

# INTELLECTUAL PROPERTY RIGHTS REGIME WITHIN THE EAST AFRICAN COMMUNITY



ENHANCING REGIONAL PROTECTION OF IPR  
AS A KEY DRIVER TO INDUSTRIALIZATION



**ISBN No. 978-9966-1866-1-4**

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## TABLE OF CONTENTS

<b>FOREWORD.....</b>	<b>vi</b>
<b>INTRODUCTION .....</b>	<b>vii</b>
<b>ACKNOWLEDGEMENT .....</b>	<b>viii</b>
<b>LIST OF ABBREVIATIONS.....</b>	<b>ix</b>
<b>EXECUTIVE SUMMARY .....</b>	<b>xii</b>
<b>1 CHAPTER ONE: INTRODUCTION.....</b>	<b>1</b>
1.1 BACKGROUND .....	1
1.2 IP ENFORCEMENT CHALLENGES IN THE EAC .....	2
1.3 PURPOSE OF THE STUDY.....	3
1.4 METHODOLOGY.....	4
1.4.1 Approach to the study .....	4
1.4.2 Work Plan.....	4
1.4.3 WIPO Best Practices and Minimal Standards.....	4
1.5 Intellectual Property Rights Definitions .....	5
1.6 STRUCTURE OF THE REPORT.....	7
<b>2 CHAPTER TWO: TANZANIA .....</b>	<b>9</b>
2.1 Introduction .....	9
2.2 TANZANIA: IP LEGISLATIVE FRAMEWORK.....	9
2.2.1 The Constitution of the United Republic of Tanzania of 1977.....	9
2.2.2 Patents (Registration) Act, Cap. 217 .....	10
2.2.3 Trade and Service Marks Act, 1986 .....	10
2.2.4 Copyright and Neighbouring Rights Act, 1999 .....	11
2.2.5 The Plant Breeders' Rights Act, 2012 .....	11
2.2.6 Other IP Related Laws.....	11
2.3 INSTITUTIONAL FRAMEWORK.....	12
2.3.1 Business Registrations and Licensing Agency (BRELA).....	12
2.3.2 The Copyright Society of Tanzania (COSOTA) .....	13
2.3.3 Registrar of Plant Breeders' Rights.....	13
2.3.4 Other Institutions .....	13
2.4 ENFORCEMENT OF IP AND ANTI-COUNTERFEIT ACTIVITIES .....	16
2.5 STAKEHOLDER OBSERVATIONS.....	16
2.6 ZANZIBAR: IP LEGISLATIVE FRAMEWORK .....	17
2.6.1 Introduction.....	17
2.6.2 Zanzibar Industrial Property Act, 2008 .....	17
2.6.3 Zanzibar Copyright Act, 2003.....	17
2.6.4 Plant Breeders' Rights Act, 2014.....	17

2.7	IP INSTITUTIONAL FRAMEWORK IN ZANZIBAR.....	17
2.7.1	Zanzibar Business and Property Registration Agency (BPRA).....	17
2.7.2	Copyright Society of Zanzibar (COSOZA).....	18
2.8	ENFORCEMENT OF IP AND ANTI-COUNTERFEIT ACTIVITIES IN ZANZIBAR.....	18
2.9	CONCLUSION AND RECOMMENDATIONS.....	18
<b>3</b>	<b>CHAPTER THREE: KENYA.....</b>	<b>19</b>
3.1	INTRODUCTION.....	19
3.2	LEGISLATIVE FRAMEWORK.....	19
3.2.1	The Constitution.....	19
3.2.2	Industrial Property Act, 2001 .....	19
3.2.3	Trade Marks Act, Cap 506.....	20
3.2.4	The Copyright Act, 2001 .....	20
3.2.5	Anti-Counterfeit Act, 2008 .....	21
3.2.6	The Seeds and Plant Varieties Act, Cap 326.....	21
3.2.7	Protection of Traditional Knowledge and Cultural Expressions Act, 2016 .....	21
3.2.8	Other IP and Illicit Trade Related Laws.....	21
3.3	INSTITUTIONAL FRAMEWORK.....	22
3.3.1	Kenya Industrial Property Institute (KIPI) .....	22
3.3.2	Kenya Copyright Board (KECOBO).....	23
3.3.3	Kenya Plant Health Inspectorate Services (KEPHIS).....	24
3.3.4	Anti-Counterfeit Agency (ACA) .....	24
3.3.5	IP Supporting Institutional Framework.....	25
3.4	ENFORCEMENT of IP and Anti-Counterfeit Activities.....	27
3.5	CONCLUSION AND RECOMMENDATIONS.....	27
<b>4</b>	<b>CHAPTER FOUR: RWANDA.....</b>	<b>29</b>
4.1	INTRODUCTION.....	29
4.2	IP LEGISLATIVE FRAMEWORK .....	29
4.2.1	Law No. 31/2009 of 26/10/2009 on Protection of Intellectual Property Rights .....	29
4.2.2	Law No. 005 of 2016 on Seeds and Plant Varieties in Rwanda .....	30
4.2.3	IP SUPPORTING LEGISLATIVE FRAMEWORK.....	30
4.3	IP INSTITUTIONAL FRAMEWORK .....	30
4.3.1	Rwanda Development Board (RDB).....	31
4.3.2	The Ministry of Sports and Culture.....	31
4.3.3	Rwanda Society of Authors .....	31
4.3.4	Plant Breeders' Rights Unit.....	31
4.3.5	Rwanda Bureau of Standards (RBS).....	32
4.4	ENFORCEMENT OF IP AND ANTI-COUNTERFEIT ACTIVITIES .....	32
4.5	STAKEHOLDER VIEWS .....	32
4.6	CONCLUSION AND RECOMMENDATIONS.....	34
<b>5</b>	<b>CHAPTER FIVE: UGANDA.....</b>	<b>35</b>
5.1	INTRODUCTION.....	35
5.2	IP LEGISLATIVE FRAMEWORK .....	35
5.2.1	Constitution 1995 .....	35

5.2.2	Industrial Property Act 2014 & Regulations .....	35
5.2.3	Trademarks Act, 2010 .....	35
5.2.4	Geographical Indications Act, No. 8 of 2013.....	36
5.2.5	Trade Secrets Protection Act 2009 & Regulations .....	36
5.2.6	The Copyright and Neighbouring Rights Act, 2006.....	36
5.2.7	The Patents (Amendment) Act (2002) .....	36
5.2.8	Plant Variety Protection Act , 2014 .....	37
5.3	INSTITUTIONAL FRAMEWORK.....	37
5.3.1	Uganda Registration Services Bureau (URSB).....	37
5.3.2	Plant Variety Protection Office .....	37
5.3.3	IP Supportive Institutions .....	37
5.4	ENFORCEMENT OF IP AND ANTI-COUNTERFEIT ACTIVITIES .....	38
5.5	STAKEHOLDER VIEWS .....	38
5.6	CONCLUSION AND RECOMMENDATIONS.....	41
<b>6</b>	<b>CHAPTER SIX: BURUNDI.....</b>	<b>43</b>
6.1	INTRODUCTION.....	43
6.2	IP LEGISLATIVE FRAMEWORK .....	43
6.2.1	The Law on Industrial Property.....	43
6.2.2	The Law on Protection of Copyright and Related Rights .....	43
6.3	IP INSTITUTIONAL FRAMEWORK .....	43
6.3.1	Department of Arts and Culture Ministry of Youth, Sports and Culture.....	44
6.3.2	Ministry of Trade, Industry and Tourism.....	44
6.4	Enforcement .....	44
6.5	CONCLUSION AND RECOMMENDATIONS.....	44
<b>7</b>	<b>CHAPTER SEVEN: SOUTH SUDAN .....</b>	<b>45</b>
7.1	INTRODUCTION.....	45
7.2	IP LEGISLATIVE FRAMEWORK .....	45
7.2.1	Transitional Constitution.....	45
7.2.2	Literary and Artistic Works Act of 2001 .....	45
7.2.3	Seeds Act of 1990 .....	45
7.2.4	Industrial Designs Law No. 18 of 1974 (1974) .....	45
7.2.5	Patent Law No. 58 of 1971.....	46
7.2.6	Trademark Law No.8 of 1969 (1969).....	46
7.2.7	IP Supportive Legislation .....	46
7.3	INSTITUTIONAL FRAMEWORK.....	46
7.4	CONCLUSION AND RECOMMENDATIONS.....	46
<b>8</b>	<b>CHAPTER EIGHT: THE EAST AFRICAN COMMUNITY .....</b>	<b>47</b>
8.1	INTRODUCTION.....	47
8.2	LEGISLATIVE FRAMEWORK IN EAC .....	47
8.2.1	The EAC Treaty.....	47
8.2.2	The EAC Customs Union Protocol.....	47
8.2.3	EAC Common Market Protocol.....	47
8.2.4	The EAC Customs Management Act.....	48

8.2.5	Protocol on Decision Making by the Council of the EAC .....	49
8.3	INSTITUTIONAL FRAMEWORK OF THE EAC .....	49
8.4	Stakeholder Views .....	49
<b>9</b>	<b>CHAPTER NINE: COMPARATIVE ANALYSIS .....</b>	<b>51</b>
9.1	INTRODUCTION.....	51
9.2	THE EUROPEAN UNION (EU) .....	51
9.2.1	EU Trademark Laws .....	51
9.2.2	EU Industrial Design Laws.....	51
9.2.3	EU Geographical Indications .....	51
9.2.4	EU Trade Secrets.....	52
9.2.5	EU IP Enforcement.....	52
9.2.6	The European Commission (EC) .....	52
9.2.7	The EU Intellectual Property Office (EU IPO).....	52
9.3	AFRICAN REGIONAL INTELLECTUAL PROPERTY ORGANIZATION (ARIPO) .....	52
9.3.1	Legal Framework .....	52
9.3.2	Institutional Framework .....	53
9.4	AFRICAN INTELLECTUAL PROPERTY ORGANISATION (OAPI) .....	54
9.4.1	OAPI Legal Framework .....	54
9.4.2	OAPI Institutional Framework.....	51
9.4.3	Comparison between ARIPO and OAPI Frameworks .....	55
<b>10</b>	<b>CHAPTER TEN: RECOMMENDATIONS AND CONCLUSION .....</b>	<b>57</b>
10.1	INTRODUCTION.....	57
10.2	NATIONAL LEVEL ACTIONS .....	57
10.2.1	Autonomous National IP Offices:.....	57
10.2.2	Set up Anti-Counterfeit Agencies .....	57
10.2.3	Raise Awareness on IPRs and Illicit Trade .....	57
10.2.4	Training of Persons involved in IP Sector.....	58
10.2.5	Legal Reforms in Individual Partner States.....	58
10.2.6	National Partnerships and Collaborations.....	59
10.2.7	Use of ADR to Resolve IPR Disputes.....	59
10.3	REGIONAL LEVEL ACTIONS.....	59
10.3.1	LEGISLATIVE REFORMS IN EAC.....	59
10.3.2	Regional Collaborations.....	61
10.3.3	Establishment of Regional IP Institutions .....	62
10.3.4	Proposed EAC Trade Mark .....	63
10.3.5	EAC Regional Harmonization Action Plan .....	64
10.4	CONCLUSION .....	65
	<b>ANNEX I: STAKEHOLDERS VISITED IN KENYA .....</b>	<b>66</b>
	<b>ANNEX II: STAKEHOLDERS VISITED IN UGANDA .....</b>	<b>67</b>
	<b>ANNEX III: STAKEHOLDERS VISITED IN RWANDA.....</b>	<b>68</b>
	<b>ANNEX IV: STAKEHOLDERS VISITED IN TANZANIA.....</b>	<b>69</b>
	<b>ANNEX V - STATUS OF COMPLIANCE WITH INTERNATIONAL TREATIES .....</b>	<b>70</b>
	<b>ANNEX VI: QUESTIONNAIRE .....</b>	<b>71</b>



## FOREWORD



Industry today is proactively engaging more closely with the government as part of its goal to drive tangible contributions towards economic growth. Great effort is therefore expended every day around the world to organize trade in order to protect citizens, raise their standards of living and enforce codes of ethics.

Despite numerous legislative and regulatory efforts to streamline commerce in the East African Community, illicit trade continues to plague our region. However some of the main challenges remain circumvention, infringement and violation of laws, regulations, licensing regimes, taxation systems and embargoes. Often times the issue of illicit trade in the individual EAC partner states is not treated with severity as it deserves. One of the most prevalent forms of illicit trade today is counterfeiting and piracy.

Counterfeiting and piracy poses serious socio-economic challenges nationally, regionally and globally. The vice undermines the concept of a free and open market, fundamental to enhancement of innovation and creativity, competitiveness, increased investment, job creation and improved economic situation in Kenya and the EAC partner states. It also undermines industries in the region, poses health risks to consumers, sabotages tourism, stunts innovation and breeds lawlessness.

A country's ability to grow its gross domestic product and improve the standard and quality of life for its citizens can be severely compromised by this vice. Counterfeiting and piracy does occur through normal business, and often results in greater harm than that caused by organised crime. Every day, it grows in its reach and sophistication, requiring urgent but effective responses from the key stakeholders' i.e. intellectual property holders (businesses) and the enforcement agencies. Trends in counterfeiting and piracy as a business suggest that, there remains a vast field for law enforcement agencies to explore in their review of the existing legal framework to respond effectively.

This report has been developed against the backdrop of escalating incidences of counterfeiting and piracy in Kenya and the EAC region as a whole. It is intended to aid advocacy work within the region, raise the respect for Intellectual Property Rights as a key driver in the EAC industrialization agenda as enshrined in the EAC Common Market Protocol and treaty. It will be a useful tool for law enforcement agencies involved in the prosecution of crimes related to counterfeiting and piracy and the enforcement of the laws against the trade offenders. It also seeks to act as a guide for law makers within the EAC region in prioritizing the issue of Intellectual Property Rights and its protection in the region and utilization of the IPR for economic advantage.

Flora Mutahi

CHAIRLADY, KENYA ASSOCIATION OF MANUFACTURERS (KAM)



## INTRODUCTION



It is my pleasure and honour to introduce this report on a Study of the Intellectual Property Rights Regime within the East African Community (EAC) Partner States.

This report has provided the status of intellectual property systems of the EAC Partner States, as a basis for formulating policy and legal reforms necessary to address different forms of illicit trade regionally. It is sufficient to say that Intellectual Property Rights relate closely with trade, competition, industrial and economic improvement. Counterfeiting and piracy is the most prevalent form of illicit trade currently. This thus has become a global challenge. The global business community is adversely affected by counterfeiting and piracy in all aspects ranging from products to services, resulting to serious negative impact on investment in research and development, skewed market access and loss of income. This challenge has elevated intellectual property debate globally, it being a power tool for rationalisation of acts that are contrary to honest practices in industrial or commercial matters. EAC Partner States are no exception to this situation.

An effective intellectual property regime for the EAC Partner States has come of age judging from the dynamics of current global economy, which are virtual and largely driven by ideas and information as commodities. The regime contributes to, among other things, existence of a pro-competitive and transparent market in an economic system where the consumer is protected and businesses are facilitated to enter the market freely and compete fairly. Its establishment requires intellectual property laws complemented by appropriate collateral policies and institutions necessary for ensuring adequate protection and effective enforcement of intellectual property rights within the region.

It is therefore my sincere hope that the information in this report will lead to finding concrete policy and legal solutions towards reduction of the soaring illicit trade among EAC Partner States by enhancing levels of recognition and respect for intellectual property rights. I salute Kenya Association of Manufacturers for commissioning this important study on the intellectual property rights regime within EAC Partner States.

Sylvance Anderson Sange  
MANAGING DIRECTOR, KENYA INDUSTRIAL PROPERTY INSTITUTE (KIPI)

## ACKNOWLEDGEMENT



This report was developed through the collaborative efforts of several important players within the EAC region, among them state agencies and non-state actors that are committed to promote intellectual property rights within the East African Community. The endeavor was informed by the need to strengthen the EAC legal framework to deal with intellectual Property Rights in order to reduce the infringement of the same through counterfeiting and piracy. Their generous input and contributions make this report the fusion of their commitment, dedication and industry. We are grateful to these institutions and their staff who were involved in developing this work.

I would like to acknowledge the support from C. Mputhia Advocates led by Ms. Catherine Mputhia and Mr. Fredrick Otswong'o for their commitment and dedication in the collection and compilation of this report. The Consortium worked very closely with the KAM team from the Policy Research Advocacy Unit led by Mr. Joseph Wairiuko – Anti-Counterfeits and Illicit Trade Officer, in seeing through the successful completion of this report.

I would like to appreciate the dedication and support granted by our counterparts in the EAC Partner States, that is, the EAC Manufacturing Network who include Uganda Manufacturers Association (UMA), Rwanda Association of Manufacturers (RAM), Burundi Manufacturers Association (AIB), Confederation of Tanzania Industries (CTI) and the East African Business Council (EABC). They greatly assisted our lead team in engaging the key stakeholders in each partner states, as well as planning logistics for the stakeholders' validation workshops for this report in the respective partner states.

I wish to further acknowledge the technical contribution of our Technical Editor to this report, Dr. Henry Kibet Mutai, who through his long experience and expertise on IPR matters was able to review the report for purposes of publication. We are indebted by your valuable contribution that authenticated the content/quality of this publication.

Finally, I take this opportunity to recognize TradeMark East Africa (TMEA) for their continued support to the Association's advocacy work particularly on Intellectual Property Rights.

The Kenya Association of Manufacturers conceptualized the idea of undertaking this baseline study, in order to promote the respect for intellectual property rights within the region as enshrined in the EAC Common Market Protocol and the EAC Treaty. This idea was borrowed from the fact that IP protection and thus enforcement is territorial in nature and hence the need to advocate for a common approach within the EAC.

Phyllis Wakiaga,  
CHIEF EXECUTIVE – KENYA ASSOCIATION OF MANUFACTURERS (KAM)

## LIST OF ABBREVIATIONS

<b>ACA</b>	Anti-Counterfeit Agency
<b>ACCN</b>	WIPO Africa Copyright Common Network
<b>AEC</b>	African Economic Community
<b>APSD</b>	Anti-Piracy Security Device
<b>ARIPO</b>	African Regional Intellectual Property Organization
<b>BRELA</b>	Business Registration and Licensing Agency
<b>CAK</b>	Competition Authority of Kenya
<b>CAG</b>	Controller and Auditor General
<b>CLE</b>	Continuous Legal Education
<b>CMO</b>	Collective Management Organization
<b>COMESA</b>	Common Market for Eastern and Southern Africa
<b>COSOTA</b>	Copyright Society of Tanzania
<b>COSOZA</b>	Copyright Society of Zanzibar
<b>COSTECH</b>	Tanzania Commission for Science and Technology
<b>CTI</b>	Confederation of Tanzania Industries
<b>DI</b>	Destination Inspection (DI)
<b>EAC</b>	East African Community
<b>EACJ</b>	East African Court of Justice
<b>EALA</b>	East African Legislative Assembly
<b>ESARIPO</b>	Patent granted by Industrial Property Organization for English-speaking Africa
<b>EU</b>	European Union
<b>EWURA</b>	The Energy and Water Utilities Regulatory Authority
<b>FCA</b>	Fair Competition Act
<b>FCC</b>	Fair Competition Commission
<b>FCT</b>	Fair Competition Tribunal
<b>FMCG</b>	Fast Moving Consumer Goods
<b>IDF</b>	Import Declaration Fee
<b>IP</b>	Intellectual Property
<b>IPRC</b>	Integrated Polytechnic Regional Centre
<b>IPRs</b>	Intellectual Property Rights
<b>KAA</b>	Kenya Airports Authority
<b>KAM</b>	Kenya Association of Manufacturers

<b>KAMP</b>	Kenya Association of Music Producers
<b>KEBS</b>	Kenya Bureau of Standards
<b>KECOBO</b>	Kenya Copyright Board
<b>KEFRI</b>	Kenya Forest Research Institute
<b>KEPHIS</b>	Kenya Plant Health Inspectorate Services
<b>KIPI</b>	Kenya Industrial Property Institute
<b>KIPO</b>	Kenya Industrial Property Office
<b>KOPIKEN</b>	The Reproduction Rights Society of Kenya
<b>KRA</b>	Kenya Revenue Authority
<b>LDC</b>	Least Developed Country
<b>LSK</b>	Law Society of Kenya
<b>MCSK</b>	Music Copyright Society of Kenya
<b>MINEACOM</b>	Ministry of Trade and Industry, Rwanda
<b>MINIJUST</b>	Ministry of Justice, Rwanda
<b>MINISPOC</b>	Ministry of Sports and Culture, Rwanda
<b>MoITC</b>	Ministry of Industry, Trade and Cooperatives, Kenya
<b>NACOSTI</b>	National Commission for Science, Technology and Innovation
<b>NCAC</b>	National Consumer Advocacy Council
<b>NCAJ</b>	National Council on the Administration of Justice
<b>NEP</b>	National Enquiry Point (NEP)
<b>OAPI</b>	Organisation Africaine de la Propriété Intellectuelle
<b>Partner States</b>	Kenya, Uganda, South Sudan, Tanzania, Burundi, Rwanda
<b>PBAK</b>	Plant Breeders Association of Kenya
<b>PCT</b>	Patent Cooperation Treaty
<b>PO-PSM</b>	President's Office - Public Service Management
<b>PPB</b>	Pharmacy and Poisons Board
<b>PRISK</b>	Performers Rights Society of Kenya
<b>PSF</b>	Private Sector Federation
<b>PTC</b>	Packaging Technology Centre
<b>PVoC</b>	Pre-shipment Verification of Conformity
<b>RBS</b>	Rwanda Bureau of Standards
<b>RDB</b>	Rwanda Development Board
<b>RILO</b>	Regional Intelligence Liaison Office

<b>RRA</b>	Rwanda Revenue Authority
<b>SADC</b>	Southern African Development Community
<b>SADCAS</b>	Southern African Development Cooperation Accreditation System
<b>SIDO</b>	Small Industries Development Organisation
<b>SMEs</b>	Small and Medium Enterprises
<b>STAK</b>	Seed Trade Association of Kenya
<b>SUMATRA</b>	The Surface and Marine Transport Regulatory Authority
<b>TBS</b>	Tanzania Bureau of Standards
<b>TCAA</b>	Tanzania Civil Aviation Authority
<b>TCCIA</b>	Tanzania Chamber of Commerce, Industry and Agriculture
<b>TCRA</b>	The Tanzania Communications Regulatory Authority
<b>TDCs</b>	Technology Development Centres
<b>TFDA</b>	Tanzania Food and Drug Authority
<b>TISC</b>	Technology and Innovation Support Centres
<b>TRIPS</b>	Agreement on Trade-Related Aspects of Intellectual Property Rights
<b>ULRC</b>	Uganda Law Reform Commission
<b>UNCTAD</b>	United Nations Conference on Trade and Development
<b>UNESCO</b>	United Nations Educational, Scientific and Cultural Organization
<b>UPOV</b>	International Convention for the Protection of New Varieties of Plants
<b>URA</b>	Uganda Revenue Authority
<b>URSB</b>	Uganda Registration Services Bureau
<b>VAT</b>	Value Added Tax
<b>WCC</b>	World Customs Convention
<b>WCO</b>	World Customs Organisation
<b>WCT</b>	WIPO Copyright Treaty
<b>WHO</b>	World Health Organisation
<b>WIPO</b>	World Intellectual Property Organization
<b>WPPT</b>	WIPO Performances and Phonograms Treaty
<b>WTO</b>	World Trade Organisation
<b>W&amp;M</b>	Weights and Measures

## EXECUTIVE SUMMARY

Intellectual property rights (IPRs) play a pivotal role in promoting innovation, industrialisation and creation of employment. The East African Community (EAC) is a trade bloc comprised of six Partner States, namely, Burundi, Kenya, Rwanda, South Sudan, Tanzania, and Uganda. Each of these states has individual territorial IP regimes established in line with the international treaties and conventions to which they are party. Illicit trade, which includes infringement of IP and dealing in substandard goods, can have adverse effects on human health, industrial growth and employment. The main challenge faced by the industrial sector within the EAC is how to jointly enforce or fight against counterfeiting and other forms of illicit trade.

