th>
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<tbody>
<tr>
<td>Class 1</td>
<td>22/2/12</td>
<td>Introduction: Lecturer’s and Students expectations; Syllabus of issues; Readings; Learning outcomes, Coursework assessment and exams</td>
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</tbody>
</table>
| Class 2 | 29/2/12 | - Nomenclature and Conceptualisation of IP, Innovation and ToT:  
- The development of the TRIPs Agreement; its Provisions, strengths, challenges and promise;  
- African organisation of Intellectual Propety (OAPI); African Regional Intellectual Property Organisation (ARIPO);  
- Regional Trade Agreements (RTAs) and Economic Partnership Agreements (EPAs) |
| Class 3 | 7/3/12  | - Patent and Related Doctrines; Patentability; patentable inventions (Cf. with utility model, PBR, and traditional knowledge)  
- Patenting procedure: application process; exam as to form; examination as to substance. |
| Class 4 | 14/3/12 | - Rights of the patentee: Limitations and exceptions; obligations of patentee;  
- Patent infringement  
- Patent remedies: civil and criminal |
| Class 5 | 21/3/12 | - Trade Mark and Related Doctrines; definition: (Cf. Collective marks, certification marks; domain name...)  
- Rights conferred by TM and dealing with TM (TM use; franchising, etc) |
| Class 6 | 28/3/12 | - Trade mark registration;  
- Rights; limitations and exceptions ; obligations  
- TM infringement; Remedies (civil and criminal) |
| Class 7 | 4/4/12  | - Copyright and Related Rights: Copyrightability; subject matter of copyright |
| Class 8 | 11/4/12 | - Copyright: Economic and moral rights  
- Limitations and exceptions |
| Class 9 | 18/4/12 | - Dealing in copyright  
- Infringement and remedies (civil and criminal) |
| Class 10 | 25/4/12 | - Utility Model (UM): petty or utility patent (relate to political economy of innovation in Kenya and Africa: Informalisation of the economy; definition; rights. Dealing in UM;  
- Infringement; remedies.  
- Industrial Design and Design Rights: Definition and types; significance;  
- Rights; Limitations and Exceptions; |

**ASSIGNMENT/CAT**
| Class 11A | 2/5/12 | ● Folklore (or Traditional Cultural Expression (TCE)); Definition; types of folklore; significance and rationale for protection; procedure and exploitation |
| Class 11B | 2/5/12 | ● Traditional Knowledge & Geographical Indication (GI)  
Traditional knowledge v. patenting life forms: (biopatents) |
| Class 11C | 2/5/12 | ● GI: definition; status under TRIPs; status in Kenya and Africa |
| Class 12A | 9/5/12 | ● Trade Secret  
● Definition; types and examples; significance; procedure of protections  
● Rights, Limitations and exceptions; Remedies. |
| Class 12B | 9/5/12 |  
IP as a Business Aspect  
● IP and innovation as marketable commodities, services or technologies; IP valuation (eg what is the worth of a song?)  
● Commercializing IP (licensing, assignment, etc).  
● Taxing IP (taxing royalties ...); Cf. taxing the Internet and related innovations |
| Class 13A | 16/5/12 |  
Trade in Counterfeit Products and Parallel Importing:  
● Trade in counterfeit products: definition, types and examples; strategies in Kenya & Africa  
● Competition and Consumer Aspects of IP: Comparative or misleading advertising: unfair competition; injurious falsehood, trade libel...  
● Rights and remedies... |
| Class 13B | 16/5/12 |  
Technology Transfer in Africa: Conceptual parameters  
● Forms of ToT: case Study in technology transfer  
● Transferring health and security or military technology in Africa  
● Prosecution, Administration and Enforcement of IP and Innovation; Reforming IP and ToT in Kenya and Africa.  
THE PEOPLE REST (their case). |
| May/June | End of Semester Examinations (beginning May 21, 2012) |  
Email (pls use both):  
sihanya@sihanyamentoring.com  
sihanya@innovative lawyering.com  
www.innovativelawyering.com |
(i) Copyright notice
Earlier versions of these materials were issued as Intellectual Property Law Teaching Materials to the previous Classes; and have been revised for each successive LLB IV Class. The materials are protected under Kenya’s and transnational copyright and intellectual property laws. These materials and the earlier versions may not be copied, published, reproduced or distributed, or otherwise dealt with in any form without the express written approval of the author. In any event adequate acknowledgement and attribution of source must always be made.

(ii) Prefatory
My approach in this course appreciates the dynamic and practical context in which IP, innovation and ToT should be studied. It is informed by the increasing significance of innovation and IP in Kenya and Africa; progressive liberalisation of the international political economy; regulatory reforms; and the realities of African (and especially Kenyan) political economy. Indeed, the title that more appropriately captures the issues is Intellectual Property, Innovation and Transfer of Technology in Kenya and Africa to emphasise the practical and dynamic context.

These materials contain a comprehensive bibliography and reference materials to facilitate understanding and appreciation of the issues, further research and informed discourse, IP practice and related interventions. They are based on my book, Intellectual Property in Kenya and Africa: Transferring Technology for Sustainable Development, (forthcoming 2012). They take into account my writings on IP and ToT as well as materials I relied on to teach two 4th year second semester options for some years: Science ad Technology (read ICT) Law, and International Economic Law (IEL). You may wish to consult these two as well as the materials I have been using and which other lecturers use to teach Consumer Protection Law at the School (then Faculty) of Law, and Media and Entertainment Law (now Commentator Law) at the School of Journalism and Mass commentator (SOJMC), among others.
(iii) Objectives of the course and learning outcomes
My intention in these course materials and in the book is to enable the student (and future) lawyer scholar, litigant, disputant, corporate strategist, policy maker, policy implementer, administrator and general reader to appreciate conceptual and analytical, as well as practical parameters which undergird IP innovation and technology transfer law, policy as well as transactions. The most immediate purpose is to foster appreciation of the context in which IP, innovation and ToT law operate; and also to facilitate the development of critical, creative, analytical and practical skills in IP, innovation and ToT law. The materials are largely justified by the fact that there is no single book that addresses all the relevant issues. The scarcity of relevant materials was particularly pronounced at the beginning of this project in 1998. There was no appropriate literature on IP, innovation and ToT in Kenya and Africa in general. Indeed, most of the available literature was on UK and US IP. These materials review the IP rules and provide the basic principles and rationale for understanding the theoretical and conceptual issues in IP, innovation and ToT. To be sure, I started this project partly because my students and I were quite frustrated by the sheer lack of relevant IP materials in Kenya and Africa.

After reading these materials the student or reader should be able to handle matters regarding IP, innovation and technology transfer which are becoming common, subtle, sophisticated, and complex. The reader would also appreciate IP as an important tool for trade, entertainment and development.

(iv) Textbooks and materials

Textbooks
Currently there is no single standard textbook which appropriately addresses the concerns of intellectual property, innovation and technology transfer transactions in Kenya and Africa. (My book which addresses the issues in this course, Intellectual Property in Kenya and Africa: Transferring Technology for Sustainable Development is forthcoming in 2012) Appropriate readings are indicated; and the basic ones will be supplied, subject to the relevant copyright laws. Some good books include:


The foregoing are very good guides even though their focus is UK, and to some extent European Union (EU), IP law. I have copies; I made requests for the School Library.


(s) Arthur Miller & Michael Davis *Intellectual Property*. The foregoing three are very good sources of US IP law.


(u) Marisella Ouma & Ben Sihanya (2010) “[Access to Knowledge in Africa: The Role of Copyright:] ‘Kenya,’” a study under the auspices of the African Copyright and Access to Knowledge (ACA2K) project and International Development Research Centre (IDRC) Acacia Initiative for Africa and Shuttleworth Foundation Intellectual Property Rights programme in C. Armstrong, J. De Beer, D Kawooya, A Prabhala, T Schonwetter (eds) (This book was launched on Saturday, July 31, 2010 at the University of Cape town, South Africa July 31, 2010).


