



LAWS OF KENYA



## **INDUSTRIAL PROPERTY ACT**

No. 3 of 2001

Revised Edition 2012 [2001]

Published by the National Council for Law Reporting  
with the Authority of the Attorney-General

[www.kenyalaw.org](http://www.kenyalaw.org)



**NO 3 OF 2001**

**INDUSTRIAL PROPERTY ACT**

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## NO 3 OF 2001

## INDUSTRIAL PROPERTY ACT

[Date of assent: 27th July, 2001.]

[Date of commencement: 1st May, 2002.]

**An Act of Parliament to provide for the promotion of inventive and innovative activities, to facilitate the acquisition of technology through the grant and regulation of patents, utility models, technovations and industrial designs, to provide for the establishment, powers and functions of the Kenya Industrial Property Institute and for purposes incidental thereto and connected therewith**

[L.N. 38/2002; Act No. 2 of 2002, Act No. 7 of 2007.]

## PART I – PRELIMINARY

**1. Short title**

This Act may be cited as the Industrial Property Act, 2001.

**2. Interpretation**

In this Act, unless the context otherwise requires—

“**application**” means an application under this Act for the grant of—

- (a) a patent;
- (b) a certificate of utility model or technovation; or
- (c) registration of an industrial design.

“**ARIPO**” means the African Regional Industrial Property Organisation;

“**ARIPO Protocol**” means the protocol on patents and industrial designs adopted at Harare on December 10, 1984;

“**Assistant Managing Director**” means the Assistant Managing Director appointed under section 12;

“**Board**” means the Board of Directors of the Kenya Industrial Property Institute constituted under section 6;

“**Court**” means the High Court of Kenya;

“**Deputy Managing Director**” means a Deputy Managing Director appointed under section 12;

“**examiner**” means an examiner appointed under section 12;

“**former Office**” means the Kenya Industrial Property Office existing immediately before the commencement of this Act;

“**industrial design**” has the meaning assigned to it in section 84;

“**Industrial Property Journal**” means a journal published by the Institute mainly for the purpose of advertising industrial property applications and for publishing other matters required to be published under the Act;

“**industrial property rights**” mean rights under patents, certificates of utility models and include technovation and registration of industrial designs issued under this Act;

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

“**Institute**” means the Kenya Industrial Property Institute established under section 3;

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

“**international classification**” as regards industrial designs, means classification in accordance with the Locarno Agreement of October, 1968, establishing an international classification for industrial designs;

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

“**inventor**” means the person who actually devises the invention as defined in section 21 and includes the legal representative of the inventor;

“**licence contract**” means a contract or agreement by which a person grants permission to use his industrial property rights;

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

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

“**Managing Director**” means the Managing Director of the Institute appointed under section 11;

“**Minister**” means the Minister for the time being responsible for matters relating to the Institute;

“**National Council for Science and Technology**” means the Council established by section 3 of the Science and Technology Act (Cap. 250);

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

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

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

“**regulations**” means regulations made under this Act;

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



“**Tribunal**” means the Industrial Property Tribunal established under section 113;

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

## PART II – ADMINISTRATION

### 3. Establishment and incorporation of the Institute

There is established an institute to be known as the Kenya Industrial Property Institute which shall be a body corporate with perpetual succession and a common seal and shall be capable, in its corporate name, of—

- (a) suing and being sued;
- (b) taking, purchasing or otherwise acquiring, holding, charging or disposing of movable and immovable property;
- (c) borrowing and lending money; and
- (d) charging fees for services rendered by it;
- (e) entering into contracts;
- (f) doing or performing all such other things or acts necessary for the proper performance of its functions under this Act which may lawfully be done by a body corporate.

### 4. Headquarters

The Headquarters of the Institute shall be in Nairobi.

### 5. Functions of the Institute

The functions of the Institute shall be to—

- (a) consider applications for and grant industrial property rights;
- (b) screen technology transfer agreements and licences;
- (c) provide to the public, industrial property information for technological and economic development; and
- (d) promote inventiveness and innovativeness in Kenya.