The Kenya Association of Manufacturers (KAM) commissioned a study on IPRs Regimes within the EAC on behalf of other membership organisations in the EAC to establish the current IPRs regimes in the region. The main objective of the study was to provide a strong evidence-based background that can be used by the private sector in advocacy work towards the harmonisation of IP laws across the region and, if possible, to recommend suitable regime options for protection and enforcement of IP in the region as a single territory.

Study findings were grouped into IP legislative framework, institutional framework, enforcement mechanisms and stakeholder views. The aim was to identify issues concerning the current IPRs legislation within the Partner States, current IPRs administrative structures under the EAC, current legislation that touches on enforcement of IPRs and curbing of illicit trade within the Partner States and the EAC, institutions and agencies that deal with regulation and enforcement of IPRs both at national level and the EAC and to highlight the strengths and weaknesses of the reviewed legislation and institutional framework. The study looked at the institutions and agencies that deal with curbing illicit trade both at national level and the EAC. It also considered applicable international legal instruments that are applicable to IPRs within the EAC, comparative studies of other regional IP regimes and enforcement mechanisms with a view to benchmarking best practice for the region.

### Study Findings

All of the Partner States have at least one national IP law or framework that governs IPRs regimes. Even though each of the Partner States has at least a national industrial property or copyright office for administering IPRs, the legal and institutional frameworks are not unified thus causing delays and lack of action or follow-up on some important IP enforcement matters within and across borders.

### Study Recommendations

The study's recommendations are categorised under those that should be implemented at the national level and those requiring implementation at the regional (EAC) level.

At the national level, the main recommendations to come out of the study are that:

- National IP offices should be autonomous;
- Autonomous anti-counterfeit agencies to deal with counterfeit issues should be established where they do not exist;
- Measures to increase the levels of awareness of the importance of IPRs as well as the dangers of counterfeit goods and illicit trade should be taken. This should include integrating IP as a mandatory course in tertiary institutions;
- Training and capacity building of personnel in the national IP offices, lawyers, and the judiciary to be enhanced;
- Establishment of inter-agency IP committees comprising national IP offices, enforcement agencies and standards regulating authorities to enhance enforcement;
- Encourage the use of ADR mechanisms to resolve disputes regarding IPRs.

**At a regional level, the following measures are recommended:**

- Establishment of a regional IP office that will allow protection of IPRs in all partner states through a single online filing;
- Establishment of an EAC mark/geographical indication that confers upon the owner exclusive rights in all EAC Partner States;
- Development of an EAC model IP law to harmonise the individual partner states' national IP legislations;
- Development of an EAC Anti-counterfeit law;
- Enhance collaboration between the national IP offices;
- Establish regional sharing of IP information and database of national IP offices;
- Establish regional MOUs and collaborative agreements to give effect to the provisions of the EAC Common Market Protocol;
- Formation of regional institutions in IP e.g. IP training institute;
- Establish mutual recognition agreements on IPRs allowing recognition of an IPRs granted in a partner state;
- Conduct joint IP awareness and enforcement efforts.





## 1 CHAPTER ONE: INTRODUCTION

### 1.1 BACKGROUND

The Kenya Association of Manufacturers (KAM) is the representative organization for manufacturing value-add industries in Kenya. Established in 1959 as a private sector body, KAM has evolved into a dynamic, vibrant, credible and respected business association that unites industrialists and offers a common voice for businesses. KAM provides an essential link for co-operation, dialogue and understanding with the Kenyan Government by representing the views and concerns of its members to the relevant authorities.

According to KAM, one of the main challenges faced by the industry sector within the East African Community (EAC) concerns illicit trade and, specifically, how to jointly fight against one of the most prevalent form of illicit trade i.e. counterfeiting. This is a vice that erodes the market share of genuine manufacturing value-add industry, threatens their overall expansion and growth and hampers the creation of job opportunities in the manufacturing industry in the region. This is a real threat to the economy as it has led to shrinkage of the market share (by approx 40% according to a 2012 KAM survey) leading to the ultimate closure of some industries.

It is against this backdrop that KAM initiated this study on the status of intellectual property rights within the EAC with a view to identifying gaps and recommending the best practices in order to eliminate illicit trade and counterfeiting activities in the region.

Illicit trade involves dealing/trading in both illegal goods and services and dealing with legal goods and services illegally, affecting all aspects of social and economic lives<sup>1</sup>. The trade not only leads to massive loss of revenue by manufacturers but also endangers the lives and health of innocent and most likely ignorant consumers<sup>2</sup>. This can also lead to massive tax loss.

The Organisation for Economic Co-operation and Development (OECD) estimates that EAC governments lose over US\$ 500 million in tax revenue annually due to the influx of counterfeit and pirated products.<sup>3</sup>

Key industrial actors that have adversely been affected by counterfeiting are those in the Fast Moving Consumer Goods (FMCG) sector as their value-added products are easy to sell. Such sectors include: motor vehicle assemblers and components (spare parts) sector, energy, electrical and electronics sector, food, beverages and tobacco sector, chemical and allied sector, pharmaceutical and medical equipment sector.

1 Karl Lallerstedt & Mikael Wigell, "Illicit trade flows; how to deal with the neglected economic and security threat," Finnish Institute of International Affairs, Briefing Paper 151, March 2014. [Cited in National Council on the Administration of Justice, Enforcement Manual to Combat Illicit Trade in Kenya, available at [http://www.judiciary.go.ke/portal/assets/filemanager\\_uploads/Downloads/Enforcement\\_Manual%202.compressed.pdf](http://www.judiciary.go.ke/portal/assets/filemanager_uploads/Downloads/Enforcement_Manual%202.compressed.pdf) page 2 [Accessed on 12 October 2016]

2 40% of malaria drugs are counterfeit according to Presentation by the chief executive of Kenya Association of Manufacturers, Betty Maina, "Anti-Counterfeit Bill – We Count on Legislators to Act Rightfully" September 2008, available at [www.kam.co.ke/](http://www.kam.co.ke/).

3 NCAJ, Enforcement Manual to Combat Illicit Trade in Kenya [http://www.judiciary.go.ke/portal/assets/filemanager\\_uploads/Downloads/Enforcement\\_Manual%202.compressed.pdf](http://www.judiciary.go.ke/portal/assets/filemanager_uploads/Downloads/Enforcement_Manual%202.compressed.pdf) page 2 [Accessed on 12<sup>th</sup> October 2016].

The EAC Partner States are a party to several regional and international covenants and declarations that relate to the protection and enforcement of IPRs. Some of these agreements oblige the EAC Partner States to take steps to harmonise IPR legislation while others oblige them to put certain minimum provisions in place. The most pertinent of these agreements include the EAC Treaty and the protocols concluded under it, the WIPO-Administered Treaties such as the Paris and Berne Conventions, the WTO-TRIPs Agreement and the ARIPO administered Protocols.

The closing down of a company in one EAC partner state directly affects trade in the rest of the region in a phenomenal way. The entire region is drawn back to being dependent on imports from other regions and as such, the trade deficit increases exponentially every year. The region therefore becomes a net importer and a trading entity rather than a manufacturing entity. This reality has greatly contributed to the low investment levels in the manufacturing sector yet the region is very rich in raw materials. The aftermath of all this is that consumers in the EAC are exposed to hazardous products in terms of their health and safety of products regional standards are compromised.

Counterfeiting continues to pose a real threat to industry. The main challenge has been the poor inter-agency collaboration, cooperation and coordination in the fight against counterfeiting and illicit trade in totality as every government enforcement agency in EAC has its own mandate and hence works in silos in delivering on its specific core mandate. In some partner states, lack of policy and legislative and institutional framework is the cause of the difficulties faced in enforcement.

## **1.2 IP ENFORCEMENT CHALLENGES IN THE EAC**

The EAC comprises six countries namely: Burundi, Kenya, Rwanda, South Sudan, Tanzania and Uganda. All partner states of EAC are members of the World Intellectual Property Organization - WIPO (except South Sudan) and have national IP legislation and this underscores the importance of IPR regimes. Most of them (except Burundi and S. Sudan) are members of the World Trade Organization and are thus bound by the TRIPs Agreement. Four out of six partner states are members of the African Regional Intellectual Property Organization (ARIPO) and only two are party to the Banjul Protocol for regional filing of trademark applications. Each of the partner states has at least a national industrial property or copyright office for administering IPRs.

Regarding IP enforcement within the EAC, the glaring challenge is the fact that by virtue of the territorial nature of IP, each Partner State has its own IP laws. There are, therefore, different IP territories in the same EAC which has greatly affected the enforcement against counterfeits and illicit trade across the borders due to the fact that there are both challenges of transit goods as well as the porous borders where illicit goods can be smuggled back into any of the partner states.

One attempt to resolve this issue was made with the drafting of an EAC Anti-Counterfeit Bill, 2011 that was presented to the East African Legislative Assembly (EALA) but is yet to be enacted into law. The law would provide for a uniform definition of counterfeit, scope of coverage, establishment of national anti-counterfeit agencies, appointment of inspectors, remedies among others. In the absence of such an Act, each state has continued to enact or amend their national laws relating to anti-counterfeit activities even though the issue of illicit trade and, specifically, that of counterfeit goods is cross-border in nature.

Kenya has tried to address the issue of counterfeiting through the enactment of the Anti-Counterfeit Act 2008 which provided for the establishment of the Anti-Counterfeit Agency which is mandated to fight against counterfeits in Kenya as well as create consumer awareness on the vice in order to reduce the demand for counterfeits.

In Tanzania, Fair Competition Commission (FCC) fights counterfeit products using the Merchandise Marks Act which gives it the power to seize goods, arrest and prosecute culprits. In Rwanda, anti-counterfeit activities are dealt with by the IP Office under the Rwanda Development Board (RDB) in conjunction with the Police. In Uganda, Anti-counterfeit Act has just been signed that proposes establishment of an Agency to deal with counterfeit matters. Today, illicit trade issues are referred to courts directly with the assistance of the Uganda Registration Services Bureau (URSB) under the Ministry of Justice and Constitutional Affairs. In South Sudan, matters of IP enforcement and counterfeit are yet to be incorporated in the government main stream policy.

### 1.3 PURPOSE OF THE STUDY

The objectives of the study, as set out in the terms of reference, are:

- To explore IPRs regimes in both the EAC Partner States and the EAC as a trade bloc with a view to securing an enforceable legal framework within the EAC;
- To explore and sum up the existing IP legislations in each of the Partner States of EAC with a view to promoting harmonisation; and
- To recommend adoption of best practices within EAC from comparative regions.

In light of the above TORs, the following research questions were formulated:

- ❖ What are the current national intellectual property (IP) legislations in each Partner States of EAC and EAC itself?
- ❖ What are the strengths, weaknesses in the national and regional IP legislations within EAC Partner States?
- ❖ What are the institutions that currently regulate and enforce IPRs at national level and regional level and recommended institutional reforms, where applicable?
- ❖ Which legislative reforms can the Partner States undertake at national level to enhance harmonization of IP enforcement within EAC?
- ❖ What are the comparative jurisdictions legislative and institutional reforms can EAC conduct so as to enhance IP regulation and enforcement in order to promote the respect for IPR within and across the regions?

## **1.4 METHODOLOGY**

### **1.4.1 Approach to the study**

A holistic purposeful approach towards the TORs and the study as a whole was adopted while remaining focused on the specific requirements of KAM. In line with the objectives, TORs, specific tasks and scope of the study set out by KAM, the study was conducted as follows:

- i. Desk review of the legal framework governing regulation of IP in the EAC highlighting the status and thrust of IP policy in the region,
- ii. Distribution of questionnaires to relevant stakeholders in four EAC Partner States namely; Kenya, Rwanda, Tanzania Mainland (Tanganyika) and Uganda.
- iii. Conducting of one-on-one meetings or telephone interviews with some stakeholders of Burundi delegations.
- iv. Analysis of the desk review data and questionnaires and highlighted EAC's Partner States obligations under international treaties which address IP enforcement,
- v. Analysis and comparative study with other jurisdictions having comparable circumstances to those of EAC (such as OAPI and the EU) in order to identify viable practices in the legal structures for regulation of IP in these countries that can be adapted or adopted,
- vi. Recommended practical strategies for the implementation of the proposed IP regulation and institutional framework.

Given the current situation in South Sudan and Burundi, the study in these two partner states was limited to a desk review of the legal framework governing regulation of IP.

### **1.4.2 Work Plan**

A team of four consultants carried out the study over an initial period of three months which was later extended by an additional three months. The scope of work included site visits, working group seminars and facilitation of stakeholder forums in Kenya, Rwanda, Uganda and Tanzania.

The study included reviewing the framework of EAC Partner States, that is, Kenya, Uganda, Tanzania and Rwanda and stakeholder visits to EAC Partner States. Burundi and South Sudan were not included because they were out of the scope of the study.

Over 100 stakeholders were visited or contacted across EAC region amounting to over 90% of identified stakeholders. A report was compiled for each member state and presented to stakeholders' workshops in every country for input and validation. Their input and further findings were incorporated into the report before the final report was presented to the client.

### **1.4.3 WIPO Best Practices and Minimal Standards**

While collecting data and information, a detailed analysis of the legal and institutional frameworks of each EAC Partner State highlighting strengths, weaknesses and proposing recommendations was performed. The study utilised the benchmark indicators proposed by WIPO for use in carrying out baseline surveys to ascertain the current status of IP laws while developing national IP strategies and

policies.<sup>4</sup> These indicators include those that are useful for evaluating the status of, firstly, the ideal IP law, and secondly, the ideal IP office.

With regard to the legislative framework, the indicators that measure the extent to which a country's laws have developed include:

- ❖ Scope of coverage: Legislation should cover patents, utility models, industrial designs, trade marks, copyright and related rights, trade secrets & plant varieties;
- ❖ Participation in and compliance with international treaties, conventions and protocols;
- ❖ Policies and regulations that enhance the use of TRIPS flexibilities, e.g. compulsory licensing, parallel imports, and bolar provision/regulatory exception;
- ❖ Unfair competition and antitrust laws; and
- ❖ Laws establishing IP tribunals.

With regard to the institutional framework, the indicators used to evaluate the ideal IP office include:

- ❖ Legal status of the IP Office;
- ❖ Autonomy of the IP office as determined by whether it has a board of directors, can charge fees for services & retain income, recruit staff, sue or be sued and enter into partnerships;
- ❖ Role of the IP office as determined by whether it carries out IP registration and protection, IP outreach, promotion of innovation, promotion of IP utilisation and support for enforcement;
- ❖ Undertaking formal and substantive examination;
- ❖ Extent of automation and modernization;
- ❖ Availability of human resources; and
- ❖ Streamlining of the operations of IP professionals.

## 1.5 INTELLECTUAL PROPERTY RIGHTS DEFINITIONS

This section defines some of the key terms used in this study.

The 1967 Convention establishing the World Intellectual Property Organisation (The WIPO Convention) defines IP as encompassing the rights relating to:

Literary artistic and scientific works; performances of performing artists, phonograms, and broadcasts; inventions in all fields of human endeavour; scientific discoveries; industrial designs; trademarks, service marks, and commercial names and designations; protection against unfair competition; and all other rights resulting from intellectual activity in the industrial, scientific, literary or artistic fields.<sup>5</sup>

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<sup>4</sup> WIPO, "Methodology for the Development of National Intellectual Property Strategies -Tool 3: Benchmarking Indicators" (2014).

<sup>5</sup> Article 2, WIPO Convention.

There has been significant progress since the 1967 WIPO Convention that has seen the range of IP rights expanded to include trade secrets, plant breeder's rights, geographical indications and rights to layout designs of integrated circuits.

Illicit trade, on the other hand, has been defined by the WHO as “any practice or conduct prohibited by law and which relates to production, shipment, receipt, possession, distribution, sale or purchase including any practice or conduct intended to facilitate such activity.”<sup>6</sup> For the purposes of this study, the term illicit trade is restricted to the smuggling of excisable goods, IP infringements, trading with illegal weights and measures and illegal manufacturing.

In terms of IP infringement, counterfeiting can be defined as the unauthorised manufacturing of products which mimic the features of genuine goods and thus making them easily identifiable with registered products of licit companies while pirated goods are those reproduced without authority of the owner.<sup>7</sup>

IPRs are legal regimes that protect innovative works that have commercial worth/value<sup>8</sup>. The inventors or owners are granted exclusive rights that protect access to and use of their property from unauthorized third parties<sup>9</sup> but within a certain timeframe in which the IPR holder is expected to have recouped his/ her innovation costs and benefits.

Trade marks are defined as signs that distinguish goods or services offered by an enterprise from any other<sup>10</sup>. The sign may be a device or words or combination of both. Trade marks grant the owner of an enterprise exclusive rights to use signs such as symbols, colours, letters and shapes that uniquely identify the enterprise.

Patents are exclusive rights granted for an invention<sup>11</sup> that is new (novel), involves an inventive step and is industrially applicable.

Utility model certificates are petty patents granted for minor technological innovations.

Industrial design refers to any protection given to the outward appearance of objects as defined by shape, pattern, ornament or aesthetics appeal to the customers for example bottles and 3D objects.

Plant Breeder's rights are exclusive rights granted to breeders of stable new plant varieties.

Technovations are certificates granted to employees who develop improved process steps within a manufacturing or similar system.

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6 Article 1(a), WHO Framework Convention on Tobacco Control (2003).

7 Staake and Fleisch *Countering Counterfeit Trade: Illicit Markets Insights, Best-Practice Strategies, and Management Toolbox* (Springer-Verlag, Berlin 2008) at 4. [Referred by Enforcement Manual to Combat Illicit Trade in Kenya [http://www.judiciary.go.ke/portal/assets/filemanager/uploads/Downloads/Enforcement\\_Manual%202020compressed.pdf](http://www.judiciary.go.ke/portal/assets/filemanager/uploads/Downloads/Enforcement_Manual%202020compressed.pdf) page 5 [Accessed on 12<sup>th</sup> October 2016]

8 Intellectual Property Rights in Kenya [http://www.kas.de/wf/doc/kas\\_18323-1522-2-30.pdf?110214131039](http://www.kas.de/wf/doc/kas_18323-1522-2-30.pdf?110214131039) page 14 [accessed on 12<sup>th</sup> October 2016]

9 ICTSD-UNCTAD Policy Discussion Paper, Intellectual Property Rights: Implications for Development (ICTSD-UNCTAD Geneva Switzerland: August 2003), p. 27.

10 Section 2(1) of the Trademarks Act (Cap 506), also see Intellectual Property Rights in Kenya [http://www.kas.de/wf/doc/kas\\_18323-1522-2-30.pdf?110214131039](http://www.kas.de/wf/doc/kas_18323-1522-2-30.pdf?110214131039) page 17 [accessed on 12<sup>th</sup> October 2016].

11 Article 27, TRIPS Agreement.



Traditional knowledge refers to a living body of knowledge passed on from generation to generation within a community that often form part of a people's cultural and spiritual identity.

Trade secret refers to secret distinct information that is valuable commercially such as production methods, business plans or clientele that may give a person or company a competitive advantage<sup>12</sup>

Lastly, copyright are IP rights granted to new literary or artistic works/creations of the mind including: musical and audio-visual works, sound recordings and broadcasts valid beyond lifetime.

## 1.6 STRUCTURE OF THE REPORT

The study covered Uganda, Kenya, Tanzania and Rwanda. The following Chapters deal with findings and recommendations of the study. Within EAC, there are different types of IP offices. Some are divisions within a government department, others are departments within a government ministry, yet others are either semi-autonomous or fully autonomous organisations. In all cases, the operation structures of IP offices are found in the legislations on which such offices were created.

In particular, Chapters Two to Seven deal with the study findings highlighting legislative and institutional framework of each EAC partner state. It reveals the status, strength, weakness and observations as observed from the field. Chapters Two, Three, Four, Five, Six and Seven cover findings from Tanzania, Kenya, Rwanda, Uganda and South Sudan respectively.

Chapter Eight presents EAC Protocols, Acts, status, strength and weaknesses and recommendations from the stakeholders' point of view and salient recommendations required in administration of IPRs in the region. Chapter Nine brings out a comparative analysis of similar trading blocs with harmonized IP regimes. It highlights best practices in regional or community IP enforcement regimes including EU, ARIPO and OAPI. Chapter Ten concentrates on consultants' recommendations, conclusion and way forward. In addition, the report contains extra material in Annexes comprising list of participants, authors and study questionnaire among others.

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<sup>12</sup> Intellectual Property Rights in Kenya [http://www.kas.de/wf/doc/kas\\_18323-1522-2-30.pdf?110214131039](http://www.kas.de/wf/doc/kas_18323-1522-2-30.pdf?110214131039) page 18 [accessed on 12<sup>th</sup> October 2016].



## 2 CHAPTER TWO: TANZANIA

### 2.1 INTRODUCTION

This chapter examines the IP legislative and institutional frameworks of Tanzania with the goal of identifying the weaknesses and strengths of the frameworks from both a legislative and institutional perspective. It will also incorporate some of the views obtained from stakeholders.