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Industrial Property Regulations, 2002
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Trade Marks Act, Cap. 506 amended by the Trade Marks (Amendment) Act, 2002.
Trade Marks (International Registration) Rules, 2003
Copyright Act Cap 130 and 1989 (Cap 509) were used to determine various IP cases. Thus, although repealed, they are important in appreciating the various court decisions.
These materials are organised so as to assist students appreciate and apply the subject, including in the CATs and final exams. They will also be useful to students working on dissertations on related topics, or on other projects, as well as when they leave college and engage in IP lawyering in one way or the other. Endeavour to read the essential readings, including the handouts. Follow the discourse in the *Nation, Standard, East African, Time, Newsweek, Standard, Business Daily, The Economist*, broadcast media, the Internet, and through observations. I use these, as well as my blog spot, in my research and teaching.

(v) Evaluation: examinations, continuous assessment tests (CAT) and course work
The exam and course work or CAT require clear appreciation of the issues including the concept, doctrine, rule of law, transaction and the policy context. As indicated, conceptual parameters, and the practical implications of the course, will undergird the assessment and examinations. Conceptual and practical skills are important in appreciating, practising, applying administering and enforcing IP, innovation and technology transfer law. They are intended to replace a legalistic approach, and especially the cramming of legal rules (out of context) for exam purposes. Students performed very well in the previous exams mainly because they appreciated conceptual parameters and related these to the rules of law and to real life transactions - to the real problems and aspirations of real people.

(vi) Some Abbreviations and Acronyms

<table>
<thead>
<tr>
<th>Abbreviation</th>
<th>Full Form</th>
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<tbody>
<tr>
<td>AGOA</td>
<td>African Growth and Opportunities Act, 2006 (US) (revised)</td>
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<td>AEC</td>
<td>African Economic Community (proposed by OAU in 1980)</td>
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<tr>
<td>AU</td>
<td>African Union</td>
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<tr>
<td>BITs</td>
<td>Bilateral Investment Treaties</td>
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<tr>
<td>Biz</td>
<td>Business</td>
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<tr>
<td>CBD</td>
<td>Convention on Biodiversity, 1992</td>
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<tr>
<td>CERDS</td>
<td>Charter on Economic Rights and Duties of States, 1974</td>
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<tr>
<td>COCOM</td>
<td>Co-ordinating Committee for Multilateral Export Control</td>
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<tr>
<td>COMESA</td>
<td>Common Market for Eastern and Southern Africa (formerly Preferential Trade Area (PTA))</td>
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<td>CP</td>
<td>Consumer Protection</td>
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<tr>
<td>CPC</td>
<td>(European) Community Patent Convention</td>
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<td>DRC</td>
<td>Democratic Republic of the Congo</td>
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<tr>
<td>EAC</td>
<td>East African Community (Kenya, Uganda, Tanzania)</td>
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<td>ECOSOC</td>
<td>UN Economic and Social Council</td>
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<tr>
<td>Abbreviation</td>
<td>Full Form</td>
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<tr>
<td>ECOWAS</td>
<td>Economic Community of West African States (cf. ECOMOG)</td>
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<td>E(E)C</td>
<td>European (Economic) Community (cf EU)</td>
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<td>EDI</td>
<td>Electronic Data Interchange</td>
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<td>EOI</td>
<td>Export Oriented Industrialisation</td>
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<tr>
<td>EPC</td>
<td>European Patent Convention</td>
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<tr>
<td>ESAF</td>
<td>Enhanced Structural Adjustment Facility (see SAPs)</td>
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<tr>
<td>EU</td>
<td>European Union</td>
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<tr>
<td>FCN</td>
<td>(treaty of) Friendship, Commerce and Navigation</td>
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<td>FDI</td>
<td>Foreign Direct Investment</td>
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<td>GATS</td>
<td>General Agreement on Trade in Services, April 15, 1994</td>
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<td>GATT</td>
<td>General Agreement on Trade and Tariffs</td>
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<td>IACL</td>
<td>International Association of Consumer Law</td>
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<td>ICSID</td>
<td>International Centre for the Settlement of Investment Disputes</td>
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<td>IGAD</td>
<td>Intergovernmental Authority on Development (formerly IGADD)</td>
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<td>IPA</td>
<td>Industrial Property Act (Kenya)</td>
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<td>ISI</td>
<td>Import Substitution Industrialisation</td>
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<tr>
<td>ITO</td>
<td>(stillborn) International Trade Organization</td>
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<td>JV</td>
<td>Joint Venture</td>
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<td>KIPO</td>
<td>Kenya Industrial Property Office</td>
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<td>KEPHIS</td>
<td>Kenya Plant Health Inspectorate Service</td>
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<td>LDCs</td>
<td>Least Developed Countries</td>
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<tr>
<td>MAI</td>
<td>(OECD’s) Multilateral Agreement on Investments</td>
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<tr>
<td>MIA</td>
<td>(stillborn?) Multilateral Investment Agreement</td>
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<td>MFN</td>
<td>Most Favoured Nation Treatment</td>
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<td>MNC</td>
<td>Multi National Corporation (Cf. TNC)</td>
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<td>NAFTA</td>
<td>North American Free Trade Area</td>
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<td>NATO</td>
<td>North Atlantic Treaty Organisation</td>
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<tr>
<td>NIEO</td>
<td>New International Economic Order</td>
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<td>NTBs</td>
<td>Non-Tariff Barriers</td>
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<td>OAU</td>
<td>Organisation of African Unity (now AU)</td>
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<tr>
<td>OAPI</td>
<td>Organisation africaine de la propriete intellectuelle</td>
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<tr>
<td>OECD</td>
<td>Organisation for Economic Co-operation and Development</td>
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<tr>
<td>PAIPO</td>
<td>Pan African Intellectual Property Organisation</td>
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<tr>
<td>PCT</td>
<td>Patent Co-operation Treaty</td>
</tr>
<tr>
<td>PIL</td>
<td>Public Interest Lawyering</td>
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<tr>
<td>PTA</td>
<td>Preferential Trade Area (see COMESA)</td>
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<tr>
<td>SADC</td>
<td>South African Development Community (formerly SADCC)</td>
</tr>
<tr>
<td>SA</td>
<td>Strategic Alliance</td>
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<tr>
<td>SAL</td>
<td>Social Action Lawyering</td>
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<tr>
<td>SAPs</td>
<td>Structural Adjustment Programmes (cf. ESAF)</td>
</tr>
</tbody>
</table>
1. Nomenclature and Conceptualisation of IP, Innovation and ToT

“What is in a name? That which we call a rose by any other name would smell just as sweet,” William Shakespeare, *Romeo and Juliet*. Was Shakespeare right? In poetry? In IP?

Why address nomenclature in IP, innovation and ToT?
- to identify and define terms and phenomena
- to develop a common vocabulary
- to facilitate discourse
- To foster IP, innovation and ToT transactions (hence clauses on definition, interpretation).
- to facilitate recognition, protection, promotion, administration and enforcement of IP, innovation and ToT (these depend to a large measure on definition of terms - what's copyright?…)

The distinction among IP, IPR, IPP, IPPR, etc.
- Recall examples of misuse of terminology in IP, innovation and ToT (Land Rover; Diana: patenting of image hits a snag? Patent a book?...

Distinction among discovery, innovation and invention.