In making this analysis, it is important to bear in mind that the present United Republic of Tanzania came into being in April 1964 as the result of a union between two countries namely, Tanganyika and Zanzibar. Within the Tanzania constitutional set-up, Zanzibar retains a significant degree of autonomy and as such has its own Legislature, Executive and Judiciary. Zanzibar has jurisdiction over a list of matters which are “non-union matters”. International Conventions unless stated otherwise during the signing and ratification, generally bind both parts of Tanzania, namely mainland Tanzania and Zanzibar.<sup>13</sup>

This unique history means that the IP regime in Tanzania is regulated by two separate and independent legal systems since IP issues were not classified as forming part of the union matters. As such, for IP protection, mainland Tanzania and Zanzibar are two different jurisdictions.<sup>14</sup> In this regard, this Chapter will first discuss the findings on the IP regime prevailing on the Tanzania mainland and, in the second part, discuss briefly the laws and institutional framework existing in Zanzibar.

At the international level, Tanzania is a member of the World Intellectual Property Organization, having become a signatory to the WIPO Convention in December 1983. It is also a party to a number of IP-related treaties and agreements that inform its domestic legal framework. These include the Paris Convention for the Protection of Industrial Property (joined June 16, 1963), Berne Convention for the Protection of Literary and Artistic Works (joined July 25, 1994), Patent Cooperation Treaty (PCT) (joined September 14, 1999), and the Nice Agreement (joined in 1999). Tanzania is also a contracting party to the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs) by virtue of its being a member of the WTO, which it joined in 1995.

Regionally, Tanzania is a member of the African Regional Intellectual Property Organization (ARIPO). As a member of ARIPO, Tanzania is party to the 1982 Harare Protocol on Patents and Industrial Designs and the 1993 Banjul Protocol on Marks, both of which it joined in September 1999. It should be noted in this regard that even though Tanzania is a member of ARIPO, Zanzibar has not been designated. Zanzibar IP registrations are therefore deemed as foreign.

### 2.2 TANZANIA: IP LEGISLATIVE FRAMEWORK

#### 2.2.1 The Constitution of the United Republic of Tanzania of 1977

The Constitution of the United Republic of Tanzania provides for the overall protection and enforcement of IPRs. The Union of Tanganyika and Zanzibar Act, 1964, which ratified the Articles of Union between the Republic of Tanganyika and the People’s Republic of Zanzibar, provides for the government of the United Republic and of Zanzibar, makes provision for the Modification and

<sup>13</sup> According to Ahmada M. Juma, BPRA, 2016.

<sup>14</sup> Mkono, Nimrod; Kameja, A A and Mrema A N: IP in Tanzania, Africa Sponsored Editorial, October, 2009: [www.managingip.com](http://www.managingip.com).

Amendment of the Constitution and Laws of Tanganyika for the purpose of giving effect to the Union and the said Articles, and for matters connected therewith and incidental thereto.

### **2.2.2 Patents (Registration) Act, Cap. 217**

This Act provides for the protection of inventions through the grant of patents and registration of utility certificates. It facilitates the acquisition of technology on fair terms through the grant and regulation of patents and utility certificates. The Act establishes the office of the Registrar of Patents, who is responsible for the administration of the Act, and provides for the patents registration procedures. It also provides for the filing of a regional patent and utility model through ARIPO.

According to the Act, a patent restricts commercial use, distribution or sale of goods made out of the invention without the consent of the owner. Any person using or exploiting the patented invention without the consent of the owner infringes on these rights, may face legal action and will be liable to compensate the owner for the wrongful acts. The patent owner has the right to work the invention without fear of the invention being infringed or being subjected to unfair competition. Under Tanzanian law, the term of a patent lasts for an initial period of ten years, which can be renewed for two further five year terms, subject to the fulfilment of certain conditions. The law also bestows upon a patentee the right to decide on whom to license, or assign on terms to be agreed upon by both parties. Patents are granted by the Government through the Business Registrations and Licensing Agency (BRELA).

### **2.2.3 Trade and Service Marks Act, 1986**

This Act, and its implementing regulations, provides for the registration and protection of trade and service marks in Tanzania. The Act establishes the office of Registrar of Trade and Service Marks, who is responsible for the administration of the Act. The core ideal of the Act is to protect owners of marks from unscrupulous competitors who would desire to take advantage of established business reputation of marks of their competitors. For SMEs, the protection afforded through Trade and Service Marks Act is particularly important because their business success and market penetration largely depends on their ability to distinguish their products/services from the rest.

Registration of a mark is not a mandatory requirement, provided that in using an unregistered mark one does not interfere with the rights of a registered mark owned by another. Registration of a mark gives exclusive rights of use to the owner of that mark. Under the Act, a trade mark is valid for an initial period of seven years which can then be renewed for further terms of ten years.

Applications for registration of marks are made in writing to the Registrar. After examination, an application is advertised in the Trade and Service Marks Journal. If the Registrar receives no objection within sixty days of advertisement, he then proceeds to issue the Certificate of Registration.

The Act provides for registration of regional trademarks under Banjul Protocol of ARIPO and international registration of marks under Madrid System of WIPO.

#### **2.2.4 Copyright and Neighbouring Rights Act, 1999**

This Act provides for the protection of copyright and neighbouring rights. It is implemented by the Copyright and Neighbouring Rights (Production and Distribution of Sound and Audiovisual Recordings) Regulations, 2006 and the Copyright and Neighbouring Rights (Registration of Member and Their Works) Regulation, 2005. It is consistent with the provisions of both the Berne Convention and the TRIPs Agreement.

The Act grants exclusive right to the authors of literary and artistic works that are original and possess a creative spark. The duration of protection of copyrightable works is, in the case of natural person, life of the author plus fifty years. In the case of a legal person, or pseudonymous works, the duration of protection is fifty years from the date of publication. With regard to folklore, the Act provides that expressions of folklore are not to be utilised in the absence of authorisation from the competent authority, that is, the National Arts Council of Tanzania.

One of the key features of the Act is that it has established a collective management framework in the name of the Copyright Society of Tanzania (COSOTA) for purposes of copyright management on behalf of its members. Under the Act, COSOTA is mandated to promote and protect the interests of the authors and other participating actors of copyrightable works, collect and distribute royalties and other remunerations, maintain registers of works, productions and associations of authors among others.

In addition to the traditional acts of infringement, the Act has also expanded the spectrum of infringing practices by faulting those who import or own instruments which are susceptible to be used to facilitate copyright infringement.

#### **2.2.5 The Plant Breeders' Rights Act, 2012**

Plant breeders' rights in Tanzania are governed by The Plant Breeders' Rights Act, 2012. This Act establishes a Plant Breeders' Rights Office and sets out the legal framework for the protection of plant breeders' rights. However, the plant breeders' rights regime is still at a nascent stage.

#### **2.2.6 Other IP Related Laws**

There are a number of other laws dealing with other issues that touch on IP but which are typically not considered core IP issues. These include:

##### **Merchandise Marks Act, 1963**

This Act controls the use of marks and trade descriptions in relation to merchandise and consequentially amends the Penal Code. The Merchandise Marks Regulations, 2008 were put in place to enable the Act deal with the developing challenges in the industry. They provide for description of marks and enforcement of IPRs against infringers.

## **Business Activities Registration Act, 2007**

The Business Activities Registration Act, 2007 provides for registration of business names, establishment of a business activities registration system, business registration centres and matters related thereto that have direct impact on the enforcement of trademark rights.

## **Fair Competition Act, 2003**

The Fair Competition Act contains provisions that encourage competition in the economy by prohibiting restrictive trade practices, regulating monopolies, concentrations of economic power and prices, with the aim of protecting the consumer. It thus provides for fair competition in trade.

## **The Traditional and Alternative Medicine Act, 2002**

This Act provides for the promotion, control and regulation of traditional and alternative medicines practice. It also establishes the Traditional and Alternative Health Practice Council. Its objective is to provide for the management of herbal medicine in the country.

## **2.3 INSTITUTIONAL FRAMEWORK**

IP in Tanzania is administered by a number of different entities. The following sub-sections discuss the principal bodies involved in the administration and enforcement of IP rights.

### **2.3.1 Business Registrations and Licensing Agency (BRELA)**

The national IP office for mainland Tanzania is the Business Registrations and Licensing Agency (BRELA). BRELA is an Executive Agency under the Ministry responsible for business administration and regulation of the laws. It is a combination IP and related services office that is mandated to register companies, business names and IPRs, as well as issue industrial licenses.

Its main mandate is to ensure businesses operate in accordance with the laid down regulations and sound commercial principles, including to administer companies and business names laws, regulate business by administering business and industrial licensing laws, administer IP laws, encourage and facilitate local and foreign business investment, stimulate scientific and technological inventiveness and innovation and encourage technology transfer, protect the development of creativity in artistic, literary works, and expression of folklore by protecting such work in conjunction with rights owners.

With regard to its IP mandate, BRELA currently carries out only formal examinations on patents and industrial designs applications. As a result of lack of capacity to carry out substantive examination, substantive examinations of applications are done at ARIPO and WIPO.

BRELA's performance as an IP office is constrained by lack of awareness among applicants, lack of political goodwill to support IP agenda, outdated supporting laws and regulations, lack of adoption of an IP policy and strategy and lack of resources.

In order to address these challenges, it is recommended that BRELA enhances inter-agency collaboration through commitment instruments, such as MOUs with other agencies, and that the

government allocate more resources for sensitization of the public on the importance of IPRs and the effects of consuming counterfeit goods.

### **2.3.2 The Copyright Society of Tanzania (COSOTA)**

COSOTA is a statutory body established under section 46 of the Copyright and Neighbouring Rights Act, 1999. It is vested with power to administer the Copyright Act. COSOTA has a dual function by virtue of being both a Copyright Office and a Collective Management Organization (CMO) mandated to promote and protect the interest of authors, performers, publishers, producers of sound recordings, broadcasters and in particular, to reduce piracy, collect and distribute royalties or other remunerations accorded to them in respect of their rights provided under the Act.

Stakeholders were of the view that COSOTA faces a number of challenges in its operations. These include lack of resources to monitor and regulate the creative industry, inadequate funding from the government, rapid development in ICT, especially in internet downloading and cyber related crime. Lack of collaboration from supporting agencies such as the Police, FCC and Customs is due to limited budgetary provisions.

In order to overcome these constraints, it is recommended that COSOTA be allocated more resources by the government and that it engages in more cooperation with other agencies as this would go a long way in assisting it to deliver on its mandate.

### **2.3.3 Registrar of Plant Breeders' Rights**

The Plant Breeders' Rights Act establishes a Plant Breeders' Rights Office within the Ministry for Agriculture. The Act also provides for the appointment of a Registrar of Plant Breeders' Rights responsible for, among other things, granting breeders' rights and maintaining a register.

### **2.3.4 Other Institutions**

#### **Fair Competition Commission (FCC)**

The FCC is a public institution established under section 62(1) of the Fair Competition Act with the aim of promoting and protecting effective competition in trade and commerce as well as protecting consumers from unfair and misleading market conduct. The FCC makes necessary interventions to ensure that competition is allowed to regulate the competitive market. It intervenes to prevent significant market dominance, price fixing and extortion of monopoly rent to the detriment of the consumer and market instability. It deals with all issues of anti-competitive conduct, abuse of dominance and has provision for curtailing mergers and acquisitions if outcome is likely to create dominance in the market or lead to uncompetitive behaviour.

Under Merchandise Marks Act, 1963, the FCC carries out the function of consumer protection regime. It has powers to gather information, conduct investigations and impose sanctions for violations of the law. It is also charged with the responsibility of enforcing the Merchandise Marks Act of 1963, which is the legal instrument for fighting counterfeits.



Stakeholders were of the opinion that the FCC provides a good model of a reliable public organization that represents public interest as well as consumers insofar as illicit trade is concerned. However, FCC is faced with challenges of inter-agency cooperation, inadequate resources, lack of capacity to regulate illicit trade across the country and lack of awareness by the consumers.

As a way of overcoming these challenges, it is felt that FCC should strengthen its ties with other supporting agencies including the Police and Customs Officials through signing of MOUs.

### **Tanzania Bureau of Standards (TBS)**

The TBS was established in 1975 under the Standards Act No.3 of 1975 as the National Standards Institute. Today, TBS operates under the Standards Act No. 2 of 2009, which gives it powers to regulate quality control of products of all descriptions and to promote standardization in industry and commerce. TBS supports IP offices in fighting illicit trade in sub-standard products that are non-medical in nature.

Unfortunately, the office is understaffed and cannot carry out its inter-agency support services to the IP offices due to volume of work and enquiries they receive in a day. TBS requires allocation of more resources to manage quality assurance, regulate standards and also assist in fight against counterfeit products especially at the border entry points.

### **Tanzania Food and Drug Authority (TFDA)**

The TFDA was established in 2003 under the Executive Agencies Act, Cap 345 of 1997. It is mandated to regulate the quality, safety and efficacy of food, medicines, cosmetics and medical devices. Such functions are also provided under the Tanzania Food, Drugs and Cosmetics Act, Cap 219.

The TFDA faces challenges in executing its functions due to the enormous existence of substandard and counterfeit products in the market. These fake goods filter through unauthorized border points due to lack of harmonized regulatory systems in the EAC and Southern Africa Development Community (SADC) regions.

Nevertheless, TFDA is also responsible for improving inspection activities and providing public education to all stakeholders.

### **Tanzania Commission for Science and Technology (COSTECH)**

COSTECH is responsible for co-ordinating and promoting research and technology development activities in the country. It is the chief advisor to the Government on all matters pertaining to science and technology and their application to the socio-economic development of the country. Thus, the Commission maintains a system of collaboration, consultation and cooperation with parties within Tanzania whose functions relate to the development and application of science and technology. In view of this all major national research and development institutes are affiliated to COSTECH.

Today, COSTECH acts as the focal point for the WIPO-initiated Technology and Innovation Support Centres (TISCs) which are distributed all over the country to provide innovators with free access to patent documentations. Nevertheless, it experiences challenges in inadequate resources for creation of awareness and promotion of research and innovation, capacity to regulate R&D in the entire country among other things. Other impediments to its work include lack of a national IP Policy, lack of resources and incentives to promote innovation and TISCs, and lack of a national database on research and innovation.

### **Small Industries Development Organisation (SIDO)**

SIDO was established in October 1973 as a parastatal organisation. Its objective is to develop the small industry sector in Tanzania. It formulates policy and support to small scale industries.

The main challenges faced by SIDO relate to inadequate funding, training technical manpower, lack of awareness of its role especially by music industry, unwillingness to cooperate at inter-agency levels and low number of innovations from universities and research institutions.

### **Confederation of Tanzania Industries (CTI)**

The CTI is an independent, self-financed, legally constituted Business Membership Organization. As an advocacy and lobby group, the CTI ensures that there is a conducive legal, financial and economic environment within which industry can operate effectively, prosper and contribute to national wealth and development. It conducts need-based studies on various topics, including the state of counterfeits in Tanzania, and comes up with relevant draft policy frameworks for the government to adopt.

However, CTI is faced with some challenges including lack of capacity in its anti-counterfeit department which is under staffed with only 6 members with neither office nor budget, lack of a comprehensive law to curb counterfeiting and limited inter-agency collaboration on fighting against illicit trade. Other challenges include consumer perceptions and low purchasing power.

As such, recommendations to enhance its role include the raising of awareness amongst the public, development of an institutional framework on IPRs, and the conclusion of an MOU amongst anti-counterfeit agencies in each partner state to enable combating of counterfeit goods across EAC. There is also a need to enhance awareness at regional level through EAC and as such, manufacturers could spend more money to educate the public on counterfeits and original products. The government should also collaborate with consumer bodies to enhance consumer awareness on counterfeit products.

### **Tanzania Chamber of Commerce, Industry and Agriculture (TCCIA)**

Like the TCI, the TCCIA is a member driven organization whose functions include collecting suggestions and information from members for consideration or action by the national IP Offices. Some of the other functions of TCCIA are to serve and support business community, create a legislative climate in which businesses can profit and increase employment, broaden the tax base, and identify public issues. Its main challenge is the low level of membership relative to the business community in Tanzania attributed mainly to lack of awareness.

## 2.4 ENFORCEMENT OF IP AND ANTI-COUNTERFEIT ACTIVITIES

On mainland Tanzania, courts play the primary role in resolving disputes regarding IPRs. The law enforcement agencies contribute to the protection of IPRs through investigations, arrests, seizure and detention of goods and material suspected to be in violation of the laws governing IPRs. The TRA also contributes to this protection by detaining goods that are suspected to be counterfeited from importation into and export from Tanzania.

The IP laws referred to above provide for aggrieved parties to seek various civil remedies against infringers. These include injunctions, damages and account of profits in appropriate cases. The Acts also provide for orders seizure and delivery of the offending items. Criminal penalties are also available in a number of instances.

## 2.5 STAKEHOLDER OBSERVATIONS

During the study, the views of various stakeholders regarding the status, management and enforcement of IPRs in Tanzania were sought and collated. The following are some of the opinions expressed:

- There is a general lack of public awareness on the importance of abiding by IP laws. The concept of IP is still new and people see nothing wrong in copying. There is a tendency to place ownership on physical property and not on the IP. For instance, if one buys a tape, he regards the tape as his property and therefore feels free to make as many copies as possible out of it;
- The Government needs to strengthen its law administering and enforcing machinery to protect works from piracy;
- There are inadequacies inherent within the legal system in connection with IPRs matters, and part of the business community is openly involved in doing business in pirated intellectual goods.
- The public at large is ill-informed of the laws governing their rights to IP. Although people are involved in the creation of works of art, such as literary works, folklore and other cultural productions and events, in most cases these are done without awareness of laws protecting the rights on such creations;
- Tanzania is a signatory to the TRIPS Agreement but has not taken full advantage of its flexibilities in promoting innovation through IP regimes.
- National laws need to be amended in line with regional legislation;
- The country has a limited infrastructural and expertise base in BRELA;
- There is lack of effective IP protection in Tanzania which calls for significant improvement, adaptation and enlargement of legal, administrative and enforcement framework as well as human capacity;
- The costs associated with the implementation of the TRIPS Agreement are enormous. The relevant departments do not have fully functioning facilities. Although the legal framework and the necessary institutional framework for IPR administration has now been established, other IP implementing agencies such as the police department, the customs office and the

judiciary need adequate preparation in order to be able to curb infringement of IPRs; and

- Extensive training is required to increase awareness of IP laws in educational institutions at the tertiary level.

## **2.6 ZANZIBAR: IP LEGISLATIVE FRAMEWORK**

### **2.6.1 Introduction**

As earlier mentioned, Zanzibar has its own IP legislative framework, separate from that existing on the mainland due to the fact that IP is not a union matter. However, Zanzibar is unable to accede to any international or regional treaty on IP since foreign affairs, and the ability to sign or ratify treaties, is a union matter falling under the government of the United Republic. Zanzibar is therefore not a party to any regional or international IP treaty, nor is it a member of the EAC, ARIPO, WIPO or the WTO. This poses serious difficulties for the harmonisation of IP laws.

### **2.6.2 Zanzibar Industrial Property Act, 2008**

Unlike on mainland Tanzania, in Zanzibar, all matters regarding the registration and protection of industrial property are contained in one statute, the Zanzibar Industrial Property Act, 2008 (Act No. 4 of 2008). This Act covers patents, utility model certificates, industrial designs, layout designs (topographies) of integrated circuits, trade and service marks, geographical indications and unfair competition.

### **2.6.3 Zanzibar Copyright Act, 2003**

This Act provides for the protection of copyright and related rights (Neighbouring Rights) in Zanzibar. It provides for authors to enjoy both economic and moral rights in their works and also protects expressions of folklore from utilization in the absence of authorization from the competent authority.

### **2.6.4 Plant Breeders' Rights Act, 2014**

This Act provides for the grant and protection of plant breeders' rights. Section 3 of the Act provides for the establishment within the Ministry responsible for agriculture of an Office to be known as the Plant Breeders' Rights Office and section 4 provides for the appointment of a person or an officer who has relevant qualification and experience to perform the functions conferred to or imposed on the Registrar of Plant Breeders' Rights under the Act.

## **2.7 IP INSTITUTIONAL FRAMEWORK IN ZANZIBAR**

### **2.7.1 Zanzibar Business and Property Registration Agency (BPRA)**

The administration of IP in Zanzibar is carried out by the Zanzibar Business and Property Registration Agency (BPRA) which governs the administration of IP office as a body under the Ministry of Trade, Industry and Marketing. As such, BPRA is responsible for the administration of all business entities registration including IP issues. The total number of staff within BPRA is about 39, four of whom are dedicated to IP matters. The main activity of the Division is to administer the new Industrial Property Act and register IP works in Zanzibar

### **2.7.2 Copyright Society of Zanzibar (COSOZA)**

COSOZA, which falls under the Attorney General's Chamber of Zanzibar, is established under Zanzibar Copyright Act. It administers and enforces all matters relating to copyright in Zanzibar. It faces a number of challenges in its operations including an insufficient number of staff, lack of training to the enforcement officers and agents, shortage of financial resources and a lack of Awareness on IP.

## **2.8 ENFORCEMENT OF IP AND ANTI-COUNTERFEIT ACTIVITIES IN ZANZIBAR**

The Zanzibar Copyright Act, 2003 provides for sanctions under the enforcement of copyright in the nature of civil remedies and indicates that any person whose rights under the Act, are in imminent danger of being infringed or have been infringed, may institute proceeding before the Court for injunctions, damages, profits and exemplary damages.

## **2.9 CONCLUSION AND RECOMMENDATIONS**

The Tanzanian IP legislative and institutional framework is twofold given the two different legal systems for the mainland and island. This legislative framework is reviewed from time to time to suit the national social and economic development. There are slight differences in IP legislation as well as institutional arrangements for Zanzibar and Tanzania Mainland. The IP regime provides for regional patent and trade mark registration under ARIPO. However, the IP Offices namely, BRELA and BPRA are still part of the mainstream Ministry of Industry & Trade. Since they lack autonomy, there are challenges associated with speedy execution of both administration as well as enforcement of IP in the country. COSOTA and COSOZA act as both government offices and CMOs. The registrar of plant breeders' rights does not have an independent office. There is no stand-alone Anti-counterfeit Act or agency to coordinate other agencies in fighting against IP infringement. In addition, there are challenges of enforcing IPRs in the country due to inadequate capacity and resources to curb infringement activities in the country.

In light of these challenges, it is recommended that Tanzania consider measures that would harmonize the legislative framework for both Tanzania Mainland and Zanzibar in line with WIPO minimum benchmarking standards. The country needs to enhance measures to raise IP awareness and to increase its capacity in management and enforcement of IP in the country. Both mainland Tanzania and Zanzibar should also facilitate inter-agency collaboration in fighting against illicit trade and especially counterfeiting activities.

### 3 CHAPTER THREE: KENYA

#### 3.1 INTRODUCTION

Kenya is the only non-least developed country among the EAC Partner States. It has a robust IP system that is consistent with the WTO-TRIPS Agreement as well as the main WIPO administered Treaties. It has the most complex IP enforcement regime in the EAC. Its IP legislative framework is governed by a number of laws.

At the international level, Kenya is a member of WIPO, having signed the Convention Establishing the World Intellectual Property Organization (October 5, 1971). It is a party to the Paris Convention for the Protection of Industrial Property (June 14, 1965), Convention for the Protection of Producers of Phonograms Against Unauthorized Duplication of Their Phonograms (April 21, 1976), Brussels Convention Relating to the Distribution of Programme-Carrying Signals Transmitted by Satellite (August 25, 1979), Nairobi Treaty on the Protection of the Olympic Symbol (September 25, 1982), Berne Convention for the Protection of Literary and Artistic Works (June 11, 1993), Patent Cooperation Treaty (June 8, 1994), Madrid Agreement Concerning the International Registration of Marks (June 26, 1998), and the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (June 26, 1998).

As a member of the WTO, Kenya is also bound by the provisions of the WTO-TRIPS Agreement.

Regionally, Kenya is a Member of ARIPO and as such is a party to the Harare Protocol on Patents and Industrial Designs.

#### 3.2 LEGISLATIVE FRAMEWORK

##### 3.2.1 The Constitution

The Constitution of Kenya 2010 is the highest law of the land. Unlike the previous Constitution, the 2010 Constitution recognizes IPRs and makes provision for them under several Articles. Article 11 on Culture provides, among other things that the State shall “promote the intellectual property rights of the people of Kenya” and enact legislation “to ensure that communities receive compensation or royalties for the use of their cultures and cultural heritage.” Article 40 provides for protection of rights to property including intellectual property while article 69 provides, inter alia, that (c) The state shall protect and enhance intellectual property in, and indigenous knowledge of, biodiversity and the genetic resources of the communities; (e) Protect genetic resources and biological diversity.

##### 3.2.2 Industrial Property Act, 2001

This Act, and its implementing Regulations, provides for the grant and administration of patents, utility models and industrial designs. Its objectives include the promotion of inventive and innovative activities, and the facilitation of the acquisition of technology through the grant and regulation of patents, utility models, technovations and industrial designs. It provides for the establishment of the Kenya Industrial Property Institute and Industrial Property Tribunal. Under patents, the Act defines invention as a new and useful art that has an inventive step. It provides for substantive examination of patent applications and registration system for utility models.



It also provides for criminal and civil enforcement, contractual licenses, term of protection of a patent, a registered utility model or industrial design as 20, 10 and 15 years respectively. The Act provides for change of ownership, compulsory licenses, parallel imports and third party or Government use.

The Act complies with the provisions of the Harare Protocol on Patents and Industrial Designs of the African Regional Intellectual Property Organisation (ARIPO). At international level, the Act has provisions for complying with a set of certain relevant Conventions and Treaties.

With reference to enforcement, the Act has put in place relevant provisions for both criminal and civil enforcement measures.

### **3.2.3 Trade Marks Act, Cap 506**

This Act, and its implementing Rules, provides for the protection of trade and service marks in Kenya. The Act sets out the requirements for registration of a trade mark, examination of the application and publication of a trade mark application in the Kenya Gazette or the Industrial Property Journal. It has provisions on opposition proceedings, registration of a mark for an initial period of ten years which may subsequently be renewed after every ten years, licensing of marks, assignment of marks, maintenance of the Register of Marks in terms of among others, change of name or address; and expungement proceedings.

It provides gazettment of the Registrar of Trade Marks for purposes of the Trade Mark Act. The Act has elaborate provisions against the infringement of trademark rights. The Trade Mark (International Registration) Rules, 2003 provide for procedure under the Madrid System for registration of international marks.

On enforcement, the Act makes it a criminal offence to sell or import goods with a forged registered trade mark. The Act provides that the High Court hears and determines infringement proceedings. On appeals, any person aggrieved by the decision of the Registrar of Trade Marks may appeal to the High Court of Kenya.

With regard to geographical indications, though the Trade Marks Act does not specifically mention them, GIs can be protected as collective marks. However, a substantive Geographical Indications Bill is still pending in Parliament.

### **3.2.4 The Copyright Act, 2001**

This Act makes provision for copyright in literary, musical and artistic works, audio-visual works, sound recordings, and broadcasts. It establishes the Kenya Copyright Board (KECOBO) as the body charged with the duty of administering the Act and carrying out the functions specified therein, including among other things, the licensing of Collective Management Organisations (CMOs) and supplying authentication devices in the form of tamper proof stickers to identify genuine products.

The Act outlaws certain activities that have the effect of promoting counterfeiting of copyrighted materials. For instance, under the Act it is a civil wrong to import pirated copies of works. It is also illegal to circumvent technological devices used to protect copyright rights, remove or alter electronic rights management systems and to distribute, import and broadcast copyright works without the



consent of the owner. The remedies provided for under the Act include damages, injunction, and delivery up. The Act also provides for Anton Pillar orders to secure evidence before it is hidden or destroyed by the accused party.

### **3.2.5 Anti-Counterfeit Act, 2008**

This Act prohibits trade in counterfeit goods and is aimed at consolidating efforts and promoting inter-agency cooperation to fight the trade in counterfeit goods. The Act defines the meaning of counterfeiting and counterfeit goods and establishes the process to be followed by a complainant in the event that they wish to lodge a complaint against allegedly infringing goods. Among the measures provided for in the Act include the seizure of goods and the laying of criminal charges against individuals found guilty of dealing in the counterfeit goods. The Anti-Counterfeit Act establishes the Anti-Counterfeit Agency with the mandate to administer anti-counterfeiting policy and law in Kenya. The Act is viewed in EAC as giving law enforcement agencies “teeth to bite” in the fight against the proliferation of counterfeit products in Kenya.

### **3.2.6 The Seeds and Plant Varieties Act, Cap 326**

The Seeds and Plant Varieties Act provides for the enforcement of Plant Variety Protection in Kenya. The Act initially came into force in 1975 but this has been amended up to 2012 to be in compliant with WTO-TRIPs Agreement and UPOV 1991<sup>15</sup>. The Act is administered by the Kenya Plant Health Inspectorate Services (KEPHIS). The law has provision to regulate trade in seeds, including provision for the testing and certification of seeds; provide guidelines for the establishment of an index of names of plant varieties and to empower the imposition of restriction on the introduction of new varieties and control the importation of seeds; provide for the grant of proprietary rights to persons breeding or discovering new varieties<sup>16</sup>. The Act also grants plant breeders in plant variety exclusive rights to produce reproductive material of the variety for commercial purposes for a period of 20 years and 25 years in case of trees. Any infringement thereof is actionable and the owner of the right who is entitled damages, injunction, and account for profits. It also is an offence under the Act to make false representation or give false information regarding the exercise of plant breeders’ rights.

### **3.2.7 Protection of Traditional Knowledge and Cultural Expressions Act, 2016**

This Act provides a framework for the protection and promotion of traditional knowledge and cultural expressions in Kenya. It seeks to protect Kenya’s communities’ cultural heritage. It bestows upon the County governments a devolved role and responsibility of ensuring registration of works as well as receiving, documentation and storage of works from communities within their counties.

### **3.2.8 Other IP and Illicit Trade Related Laws**

#### **The Standards Act, Cap 496**

The Act provides for supportive legislative framework in regulating and standardization of quality of goods and services in Kenya save for drug and poison.

<sup>15</sup> <http://www.kephis.org/>

<sup>16</sup> Seeds and Plant Varieties Act Cap 326

## **Pharmacy and Poisons Act, Cap 244**

The Act regulates pharmaceutical drugs and poisons in Kenya. It provides supportive administrative services on compulsory licensing and access to essential drugs in Kenya.

## **Customs and Excise Duty Act, Cap 472**

The Act supports IP legislative framework on enforcement at the borders. It spells out border measures to undertaken during entry of goods into the country.

### **3.3 INSTITUTIONAL FRAMEWORK**

There are four main IP Offices in Kenya. However, there are many more other supporting institutions in promotion and enforcement of IP in the country.

#### **3.3.1 Kenya Industrial Property Institute (KIPI)**

The Act provides for establishment of an Industrial Property Tribunal and an Institute as a body corporate whose mandate includes: applications for and registration of industrial designs, applications for and registration of utility models, applications for and grant of patents, publication of applications and granted patents as well as registered utility models and industrial designs in the Kenya Gazette or the Industrial Property Journal.

Kenya Industrial Property Institute (KIPI) is a government parastatal under the Ministry of Trade and Industrial Development. The Institute was established on 2nd May 2002 upon the coming into force of the Industrial Property Act 2001. Previously, the Institute existed as Kenya Industrial Property Office (KIPO), which was established in February 1990 after enactment of the Industrial Property Act, CAP 509 of the Laws of Kenya.

The Institute administers two Acts of Parliament namely, the Industrial Property Act, 2001, and the Trade Marks Act, Cap 506.

Its mandate includes receiving and processing applications for and registration of industrial designs, utility models, grant of patents, promotion of innovative and inventiveness in Kenya, provision of industrial property information to the public for technological and economic development, and screen technology transfer agreements and licenses. KIPI has about 15 patent examiners, 37 trademark personnel and more than 15 support staff. It is the only national patent office within Africa South of Sahara that carries out substantive examination on patent applications to determine novelty and inventive before grant of a patent. Today, it has received about 2,500 patent applications filed directly by applicants and about 100,000 trademark applications.

According to the Managing Director, KIPI's role in awareness creation is factored in the promoting inventiveness and awareness function of the institute. The institute does not have enough resources for a national outreach. As such, it liaises with other organisations such as the National Commission for Science, Technology and Innovation (NACOSTI) for support in creation of awareness and promotion of innovation value addition in the industry. The Commission also bridges the gap between innovation and protection of IPRs. Although Article 43 of the Common Market Protocol

provides for corporation among member states in protection of IP rights, the IP organisations under the protocol have no implementing powers<sup>17</sup>. There is no organisation to interlink the science and technology institutions within the EAC and the implementing institutes e.g. KIPi. WTO-TRIPS Agreement refers to compliance of the international regulations among member states and does not talk about regional level IPRs enforcement. In addition, there is no equivalent body to bring EAC organisations to discuss Article 43 of the Common Market Protocol on corporation among member states. Lack of policy and resources to sensitize member states' citizens on role of IPRs in curbing illicit trade. There are no clear provisions in laws to limit free movement of goods that infringe on IP and there is no regional corporation on IPRs.

The best thing to do is develop a multilateral framework for trade regulations at the national level, redrafted to broaden definition of the term 'citizen' to include EAC citizenship rather than individual member citizenship and transfer the provisions of IP from Kenya National Innovation Agency (KENIA) to the implementing agencies within the EAC. Come up with a sector sui generis relevant to the member states in organisations that deal with IPRs. It may not be possible to harmonise the laws because of different cultures within the EAC, the alternative would be through standardisation, by meeting the minimum international standards on IPRs. It would be easy to approximate IP laws in the EAC to each other to avoid conflict.

### 3.3.2 Kenya Copyright Board (KECOBO)

KECOBO was established in 2001 under the Copyright Act. Its main functions are to direct, coordinate and oversee the implementation of the laws and international treaties and conventions to which Kenya is a party to and which relate to copyright and other rights recognized by the Act and ensure the observance thereof, license and supervise the activities of Collective Management Organizations as provided for under the Act. It is also required to devise and implement training programs on copyright and related rights, enlighten and inform the public on matters relating to copyright and related rights, maintain an effective databank on authors and their works; administer all matters of copyright and related rights in Kenya as provided for under this Act; and deal with ancillary matters connected with its functions under the Act.

The Board has copyright Inspectors seconded from the Kenya Police, who have powers to enter premises, ship or aircraft to ascertain whether any infringement of the law is being committed therein. Police officers and officers of the board also have powers of arrest under the Act. Prosecution of cases filed in respect to crimes committed in contravention of the Act is governed by the Criminal Procedure Code, and may be conducted by a public prosecutor or the Board.

The other strength of the Board is that it is comprised of members drawn from both the public and private sectors. The members from the private sector are nominated by associations representing software, producers of sound recordings, publishers, film distributors, performers, broadcasting stations, musicians and the audio-visual industry. There are four experts on copyright and related rights and five members who represent various arms of the government.

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<sup>17</sup> Sange S, MD, KIPi, 2017

KECOBO is mandated to enforce copyright and related rights in Kenya. The Board currently has a legal and enforcement department that has 5 prosecutors and 10 copyright inspectors. The prosecutors are lawyers who are highly specialized in copyright and related rights. The inspectors are attached from the National Police Service and trained in investigation of copyright and related rights. Enforcement also includes training and awareness creation in collaboration with various government agencies such as the National Police Service, the Department of Weights and Measures, the Judiciary, the Anti-Counterfeit Agency as well as the rights holders. The Kenya Copyright Board registers copyright works of musical, audio visual, literary and artistic nature. KECOBO has an Anti-Piracy Security Device (APSD) as a tamper proof sticker that is applied on legitimate audio and audio-visual works (films, CDS, DVDS and VCDs).

### **3.3.3 Kenya Plant Health Inspectorate Services (KEPHIS)**

KEPHIS is a State Corporation established in October 1996. The Corporation's activities and services involve offering inspectorate services on all matters related to plant health and quality control of agricultural inputs and produce. The activities include certification of the quality of seeds and fertilizers, testing and monitoring the presence of harmful residual agro-chemicals on agricultural produce, soils and water systems, co-ordination of the release of superior and well-adapted varieties/cultivars to the farming community, protecting the rights of the breeders/discoverers of new plant varieties through grant of rights to the owners of such varieties and registering them and preventing introduction into the country of harmful foreign weeds, pests and diseases through adherence to strict quarantine regulations and procedures.

KEPHIS collaborates with KIPi in raising awareness of IPRs. In 2013, KEPHIS participated in the Traditional Knowledge bill and the creation of the National IP policy. KEPHIS also mediates disputes with two cases of mediation having been undertaken so far. In case of any infringements, KEPHIS can be called in as a witness. It also does enforcement where fraudsters use fake seeds during the planting season.

The challenge faced by KEPHIS is in relation to the overlapping mandates of intra state agencies e.g. ACA has prosecution powers while KEPHIS don't. They depend or use the ACA prosecutors when they have a matter on fake seeds. There is a general lack of resources for enforcement agencies. It is important to enhance inter-agency collaboration on awareness creation and allocation of more resources in enforcement by the government<sup>18</sup>.

### **3.3.4 Anti-Counterfeit Agency (ACA)**

The ACA was established under the Anti-Counterfeit Act, 2008 as a State Corporation with the mandate to enlighten and inform the public on matters relating to counterfeiting, combat counterfeiting, trade and other dealings in counterfeit goods, devise and promote training programs to combat counterfeiting and co-ordinate with national, regional or international organizations involved in combating counterfeiting. The principal aim of the Act is to prohibit trade in counterfeit goods. The Agency has three main functions. It enforces the provisions of the Anti-Counterfeit Act, 2008; enlightens and informs the public on counterfeiting issues and combats counterfeiting in Kenya.

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<sup>18</sup> MD, KEPHIS

The Act mandates the Agency to incorporate the following Acts in carrying out their duties: Weights and Measures Laws or Cap 513, Pharmacy & Poisons Act Cap 244 revised 2002, East African Community Customs Management Act 2004 and Standards Act. ACA carries out consumer awareness and sensitization programs, indirect consumer protection as a result of reduction in counterfeit goods, enforcement of intellectual property rights in Kenya and promote fair trade practices.

However, ACA faces some challenges including the increased volume of counterfeit goods being traded, number of counterfeit-related court cases and complaints, lack of stakeholders' goodwill to the Agency's plans and activities, inadequate funding by the Government, lack of collaboration and linkages with stakeholders and development partners, inability to respond quickly to shifting market dynamics, lack of cooperation from some government agencies due limited resources, lack of public awareness, inadequate skilled manpower on matters relating to counterfeiting and inadequate relevant data on counterfeiting.

### **3.3.5 IP Supporting Institutional Framework**

#### **Kenya Revenue Authority (KRA)**

The Customs Services Department (previously known as Customs and Excise Department) of the Kenya Revenue Authority was established by an Act of Parliament in 1978. It is the largest of the four revenue departments in terms of manpower, revenue collection and countrywide operational network. The primary function of the Department is to collect and account for import duty and VAT on imports. Apart from its fiscal responsibilities, the Customs Services Department is responsible for facilitation of legitimate trade; border measures, protection of society from illegal entry and exit of prohibited goods<sup>19</sup>. The Department is headed by the Commissioner of Customs Services Department deputized by the Senior Deputy Commissioner.

#### **Weights & Measures Department**

The Weights and Measures (W&M) Department administers the Weights and Measures Act, Cap.513, Laws of Kenya and the Trade Descriptions Act, Cap.505, Laws of Kenya as vital instruments for the scientific, technical and industrial development of the country. Currently, the Department's services are available throughout the country through twenty-one Zonal Offices at Nairobi, Mombasa, Malindi, Wundanyi, Nyeri, Thika, Meru, Embu, Machakos, Mwingi, Nakuru, Garissa, Eldoret, Kitale, Kericho, Kakamega, Bungoma, Busia, Kisii, HomaBay and Kisumu. The Department is a vital agency in curbing illicit trade, consumer protection as well as promoting scientific, technical and industrial development of a country. Its core functions are: establishment of a uniform system, of measurement in trade, control of weighing and measuring equipment in use for trade, control of the sale of goods, and protecting the consumer against cheating through the use of falsehood in the sale of goods and in the provision of services in the course of trade.

However, as a department of a ministry W& M is constrained with limited budgetary provisions, lack of adequate staff and resources to effectively assist in curbing illicit trade in counterfeit products.

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<sup>19</sup> <http://www.kra.go.ke/customs/faqcustoms2.html>



## **Pharmacy and Poisons Board**

The Pharmacy and Poisons Board is the Drug Regulatory Authority established under the Pharmacy and Poisons Act. The Board regulates the practice of pharmacy and the manufacture and trade in drugs and poisons. The Board implements the appropriate regulatory measures to achieve the highest standards of safety, efficacy and quality for all drugs, chemical substances and medical devices, locally manufactured, imported, exported, distributed, sold, or used, to ensure the protection of the consumer as envisaged by the laws regulating drugs in force in Kenya.

## **Collective Management Organisations (CMOs)**

These are private organisations that are licensed by KECOBO under the Copyright Act, 2001 to collectively administer the rights of their members such as music composers, performers, authors, artists, book publishers among others. They are registered as companies limited by guarantee mandated to manage the copyright economic rights that cannot be administered by individuals. Currently, there are four such CMOs in Kenya: the Reproduction Rights Society of Kenya (KOPIKEN), Kenya Association of Music Producers (KAMP), the Performers Rights Society of Kenya (PRiSK) and the Music Producers Association of Kenya (MPAKE).

KOPIKEN is licensed as a collecting society that licenses the reproduction of copyright protected literary materials against payment of fees whenever it is impractical for rights holders (authors and publishers) to license and collect fees individually. PRiSK is a collective management organisation licensed by KECOBO to represent performers in musical and dramatic works. KAMP is licensed to collect and distribute royalties to producers of sound recordings.

However, the presence of several CMOs is a challenge with regard to enforcement as compared to other East African countries like Rwanda and Tanzania where there is only one entity that is government regulated and thus increasing effectiveness in enforcement. One entity that has the backing of government machinery ensures effective protection of rights of copyright holders. It is recommended to establish one office, based in a central place like Arusha that has representation from the East African countries. This will ensure that all East Africa music and works of arts will be treated as local and enjoy protection throughout the East Africa region.

## **The Competition Authority of Kenya (CAK)**

The CAK, created by the Competition Act, regulates anti-competitive business practices and advocates for fair markets that deliver superior value to customers, producers and investors. CAK has investigative functions, adjudicative and advocacy with a view to promoting a healthy competition culture. Its main role is to receive complaints pertaining to suspected breaches of the prohibitions of restrictive agreements; undertake investigations; authorize the gathering of information required for assessment of cases; conduct hearings; publish decisions on cases; determine what penalty or remedy is appropriate; monitor compliance with a penalty or remedy; publish, promote and advertise the provisions of the Act and the activities of the commission. CAK advocates for competition;

undertake general studies on the effectiveness of competition in individual sectors of the economy; collect information for the performance of the commission's functions and perform other functions imposed by legislation<sup>20</sup>.

It protects the consumer by regulating market conduct, both unilateral and concerted aimed at ensuring that the prices are determined by forces of supply and demand, dominant firms do not abuse their positions for example by barring new entrants, pricing unfairly and refusing to deal, competitors do not share markets/territories, and prohibits misleading/deceptive advertising and unconscionable conduct and ensures that consumers are compensated in regard to detriment, economic or physical, occasioned by condition of goods.

### 3.4 ENFORCEMENT OF IP AND ANTI-COUNTERFEIT ACTIVITIES

With regard to the enforcement of IP rights, a number of different avenues exist under Kenyan law. These include five specialized IP forums established under specific laws to deal with disputes that arise in the course of the regulation and administration of the different types of IP. These forums include the Managing Director of KIPi who is mandated to deal with a wide range of disputes including hearing of oppositions against registration of industrial designs, the Registrar of Trademarks who mainly deals with preliminary disputes involving trade marks, the Industrial Property Tribunal which a number of disputes arising under the Industrial Property Act, the Seeds and Plant Varieties Tribunal which deals with disputes involving Plant Breeders Rights and the Competent Authority which deals with disputes involving copyright and collective management societies.

The composition and jurisdictional scope of these tribunals are determined by the respective Acts of Parliament that establish them. Appeals from decisions of these bodies can be made to the High Court of Kenya.

### 3.5 CONCLUSION AND RECOMMENDATIONS

The Kenyan IP legislative and institutional framework is relatively well developed. The country has IP laws that are broadly consistent with the Paris Convention, the Madrid Agreement and Protocol, the Berne Convention and UPOV among others.