IP is interdisciplinary: It implicates constitutional and administrative law; contract (eg contract in restraint of trade; franchising - eg *Kiambu General Transport Agency Limited v. EABL*; contractual licensing in IP, innovation and ToT); employment or labour law (eg protecting employed authors, inventors, breeders…); competition (unfair competition; contracts in restraint
of trade; IP, innovation and ToT have characteristics of and relate to exclusion and monopolistic practices (eg. s. 69 of IPA 2001, s. 92 IPA, 1989); natural resources environmental and climate law (eg the debate on patenting GMOs and GMFs; biotech v. biodiversity; concerns for protecting and rewarding traditional knowledge); corporate law (eg IP is a business or corporate asset; an issue to be considered in asset inventorying and valuation; in balance sheets; in dail business transactions; in securitisation; in taxation; during mergers and acquisitions (M&A));
gender (how to protect female innovators is crucial esp. in the context of traditional knowledge v. patenting; folklore v. copyright; human rights law (IP is a property right, and part of human rights; see Art. 27 UDHR which balances individual rights with social benefit from the innovation; innovations for adapting to and mitigating climate change; tax law (taxing IP is an emerging field - cf. Prof. Karrer’s case); consumer law (some consumer lawyers argue IP is anti-consumer protection… consider trade in counterfeit products…); etc.

Readings


The candidate should also internalise political economy of IP, innovation & ToT.
The talking points in this regard cover the following and more.
The political economy of IP, innovation and ToT law is crucial to put the issues in context; it also helps connect various sub-issues, narratives or anecdotes. (NB: law operates in a social, political, technological and economic context). Eg: debates of the 1980s: Revise Paris Convention? Place IP in GATT?

The subtopics include:
Brief history and development of IP (this is important in understanding the political economy on IP and ToT)
(i) Technology and innovation in classical and neo-classical theory; cf Schumpeterian innovation
(ii) Technological change and convergence: IP, innovation and ToT issues (bioinformatics, telematics, nanotechnology ....)
(iii) Technology and environmental governance or the green or gene movement
(iv) Endogenous technological capability and informalisation of the economy
(v) The human rights discourse in technological development and innovation
(vi) Technology and the rise of the consumer movement
(vii) Post modern and game theoretic analyses of innovative, IP and ToT transactions


The candidate should also appreciate the conceptual parameters of IP, innovation and ToT. Some of the key issues include:
(i) Is the subject IP or IPR, etc. (see Nomenclature, supra).
(ii) The case against IP
(iii) Justifying IP, innovation and ToT
(iv) Efficient management of IP, innovation and ToT
(v) Theories of IP: natural or human rights; utilitarian or economic theories related to incentives and rewards…
(vi) Forms of incentives and rewards in Kenya and Africa
- direct financial payments
- certificates of recognition or achievement …
- tax incentives
- Government procurement (including *jua kali* innovations and sheds…)
- appropriate policy
  - Development plans; sessional papers
- Regulatory, legislative and judicial framework
  - IP statutes and enforcement (e.g. *KAS v. Prof Obel, infra*)
- Innovative measures (cross cutting)
(vi) Development of transnational innovation, IP and ToT law
  - TRIPs;
  - ARIPO/OAPI

Readings


2. The development of the TRIPs Agreement and its Provisions; IP and innovation in Regional Trade Agreements IP and innovation in Economic Partnership Agreements (EPAs)

- From GATT to WTO TRIPs
- TRIPs provisions: core provisions on key IP doctrines: patent, TM, ©
- TRIPs challenges and prospects
- ARIPO- development
- ARIPO- core instruments
- OAPI- development & core instruments
- Regional Trade Arrangement (RTA)- various categories: treatment of IP and Innovation
- EPA- various categories ; treatment of IP and innovation
3. Patent and Related Doctrines (including comparison with utility models, PBRs, and traditional knowledge)

(i) Definition - a certificate; a property right or juridical relationship
(ii) Status of patent in IP “hierarchy”
(iii) Development of patent law in Kenya -problems of the dependent system; WIPO Model law
(iv) Patentability - novelty (IPA, 2001 s. 23)
   - inventive step (who is PHOSITA?) (IPA, 2001 s. 24)
   - industrial applicability (industrial and commercial...utility) (s. 22 & s. 25)
   - excluded subject matter (ss. 21 & 26 IPA, 2001); temporary exclusion (s. 26)

Readings

3.1 Patenting procedure
- request, etc. (s. 34)
- exam as to form (s. 41)
- exam as to substance (s.44)
  - what if application is rejected? (Tribunal…) (s. 47); cf. patent interference proceedings

Readings
Bainbridge (2009) “Patent law, background, basic principles and practical aspects”

4. Rights and obligations of patentee
- Rights - s. 53 IPA, s. 17, S&T Act; ss. 16, 35-38… IPA
(i) Ownership of and dealing with patent - employment scenario etc. (s. 17 S&T Act; s. 32 IPA 2001, s. 17 S&T Act; s. 17 IPA; s. 15 IPA; s.16 IPA
(ii) Duration and renewal or maintenance of patents (s. 60 IPA)
(iii)Infringement, defences and remedies sectoral focus of patents and related doctrines.

Readings
Cornish, Llewelyn & Aplin (2010) “Scope of monopoly” (Chap.6), Chap.7: “Property rights and exploitation”

Kimani, D. (199) “Kenyan firms contest the right to sell drug” *The East African* (Nairobi) October 4-10, p. 4 (on alleged baseless threat of infringement; defence of patent expiry: manufacture and sale of branded and generic drugs …)

**Case law**


*Electrolux v. Hudson* (1997). FSR 312 (Bainbridge p. 455 etc)

**5A. Trade Mark and Related Doctrines**

(i) What are TMs?: Trade mark law addresses the question, what is in a name?
- TM, SM, trade names, certification marks, collective marks…

(ii) Historical dev of TM
- Paris, TRIPs, WIPO TM Treaty 1996
- UK and Kenyan law (1938, 1994 UK Acts; amendments to Kenyan Trade Marks Act, Cap 506)

(iii) Purposes of TM
- Registration and registrability: distinctive v. capable of distinguishing; (confusion and association: *Wagamama*)

(iv) TM v. passing off (cf. s. 5 TM Act); notorious marks (s. 15A TM Act; Art. 6 bis of Paris)

**5B. Rights conferred by TM and dealing with TM** (franchising, etc. e.g. *Maranga*)


(ii) Revocation: e.g. genericisation, eg thermos, aspirin, “a Tusker”…, “Zainer” “toss it in,” “Otonglo Faulu,” “Amina Faulu”… Faulu Bank (impact of advertising; competition’s sale or marketing, and consumer practices …)

(iii) Infringement, defences - Mother Care/Other Care... not used in a TM sense, etc; Beirsdorf (Nivea v. Niveline…)

(iv) Remedies - injunction, damages, expunction, self help …

**Readings**

“Trade mark law in Kenya” - untitled; clause by clause analysis of TM Act, Cap. 506.


“McDonald’s Corporation” from Hoover’s Handbook of American Business, 1995

Anecdote on Land Rover in Brazil (4 pieces in the *Financial Times*, 1991)


Goldstein & Reese (2010), pp. 167-401, Trade mark law”

Cornish & Llewelyn & Aplin (2010), Chap. 18: Registered Trade marks,” pp. 707-814

Bentley & Sherman (2009), Chapters 42: “Exploitation and use of trade marks,” pp. 959-974

Sihanya (forthcoming 2012) IP and Innovation in Kenya and Africa, Chapters _____


Legal instruments
Trade Marks Act, Cap. 506 (amended).
Paris Convention, 1883 (well known marks, Art. 6 bis; service marks need not be registered? Art. 6 sexies); GATT TRIPs Code, 1994; WIPO Trademark Law Treaty (adopted 1994 and entered into force 1996)

Case law
Re An Application by the American Cyanamid Co. [1968] EA 270-73.
Assabwalla v. Khadija Bint Gafoor & Others [1962] EA 571-9 (bona fide use of own name in competition to registered trade mark upheld as not constituting infringement - see s. 11 TM Act, Cap. 506, Kenya).
Re An Application by Bourjois Ltd. [1964] EA 265-9 (proposed TM likely to deceive; application declined).
Brooke Bond Kenya Ltd. v. Chai Ltd. [1971] EA 10-16 (TM, passing off)
EA Industries Ltd. v. Trufoods Ltd. [1972] EA 421-23 (passing off; - but also TM).

True Love case (Kenya, SA)
“Sportsman v. Horseman;” “G4S;” “Pep Tang”...

Readings


Goldstein & Reese (2010), pp 167-401

6. Copyright and Related Rights
6A. Copyright law sources
(i) International development of © and related rights
- Berne 1886 (Paris Text 1971)
- Universal Copyright Corporation (UCC) 1952
- International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations, aka the Rome Convention 1961
Other conventions on related rights
- Convention for the Protection of Producers of Phonograms against Unauthorized Duplication of Their Phonograms
- TRIPs 1994
- WCT 1996
- WPPT 1996
- Africa - no transnational regime (cf. ARIPO, OAPI)

(ii) Historical dev. of © law
- Brief history of copyright law from the invention of the printing press to date. Why from then?
- link between UK law and Kenya’s © Act
- sources of copyright law (Cap. 130 of 1966; Copyright Act No 12 of 2001, Cap 130; Judicature Act)
- difficulties with s. 51© Act... i.e. © subsists only under Act or other written law
(iii) Subject matter of © - primary v. related works (secondary? derivative?), etc. esp. s. 22 and s. 2 (see s. 3 and s. 2 of Cap 130)
(iv) moral v. economic or material rights

Readings
Bainbridge (2009), Chap. 2 “Background basic principles”; chap. 3 “Subsistence of copyright” __
Cornish, Llewelyn & Aplin (2010), Chapters __
Sihanya (forthcoming 2012) IP and Innovation in Kenya and Africa, Chapters __

6B. Copyrightability
Idea/expression dichotomy; originality; tangibility; quantity produced; qualified person (nationality, etc.).
(i) Authorship and ownership s. 31 (cf. s. 13 of Cap 130 1966…)
Who is an author? anonymous, pseudonymous; significance of authorship
(ii) Overlap, fragmentation in authorship and ownership
- employment or under contract of service; commission or consultancy; government or NGO/religious organisations? or international body; reporters or editors; lecture or dictation scenarios; supervision

7A. Rights conferred by ©; dealing in © or exploitation of © (ss. 26-29; 33; etc)
- moral and economic rights
- assignment…
- contractual licences (e.g s. 48)
- compulsory licences (s. 48)

(iii) Duration: extension, revival

Readings
Sihanya (forthcoming 2012) IP and Innovation in Kenya and Africa, Chapters __

7B. Infringement of ©
Administration or ex officio measures. Civil remedies (injunction, damages, delivery up, account of profits) v. criminal sanctions… (ss. 35, 38)
Defences: © does not subsist; fair dealing; public interest… (NB: ss. 26-29 © Act 2001; ss.7-12 Cap 130); Add: British Leyland v. Armstrong Patents: ©, and design rights do not grant monopoly rights (take into account consumer interests); to say there is infringement would allow a party to derogate from a grant (have their cake and eat it) - i.e. others should be able to repair the exhaust pipe …

© administration (consider the role of the copyright office (like Kenya © Board, the private organizations including the collective management organisations such as Music Copyright Society of Kenya, the Reprographic Organisation of Kenya (KOPIKEN), Performers Rights Society of Kenya (PRSK), the Kenya Association of Music Producers (KAMP) …). What is their role in administration of copyright and related rights? Where do they draw their authority from? (ss. 46, 48)

Copyright management and administration:
- registration (process, cost...)
- Collective Marketing Organisations (CMOs)
- Competent Authority
- KECOBO
- Collective Copyright litigation: rules, procedure and evidence etc What courts have what jurisdiction?
  IP/copyright in Constitution 2010 (cf Uganda, S.A, Nigeria) “Faction” cf Stanford Lawyer Magazine; fun fiction and related copyright issues
  Reforming Competent Authority, Cf. Industrial Property Tribunal

Readings
Bainbridge (2009) Chap. 7 “Defences to copyright infringement and the permitted acts”

Protecting ICT, computer software and e-commerce innovations [detailed discussion in S&T
- hardware v. software
- what is patentable and what is copyrightable? Source code, functionality?
“To patent or to copyright, that is the question.” Or apply trade secrets law?
Discourse:
- Intellectual effects are not patentable; industrial effects are
- patent provides strong protection, but:
- difficulty of determining prior art
- disclosure of source code may be required
- infringement could be difficult to establish
- length of time to obtain a patent (about 3 years) makes it inappropriate for software developers
- patents have stronger exclusive or, “monopoly” characteristics (good and bad?)
- copyright - long duration of protection
- protection of business methods
- under the TRIPs Agreement 1994 - software protectable as literary work under Berne.
- US, Australia - patentable; in Jan 1999, the US Patents and Trademarks Office (USPTO) granted the Quick Install Process Patent (QIPP) to an American who claimed to have invented a
“process [which] does not suffer from any of the limitations all other Y2K tools have, [and] which works on everything, installs much faster than other methods and does not require a lot of costly programmers to use or install.”

- UK - not quite patentable, see Merrylynch case (electronic securities trading system patentable in US, not UK, now debatable in UK).
- Kenya - copyrightable (s. 2) © Act, 2001) but where are the details?

8. Performer’s Rights, Rights of the Producers of Sound Recordings and Rights of Broadcasting Organisations (of character merchandising; protecting and securing benefits from the image of celebrities, etc)

rights of a performer s. 30 © Act 2001)
- rights in performance
  - endorsement
  - sponsorship
- rights of the producer of sound recordings s. 28
- rights of the broadcasting organizations s. 29
- civil & criminal aspects (ss. 35, 38)

Readings


Sihanya (forthcoming (2012) “Character merchandising, endorsement and sponsorship” (Chap. 15)


Kumar, U. (1991) “Copyright law and its application in Lesotho: principles of copyright and fields covered by copyright” (folklore addressed at pp 23-28?)


**Legal instruments**  
Copyright Act No. 12 of 2001; Nigerian Copyright Act, 1990 as amended in 1992; 1999 (stronger on © administration and enforcement; e.g. inspectors have warrants. Act has details on software and folklore.  
Berne Convention, 1886; Rome Convention, 1961 (on performer’s rights).  
WIPO Copyright Treaty (WCT), 1996; WIPO Performances and Phonograms Treaty, (WPPT), 1996

**Case law**  

NB. On authorship and ownership: (cf. work for Gov’t or international bodies, employee and employer, consultant and client, reporter v editor/dictator v speechmaker): in case of anonymous (name not disclosed, or simply Anon, e.g. *Primary Colors*, a fiction novel later adapted into a film) and pseudonymous (e.g. pen names, like poet Y.S. Chemb/Henry Barlow; Yusuf Dawood?), the first owner is the publisher or entrepreneur. But once the identity of author is known, author becomes owner, unless there is a contract to the contrary (see ss. 23(4), 25, 31).