The national IP institutional framework comprises an autonomous regime as set out in the WIPO minimum benchmarking requirements. It has autonomous offices for patents and trademarks, copyright and plant breeders' rights. The Anti-counterfeit Agency is vibrant and coordinates with other agencies in fighting against IP infringement. However, there are challenges of enforcing IPRs in Kenya due to inadequate capacity and resources to curb infringement activities in the country.

It is therefore recommended that Kenya strengthens its capacity in management and enforcement of IP. There is also need to enhance awareness and establish proper mechanisms for inter-agency collaborations in fighting against illicit trade and especially counterfeiting activities.

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<sup>20</sup> <http://www.industrialization.go.ke/index.php/state-corporations/89-anti-counterfeiting-ag>





## 4 CHAPTER FOUR: RWANDA

### 4.1 INTRODUCTION

Rwanda is a member of a number of multilateral institutions and party to a number of international agreements and treaties that have influenced the shape of its IP legal framework. The WIPO-Administered Treaties to which Rwanda is a party include the Paris Convention for the Protection of Industrial Property (June 14, 1965), the Madrid Agreement Concerning the International Registration of Marks (June 26, 1998), the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (June 26, 1998), the Patent Cooperation Treaty (June 8, 1994), the Berne Convention for the Protection of Literary and Artistic Works (June 11, 1993). As a member of the WTO, Rwanda is bound by the provisions of the TRIPS Agreement, although being a least-developed country, some of the IP provisions are not yet applicable to it.

At the regional level, Rwanda is a member of ARIPO and a party to the Harare Protocol on Patents and Industrial Designs.

Rwanda's IP rights have been classified as industrial property rights and copy rights. Industrial property rights include, but are not limited to, protection from unfair competition, trademarks, utility models, patents and industrial designs. They are governed by several policies and legislative frameworks. This regime constitutes of both international conventions and domestic laws that have provided a rigorous legal arena to which these rights are provided for and protected.

### 4.2 IP LEGISLATIVE FRAMEWORK

#### 4.2.1 Law No. 31/2009 of 26/10/2009 on Protection of Intellectual Property Rights

This is the main IP law in Rwanda. It provides substantive legislation on all the types of IPRs, unlike in Kenya and Tanzania where the laws are found in different statutes, with the key objective being to address the issues of the promotion of innovation and transfer of technology. This Act has unified laws relating to IP in Rwanda which were piecemeal legislation that had been in force since the colonial times.

The legislation defines “intellectual property” as meaning, the rights relating to literary, artistic and scientific works, the rights of performances of performing artists, rights relating to phonograms, wireless broadcasting, inventions in all fields of human endeavour, to scientific discoveries, industrial designs and models, trademarks and service marks, commercial names and designations, protection against unfair competition; and any other rights resulting from intellectual activity in the industrial, scientific, literary or artistic fields.

The legislation provides for patents, copyright, industrial designs, trademarks, unfair competition and related IP legislative framework.

It establishes IP Office under the Rwanda Development Board (RDB). Its objective is to contribute to the promotion of technological innovation and to the transfer and dissemination of technology to the mutual advantage of producers and users of technological knowledge and in a manner conducive to social and economic welfare of population with regards to the balance of rights and obligations.

Further, it seeks to create a fair and equitable commercial environment by the reduction and the prevention of distortions and impediments to free trade and to set up principles, rules and disciplines dealing with trade in counterfeit goods.

This legislation aims to foster industrial and commercial development by promoting innovations and inventions and increase the contributions to Rwanda's cultural, socio-economic development by encouraging the creation of original works in scientific fields and literary arts. The Law has covered an extensive scope which covers industrial property rights, copyrights and related rights as set out in detail in chapter one of the legislation.

#### **4.2.2 Law No. 005 of 2016 on Seeds and Plant Varieties in Rwanda**

This law governs the protection of seeds and plant varieties in Rwanda. It repealed Law No. 14/2003 of 23 May 2003 that provided limited provisions to governing the production, quality control and commercialization of seeds. It provided inadequate provisions as it did not make provisions for intellectual property protection for seed and plant varieties and plant breeder's rights. There is a transition period before the act comes into effect as stakeholders have a grace period of 12 months to comply with the requirements set out in terms of the Law Governing Seeds and Plant Varieties in Rwanda.

Furthermore this Act has empowered the registrar to approve or reject the protection of a plant variety, to withdraw the plant breeder's right certificate, to nullify the plant breeder's right and to remove from the register, a protected plant variety. Interested person can access to the plant breeder's rights register with permission from the Registrar upon application and payment of the prescribed fees.

#### **4.2.3 IP SUPPORTING LEGISLATIVE FRAMEWORK**

##### **Law No. 21/2006 of April 28 2006 on the Customs System**

This law specifically prohibits counterfeit goods under Article 102(5). It spells out IP enforcement border measures as a support service to mainstream IP legislations.

The Rwanda Inspectorate and Competition Authority (RICA) Act

The Act creates the National Standards Inspectorate, Competition and Consumer Protection Authority abbreviated as "NICA which provides for consumer protection and enforcement of consumer protection issues. RICA deals with economic competition of two or more different and rival enterprises engaged, on the same market, in identical or similar commercial activities, and general organised examination or evaluation of a commodity or service characteristics to determine conformity to specified standards or regulatory requirements.

#### **4.3 IP INSTITUTIONAL FRAMEWORK**

Article 10 of the Intellectual Property Act vests the administration of IP in three organs, the Ministry in charge of industry, the Ministry in charge of copyrights and cultural matters and the IP organ which is the Rwanda Development Board (RDB). The Ministry in charge of industry's responsibilities

includes setting up a policy that governs the promotion of IPRs, to enact orders that govern the application of IP law and supervise the organ in charge of the IP.

#### **4.3.1 Rwanda Development Board (RDB)**

The National IP Office is a Department of RDB. The IP Office function is managed by a department within the RDB that has powers set out under the IP Act that include granting rights, creation of awareness, capacity building, mediation and arbitration. The national IP office is headed by a Registrar General and this department is in charge of registering intellectual property rights, immoveable and moveable property as well as business registration. The national IP office is a further division in this department and operates as a separate unit within the department.

The functions of the RDB, as the empowered IP organ under the Act, include granting authentic industrial property titles, carrying out all tasks provided by the Law including the registration of applications for titles of IP, publishing, calculating and extending their deadlines and duration, and managing all related matters, guaranteeing the free and honest exercise of industrial and commercial activities through the prevention and elimination of acts of unfair competition in relation to industrial property, assuring equitable remuneration and a just distribution of dividends arising from use of works.

The national IP office does not have capacity to conduct formal and substantive examination of patents this is still done through ARIPO. The national IP office has an IP Tribunal mandated to arbitrate and mediate on IPR disputes, therefore, performing a dispute resolution function. Enforcement in counterfeiting is performed by the Revenue Authority and Police force. There is no independent agency that oversees anti-counterfeit matters.

#### **4.3.2 The Ministry of Sports and Culture**

The Ministry of Sports and Culture (MINISPOC) is the ministry in charge of policy making, capacity building and research when it comes to sports and culture. As such, copyrights are administered under MINISPOC whose main mandate is the protection of copyright, providing and promoting services to artists and performers. This ministry also advances the protection of the national culture and heritage as well as effecting decrees prescribed by the law (MINISPOC, 2016).

#### **4.3.3 Rwanda Society of Authors**

The Rwanda Society of Authors (RSA) is currently the collective management organization that deals with management of collective rights in copyright laws. It is a CMO and manages copyright matters on behalf of its members. RSA has a Board comprised of representatives from the oversight agency. The RSA has only 3 staff members.

#### **4.3.4 Plant Breeders' Rights Unit**

There is a desk for administration of registration of new plant varieties in the Ministry of Agriculture.

#### **4.3.5 Rwanda Bureau of Standards (RBS)**

The RBS regulates and manages standards and therefore is the regulator as well as the enforcer for sub-standard goods.

### **4.4 ENFORCEMENT OF IP AND ANTI-COUNTERFEIT ACTIVITIES**

Enforcement of IPRs is covered under the IP laws, customs laws and police enforcement. Thus, one can apply to the High Court (commercial division) for preservatory orders and other enforcement orders. In relation to enforcement, Rwanda relies on the courts especially in the High Court Commercial division that entertains the IP matters. Criminal sanctions are also available with police having powers to enforce by seizure and prosecution.

Rwanda has additional enforcement mechanisms which are lacking in other partner state's laws. For example, IP infringement is deemed to be an act of unfair trade practices under the IP Act. As such, acts infringing on trademarks, unauthorized use of technical knowhow and misuse of secret information are all unfair trade practices that can be referred to competition tribunal. This therefore means that IPR infringement can be pursued through the IP Act, Competition Tribunal as well as criminal sanctions.

The remedies available to aggrieved persons include, but are not limited to, the cessation of release of counterfeit trademark goods, counterfeit trademark goods be disposed of outside commercial channels without compensation of any sort to the person infringing the rights, that materials or instruments the predominant use of which has been or may be the creation of infringing goods be disposed of outside the channels of commerce without compensation of any sort in such a manner as to minimize the risks of further infringement of the owner's right as well as the seizure, forfeiture or destruction of the infringing goods and of any materials and instruments having mainly served in the commission of the offence.

### **4.5 STAKEHOLDER VIEWS**

In the course of carrying out the study, the following are among the major issues raised by stakeholders regarding IP:

#### **Lack of awareness**

Most of the stakeholders interviewed were of the view that lack of awareness among the public as well as the enforcement institutions made curbing of illicit trade difficult. Stakeholders were, however, of the view that if awareness was raised then it would promote IP sector. A proposal was made that basic IP could be included in university curricula as a mandatory course in business and science-related subjects.

#### **High enforcement costs**

The cost of securing and registering IP is perceived to be high. For example, patent examination has to be done through the ARIPO system. Furthermore, in order to allow for seizure of suspected counterfeit goods, the IP holder has to make a security deposit of 20% of the value of the goods

before the case can be heard. This cost was seen to be prohibitive. However, the 20% deposit security was necessary to avoid frivolous enforcements and the cost was justifiable as it was refundable. In certain cases, it was felt that instead of a deposit security, it would be better for the enforcement agency to consider signing indemnities and guarantees with the IPRs holder to enable enforcement.

### **Institutional capacity**

There was a general view that there is need to enhance capacity of the national IP law office/RDB which requires hiring more staff members and undertaking trainings and capacity building. Currently, the national IP office has inadequate capacity to conduct substantive examinations of patents which is why the same is undertaken at ARIPO. The national IP office requires more capacity. However, other stakeholders were of the view that the existing capacity is sufficient given the number of patents received per year. The proposed recommendation to have the national IP law office operate as an autonomous institution was also objected to as it was argued that the Rwandan business model was anchored on the Singapore business model which provides for one stop centres for institutions involved in business support. As such, it was preferred that the national IP office operate as a department within the RDB, with the proposal for autonomy being a long term objective. This view was by all stakeholders' consensus.

The private sector felt that there were insufficient implementation mechanisms of the IP laws. There is very low demand for IP legal services thus the low number of legal experts in IP. Furthermore, the lack of experts in the sector is attributed to low demand for the services within the sector.

### **Insufficient prioritization of IPRs with the regulators**

Stakeholders were of the view that the IP sector was not accorded enough attention in regards to budgetary allocation and legal reforms. Many concurred that if IP was prioritized, then the sector would grow and contribute more to the economy.

It is felt that the regional institutions, such as EALA need, to prioritize IP legislation and establish a regional policy and law on IPRs.

In terms of regional harmonization, it was felt that regional harmonization would be better if it was undertaken in stages. There was need to begin by harmonization of EAC rules on GIs as the region had similar products that could qualify as GI, for example, tea and coffee which were grown in Rwanda, Uganda and Kenya.

It was felt that there was also need to have more regional collaborations on IP, for example, sharing information, mutual recognition agreements and synchronization of IP national offices across the region.

A proposal to establish a regional IP office and a regional EAC mark modelled on the European Union was acceptable to most stakeholders with many advising that the same would work if further feasibility studies were conducted to create the model.

## 4.6 CONCLUSION AND RECOMMENDATIONS

Rwanda has a strong IPR regime however the implementation can be enhanced so as to ensure effectiveness.

Rwanda's IP legislative framework is consistent with minimum standards in WTO-TRIPS and WIPO administered treaties. However, domestication of such treaties did not fully meet the WIPO benchmarking recommendations due to certain challenges including lack of resources and awareness. In terms of functions and mandates of the national IP office, the RDB model of administration of IP is appropriate for Rwanda given its social and economic development strategy. However, the institution staffing and capacity fell below the threshold as provided for in WIPO recommendation. It was established that the Rwanda business model is that the ideal national structure is that the IP office would operate as a department in the larger RDB. Given the national organizational structure and the WIPO structure, it was found that the Rwanda business model would prevail over the WIPO structure.

Therefore, it is recommended that Rwanda enhances awareness creation activities for the public and increases capacity building for the national IP office in terms of staffing and ability to conduct formality and examination of patents, as the core functions of the office meet the WIPO standard. The country should also strengthen her measures to combat counterfeit infringement menace.



## 5 CHAPTER FIVE: UGANDA

### 5.1 INTRODUCTION

Uganda is party to a number of international treaties that have had an influence on its legal framework insofar as IP is concerned. As a member of WIPO, which it joined in 1971, Uganda is also a party to the Paris Convention (June 14, 1965) and the PCT (June 8, 1994). However, Uganda is not a signatory to the Berne Convention.

Regionally, Uganda is member of ARIPO and, as such, is a party to the Harare Protocol and the Banjul Protocol.

### 5.2 IP LEGISLATIVE FRAMEWORK

#### 5.2.1 Constitution 1995

Under Article 189 of the Ugandan Constitution, the discharge of certain functions and provision of services are divided between the Government and the district councils. The Sixth Schedule to the Constitution, which specifies those functions and services that are the responsibility of the Government, identifies “Copyright, patent and trademarks and all forms of intellectual property as being among those functions and services. The Constitution also contains provisions recognising and guaranteeing the subsistence of the ‘Institution of Traditional or Cultural Leaders’.

#### 5.2.2 Industrial Property Act 2014 & Regulations

This Act provides for the promotion of inventive and innovative activities, to facilitate the acquisition of technology through the grant and regulation of patents, utility models, industrial designs and technovations and to provide for the designation of a registrar, to provide for the functions of the registrar, and the establishment of a register of industrial property rights and for related matters. The Act vests registration of industrial property in the Registrar General who is appointed under the Uganda Registration Services Bureau. The Act provides for substantive examination of patent applications, international patent filing via PCT and regional patent, UM and industrial designs with ARIPO. The law contains several provisions on enforcement and remedies in tandem with international IP treaties.

#### 5.2.3 Trademarks Act, 2010

This Act, and its implementing Regulations, provides the framework for the protection of trade marks. The Act provides for the appointment of a registrar; registration of trademarks; the procedure and duration of trademarks; the effect of registration; and for infringement of a trademark; the use and nonuse for a trademark; fees, legal proceedings and appeal for trademark offences and for regulations and related matters.

Although Uganda is a member of the Paris Convention, the Act does not make provision for claiming priority. It is therefore not clear whether convention priority can be claimed. Furthermore, although Uganda is a member of the Banjul Protocol of ARIPO, no provision is made in Uganda’s national law for the recognition of ARIPO registrations in which Uganda is designated, nor for the filing of ARIPO applications in Uganda. Provision is made in the Act for the registration of trade marks

for goods and for services. However, as the Rules under the old Act are still in force, they make no provision for the classification or registration of services.

#### **5.2.4 Geographical Indications Act, No. 8 of 2013**

This Act provides for the recognition, registration and enforcement of GIs in Uganda. The Act provides for the protection and registration of GIs, provides the duration of protection, the appointment of a registrar, remedies for infringement or prohibited use of GIs and for related matters. It defines “geographical indication” as meaning “any indication which identifies goods as originating in a particular country, region or locality where a given quality, reputation or other characteristic of the goods is essentially attributable to its geographic origin.”

#### **5.2.5 Trade Secrets Protection Act 2009 & Regulations**

This Act provides for the protection of undisclosed information in commercial transactions and other related matters. The Act provides for application of the law to protection of trade secrets, right to prevent disclosure, acquisition or use of trade secrets, conditions for protection, right of action, disclosure contrary to honest commercial practice, acts not contrary to honest commercial practice. It also provides that the right in a trade secret does not prejudice rights in other forms of IP, and that the right can be assigned, transferred or licensed. In each of these cases, the rights and obligations are to be set out in a written contract. Remedies available for breach include grant of an injunction, damages and account of profits.

#### **5.2.6 The Copyright and Neighbouring Rights Act, 2006**

As noted earlier, Uganda is not a party to the Berne Convention. However, this Act provides for the protection of literary, scientific and artistic intellectual works and their neighbouring rights; and for other related matters. This Act provides for registration of copyright as a formal administrative measure. The Copyright Act provides for contracts which relate to exploitation of authors rights and clearly sets out formality requirements which must be met for such a contract to be valid. The Act has provisions on CMOs. The Act also has provisions to cater for Persons with Disabilities as an author can transfer rights of works alteration for it to be put in Braille form for production. Also, the Fair Use provision envisaged by the Marrakesh Treaty is already in law. Registration of Copyright is automatic. Furthermore, disputes are resolved through arbitration and are referred to an arbitrator or arbitrators under the Arbitration and Conciliation Act.

#### **5.2.7 The Patents (Amendment) Act (2002)**

The Act and its Regulations incorporates the Patent Cooperation Treaty (PCT) system into domestic law and is still in force despite the repeal of the Patents Act (1993) by the Industrial Designs Act. It is an Act that amended the Patents Statute, 1991 to provide for international applications and connected matters by giving effect in Uganda to the provisions of the Patents Co-operation Treaty. It elects Uganda as receiving office, designated office among other duties under PCT.

### **5.2.8 Plant Variety Protection Act, 2014**

The Act provides for protection of new plant varieties in Uganda in accordance with UPOV. The subject matter for protection is propagating material and excludes microbial flora such as algae.

It should also be noted that Uganda has a Seeds and Plant Act, 2006, which provides for the promotion, regulation and control of plant breeding and variety release, multiplication, conditioning, marketing, importing and quality assurance of seeds and other planting materials and for other related matters.

## **5.3 INSTITUTIONAL FRAMEWORK**

### **5.3.1 Uganda Registration Services Bureau (URSB)**

The URSB, which is a semi-autonomous department under the Ministry of Justice and Constitutional Affairs, oversees all IP registration activities in Uganda. The Bureau was created to take over the functions of the Registrar General's Office. The URSB Act, which created the URSB, came into force on 16 August, 2004 but the self-accounting status was not granted until July 2010. The bureau is governed by the Board of Directors and the Chief Executive Officer, who is also the Registrar General.

The functions of the Bureau as provided for under the URSB Act include carrying out all IP-related registrations required under the relevant laws. Its mandate also includes business registrations, civil registration and the collection of non tax revenue. The national IP office has a mandate of conducting arbitration and mediation in IPR disputes as a tribunal.

The URSB has a specific Registrar of Copyright who solely deals with the Copyright issues. The Bureau also has about 6 offices in various towns which allow the citizens have easier access to public services in intellectual property

The staffing at IP office is minimal with only 3 registrars who separately handle trademark registration, patents and copyrights. The unit is headed by a manager. At the time of conducting this study, the national IP unit had about 15 staff which is inadequate to meet the demands in the IPR sector. The URSB does not undertake formal and substantive examination of patent applications in Uganda.

### **5.3.2 Plant Variety Protection Office**

There is an office of plant variety protection established under the Plant Variety Protection Act, 2014. The office is headed by a registrar of plant variety answerable to the Commissioner for crop protection under the Ministry of Agriculture, Animal Industry and Fisheries.

### **5.3.3 IP Supportive Institutions**

#### **Uganda National Bureau of Standards (UNBS)**

The UNBS is a statutory body under the Ministry of Trade, Industry and Co-operatives established by the UNBS Act, Cap 327. It is governed by the National Standards Council and headed by the Executive Director who is responsible for the day-to-day operation of UNBS.

The Mandate of UNBS includes the formulation and promotion of the use of standards; enforcing standards in protection of public health and safety and the environment against dangerous and sub-standard products; ensuring fairness in and precision in industry through reliable measurement systems; and strengthening the economy of Uganda by assuring the quality of locally manufactured products to enhance the competitiveness of exports in regional and international markets.

### **Uganda Revenue Authority (URA)**

The URA is established under the URA Act. Its mandate includes anti-counterfeit enforcement.

## **5.4 ENFORCEMENT OF IP AND ANTI-COUNTERFEIT ACTIVITIES**

Enforcement of IP in Uganda is generally carried out through the court system. Complainants have a variety of remedies available to them including injunctions and damages for breaches of IPRs. Other remedies available include the suspension of clearance of suspected pirated goods, removal from the register of unqualifying GIs, destruction of infringing goods and recovery of profits.

The Trade Marks Act also provides for offences such as forging or counterfeiting a mark, making false entries in the register of Trademarks, falsely representing a mark as registered, falsely applying a registered mark, possession of dye for purposes of committing an offence, and the prohibition of import or export of goods to which false marks have been applied.

## **5.5 STAKEHOLDER VIEWS**

A number of issues emerged as key for stakeholders. These include:

### **Insufficient political good will**

It was felt that there was a general lack of political goodwill in passing IPR related legislation. It was also noted that there was political interference when it came to enforcement due to a probable conflict of interest.

### **Need for specialized court**

It was noted that there was need to establish a specialized court to handle matters to do with counterfeit as they are currently handled as a petty crime in the courts. It was felt that a specialized court needs to be set up to handle crimes of a “commercial nature” such as dumping, counterfeit, tax evasion amongst others. This would allow the IP related crimes be handled separately from other common crimes, furthermore the same would be handled by trained personnel within the judiciary and police force. However one stakeholder from the private practice in Uganda commented that there is in place a utilities court which handles such matters.

### **Difficulty in combating online piracy and counterfeiting**

It was noted that with increased use of digital technology it had become easier for infringers to infringe. It was further noted that it is easier for infringers to infringe copyrighted works through online platforms. It was also easier for infringers to purchase counterfeit materials through online

portals. It was recommended that increased training in cybercrime and cyber laws be provided so as to minimize the vice.

### **Inadequate regional initiatives and co-ordination at EAC**

A representative of the ULRC noted that there had been similar initiatives being conducted at several levels within the EAC. He noted there was an EALA initiative as well as the private sector initiative and he noted that there was a lack of co-ordination in the initiatives between the private sector and the EAC.

### **Lack of awareness of IPRs**

There has been a lack of awareness of IPRs in Uganda and the region therefore there was a low demand for IPR services even within the legal services industry. Consequently many lawyers did not find a need to develop competency in IP as there was a low demand for services.