**9. Folklore or Traditional Cultural Expression (TCE), Traditional Knowledge & Geographical Indication (?)**

**Folklore**  
There are concerns about protecting folklore, and orate innovators (who may not reduce innovations into tangible media through writing, tape recording, etc. This is due to the unauthorized exploitation of folklore by “foreigners”  
- What is folklore and why should it be protected and promoted?  
- Is the current IP framework suitable for the protection or promotion of folklore?  
- Traditional knowledge approach (eg under international instruments on cultural heritage; WIPO/UNESCO’s Model Provisions for National Laws on the Protection of Expressions of
Folklore against Illicit Exploitation and Other Prejudicial Actions, 1982; UN Working Group on the Rights of Indigenous (and Aboriginal?) Sui generis Approach.
- © Act’s approach (definition of folklore (ss.2 and 49 IPA 2001. cf. s. 18 1966 Act); A-G may make regulations on use of folklore (i.e. determine the terms…) “except by a national public entity for non-commercial purposes, or the importation of any work abroad which embodies folklore” (i.e. these are excluded from A-G’s regulatory remit);
- in Ghana, folklore vests in the state and is protectable and promoted (for the people’s benefit) in perpetuity; any person intending to use folklore must pay fees which are administered by the Gov’t; is this a viable model? in the context of popular struggles for democracy, allegations of official corruption, and Ghana's and Kenya's experience (e.g. with management of public resources/national (cultural heritage)? NB. Kenya has a ministry responsible for national heritage, and culture … is it only the commercial angle that is missing? Research this issue ….
- Significance of folklore and challenges to dev of Kenya's cultural/folklore industry [eg. dev. of tech to record and market it, but such tech may also be used to bootleg/counterfeit folklore; problem of regulatory inertia; etc.]

Traditional knowledge (focus on the TK questions-TK v.IP...)
What is traditional knowledge?
Cf. Local knowledge, indigenous knowledge, folklore or traditional cultural expressions? traditional resource rights..

Readings


Legal instruments including statutes
African Model Legislation for the Recognition and Protection of the Rights of Local Communities, Farmers and Breeders, and for the Access to Biological Resources.

Case Law (UK, US cases are discussed in the materials, esp. in the main texts)
EABL v. Castle Brewing K Ltd. HCCC 848 of 1998.

10. Patenting life forms: biopatents v. traditional knowledge [We consider biopatents here]. Utility models and the patentability of computer programs (under copyright) are relevant here. Relate to: Political Economy: Tech change; and Enviro mov’t).
- biotech v biodiv: biopatents (GMOs, cloning...) (s. 26 & 29 IPA; Art. 27 (3) (b) TRIPs
- ethical/moral (consider cloning, genetic engineering, genetically modified foods etc)
- religious (humans playing God?)
- political (the decision is political; sovereignty debate; political fall out - sleepless in Seattle...)
- economic issues
- social/legal- marginalisation; only individuals have rights?
- traditional knowledge
- pharmaceutical industries and biopiracy/traditional knowledge: protection and exploitation of traditional knowledge

Cf. Arts 3, 8(j), 15, 16 and 19 CBD - harmonizing the legal issues

The Role of the Patent and Trade Mark Attorney

Readings
Gopo, Joseph & Patricia Kameri-Mbote (2005) “Biotechnology: a turning point in development or an opportunity that will be misiled.” In Teaching in Genes


Legal instruments and statutes
Industrial Property Act, 1989 (Cap. 509) repealed and replaced Patents Registration Act Cap. 508 (see s. 125 of IPA).
Industrial Property Bill, 1999 (to make Kenya TRIPs-compliant; etc
Biosafety Act 2009; Biotechnology Regulations...

11. Utility Model, Industrial Design and Design Rights (Kenya)
(a) Utility Model, petty or utility patent [relate to political economy: informalisation of the economy - jua kali sector]
-cf. Paris; Art. 4; TRIPs Art. 2(1) applies Arts 1-12 of Paris [includes utility models but no clear guidelines on same; emphasis on patents, TM…)

-Registrability:
- focuses on utility in agric, industry, education, enviro conservation (s. 25 IPA) (cf. patent, ©…)
- relates to shape, structure or assemblage of articles (ss. 81, 82, 83) (cf. industrial designs, design rights).

Non registrable (s. 82(1): not novel (cf. patent)
- s. 34(5): if it is obvious to one having "ordinary technical knowledge in the field…"
- s. 46 in the context of patenting
- presumption of national novelty

Procedures:
- the first to file secures protection (s. 48)
- (if 2 apply same day, they either agree on who gets or neither gets; KIPO/KIPI not to resolve dispute; is this fair? or administrative/regulatory inertia?)
- details and identity of inventor: name, nationality, date of submission, title of model (s. 34(3))
- specification (cf. patents): title of model; explanation of drawings & model; scope of model
- request for exam of an application to the Managing Director (s. 66); who may request; within what period; withdrawal of application
- rejection of application; examiner to give reasons (s. 67)
- publication, exam, registration fees payable (s. 65)
- utility model registration and certificate to be published (s. 63, s. 64)

Scale down (s. 51) (patent application may be converted into utility model application; may be there is no inventive step; cf. scale up in Japan or Germany…. (EC Directive of 1997 meant to harmonise utility model protection in Europe; it created a new IP in the UK; it came into force 31/12/1999. See Bainbridge, Intellectual Property Pitman Publishing, London (4th ed., 1999) p. 439; cf. Cornish, Llewelyn & Aplin (2010), pp. 140-143 Rights and duties (see also under patents)
-right to exclusively produce, use, sell, import or distribute the articles commercially or industrially (s. 52(2))  
-duty to seek licence where use would conflict with patented invention/protected model (s. 52(3)).

Exploitation of right  
-non-exclusive licence (s. 54; 55; 58; 60) (eg to several furniture shops…); eg where one is already exploiting model in good faith at time of invalidation.  
-compulsory licensing similar to patents (s. 56, 59)  

Duration (s. 57) (5-12 yrs); cf. IP Bill, 1999 (a flat 10 yrs), IP Act of 2001  
Infringement (s. 53)  
-trial by examiner and appeal on various issues, e.g. to invalidate registration; confirm scope; grant non exclusive licence (s. 68; s. 69, s. 70)  
-appeal (s. 71)  

Readings  
Cornish, Llewelyn & Aplin (2010), pp. 11; 140-143: “A second-tier right for Europe?”  
Odhiambo Omondi, Austin (1992) LL.B. dissertation on jua kali

12. Industrial Design and Design Rights  
(i) What is an industrial design? Cf. design rights; mask works and various designs…): s. 84(1) IPA 2001 1989: s. 72 (1) 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.”  
(ii) Registrability and registration in Kenya: IPA does not protect “anything in an industrial design which serves solely to obtain a technical result” (i.e. not merely functional? This is the realm of design right?) (s. 84(2), s. 85 IPA 2001 1989: s. 72(2); s. 73).  
(iii) Works not registrable: works of sculpture, architecture, painting, engraving, enamelling, embroidery and photography and other inventions of a purely artistic nature. (Is it because these are copyrightable?) inventions contra public order, safety… etc.; designs whose features correspond to or are determined by the functions to be performed by the products; designs that consist solely in a change in the colour of designs already registered e.g. from green to blue….  
(iv) Rights conferred and duties imposed by registered (industrial) designs (eg the exclusive right to exploit the design; to sell or cause to be sold for commercial and industrial purposes the goods in which the design is incorporated…” s. 85 (i) IPA 2001(s. 73(1) IPA 1989.  
Rights/exploitation, transfer, assignment and licensing of industrial design: cf. ss. 81/82 IPA 1989
(v) Duration of protection. ss. 88 IPA 1989; IPA 1989: s. 75 five years from deposit & renewable for 2 five year terms?
(vi) Infringement and defences
(vii) Reliefs and remedies (enforcement ss. 92 & 93 IPA 2001; cf ss. 81, 82 IPA 1989)
(viii) Protection of designs under copyright? Copyright Act 2001

Readings
Bainbridge (2009) Chaps. 16, 17, 18: “What is a design?” “Registered designs,” and “Design right,” respectively
Cornish Cases and Materials, Chap. 4

Case law
British Leyland Motor Corp. v. Armstrong Patents [1986] 2WLR 400 (a © and design right case. See Bainbridge, (4th ed., 1999) pp. 168/9 for a re-evaluation of this case, esp. the (judicial) opinion to the effect that the 1988 UK Copyright, Designs and Patents Act provides statutory defences and "non derogation from grant" or implied right or licence to repair the exhaust pipe… must be treated with caution.