### **Inadequate capacity and expertise within the institutions**

It was felt that the national IP office did not have sufficient capacity in terms of human resource and they concurred that there was a need to increase staffing at the national IP office.

Some stakeholders were of the view that lack of autonomy of the national IP office presented an institutional challenge as the national IP office would then be limited in the performance of some of its roles such as generating incoming and raising awareness. However during the validation workshop, the national IP office noted that there was no need to have an autonomous IP unit as long as the national IP office was sufficiently empowered or mandated to carry out its core functions. The representative questioned the rationale for setting up an autonomous national IP seeking to understand if there would be an issue of the national IP office operated as a department within a larger organization so long as it was sufficiently funded.

Other stakeholders were of the view that the enforcers, regulators, judiciary and police force lacked capacity to enforce IPRs. This was in terms of staffing, institutional capacity and expertise. It was felt that there was a need to increase institutional capacity and empower the enforcement mechanisms so as to meet the demands.

### **Consumer perceptions**

It was felt that consumer perceptions played a role in the high level of counterfeit within the region. Consumers did not understand that counterfeiting is illegal and even where they did; demand for counterfeit products was driven by low purchasing power. It was felt that there was a need to enhance consumer awareness in so far as counterfeiting is concerned.

### **Insufficient regulatory regime**

A number of stakeholders were of the view that the regulatory regime would be strengthened if there was an intellectual property policy as well as a law on anti-counterfeit and an enforcement agency to handle enforcement of counterfeits.

### **Intra-agency collaboration**

There were some initiatives on intra agency collaboration to enhance IPR protection and fight counterfeit however stakeholders felt that there was a need to enhance the intra-agency collaboration to strengthen enforcement of IPR.

### **Encourage use of alternative dispute resolution methods**

It was suggested that IPR holders should be encouraged to resort to arbitration as a means of upholding and securing their IPRs. Arbitration was a good enforcement alternative as it was faster and also there was expertise.

### **Autonomy of IP Office**

The intellectual property law office is not autonomous and is therefore limited in terms of institutional capacity and budgetary constraints.

### **Limitation in the use of international mechanisms to register IPRs**

It was noted that the use of ARIPO as a means to register IPRs regionally was limited as not all partner states were signatories of all treaties. For example, Kenya was not a signatory of the Banjul protocol and therefore one could not designate Kenya and have to undertake a national filing in Kenya. The ARIPO system was also felt to be expensive.

### **IPR prioritization in the national economic outlook**

It was felt that there was insufficient government appreciation and prioritization of intellectual property leading to insufficient budgetary and institutional support for intellectual property law matters. A number of IPR laws took long to be legislated due to this.

### **Different development of partner states**

It was noted that the partner states were at different stages of development with all the partner states save for Kenya classified as least developing countries (LDC). As a consequence the legislative and implementation pace of IPR legislation did not take place at a similar pace.

### **Low literacy levels**

Some stakeholders felt that there was a low literacy level amongst the general population which affected IPR awareness.

### **Views on regional enforcement of IPR**

It was noted that the region could look into having a central IPRs registry where information and data could be shared especially on well-known marks in the region. However it was pointed out by some stakeholders that this would only be possible if the law was first amended to provide for this.



There was also a call for enhanced collaboration between the judicial organs within the EAC on training and enforcement.

It was also proposed that there should be in each partner state and regionally, a data base for IPRs infringers that is, black listing and the state should not trade with such infringers as a deterrent.

It was also noted that it was difficult for enforcers to identify counterfeited works without the involvement of the private rights holders. There should be curriculum changes to provide for IP; law related courses. It was felt that there should be an increased use of the EACJ to hear trade related disputes including IP rights disputes which have a regional dimension. There should be increased lobbying and advocacy by the private sector. In terms of enforcement, the infringer rather than the rights owner should pay for destruction costs.

### **Increased regional collaboration**

The importance of lawyers' collaboration in enhancing IP capacity so as to provide services in this sector was also noted. There should be increased collaboration between consumer organizations and IP rights institutes to create awareness with the public on IP rights and the dangers of consuming counterfeited products.

Increase automation and technology in fighting illicit trade

The need for increased surveillance technology in order to fight the vice was observed. In this regard it was noted that the Government could delegate the provision and management of surveillance technology to the private sector.

## **5.6 CONCLUSION AND RECOMMENDATIONS**

The Ugandan national IP office, URSB is fully autonomous. It operates as a department of a larger institution the URSB whose mandate is to offer various services to support the business environment. Therefore it doesn't meet the recommendation found in the WIPO Guidelines which recommend the formation of an autonomous IP office. There is no Anti-counterfeit Agency and no anti-counterfeit law which makes enforcement against counterfeits a challenge.

Enforcement has been deemed to be inadequate due to lack of a sui generis anti-counterfeit law and agency. A second reason enforcement has been deemed to be inadequate is due to insufficient staffing and expertise/training of staff within the enforcement institutions. The sentences on enforcement though satisfactory are not applied as the enforcement agencies deem IPR infringement to be a misdemeanour and seldom apply the maximum sentences provided for in the law. Therefore there is inadequate deterrence of IPR related crime.

Uganda has legislated on all the IP laws as the WIPO benchmark that is, patents, copyrights, trademarks, utility models, industrial designs, geographical indications and trade secrets that ensure there is accurate protection of rights as well as enforcement mechanisms. Additionally, the Uganda Constitution specifically recognizes intellectual property rights as property rights which further strengthens the IPR framework in Uganda. However Uganda has not yet passed laws on traditional



knowledge, plant breeders' rights and geographical indications. These need to be passed to strengthen the IPR regime in Uganda.

Uganda has signed several treaties on IPRs and these fill any gap caused by insufficient national legislation. However, there is a need to look into signing the Berne Convention. There is no express provision that infringement of IPRs be considered as unfair trade practice as compared to Rwanda where IPR infringement is given a tripartite approach that is, as an unfair trade practice, an infringement and a criminal offence in some instances. There is therefore need to include IPR infringement as unfair trade practices in the Competition and Restrictive Trade practices law so as to strengthen enforcement options.

There is no substantive law on anti-counterfeit and PBRs. Since anti-counterfeit agency is missing, it is hard to coordinate other supportive agencies in fighting against IP infringement. There are challenges of enforcing IPRs in country due to inadequate capacity and resources at URSB to curb infringement activities in the country.

Therefore, it is recommended that Uganda strengthens her capacity in management and enforcement of IP in the country. There is also need to enhance awareness and establish mechanisms for inter-agency collaborations in fighting against illicit trade and especially counterfeiting activities in Uganda.

## 6 CHAPTER SIX: BURUNDI

### 6.1 INTRODUCTION

Burundi was not one of the four countries that was a focus of this study. However, some information regarding its IP legal framework was collected through a desk study.

Burundi is a member of WIPO. It is also a signatory to a number of treaties and conventions relating to IPRs including the Berne Convention, which it only joined in 2016, the Paris Convention. Burundi is not, however, a signatory to the Madrid System for the International Registration of Marks which is governed by the Madrid Agreement, and the Protocol relating to that Agreement.

As a member of the WTO, Burundi is bound by the TRIPS Agreement.

The following sections provide a brief overview of the main IP statutes in Burundi. It should be noted that Burundi does not have a law on the protection of new plant varieties.

### 6.2 IP LEGISLATIVE FRAMEWORK

#### 6.2.1 The Law on Industrial Property

**The Law No. 1/13 Of July 28, 2009 relates to Industrial Property in Burundi**

The law seeks to protect industrial property rights. It regulates in particular the rights relating to patents, utility model certificates, industrial designs, layout designs for integrated circuits, traditional knowledge, crafts objects and distinctive signs. It provides definition of counterfeit branded goods as all goods, including their packaging, which bear, without authorization, a factory or trademark which is identical to a factory or page 3 trademark that has been validly registered for said goods, or whose essential aspects cannot be distinguished from this factory or trademark, and which therefore infringes the rights of the holder of the mark in question under the legislation in Burundi. It provides for domestication of Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure, signed in Budapest on April 28, 1977 and amended on September 26, 1980.

#### 6.2.2 The Law on Protection of Copyright and Related Rights

This law is applicable to literary and artistic works that are original intellectual creations in the literary and artistic domain, whatever may be the genre, value, purpose, mode or form of their expression. It provides for all relevant provisions available in Berne Convention including establishment and regulation of CMOs. Article 3 of the Law provides that copyright protection provided for by this Act shall not be subject to any formalities and therefore there is no requirement for registration.

### 6.3 IP INSTITUTIONAL FRAMEWORK

#### 6.3.1 Department of Arts and Culture Ministry of Youth, Sports and Culture

The Administration of Copyright and Neighbouring Rights is vested in the Department of Arts and Culture Ministry of Youth, Sports and Culture.

### **6.3.2 Ministry of Trade, Industry and Tourism**

Administration of patents, utility models, trademarks and industrial designs is vested in the Ministry of Trade Industry and Tourism.

## **6.4 ENFORCEMENT**

The enforcement of IPRs is done through the Courts and the Customs. With regard to copyright, the courts have the power to impose civil as well as criminal sanctions.

## **6.5 CONCLUSION AND RECOMMENDATIONS**

Burundi's IP legislative and institutional framework is at its infancy stage due to its political instability among other things. Its IP legislative framework is being reviewed from time to time to suit the national social and economic development as well as conform to the international treaties to which it is party to. Burundi is a member of WIPO Paris Convention on Industrial Property Rights, Berne Convention for Protection of Literary and Artistic Works, PCT and WTO-TRIPs Agreement among others. It is not a member of Madrid Agreement for Protection of International Marks and ARIPO. The IP regime provides for international patent filing under PCT. However, the Industrial Property Office is still under the Ministry of Trade, Industry and Tourism. It has copyright Act that is in compliant with Berne Convention. It lacks PVP laws and Anti-counterfeit legislation.

Since it lacks autonomy, there are challenges associated with speedy execution of both administration as well as enforcement of IP in the country. The national IP institutional framework regimes do not fulfil most of the minimum requirement set out in the WIPO benchmarking recommendations. There is no stand-alone anti-counterfeit agency to coordinate other agencies in fighting against IP infringement. In addition, there are challenges of enforcing IPRs in the country due to inadequate capacity and resources to curb infringement activities in the country.

Therefore, it is recommended that Burundi aspires towards acceding to Madrid System and UPOV regime. It should harmonize its IP legislative framework to march with WIPO minimum benchmarking standards. The country needs to strengthen measures to raise IP awareness, enhance its capacity in management and enforcement of IP in the country. It should increase participations in inter-agency collaborations in fighting against illicit trade and especially counterfeiting activities.

## 7 CHAPTER SEVEN: SOUTH SUDAN

### 7.1 INTRODUCTION

South Sudan, like Burundi, was also not one of the countries identified as a focus of this study. However, a limited amount of information regarding its IP system has been gathered by way of a desk study. It is worth remembering in this regard that South Sudan is a young independent state having only gained its independence from Sudan in 2011.

It does not have any of her own legislation on IP save for having signed WCO, Nagoya Protocol on ABS and EAC Treaty. All her IP related laws are reflected in the following Acts of the older Sudan.

### 7.2 IP LEGISLATIVE FRAMEWORK

#### 7.2.1 Transitional Constitution

According to the Transitional Constitution, IPRs in South Sudan are regulated in terms of the Sudanese Laws. The Constitution states that all current Laws of Southern Sudan shall remain in force and all current institutions shall continue to perform their functions and duties, unless new actions are taken in accordance with the provisions of this Constitution; and its Schedule “A” places intellectual property under the exclusive legislative and executive powers of the National Government. However, Sudanese patents and trade mark registrations are not recognized in South Sudan.

The Ministry of Justice admits trade mark applications under the provisions of the trademarks act of 1969 that is currently in force in the neighbouring Sudan. In principle, registrations, submitted under the act of 1969, will remain valid after the issuance of the new trademark law of South Sudan. South Sudan is a party to the main IP Treaties such the Paris Convention, the Madrid Agreement and Protocol, the Berne Convention, the Brussels Convention, the Phonograms Convention and the WCT and the WTO/TRIPS

There is however no evidence of the practicality of enforcement and administrations of this laws. Since the separation of South Sudan there is no evidence that the operating laws have been updated since. There is also no evidence of any IP regulatory work going on in South Sudan due to the political instability that is prevailing in there at the moment.

#### 7.2.2 Literary and Artistic Works Act of 2001

This Act provides for the protection of Copyright and Related Rights (Neighbouring Rights), Enforcement of IP and Related Laws, IP Regulatory Body. It however is only available in Arabic language.

#### 7.2.3 Seeds Act of 1990

This act relates to Enforcement of IP and Related Laws, IP Regulatory Body, and Plant Variety Protection. It is also only available in Arabic language.

#### 7.2.4 Industrial Designs Law No. 18 of 1974 (1974)

It relates to Enforcement of Industrial Designs, It is shared by both Sudan countries and is available in Arabic and English language. It provides for registration of industrial designs.

### **7.2.5 Patent Law No. 58 of 1971**

It provides for the protection of inventions under patent system. It relates to enforcement of patents (Inventions).

### **7.2.6 Trademark Law No.8 of 1969 (1969)**

The Act provides for registration of trademarks. It also has provisions on competition and enforcement of trademarks.

### **7.2.7 IP Supportive Legislation**

#### **Registration of Business Names Act, 2008**

The purpose of this Act is to provide for the registration of firms, individuals and corporations carrying on business under business names in Southern Sudan, and for matters incidental thereto and connected therewith.

Other supportive legislations exist on standards, pharmacy and poisons, weight and measures, customs among others.

## **7.3 INSTITUTIONAL FRAMEWORK**

It was not possible, within the scope of this study, to establish what, if any, institutions are mandated to administer IPRs in South Sudan.

## **7.4 CONCLUSION AND RECOMMENDATIONS**

South Sudan is a young nation. IP legislative framework has not been put in place. The country uses presidential decree and policy framework based on the regime in Sudan, The IP legislative and institutional framework is not compliant with the minimum requirement by WIPO administered treaties. The country is not a signatory to any WIPO administered treaty. The national IP institutional framework is not autonomous as set out in the WIPO minimum benchmarking requirements for administration of patents and trademarks, copyright or plant breeders' rights. There is no substantive law on anti-counterfeit and PBRs. Since anti-counterfeit agency is missing, it is hard to coordinate other supportive agencies in fighting against IP infringement. There are challenges of enforcing IPRs in country due to lack to absence of legal framework, inadequate capacity and resources at IP office to curb infringement activities in the country.

Therefore, it is recommended that South Sudan should establish legislative framework for IP regime, sign WIPO administered treaties and WTO-TRIPs Agreement, strengthens her capacity in management and enforcement of IP in the country. Perhaps, South Sudan should start by sensitizing policy makers on the importance of national IP regimes. There is also need to enhance public awareness and establish mechanisms for inter-agency collaborations in fighting against illicit trade and especially counterfeiting activities in country.

## 8 CHAPTER EIGHT: THE EAST AFRICAN COMMUNITY

### 8.1 INTRODUCTION

The EAC is a regional trade bloc made up of the six member states discussed in the previous six chapters, that is, Kenya, Uganda, Tanzania, Rwanda, Burundi and South Sudan. Although the EAC aspires to evolve into a political federation, it is not yet supranational in character and does not have capacity to sign and become a party to international treaties. This Chapter analyses various EAC regional laws that touch on intellectual property.

### 8.2 LEGISLATIVE FRAMEWORK IN EAC

#### 8.2.1 The EAC Treaty

The EAC Treaty is the fundamental law of the EAC. It was concluded in November 1999 and entered into force on 7th July 2000. The main objective of the EAC according to Article 5(1) is to develop policies and programs aimed at widening and deepening co-operation among Partner States in various fields through the progressive establishment of a customs union, followed by a common market, monetary union and political federation.

The principles and objectives of the Treaty support harmonization of laws within the region. The provisions of the Treaty support the proposed harmonization of IP laws within the region as well as laws on enforcement and combating of illicit trade. The study highlights in brief the policy and decision making processes as provided in the Treaty as these would be important when implementing some of the recommendations set out in terms of legislative reforms.

#### 8.2.2 The EAC Customs Union Protocol

The EAC Customs Union Protocol was concluded pursuant to article 75 of the EAC Treaty in March 2004 and entered into force in 2005. The Protocol established the EAC Customs Union as a transitional stage to the full establishment of the Community. Within the customs union there is free movement of goods and the application of a common external tariff for trade with non-members. The Protocol also contains provisions regulating anti-dumping measures, rules of origin and other measures which touch on illicit trade.

With regard to IPRs, Article 38 obliges the Partner States to conclude a Protocol on IP that sets out the objectives, scope of cooperation and institutional mechanisms.

#### 8.2.3 EAC Common Market Protocol

The EAC Common Market Protocol was concluded in 2009, pursuant to Articles 76 and 104 of the EAC Treaty, as the second transitional stage in the process of integration. The Protocol has various provisions that support harmonization of IPRs. Partner States are expected to uphold cross border investments whereby investment in IP has been defined as a cross border investment. Discrimination against nationals from other Partner States is discouraged. Harmonization to prevent illicit trade is encouraged such as harmonized transport policy which will curb trade in illicit trade. Partner States are required to collaborate in terms of dissemination of information and statistics to do with IP. The EAC is expected to adopt a common position when negotiating international instruments and

Partner States should honour international agreements to which they are a signatory. A lot of joint awareness on IPRs and programs on IPR is also encouraged.

Specifically, under Article 29 on the protection of cross border investments, Partner States undertake to protect cross border investments and returns of investors of other Partner States in their territories. The Article goes on to define investment as encompassing IP.

Article 43 on co-operation in IPRs obliges the Partners to co-operate in the field of IPRs in order to “promote and protect creativity and innovation for economic, technological, social and cultural development in the Community; and enhance the protection of IPRs”. It then goes on to define IP as encompassing copyright and related rights, patents, layout designs of integrated circuits, industrial designs, new plant varieties, geographical indications, trade and service marks, trade secrets, utility models, traditional knowledge, genetic resources, traditional cultural expressions and folklore as well as any other areas that may be determined by the Partner States.

A key provision is found in Article 43(5) which empowers the Council to issue directives for co-operation in the administration, management and enforcement of IPRs and the elimination of discriminatory practices in the administration of IPRs amongst Partner States. Article 43 (6) provides that Partner States should honour their obligations in respect to international agreements which relate to IPRs.

Article 47, which obliges Partner States to approximate their national laws and to harmonize their policies and systems, can be interpreted as extending to IP and providing a window for the Council to take measures to this end through the issuance of directives.

However, despite the existence of the above provisions, there have been no significant tangible steps taken to actualize its wording. Thus, there are no laws and policies that have been enacted to harmonize various IP laws within the EAC region. Partner States resolved to instead develop model laws that EAC partner states can adopt. However, the said model laws are not binding and no action can be taken against a Partner State for non-compliance. It should be further noted that even the said model laws are yet to be completed due to lack of funding, and that they are still just drafts.

#### **8.2.4 The EAC Customs Management Act**

The EAC Customs Management Act was enacted in 2004 pursuant to the EAC Customs Union Protocol and entered into force in 2005. It provides, inter alia, that the Directorate of Customs established by the Council of Ministers under the Treaty, is mandated to initiate policies on customs and related trade matters and to coordinate such policies in the Partner States. Powers of the agency are set out and there are provisions on the policy making obligations of the committee established in the Act.

Section 19 of the Act empowers the Council to prohibit the importation of any goods or class of goods. The Act also gives officers of the Customs Union powers to inspect and impound suspected vessels and provides penalties for trading in prohibited goods as well as other related offences. These provisions could be used to tackle the menace of trade in counterfeit goods.



### 8.2.5 Protocol on Decision Making by the Council of the EAC

This Protocol, which was concluded in 2001, provides for the manner in which decisions on laws and policies shall be taken by the EAC Council of Ministers. It sets out those areas in which decisions must be taken by consensus and provides that all other decisions are to be taken by simple majority. Submission of Bills to the legislative assembly is one of the areas in which a decision has to be by consensus.

## 8.3 INSTITUTIONAL FRAMEWORK OF THE EAC

The EAC Council of Ministers is an organ established under Article 9 of the Treaty. It is the policy making body in the EAC and has a wide range of functions under the Treaty including making policy decisions and submitting Bills to the Legislative Assembly.

The East Africa Legislative Assembly (EALA) is also an EAC organ established under Article 9 of the Treaty. It is the legislative organ of the Community and can debate any motion relating to the functions of the Community. Members can also introduce Bills provided they relate to matters with respect to which Acts of the Community can be enacted.

The East Africa Court of Justice (EACJ), established under Article 9, has the role of ensuring adherence to law in the interpretation and application of the Treaty. Its jurisdiction is prescribed by Article 27 of the Treaty.

For purposes of enforcement and harmonization, the private sector in trans-border trade could refer IP disputes to the EACJ, which could then determine the applicable law for hearing the dispute so as to avoid conflict of laws in interpretation of IPRs.

## 8.4 STAKEHOLDER VIEWS

**Stakeholders at EAC expressed their views as follows:**

- There should be a policy to ensure implementation of Article 43 of Common Market Protocol. Such a policy should include tangible steps to facilitate awareness and training of IP;
- On training, the EAC should have a training institute for IP to train IP office staff, lawyers and other stakeholders in the IP industry such as scientists and other innovators. Such an institution could then source funding from the EAC as the EAC States would get to benefit from training in the identified institution. An easy way to achieve this would be, for example, to adopt one of the existing IP institutions within EAC region as a centre for excellence; and
- To avoid possible conflict with the ARIPO legal framework as a result of the development of an EAC regional IP framework, experts could be called upon to craft a solution that would ensure harmonization and co-existence of the two frameworks.



## **9 CHAPTER NINE: COMPARATIVE ANALYSIS**

### **9.1 INTRODUCTION**

This Chapter provides a comparative perspective to the issue of IPRs by looking at blocs or regions that have harmonized functional IP regimes akin to what is being proposed in this study. The three blocs discussed are the EU, ARIPO and OAPI.

### **9.2 THE EUROPEAN UNION (EU)**

The EU's laws, policies and institutional framework on IP have been identified as a possible benchmark for the East African Region. The EU has passed several legal measures on IP. All these measures support harmonization of IPRs in the EU. There are also a number of institutions that deal primarily with IP including the European Commission and the EU Intellectual Property Office amongst others.