13. Trade Secret or Technical Know-how and Confidential Information
(i) What is a trade secret (TS)? - the parameters or ingredients: confidential; there is an intention or obligation to keep the info confidential; it has commercial value… (e.g. Diana’s letters? And EABL’s unmalted barley beer processing technology?) the protection of technical know-how transferred through management contracts… (NB methods of doing biz not patentable but TS protectable)
(ii) Requirement for protection; Secrecy, have commercial value and proper measures should be taken to safeguard the secret, for example, signing of confidentiality documents. Article 39 of TRIPs Agreement
(iii) Trade secrets vis-à-vis other IPs (e.g. patents) in terms of nature or scope of protection… (cf. Coca Cola…)
(iv) The confidential obligation (the role of contract, and business practice) TS and the work relationship.
(v) Rights conferred and duties imposed by TS (eg duty on TS owner to keep the info secret…; compulsory licensing of know-how? State use of TS?)
(vi) Duration
(vii) Infringement and defences (e.g. it wasn’t a secret? There was no confidential obligation or relationship?)
(viii) Reliefs and remedies (enforcement)
(ix) TS, technical know-how and confidential information as property

Readings

**Case Law and Anecdotes**

*EABL v. Castle Brewing Kenya Ltd.* HCCC 848 of 1998
The Diana letters (to Major James Hewitt) (64 letters in issue)

**14. IP as a Business Asset**

IP valuation, commercialisation, Securitisation, taxation...

**Competition and Consumer Aspects of IP: Comparative/misleading advertising: unfair competition; injurious falsehood, trade libel. cf TM? Trade in Counterfeit protection?**

(i) Is unfair competition an IP issue? (Art. 10 *bis* and 10 *ter* of Paris): protect traders or innovators against unfair competition; i.e. competition contra honest practices - e.g. acts which cause confusion… false allegations; those which discredit competitors' products… allegations which mislead as to the nature, manufacturing characteristics, suitability for purpose, quantity…. These are also economic torts.

(ii) State of competition and consumer law in Africa: competition from corporate perspective v. consumer perspective (relate to political economy discussions).

(iii) Misleading v. comparative advertising: are they IP or Consumer Protection issues? should they be regulated?

(iv) Pros and cons of (comparative) advertising: See class notes; persuasive or informative ads; ad expenses in Africa exceed investment in R&D in Africa (per Chudnovsky, etc; cf. Coca Cola…); ad limits or levels indicated by franchisor/IP owner (as percentage of sales, profits…); franchisee keen to develop product or goodwill…; questions of brand loyalty enhanced or attacked by ads; ads inform; give alternatives; ads sometimes take into a/c local nuances or culture (issue of social or ethnic marketing) eg “Obey your thirst” is “Vingi huigua. Kiu haigui; tii kiu yako” in TZ; ad industry facilitates tech transfer (franchising or skill acquisition by locals); ad industry provides jobs; industry is source of tax revenue; ads facilitate exploitation and transfer of tech eg TM or IP owner exploits IP through ads….

(v) State v. self-regulation of advertising in Africa or Kenya: Issues in dev/regulation of ad industry is a delicate balancing act and include:

-IP (eg TM exploitation/infringement); genericization; consumer concerns (eg health); revenue; labour/employment (see Pros & cons above/class discussions/notes).

Institutional framework on dev/reg of ad: state and interstate cooperation: various gov’t agencies or ministries (eg KEBS…); KIPI, etc; AR IPO, WIPO, etc. Self reg: individual media houses; Marketing Society of Kenya; Int. Ad Association….

**Readings**

Jerome, F. “Trade practices and sales methods,”
Draft Media Bill 1998 (drafted by B. Sihanya & L. Mute for KUJ & FES)

Case law
News Group v. The Mirror (The Sun masthead used in the Mirror…).

Traditional knowledge (cf. Indigenous Knowledge), Traditional Cultural Expression (TCE), Genetic Resources and The IP regime
- TK and TCE have become topical issues in the IP arena especially due to their contribution to the pharmaceutical and cosmetic industries.
- The case of CSIR, the San and KoiKoi on the Hoodia plant. The San and Koi Koi people of southern Africa have used the hoodia plant for eons to stave off hunger. CSIR isolated the active ingredient and came up with an anti obesity drug which they have patented and licensed a UK firm to manufacture. CSIR and the San people came to an agreement on benefit sharing of the profits to be made from the drug.
- Issue of patentability, does the above fulfil the criteria for patentability?
- Issues of benefit sharing
- Biotechnology enhances the value of TK and genetic resources
- Conservation of the genetic resources is important
- Public goods
- Distinction between TK and genetic resources
- Protection of TK under the existing IP regime or through a sui generis system?

Readings
15. Trade in Counterfeit Products and Parallel Importing

(i) Parallel importing: what is it? Issue of exhaustion of IP; TRIPs (Art. 6); Kenyan legislation (cf. IPA 2001) ... rationale (innovator/corporate v. consumer arguments)

(ii) Regional, international and national exhaustion

(iii) Case study on parallel importing: the Silhouette case; HIV/AIDS drugs in S. Africa, Thailand... [parallel importing v. traditional IP infringement or infraction]

(iv) What's counterfeiting or trade in counterfeit products?
- forms of counterfeiting (the products; the package or label; misleading allegations of potency, etc...; all or a combination of these...)
- counterfeit trade, v. traditional IP infringement v. passing off
- pros of counterfeit trade (supporters of Robin Hood)
- cons of counterfeit trade

(v) Addressing counterfeit trade in Africa/Kenya
- criminal and civil law
- traditional IP (s. 38(2) IPA- border measures under TRIPs; IP administration

\textit{sui generis} measures

Readings
Sihanya (forthcoming 2012) \textit{IP and Innovation in Kenya and Africa}, Chapters _ (Parallel importation); Chap. 21 (Trade in counterfeit products); Sihanya (2009?) “Combatting counterfeit trade” Wekesa & Sihanya (eds)
Chudnovsky (1979) “Foreign trademarks in developing countries” (under TMs).
Bainbridge “Parallel imports”, pp. 215-17 (pp. 589-92 in 4\textsuperscript{th} ed., 1999).

Statutes and case law
\textit{Beecham v. International & Another} (cited under patents).
Counterfeit Bill 2005, 2007 (Kenya)
Anti-Counterfeit Act, 2008 (Kenya)

16. Technology Transfer in Africa: conceptual parametres

(i) North-South divide (digital divide?); N-S debate on differential dev; tech in dev; technology and resource transfer/resource use.

(ii) Does intellectual property aid or inhibit technology transfer?

(iii) NIEO; CERDS

(iv) UNCTAD and Development of ToT Code and Code of Conduct on TNCs (OECD working on draft, 2000)
- major elements of ToT Code: Competition (mkt) v. development or consumer approach
- West, South, East issues...
17. Transfer of Technology: Forms of ToT

(i) Consensual or market oriented approach (including by operation of law): Assignment; contractual licensing, (international) subcontracting, franchising, FDIs, JVs/SAs; turnkey or push button contracts….

(ii) Involuntary, statist forms: compulsory licensing; “crown” use … (cf. public interest limitation to protection of innovations….: Peter Wright's *Spycatcher*; Mary Bell's *Cries Unheard*; D. Mailu’s & C. Mangu’s *After 4. 30; Son of Woman*…, respectively); compulsory licensing on what basis? Refusing to license; licensing on unreasonable terms; not working the innovation (i.e. industrially and commercially availing the product in satisfactory quantity or prices… (ss. 17 © Act; 56/59, 95-101 IPA); crown or state use products or processes of vital importance for defence, economy, health, S&T advancement not available, or other overriding public interest (war…).

NB: Innovator still must be paid reasonable sum; licensee must comply with terms of licence; compulsory licence may only be transferred “within the industrial undertaking” and with the consent of the Tribunal.