#### **9.2.1 EU Trademark Laws**

Trade marks can be protected in two ways within the EU. One may either register a national trade mark or apply for an EU level European Union Trade Mark. Applications for a community trade mark are handled by the EU Intellectual Property Office (IPO). Once a community trademark is registered it accords protection in all 28 EU countries.

Efforts aimed at harmonizing trademark laws within the EU date back to 1989 when the first Directive aimed at approximating national laws was issued. The community mark itself was not created until 1994 when the EU Council issued the first Regulation on the Community trade mark. Thereafter the first applications were filed on 1 April 1996. The Community Trademark was administered by the Office for Harmonization in the Internal Mark (OHIM), now EU IPO. Third parties from any EU country can file an opposition against the registration of a trade mark application if they believe that it should not obtain trademark registration within the EU. When an existing trade mark in one or several European countries is causing problems an EU trade mark can be converted into several national applications.

#### **9.2.2 EU Industrial Design Laws**

The EU first provided for the harmonization of laws on industrial designs vide Directive 98/71/EC in 1998. It later passed a Regulation in 2002 establishing a community design valid throughout the EU. Internationally, the EU has acceded to the Geneva Act of the Hague Agreement on international registration of Industrial Designs enabling EU companies to obtain protection in other states parties to the Agreement.

#### **9.2.3 EU Geographical Indications**

The EU has enacted laws that govern the use of GIs with regard to agricultural products as well as wines and spirits. However, there has, as yet, been no harmonization for GIs for non-agricultural goods. There are different levels of geographical indications laws for such products across the EU which has made harmonization difficult. Therefore, if one desires to protect GIs for non-agricultural products in the EU then the same is done country by country.

#### **9.2.4 EU Trade Secrets**

The EU Directive 2016/943 provides for harmonization of the definition of trade secrets within the region and also provides for the harmonization of civil remedies on breach of trade secrets.

#### **9.2.5 EU IP Enforcement**

Enforcement of IPR is done by the EU Commission. There is a lot of lobbying on inter agency collaboration by the Commission. The Directive on enforcement of IP provides a similar set of measures for IPR holders aimed at curbing piracy and counterfeit. There is a proposal to modernize enforcement IPRs as per the digital single market entry strategy for Europe.

#### **9.2.6 The European Commission (EC)**

The EC is the regional body to enforce IPRs pursuant to a directive on enforcement of IPRs. The EC is the agency that handles IPR matters in the EU. It seeks to harmonise IP laws in the Union and fights against piracy and counterfeiting while helping the private sector access IPRs. The EU Commission monitors patent and trademark legislation in the EU.

#### **9.2.7 The EU Intellectual Property Office (EU IPO)**

The EU IPO (formerly OHIM) is based in Alicante, Spain and is charged with managing the EU mark and industrial designs. It also handles international registrations.

For patents, the European Patent Office is headquartered in Berlin with a branch in The Hague.

### **9.3 AFRICAN REGIONAL INTELLECTUAL PROPERTY ORGANIZATION (ARIPO)**

ARIPO is an intergovernmental organisation bringing together 19 African countries.<sup>21</sup> It was established following the adoption of the Lusaka Agreement in 1976. Its objectives include promoting the harmonization and development of IP laws and establishing such common services or organs as may be necessary or desirable for the co-ordination, harmonization and development of the IP activities affecting its members. The Lusaka Agreement provides the framework upon which the organisation is built.

#### **9.3.1 Legal Framework**

ARIPO operates through a series of Protocols governing different areas of IP. These include the Harare Protocol on Patents and Industrial Designs within the Framework of the African Regional Intellectual Property Organization (1982), the Banjul Protocol on Marks (1993), the Swakopmund Protocol and, most recently, the Arusha Protocol.

##### **Harare Protocol**

The Harare Protocol, which was adopted in 1982, provides the legal framework for ARIPO to receive and process applications for patents, utility models and industrial designs. Applicants are required to designate the member states in which they would wish to receive protection. The applications are

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<sup>21</sup> Botswana, Gambia, Ghana, Kenya, Lesotho, Liberia, Malawi, Mozambique, Namibia, Rwanda, Sao Tome and Principe, Sierra Leone, Somalia, Sudan, Swaziland, Uganda, Tanzania, Zambia and Zimbabwe.

then examined and, where the necessary requirements are met, the IP right in question is granted. Once informed of the grant of a right, a designated member state can notify ARIPO that that right will have no effect on its territory if it doesn't meet the requisite conditions in its law. 18 member states are currently party to the Protocol with Somalia being the exception.

### **Banjul Protocol**

The Banjul Protocol, which was adopted in 1993, establishes a system similar to that in the Harare Protocol but for trade marks. An applicant may choose to file an application either through ARIPO or through one of the states party to the Protocol, designating the States in which they desire protection. There are currently nine ARIPO members that are party to the Protocol.<sup>22</sup> For the purposes of this study, it is important to note that both Uganda and Tanzania are parties to the Banjul Protocol.

#### **9.3.2 Institutional Framework**

The organs of ARIPO include the Council of Ministers, the Administrative Council, the Secretariat and the Board of Appeal. The Council of Ministers is the apex organ and is mandated to have overall responsibility for the governance of the organization.

The Administrative Council, which is subordinate to the Council of Ministers, is responsible for the formulation and execution of the organization's policy, the approval of the programs of activities and budget as well as the appointment of its Director General. The Administrative Council is composed of the heads of IP offices in the member states.

The Secretariat is headed by the Director General who is the Principal Executive Officer of the Organization. The Secretariat is responsible for implementation of the programs of the Organization.

The Board of Appeal is established by the Administrative Council to hear appeals against administrative decisions of the organization under both the Harare and Banjul Protocols as well as any other protocol that may be adopted by the organization.

In 2002, the ARIPO council extended the mandate of ARIPO to include Copyright and Related Rights, Traditional Knowledge, Genetic Resources and Folklore. Today, ARIPO is working on a strategic plan, which will include programs to facilitate the compatibility of copyright management systems of her Member States with international standards and systems such as accession to WIPO Copyright Treaty (WCT) and WIPO Performances and Phonograms Treaty (WPPT). It is also working on access to international databases and data distribution networks such as the proposed WIPO Africa Copyright Common Network (ACCN), AFRINET and development of anti-piracy and anti-counterfeit programs.

Furthermore, it is working towards the establishment of a database on public domain on traditional knowledge, development of model legislation for the protection of genetic resources, traditional knowledge and folklore, training and awareness creation especially among traditional knowledge-holders of their rights and obligations, creating an enabling environment to facilitate the promotion,

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22 Botswana, Lesotho, Liberia, Malawi, Namibia, Swaziland, Uganda, Tanzania and Zimbabwe.

development and exploitation of traditional knowledge assets and the promotion of cultural industries and recognition of their contribution to economic development at national and regional levels.

## **9.4 AFRICAN INTELLECTUAL PROPERTY ORGANISATION (OAPI)**

OAPI is an intergovernmental organization that brings together 17 African States from a primarily francophone background.<sup>23</sup> It was established in 1977 with the adoption of the Bangui Agreement Relating to the Creation of an African Intellectual Property Organization, Constituting a Revision of the Agreement Relating to the Creation of an African and Malagasy Office of Industrial Property. The Bangui Agreement, which entered into force in 1982, has since been revised in 1999 to bring it into conformity with the TRIPS Agreement. As a supranational organization, OAPI has become a party to the Hague Agreement on the Registration of Industrial Designs, the Madrid Protocol and, most recently, the Singapore Treaty on Trade Marks.

The aims of OAPI under the Bangui Agreement, 1977 include implementing and applying common administrative procedures deriving from a uniform system for the protection of industrial property, promoting the economic development of Member States notably by means of effective protection of Intellectual Property and related rights, and providing intellectual property training.

### **9.4.1 OAPI Legal Framework**

The substantive law concerning the different branches of IP is contained in ten annexes to the Bangui Agreement dealing with patent, utility models, trademarks and service marks, industrial designs, trade names, geographical indications, literary and artistic property, protection against unfair competition, layout-designs (topographies) of integrated circuits and plant variety protection. OAPI receives, examines and grants IPRs on behalf of all its 17 member states.

#### **OAPI Trademark System**

OAPI has a regional automatic registration system for trade marks in member states. The most distinctive characteristic and advantage of OAPI is that a single trade mark registration is automatically effective in all its member states, without the option of designating only some countries. Member states do not have national IP Laws. The Bangui Agreement works as a common IP Act with its provisions having the effect of national law in each member state; no validation or extension is required.

#### **OAPI Patent System**

OAPI provides for a single patent application and registration system that covers all its member states including those that lack national IP laws or offices. It has an automatic and unified protection in the said 17 countries as opposed to ARIPO where some member country may reject the grant of an IP right due to their national laws.

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<sup>23</sup> Benin, Burkina Faso, Cameroon, Central African Republic, Chad, Comoros, Congo, Cote d'Ivoire, Equatorial Guinea, Gabon, Guinea, Guinea Bissau, Mali, Mauritania, Niger, Senegal and Togo.

This Study argues that this OAPI model would be appropriate for EAC.

#### **9.4.2 OAPI Institutional Framework**

Like ARIPO, the organs of OAPI comprise an Administrative Council consisting of representatives of OAPI Member States, a High Commission of Appeal composed of three members selected by drawing lots from a list of representatives designated by Member States and the Directorate General placed under the authority of the Director General and responsible for the executive work of the organization.

#### **9.4.3 Comparison between ARIPO and OAPI Frameworks**

In terms of substantive IP regulation, OAPI's legal framework is more extensive and detailed than that of ARIPO. This became more pronounced after the Bangui Agreement of 1999 which introduced provisions that ensure Member States comply with the TRIPS Agreement. Further, Member States of OAPI are required to be signatory of most treaties on IP including the Paris Convention, Berne Convention, Rome Convention and PCT. All these are not required of members of ARIPO.

Even though the filing procedures in both organisations are similar, under ARIPO a member state may give notice that an application properly filed with and granted by the regional body will not apply to it. This is unlike the provision in OAPI where a grant applies to all Member States. Furthermore, OAPI agreement provides for every aspect of IP including copyright, traditional knowledge, genetic resources, folklore and cultural heritage. These are not provided for in the ARIPO agreement though ARIPO has recently extended its mandate to include copyright, and has concluded the Swakopmund Protocol on the Protection of Traditional Knowledge and Expressions of Folklore and the Arusha Protocol for the Protection of New Varieties of Plants.

The OAPI system created a regional body that practically does all forms of registration and acts as the national office for the member states. Though this will save cost and ensure a high level of expertise, it denies the nations the independence to decide on what IP laws should apply to it. This could be accepted for most of the members of OAPI who were colonized by France and had adopted the culture of assimilation introduced during colonial rule but it may be difficult for other States in Africa.

For example a number of the treaties that were adopted by the Bangui Agreement sparked off opposition amongst many African States including parties to the agreement. This includes the International Convention for the Protection of New Plant Varieties. These treaties adopted by the Bangui Agreement may also be a major hindrance to cooperation between the two organizations. It is doubtful whether Member States of ARIPO will be ready to accede to those treaties at least for now. The process of filing could also be another hindrance, as not many countries in ARIPO will accept the organization's office to be deemed as a national office of the nation.





## 10 CHAPTER TEN: RECOMMENDATIONS AND CONCLUSION

### 10.1 INTRODUCTION

This Chapter presents the recommendations of the Study as derived from the analysis of the legal and institutional frameworks in the previous Chapters as well as the views collected from the different stakeholders that were contacted in the course of the study. The recommendations are divided between those actions that need to be taken at the national level by each EAC member state individually and those requiring joint action at the EAC level.

### 10.2 NATIONAL LEVEL ACTIONS

#### 10.2.1 Autonomous National IP Offices:

The WIPO benchmark recommends setting up of autonomous national IP offices which have the legal capacity to carry out certain functions with ease. Such actions include entering into partnerships, engaging in income generating activities, and receiving and raising funds. Such a model is recommended because it is also good for governance as it requires the office to have its own board of directors.

It is therefore recommended that Rwanda, Tanzania (both mainland and Zanzibar), and Uganda give serious consideration to restructuring their institutional frameworks to establish their IP offices as autonomous institutions. Burundi and South Sudan should also consider taking the same action.

#### 10.2.2 Set up Anti-Counterfeit Agencies

Out of the six EAC Partner States, Kenya alone has a distinct, autonomous Anti-counterfeit Agency. The other Partner States have different mechanisms within other institutions charged with combating counterfeit activities. Such an independent institution is important in coordinating the efforts of other agencies involved in enforcement and fighting against counterfeit trade.

It is therefore recommended that all member states set up autonomous anti-counterfeit agencies that will provide leadership to the other agencies in dealing with counterfeit issues in the partner states.

#### 10.2.3 Raise Awareness on IPRs and Illicit Trade

It was found amongst almost all the stakeholders interviewed that the low level of awareness of IP meant that there was a low level of locally generated registrations of IP across the region. Where there were existing IPRs registrations, there was a low level of enforcement and a high level of infringement amongst the general public. One of the reasons for rampant infringement and counterfeiting was a lack of awareness. Some consumers do not know that counterfeit goods are illegal. There is a low appreciation of IP with the potential IPRs holders. Among the institutions interviewed, budgetary constraints were identified as a significant factor restraining them from raising awareness. The awareness programs were also found not to be relevant to the end users as they focused too much on the legal aspects of IP rather than focusing on the relevance.

It is therefore recommended, firstly, that the governments of each partner state mount awareness programmes that are specifically tailored for specific audiences targeting consumers and potential IP holders (innovators, inventors, manufacturers and entertainers) and, secondly, that they take steps to

integrate basic IP as a mandatory course in the curriculums of business and science related subjects in tertiary institutions. The programmes should be collaborative and involve the various institutions charged with the mandate of creating awareness. Such institutions should collaborate in developing content for the awareness programs and also undertake the same jointly.

#### **10.2.4 Training of Persons involved in IP Sector**

It was found that some of the persons involved in the IPR sector were not properly trained in dealing with IPRs and in their enforcement. These included staff with the regulators, enforcers, lawyers, patent agents and the judiciary. For example, there was a consensus within the bar associations that very few lawyers practiced IP mostly because it was a new concept.

It is therefore recommended that capacity building training programs be organized for staff of the regulators, enforcers, lawyers and members of the judiciary. In undertaking these trainings partnerships with WIPO and/or ARIPO should be considered with regard to curriculum drafting. Staff with the national IP offices, lawyers and patent agents should also be encouraged to take the IP courses offered by WIPO. Consideration should be given to requiring the taking of the WIPO IP Advanced Course for one to be admitted as a patent agent in partner states.

#### **10.2.5 Legal Reforms in Individual Partner States**

Most countries do not have IP policies or strategies but were in the process of developing them. IPRs policy issues were covered in several other policies, for example, in Kenya IP was covered under the science, technology and innovation policy whereas it should be separately covered.

During the site visits it was also found that most countries had a form of IP legislation. However, there were deficiencies in the laws and some amendments to the laws are needed. For example, except for Kenya, no other partner state has anti-counterfeit laws in place. A majority of the stakeholders felt that amendments were also needed in enforcement provisions, for example those that criminalize counterfeit, to provide for stiffer penalties as a deterrent measure.

Countries also need to prioritize domesticating international conventions and ratifying those not ratified. For example, Kenya has not yet signed the Banjul protocol which stakeholders in the partner states represented argued hampered harmonization in the region.

It is therefore recommended, firstly, that the states prepare the necessary legislation to fill the gaps in their legal frameworks and, secondly, that those member states that have not acceded to the Paris Convention, Berne Convention, PCT, Madrid System and UPOV should give serious consideration to doing so and thereafter to domesticate the said treaties into their domestic laws. In undertaking this, the following should be considered: a detailed analysis of the legislative reforms needed should be done vis a vis international best standards (the detailed legal reform and draft laws were outside the scope of this study and therefore are not included in detail); WIPO partnership in drafting IP policy, strategy and model laws; and benchmarking with international best standards;

### **10.2.6 National Partnerships and Collaborations**

On the issue of national partnerships and collaboration, during site visits, it was found that there was a limited level of intra-agency collaboration between the regulators and the enforcers. More needs to be done to enhance intra-agency collaboration efforts and create new ones where possible. It was felt that having in place agreements establishing inter-agency committees would be more binding as opposed to having a general recommendation on collaborations.

It is therefore recommended that regulators and other agencies and institutions involved in administering and enforcing IP enter into formal MOUs establishing inter-agency committees to guide and monitor collaboration.

### **10.2.7 Use of ADR to Resolve IPR Disputes**

It was felt that IPR holders could resort to other forms of IPR dispute resolution and enforcement other than the judicial process through the courts. It was felt that dispute resolution through the court system was time consuming and that the judiciary did not have sufficient expertise to handle IPR issues.

It is therefore recommended that IPR holders be encouraged to resort to arbitration and other forms of ADR to resolve IPR disputes in contract arrangements such as licensing. The benefit is that it takes a short time to resolve the dispute and it is handled by experts. However, the weakness of ADR is that such mechanisms cannot be used to handle infringement and counterfeit matters as these are not contractual matters. It also cannot address the criminal aspects of IPR infringement.

## **10.3 REGIONAL LEVEL ACTIONS**

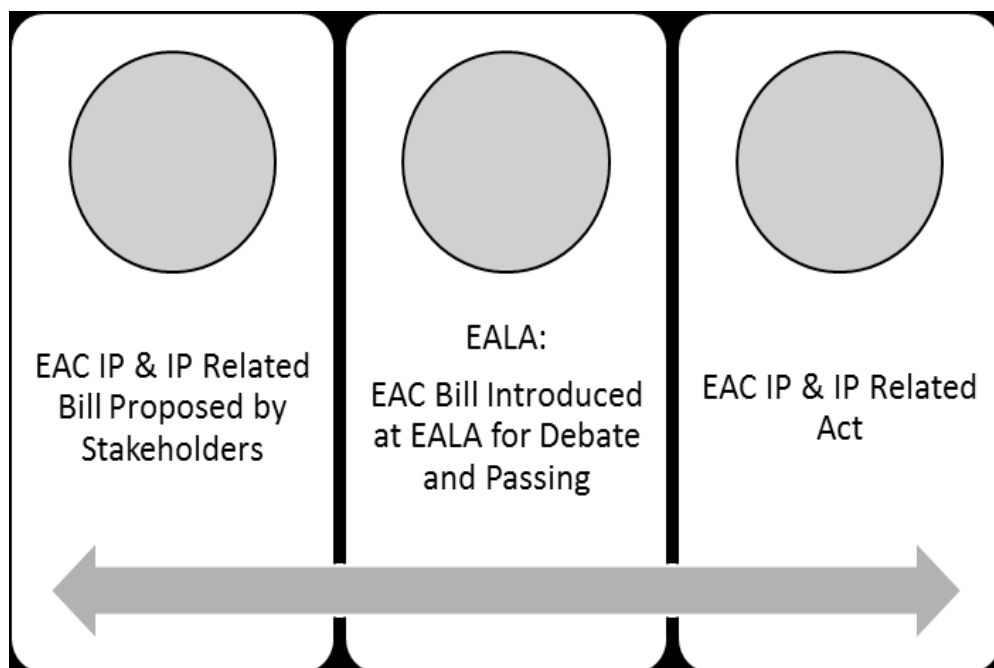
### **10.3.1 LEGISLATIVE REFORMS IN EAC**

The EAC currently has no policy or law on IP. In spite of the express provisions found in the EAC Common Market Protocol requiring the Council of Ministers to issue Directives for co-operation in the administration, management and enforcement of IPRs, no such Directives have been forthcoming. However, a draft Anti-Counterfeit Bill has been developed but not passed due to, among other factors, a lack of evidence-based supporting material.

It is therefore proposed that the following are developed: an EAC IP Policy, an EAC IP law, model EAC IP Laws for partner states to benchmark with, and an EAC Anti-Counterfeit law. The proposed laws can either be prepared as Bills for enactment by EALA or as policy documents which will then guide the development of laws.

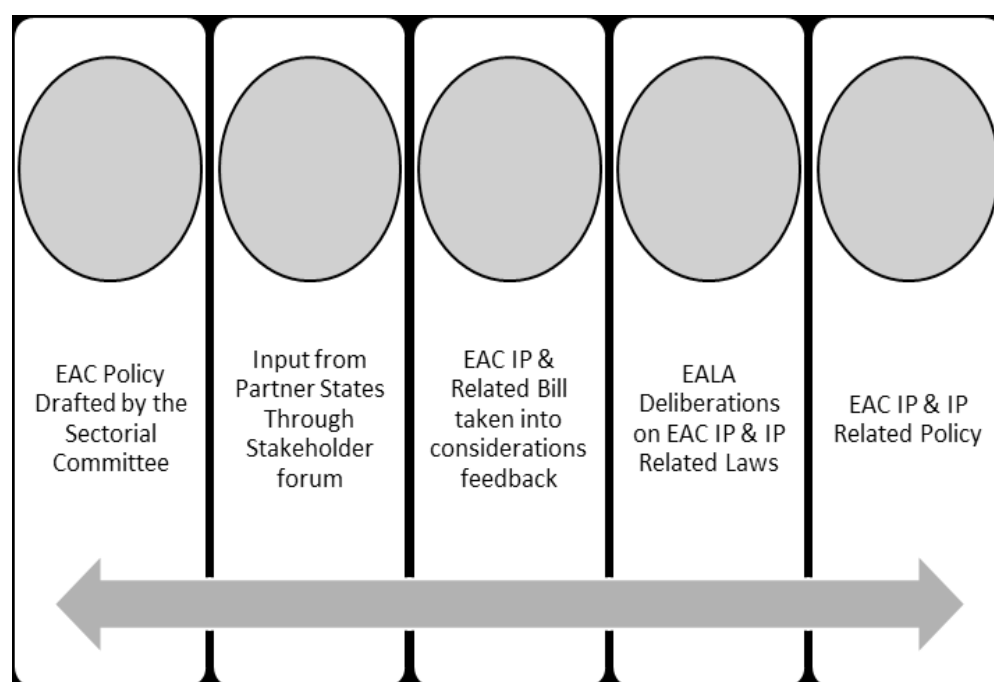
The following diagrams illustrate the processes that can be adopted to implement this recommendation.