Readings
UNCTAD (1990) *Recent Developments in the Areas of Technology to the Negotiations on the Draft Intentional Code of Conduct on the Transfer of Technology* TD/CODE TOT/55, UNCTAD.
See materials on exploitation of rights under the other headings, e.g. those relating to assignment, (contractual) licensing, etc.

Case law & anecdotes
Nyakundi Nyambga’s report on KBL cited under TM;
McDonald’s in SA; LandRover in Brazil;
SAAC v. *Saudi Kenya Ltd.* (under TM)

International Greetings v. Kenya Litho Ltd. 1 KAR 902-5.


IPA 2001: Part x (ss. 64-79)- “contractual licences,” Part XI (ss. 80-83): “Exploitation of patented inventions by Govt or by third persons authorised by the Govt.” cf. IPA, 1989, ss. 92-106; Copyright Act (ss. 14, 17); TM Act (ss. 25-28: For the avoidance of doubt, a TM is a transferrable assignable or licensable in connection with the goodwill of a business or not (s.25).

see also TRIPs Agreement

Foreign Investments Protection Act (FIPA), Cap. 518.
Companies Act, Cap. 486

18. IP Prosecution, Administration and Enforcement (see also specific chapters)

Case Study in Technology Transfer (to be circulated; students to be referred)
Important areas include: ToT in health (e.g. HIV/AIDS); agriculture and food security (irrigation; access to food; food safety); environmental protection and the conservation and sustainable use of biodiversity; ToT in ICT/e-commerce: security, defence or military technology. [On agric, biodiv and food security, see Sihanya, “Technology transfer, IP… strategies for implementing CBD” (handout).] We focus on security technology.

Transferring security or military technology in Africa
(i) What is security/military technology? Typology of peace and security challenges in Africa.
(ii) Dual nature of security tech: may be used for war/peace or other dev purposes (e.g. high tech such as telecoms, computer tech, chemicals and nuclear tech. Nuclear tech used to generate energy; arms used for defence and aggression).
(iii) Typology of needs for security, defence or military technologies; who needs security tech? for what?
(iv) Suppliers or sources of security technology (eg McDonnell Douglas, General Dynamics, Lockheed Martin (USA), Sandline (UK); SA; ammunition factory in Eldoret? (to serve who?); any other established sources? robbing police stations/military installations…. Acquirers of security tech: states; security firms; cyberwarriors; terrorists; petty criminals (see (i) supra).
(v) Significance of regulation of security tech in a unipolar, post Cold War world undergoing liberalisation: the issue of export control of security tech; constructed advantage, etc.; role of UN arms embargoes in: Angola; apartheid S. Africa (led to dev of indigenous armament industry in SA); Sierra Leone, etc. NATO’s role… What's the role of the following in security tech transfer? Geneva Conventions? AU?/IGAD? EAC, COMESA, ECOWAS/ECOMOG?
(vi) Deregulation of military/security tech (part of liberalization of political economy/ToT…) (eg arguments by TZ gov’t). The case for managed trade/ToT in security tech - what are the regulatory issues?
The foregoing are addressed below:

(i) Typology of peace and security challenges in Africa, historically and currently; 
independence struggle, governmental lawlessness (e.g. ethnic cleansing…), crime in Rwanda; Burundi; crime (SA car jacking, burglaries); international/localised terrorism/rape (cf. crime); interstate/presidential animosity (Uganda/Sudan; Eritrea/Ethiopia); insurrection or insurgency (what's the difference?); leftover of Cold War tensions and proxy wars (problem of hot peace); Resource (eg water, pasture conflicts?) Religious or ethnic nationalism or chauvinism (cf. secession) - Katanga; Eritrea; the Sudan? Biafra; Nigeria 2000; Somalia (1991; 2011) 
Why is there an increase in security firms and operations (both traditional and new products like car track and other surveillance, eg in supermarkets, homes…), hence the use of sophisticated security technologies in Kenya and Africa? (cf. Buwembo’s report, infra).

(ii) Security and economic competitiveness 
(a) Is the US (and its allies) applying security/military restrictions to control technology transfer so as to secure/maintain constructed advantage (economic and military leadership based on technological leadership)?
(b) Recently the US enacted the Helms-Burton law to penalise US and other (foreign) corporations which invest beyond a certain threshold in “rogue” states (such as Iran…) cf. the use of super 301. Why should the US (be allowed/be suffered to) apply its technology, economic, military or security law extraterritorially? 
(c) Regulation is also justified by the need to protect trade secrets and ensure security. Witness the alleged spying by a Chinese technologist employed in US nuclear plants. The dispute caused alarm and insecurity in the US, and some difficulties in Sino-US relations in 1999. Was Bruce Mackenzie spying for UK in Kenya to secure UK's imperial or neo-colonial (economic, political, security, geo-political…) interests in Kenya/Africa? (see Nation, late March/April 2000). 
(d) Is regulation unilateral, multilateral, or universal? As a matter of law and political economy why should the US or NATO overrule or overshadow the UN in security/military operations (e.g. in Somalia, Kosovo)? 
(e) After the end of the Cold War, the US (and its allies) have expressed fears that Russian nuclear technology now controlled by unpaid and starved scientists or technologists, may fall into “wrong” hands, e.g. terrorists who have the money…. How should the problem be handled?

(iii) Acquisition/Supply of Security tech 
NB: Consider the modes used in transferring security tech to and in Africa. 
(a) Hardware: the focus is on equipment (and the tech that goes with it): purchase; licence; rob police/military installations? from unstable regimes (e.g. Idi Amin's Uganda who received same from Mid East/Eastern Europe (see Ghai “The rule of law, legitimacy and governance” pp. 205/6); from refugees; from arms dealers within the North (eg. Sandline); from leftovers of WW II, or Cold War hardware? (esp. Eastern Europe discarding this hardware hence transferred to various African states and used in DRC?) Through crossborder movement e.g. in case of Kenya, from Somalia/Uganda (hence debate on control of porous borders).

(b) Software - training in the context of E/W conflagration; using tech learnt in pursuit of independence where it was violent: Angola? Algeria? Kenya? Zimbabwe? Namibia? SA? This is
related to the problem of turning swords into ploughshares or a war into a peace economy; training in hostile neighbours (Uganda/Sudan problem); espionage etc. in the IT age: consider cyber wars (use of electronic media for warfare eg to disable security or military computer installations; to corrupt bank data, etc. and cause panic & despondency…).

In the US gun control is a human rights (HR) and constitutional issue - the right to bear arms…

Who are the acquirers? Is the US a terrorist? (i.e. whose nomenclature do we use? eg US bombed a Sudanese factory for manufacturing medicinal drugs? (after Bin Laden’s Nairobi and Dar bombing & fear or suspicion of other attacks; US bombed Libya (1986) before Libyans allegedly bombed Pan Am Airlines at Lockerbie (1988)). Issue of international peace and security litigation (Mandela’s role in Libya and Lockerbie; trial in the Netherlands under Scottish law by Scottish judges; …). Can African courts handle terrorism/complex security tech issues? or do administrative actions by executive carry the day (on security grounds?) what does security and /martial court litigation and jurisprudence look like in Kenya/Africa? Does the "security" exception compromise representation/rule of law - any lawyers thrown out of martial courts/barracks? Consider the 1982 coup attempt cases, eg was Airforce 82 legal (as replacement of KAF)? do courts support violence eg successful coups - ex parte Matovu… (Uganda).

(iv) Who is transferring security tech (eg selling arms, transferring software …)?
(a) When Lady Diana died in 1997, some conspiracy theorists alleged she had been killed by those opposed to the ban of antipersonnel land mines. They argued that banning the land mines, a move she supported, would reduce (constrain) the market for such military technology… whole companies may collapse… jobs would be lost… This earned Jody Williams and International Campaign Against Landmines who were working on it the Nobel Peace Prize in 1998.
(b) During the Cold War (and even now), it was (may be) easier for African states to secure military support (e.g. concessionary rates for recycled or discarded military hardware and software) than other (e.g. agricultural and ICT technologies. These arms are largely supplied by some cynical states (e.g. Eastern Europe? The West?) or corporations (Sandline?).

(v) Regulating and liberalising transfer of security tech

NB: What are the pertinent issues to consider on whether and how to regulate or liberalise security technology transfer? No to liberalisation (i.e. regulate!): ensure security; protect the trade secrets of the state or innovator of the security tech (esp. in high tech & security tech); human life at risk; hence need to protect life, property and investments; human rights abuse (eg “riot control” tech such as tear gas…); acquisition by and threat from rogue states/terrorists; would lead to over-expenditure on military/defence (at cost of health/HIV/AIDS; food…); militarisation of society through militias… is risky (DRC, Somalia). Arguments for liberalisation: jobs created; revenue earned eg through SA sale of arms and fees from licensing dealers (eg in TZ…); forex earned. Is it OK to liberalise then implement stds, eg license, scrutinize dealers/acquirers; regulate transactions on the basis of nature of arms, purposes, whether security tech leads to job creation… and other spin offs….

(a) Where is the UN, Africa, in the security tech transfer/arms control debate? The UN has made initiatives on illegal trafficking or proliferation of small arms; there are US-EU common principles on small arms and light weapons. Do these principles control arms transfer to Africa? There is also the Latin American initiative and ECOWAS moratorium (see Agina, infra); the
March 2000 Nairobi initiative addresses the issue in the Great Lakes region and in the Horn of Africa.

(b) KTN Mon 13/3/2000; (DN 16/3/2000 Th. p. 3): Where do small arms come from in the Great Lakes and Horn of Africa region? The meeting established a Commission to reduce or eliminate arms proliferation. Kenya is to lead it under Ministry of Foreign Affairs… (see Nairobi Declaration on Arms Proliferation). It indicated that conflicts in the region provide market for arms; are suppliers within Africa?

(c) Oromo Liberation Front said: This conference is "an exercise in futility" because they excluded leaders of some parties to the conflict (esp. “rebel” leaders) Hon. Godana: it is difficult to police borders (eg Kenya and Somalia border covers about 1200 km), and this facilitates transfer of arms. [Do African states have surveillance tech to police transfer of arms into & within the country? Eg at airports, sea ports… recall Nairobi bomb blast, Ocalan, the Kurdish leader arrested in Kenya in 1999…] According to the Nairobi initiative, a lot of work is to be done before OAU Summit and UN Conference in 2001.

(d) On/12/3/2000 a UN report had named and shamed states and individuals aiding UNITA (transferring arms to UNITA; buying UNITA diamonds…) This is referred to as UN sanction busting in Angola (according to BBC radio16/3/2000 Th.): Ukrainian pilots were used in supplying arms to UNITA; and Bulgaria (Eastern European state): supplied arms to UNITA contra UN Security Council resolution (i.e. embargo busting); 2 African states (Rwanda included?) which were named in UN report denied aiding UNITA; they say the report is based on rumours.

(e) Sandline, a UK corporation, exported military technology to Sierra Leone to help restore the deposed president (“restoration of democracy”) contrary to UN arms embargo; US supported the Sandline “cause”. How would/did OAU treat this? what of individual states or (sub)regional blocs like Nigeria/ECOWAS (ECOMOG)?

(f) In the late 1990s, the UK allegedly refused to transfer to Kenya “riot control” (read tear gas; batons…) technology on grounds of the need to observe human rights (freedom of association/expression/protest. There was also the reason of observing the imperatives of resolving disputes democratically, rather than through the baton…; SA easily availed the technology (used in the Karura conflict in 1999?) [This is also an issue of source of security tech, (iv) supra].

President Moi indicated [at the Gt-Lakes and Horn conference on small arms] that security is a critical issue; but sometimes the IMF/WB don't take this into account; Kenya may have to spend (IMF/WB) money on addressing security problems and fail to implement the funded projects, but the IMF/WB may not understand. This underscores security as a dev. problem to be factored into aid/dev cooperation. (NB: aims of UN… include peace & Int. cooperation… is UN being sidelined?) On funding security measures there is debate that Uganda reduced defence spending (DN Sat 28/3/2000); see also EastAfrican - Feb/March - Museveni on Peace in Uganda) - Ug's involvement in DRC, and fight against rebels may have increased defence spending. What of
Kenya? S. Africa has had to spend about USD 5B on defence (replacements/modernisation of equipment such as fighter aircraft…). Some argue that defence is a deadweight expense in the face of poverty, HIV/AIDS… that it is not productive…

**Readings**


**Legal and Policy Instruments**

Nuclear Non Proliferation Treaty
Strategic Arms Limitation Talks (SALT)
Strategic Arms Reduction Talks (START)
Convention on the Prohibition of the Use, Production, Stockpiling and Transfer of Anti-personnel Mines and on their Destruction, came into force 1/3/99 (Also known as Mine Ban Treaty)
Helms Burton Law (US)
Ominibus Trade and Competitiveness Act, 1988 (US; esp. super 301; cf. its efficacy in the context of WTO’s multilateralism).

19. Reliefs & Remedies: IP Innovation and ToT administration and enforcement
These have been dealt with under the substantive topics. Our interest here is in the generic or crosscutting administration and enforcement issues:
-IP & ToT administration in Africa/Kenya: State v. innovator initiatives
-Capacity in the Bar
-Capacity in the Bench
-Attitudes of various interest groups (e.g. “theft” of IP not as serious as stealing a soda bottle? bottle of soda?)
  - TRIPs Agreement Part III
  - Dispute settlement under TRIPs

Case Law
Giella v. Cassman Brown [1973] EA 358-61 (also applied to trade secrets, ToT, etc.)
E.A. Industries v. Trufoods [1972] EA 420-3 (also ToT; TM/passing off)
Cut Tobacco v. BAT Ct of Appeal Civil Application No. 245 1999 (Nairobi, 96/99 UR)
Anton Piller KG v. Manufacturing Processes Ltd. [1976] 1 Ch. 55

20. Reforming IP Innovation and ToT in Kenya and Africa
(i) Reforms in the political economy generally (international & national)
(ii) Constitutional reforms
(iii) Legislative reforms
(iv) Policy & institutional reforms

Some of the very good CAT essays from the previous years are being circulated. Exam will have 5 questions.

Exam Guidelines:
1. Write legibly, even if it means in CAPITAL letters.
2. Cite authority as appropriate - e.g. academics, writers, case law, statute or transnational legal instruments; evaluate the authority eg do you agree? Why (not?)
3. Provide practical context - e.g. anecdotes i.e. indicate experience and practice. This and the previous guideline indicate that cramming is not a virtue.
4. You may use common or notorious abbreviations or acronyms (IP, ©, TRIPs, ARIPO, KIPI…).
5. In legal opinion or advisory questions, consider whether a suit, appeal… is necessary; what of ADR? And why? and what the legal issues are; how the party should address them; you may anticipate the other party’s case… Relate the answer closely to the hypothetical.
6. Brevity is a virtue! To attract or retain attention/interest, and to delineate the issues you may use a brief intro: In this question I will address the following 3 issues: first… Second, third… (without details, then embark on discussion. See some of the past CAT essays.

*** The discourse continues in appropriate fora ***

THE PEOPLE REST (their case)

I have enjoyed discussing with you the issues (including your comments). To adapt poet Yusuf Kassam’s work, “the drummer inspired the dancers; [then] the dancers inspire[d] the drummer.” Let’s make Kenya and Africa work through IP, innovation and technology transfer (ToT). Success in your exams and happiness in life.

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