### Proposed IP & IP Related Laws for Administration of Regional IP Regimes



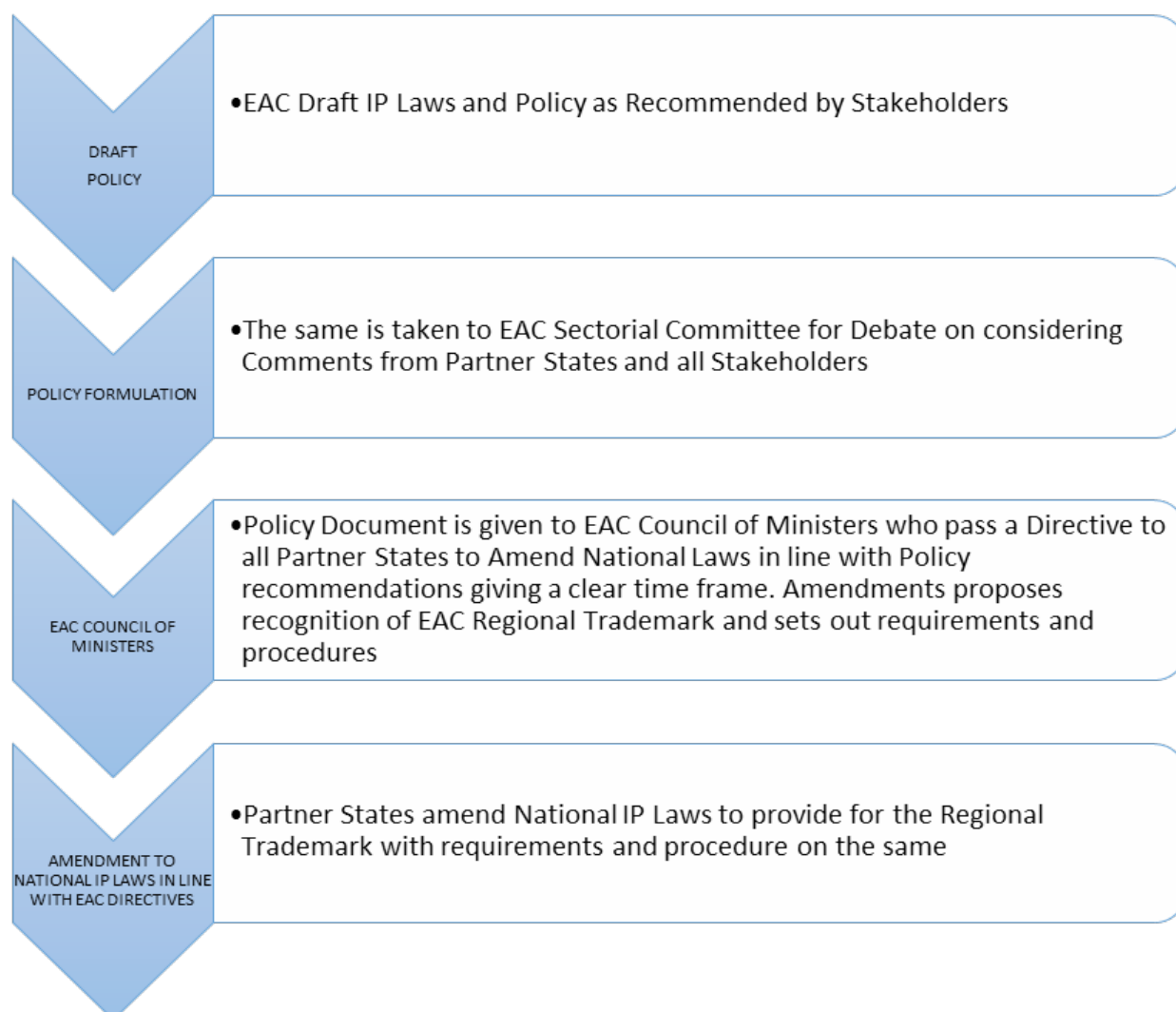
The advantage of this method is that it is faster as the Bill is drafted and introduced at the parliament for debate and passing. Its downside is that it may not have full ownership of all entities involved such as institutions. This method does not have as a pre-requisite the existence of a policy and therefore may not be attractive.

### Option One (b):- EAC IP Law Through the Sectoral Committee



The advantage of this method is that the proposed legislative reforms are drawn from a policy and is also consultative through the stakeholder forums.

**Option One (a): EAC IP Law Directly Through EALA**  
**Option Two: EAC IP Law through Amending and Harmonising National IP Laws**



A draft policy is introduced to the relevant sectoral committee which shall then discuss and recommend the same to the EAC Council of Ministers. The Council can then issue directives regarding measures for implementation at the national level. The advantage of this option is that it is inclusive as it includes most stakeholders. It is also free of political interference as it is not subjected to the legislative process. It is faster than option 1 (b).

### 10.3.2 Regional Collaborations

There is currently no formal mechanism bringing together the IP offices of the six Partner States for purposes of discussing common issues of concern.

It is therefore recommended that there should be greater collaboration among all the national IP offices in the region. This would involve regional information sharing through established data bases amongst the national IP offices. It would also involve concluding regional MOUs and collaborative agreements to give effect to the provisions of the EAC Common Market Protocol. The MOUs could cover areas such as joint enforcement efforts, joint awareness efforts and the translation of IP resources into the national language of each partner state e.g. Kiswahili, French, Kinyarwanda.



### **10.3.3 Establishment of Regional IP Institutions**

The Study recommends the establishment of an EAC IP Training Institute and an EAC IP Office.

#### **The Proposed EAC IP Training Institute**

Given the lack of awareness, capacity and human resource in IPRs in EAC, it is recommended that a community IP Training Institute be set up to address the challenge of lack of capacity in national IP offices, lack of capacity across the justice chain amongst regulators, enforcers, lawyers, patent agents, police force, customs officers and the judiciary. The recommended institute would collaborate with WIPO on course content and have the objective of providing quality training to the above categories. The proposed institute should be autonomous, have authority to issue certificates and/or diplomas in IP and to receive income from fees paid by students in order to be self-sufficient.

The recommended institute should also be able to train other entities and charge a consultancy fee where it is involved in any such arrangement. Before one can be admitted as a patent agent, they would need to pass a basic patent drafting course offered by this institute.

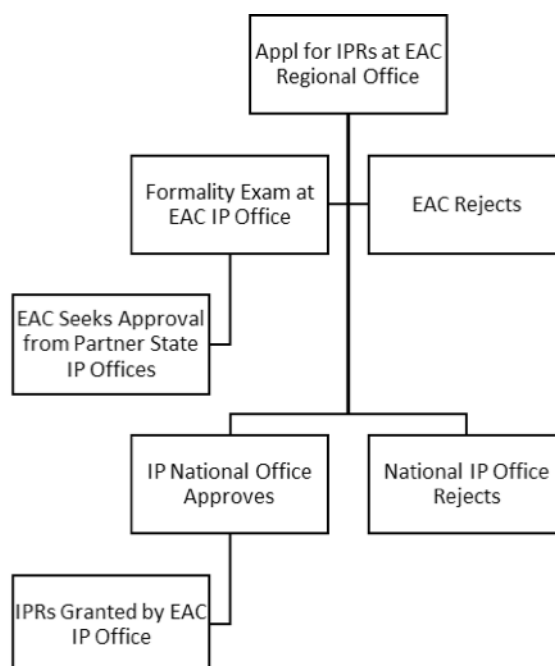
#### **The EAC Intellectual Property Office**

A number of stakeholders were of the view that an EAC regional office would enhance harmonization of IP in the region. The regional IP office would be charged with IP registration of regional nature for example where an applicant seeks to register their IP across all partner states with one filing, or where a party wishes to secure a regional mark. In the event an applicant wishes to secure IPR protection in all partner states with one filing, then the national IP law of the partner states will apply with the proposed regional office operating as the receiving and processing office.

An applicant may wish to register the proposed EAC regional mark, whereby with one filing, the applicant attains the EAC mark which is provided for and protected under the EAC IP laws. The EAC mark should be recognized under national laws. Though ARIPO and MADRID systems are in existence, the advantage in having an EAC mechanism is because it would be cheaper and faster to secure regional protection through the EAC than through the ARIPO system. An EAC mechanism would enhance visibility of the region as a strong IPR regime and therefore attract foreign investment. ARIPO does not provide for a regional mark such as “the ARIPO mark” thereby this system will further market the region in the global market.

Therefore, two options under which the regional office can be set up are recommended as follows:

**Option One: - Setting up the EAC IP Office modelled on the ARIPO system**



An application is filed with the regional office which then conducts a substantive examination of the application and seeks approval with the national IP office on granting or refusal. The mark is then granted or refused as applicable.

**Option Two:-**

Have an EAC IP Desk in each partner state, to handle regional registration under the EAC IP Act without establishing an EAC IP office.

**10.3.4 Proposed EAC Trade Mark**

It is recommended that a legal framework be put in place to create a regional mark known as the EAC regional mark in order to harmonize registration of trademarks and geographical indications. The recommendation is to amend national IP laws within the partner states to allow for the EAC regional mark. The filing and registration of the EAC regional mark would be handled through the EAC Regional office (proposed above) and if not, it would be handled through the EAC regional desk of every national IP office.

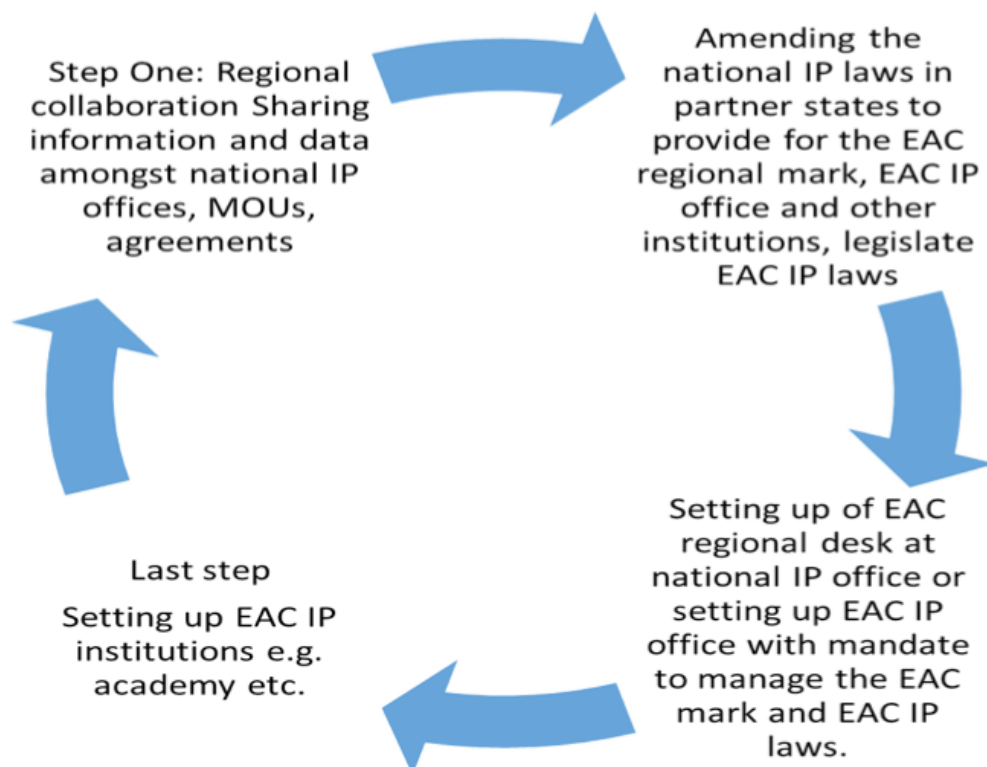
The proposal is that the EAC Mark would operate parallel to the national registrations such that, an IPR applicant can designate whether to undertake a national registration or a regional one. The EAC IP office (or EAC desk of the national IP office) would receive the application and once there is approval or no objection from the partner state registry then the mark would be granted.

The recommended EAC mark would apply for trademarks and geographical indications. The benefits of the EAC mark include allowing multiple protection in all partner states through a single filing filed online through the EAC IP Office/EAC desk of national IP office, granting its owner an exclusive

right in all current and future EAC Member and enhancing harmonized protection and enforcement of IPR.

### 10.3.5 EAC Regional Harmonization Action Plan

To enable regional harmonization of IPRs in the region, it is important to undertake regional harmonization efforts as hereunder:



## 10.4 CONCLUSION

IPRs are crucial in promoting innovation, industrialisation and creation of employment. All the Partner States of the EAC have individual territorial IP regimes established in line with international treaties and conventions. IP infringement and trade in substandard goods have adversely affected trade, human health, industrial growth and employment in the EAC. The industrial sector within EAC partner states has faced challenges in fighting trademark infringement because of lack harmonized legislative framework and IP institutional collaborations. This study, commissioned by the Kenya Association of Manufacturers aimed at looking at the IP rights regimes within the EAC to establish the status of the legal frameworks and to make recommendations for advocacy and policy formulation that promote protection and enforcement of IP in the region as a single territory.

The study established that all partner states of EAC except South Sudan are members of the WIPO. All of them have at least some sort of IP legislation or framework that governs IP regimes. All except Burundi and South Sudan, are members of the WTO and thus bound by the TRIPS Agreement. Kenya, Uganda, Tanzania and Rwanda are members of ARIPO though only Tanzania and Uganda are party to the Banjul Protocol for regional filing of trademark applications under ARIPO. Uganda has the highest number of IP laws but only industrial property and copyright have the necessary

institutional framework in place. South Sudan does not have any IP legislation. It still depends on the laws of the former larger Sudan.

In conclusion, all partner states of EAC need to work together on a common protocol akin to ARIPO Protocols or the EU that will establish a community IP office for protection, enforcement and fighting against counterfeit goods across the borders. The recommended IP Protocol should comprise provisions on administrative structure, capacity building, creation of awareness, promotion of innovation and impact of counterfeiting activities on the economy. In the meantime, all EAC partner states should accede to and domesticate salient international treaties on IP administered by WIPO, WTO and UPOV. In addition, all partner states should sign and domesticate ARIPO Protocols in order to harmonise their national IP legislations and related supporting framework.

## ANNEX I: STAKEHOLDERS VISITED IN KENYA

NO	IP STAKEHOLDER	MANDATE
1	Kenya Industrial Property Institute	Patents, Trademarks
2	Kenya Plant Health Inspectorate	Plant Breeders' Rights
3	JGIP Consultants	IP Consultant
4	National Council for Law Reporting	Legal Reports
5	Anti-Counterfeit Agency	Anti-counterfeit
6	Kenya Bureau of Standards	Standardization Marks
7	Riara Law School	Academia
8	Kenya Association of Music Producers	CMO
9	Performers Rights Society of Kenya	CMO
10	Kenya Private Sector Alliance	Private Sector
11	Kenya Association of Manufacturers	Manufacturers
12	Weights & Measures Department	Weights and Measurement
13	ILRI	Animal Research
14	Global Innovation Society-Kenya	Innovators Interest
15	Digital Society Kenya	ICT Member-based
16	Kenya Film Commission	Film
17	Kenya National Innovation Agency	Promotion of Innovation
18	High Court (Commercial Division)	Enforcement
19	Law Society of Kenya	IP Agent & Legal views
20	Kenya Law Reform Commission	Legal Reforms
21	Kenya Copyright Board	Copyright & Related Rights
22	Pharmacy and Poisons Board Kenya	Drug Regulation
23	KRA, Customs Border Control, Namanga	Border Measures
24	Music Copyright Society of Kenya	Musician views
25	The Judiciary- Commercial & Admiralty Division	Judiciary
26	Digital Broadcasters Association	Broadcasters

## ANNEX II: STAKEHOLDERS VISITED IN UGANDA

NO	STAKEHOLDER	MANDATE
1	Patent Registry	Patent Registration
2	Copyright Registry	Copyright Registration
3	Uganda Registration Services Bureau	Registration Trade Names
4	Commissioner, Law Reform	Law Reforms
5	High Court (Commercial Court Division)	Judiciary
6	Uganda National Bureau of Standards	Quality Control
7	Uganda Law Development Centre	Teaching
8	Uganda National Council for Science and Technology	Promotion of Science & Technology
9	Consultant, Trade Mark East Africa	IP Specialist
10	Uganda Police Force	Criminal Investigation
11	Private Sector Foundation Uganda	Private Sector
12	Investment facilitation and Aftercare Division	Trade
13	Uganda Investment Authority	Trade
14	Uganda Manufacturers Association	Manufacturing
15	Ministry of Trade, Industry and Co-operatives	Policy
16	Customs Supervisor in charge of International affairs	Border Measures
17	Lawyer, Uganda Revenue Authority	Border Measures
18	Intellectual Property Centre in Uganda	IPRs
19	Uganda Law Society	Legal



### ANNEX III: STAKEHOLDERS VISITED IN RWANDA

NO	STAKEHOLDER	MANDATE
1	Trust Law Chambers	Legal
2	Cedar Ark Law	Legal
3	Rwanda Revenue Authority	Border Measures
4	Ministry of Education	Policy
5	Integrated Polytechnic Regional Centre	Research
6	Rwanda Development Board	IP
7	P.S.F, East Africa Trade and Investment Hub Project, Private Sector Federation	Trade
8	Ministry of Justice	Legislative Drafting
9	K-Solutions & Partners, Rwanda Bar Association	IP Attorney
10	Culture Unit, Ministry of Sports and Culture	Policy
11	Rwanda Society of Authors	CMO
12	Ministry of Trade and Industry	Policy
13	Rwanda Manufacturers Association	Trade

**ANNEX IV: STAKEHOLDERS VISITED IN TANZANIA**

NO	STAKEHOLDER	MANDATE
1.	BRELA	IP Administration
2.	Confederation of Tanzania Industries	Policy and Advocacy communications specialists
3.	FCC Tribunal	Anti-counterfeit Services
4.	Tanganyika Law Society	Legal
5.	School of Engineering, University of Dar es Salaam	Research and Innovation
6.	East African Community	Legal Policy
7.	Tanzania Commission for Science and Technology	Science and Technology Policy
8.	Legal Unit, Tanzania Bureau of Standards	Quality Control
9.	Tanzania Chamber of Commerce, Industry & Agriculture	Trade
10.	Legal Counsel, Tanzania Food and Drug Authority	Quality Control
11.	Competition and Market Research, Fair Competition Commission	
12.	Inventor, Advocate & Trademark Agent, Mwema Advocates	IP Agent
13.	Small Industries Development Organisation	Promotion of SMEs Incubations
14.	Copyright Society of Tanzania	Copyright & CMO

## ANNEX V - STATUS OF COMPLIANCE WITH INTERNATIONAL TREATIES

NO	TREATY/PROTOCOL	KE <sup>1</sup>	UG	TZ	RW	BR	SS
1	WTO-TRIPS Agreement	√ <sup>2</sup>	√	√	√	√	-
2	Paris Convention for the Protection of Industrial Property	√	√	√	√	√	-
3	Berne Convention for the Protection of Literary and Artistic Works	√	- <sup>3</sup>	√	√	√	-
4	WIPO Copyright Treaty	-	-	-	-	√	-
5	Madrid System for Marks	√	-	√	√	-	-
6	Lusaka Agreement for Creation of ARIPO	√	√	√	√	-	-
7	ARIPO - Harare Protocol on Patents and Industrial Designs	√	√	√	√	-	-
8	ARIPO - Banjul Protocol on Marks	-	√	√	-	-	-
9	ARIPO - Swakopmund Protocol on Traditional Knowledge and Expressions of Folklore	-	-	-	-	-	-
10	EAC Treaty	√	√	√	√	√	√
11	Constitutive Act of African Union	√	√	√	√	√	√
12	COMESA Treaty	√	√	-	√	√	-
13	Nagoya Protocol on ABS	√	√	√	√	√	√
14	World Customs Organisation (WCO)	√	√	√	√	√	√
15	Hague Agreement on International Reg IDs	-	-	-	√	-	-
16	Nice Agreement on Classification of Marks	-	-	-	-	-	-
17	Brussels Satellite Convention	√	-	-	-	-	-
18	World Customs Convention (WCO)	√	√	√	√	-	-
19	Union on Plant Variety Protection (UPOV)	√	√	√	-	-	-
20	Budapest Treaty on Microorganisms	-	-	-	-	-	-

## ANNEX VI: QUESTIONNAIRE

### KAM STUDY ON IPR AND TRADEMARK LEGISLATION IN THE EAC REGION

#### Implementers' questionnaire

##### Section A: Bio Data

1. Name.....  
Ministry/Department/Organisation.....  
Designation.....

##### Section B: Knowledge or Understanding IPR legislation

2. Do you know what Intellectual Property Rights mean?
3. (a): Do you know any types of Intellectual Property Rights.
  1. Yes
  2. No(b): Please explain your answer above  
.....  
.....  
.....  
(c) What laws do you know that cover IPR?  
.....  
.....  
.....  
.....  
.....
4. What is the current IP legal and institutional framework in the country and or the region?  
.....  
.....  
.....  
.....
5. (a): Please mention the role your ministry/department/organization is expected to play in formulation of law and policy on IPR and implementation of IP laws.  
.....  
.....  
.....  
(b): please list what your ministry/department/organization has done so far in the formulation of policy & laws on IPR and implementation of IP laws. ....  
.....  
.....

6. (a): have you encountered any challenges/obstacles in the implementation of the IP laws.
  1. Yes
  2. No
 (b) What are the key challenges and/or obstacles that you have encountered in implementing IP laws?  
 .....  
 .....  
 .....  
 (c) Suggest ways in which these challenges and/or obstacles should be addressed  
 .....  
 .....  
 .....
7. How would you describe the relationship between the existing agencies and do you have any recommendations on improving collaboration
8. What is the level of activity in intellectual property? To what would you attribute the level of activity
9. Have you benefited from any training or orientation on IP laws?  
 .....  
 .....  
 .....  
 If yes who provided such training or orientation?  
 .....  
 .....  
 .....
10. Do you think there is need to harmonise IP laws in the region?  
 .....  
 .....  
 .....  
 If yes, in what way?  
 .....  
 .....  
 .....
11. What in your opinion is the role of IPRs in trade nationally and in the region?  
 .....  
 .....  
 .....

Do you have any cross border mechanisms in place to collaborate on IP related issues; eg. enforcement, training, information sharing

12: What Impact will curbing illicit trade have on our region's economy?

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

### Conclusion

What regulations do you think are necessary to better implement the IP laws in the region?

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

What is your opinion in having an EAC law on IP?

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

In addition to regulations, what are the other issues that you think need to be addressed to curb the vice of illicit trade?

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

13. Are the current IP Regulations sufficient to curb illicit trade in the region, or is there need for improvement?

14. Are there challenges faced with enforcement of IP Regulations in your country?

15. Are there adequate institutions in your view to implement IP Regulation in your country?

---

1 KE – Kenya, TZ – Tanzania, UG – Uganda, RW – Rwanda, BR – Burundi, SS – South Sudan

2 Member State (✓)

3 Non-member State (-)



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