### 6. Boards of Directors

There shall be a Board of Directors for the Institute which shall consist of—

- (a) a chairman appointed by the Minister, who shall be the holder of a degree in law or science and with at least seven years' experience in matters relating to industrial property;
- (b) the Permanent Secretary in the Ministry for the time being responsible for matters relating to Industrial Property or his representative;

- (c) the Permanent Secretary in the Ministry for the time being responsible for matters relating to Finance or his representative;
- (d) the Permanent Secretary in the Ministry for the time being responsible for matters relating to Industrial Development or his representative;
- (e) the Secretary to the National Council for Science and Technology;
- (f) the Attorney-General or his representative;
- (g) eight other members appointed by the Minister seven of whom shall be nominated as follows—
  - (i) one representative nominated by Kenya Industrial Research Development Institute;
  - (ii) one representative nominated by Kenya Association of Manufacturers;
  - (iii) one representative nominated by the Law Society of Kenya;
  - (iv) one representative nominated by the Kenya Medical Research Institute;
  - (v) a renowned research scientist from the public universities appointed by the Minister for the time being in charge of education;
  - (vi) one representative nominated by the Institution of Kenya Engineers;
  - (vii) one representative nominated by the Jua Kali Association;
- (h) the Managing Director appointed under section 11;
- (i) the Chief Executive of the Kenya Association of Manufacturers or his representative.

[Act No. 7 of 2007, Sch.]

## **7. Functions and powers of the Board**

The Board shall have all powers necessary for the proper performance of its functions under this Act and in particular but without prejudice to the generality of the foregoing, the Board shall have power to—

- (a) control, supervise and administer the assets of the Institute in such manner as best promotes the purpose for which the Institute is established;
- (b) determine the provisions to be made for capital and recurrent expenditure and for reserves of the Institute;
- (c) receive any grants, gifts, donations or endowments on behalf of the Institute and make legitimate disbursements therefrom;
- (d) enter into association with other bodies or organizations within or outside Kenya as the Board may consider desirable or appropriate and in furtherance of the purpose for which the Institute is established;
- (e) open a banking account or banking accounts for the funds of the Institute; and

- (f) invest any funds of the Institute not immediately required for its purposes in the manner provided in section 20.

#### **8. Conduct of business and affairs of the Board**

(1) The conduct and regulation of the business and affairs of the Board shall be as provided in the affairs of the First Schedule.

(2) Except as provided in the First Schedule, the Board may regulate its own procedure.

#### **9. Remuneration of Board members**

The Board shall pay members of the Board such remuneration, fees, or allowances for expenses as it may determine after consultation with the Minister for the time being responsible for Finance.

#### **10. Delegation by the Board**

The Board may, by resolution either generally or in any particular case, delegate to any committee of the Board or to any member, officer, employee or agent of the Institute, the exercise of any of the powers or the performance of any of the functions or duties of the Board under this Act or under any other written law.

#### **11. Managing Director**

(1) There shall be a Managing Director of the Institute who shall be appointed by the Board and whose terms and conditions of service shall be determined by the Board in the instrument of appointment or otherwise in writing from time to time.

(2) No person shall be appointed under this section unless such person—

- (a) has a university degree in law, science, information technology or business administration from a recognised university; and
- (b) has at least seven years' working experience in matters relating to industrial property.

(3) The Managing Director shall—

- (a) be an *ex-officio* member of the Board but shall have no right to vote at any meeting of the Board;
- (b) be the secretary to the Board; and
- (c) subject to the directions of the Board, be responsible for the day to day management of the affairs of the Institute.

[Act No. 7 of 2007, Sch.]

#### **12. Staff of the Institute**

The Board may appoint such Deputy Managing Directors, Assistant Managing Directors, examiners and such officers or other staff of the Institute as are necessary for the proper discharge of its functions under this Act or any other written law, upon such terms and conditions of service as the Board may determine.

**13. The Common seal of the Institute**

(1) The common seal of the Institute shall be kept in such custody as the Board may direct and shall not be used except on the order of the Board.

(2) The common seal of the Institute when affixed to a document and duly authenticated shall be judicially and officially noticed and unless and until the contrary is proved, any necessary order or authorisation by the Board under this section shall be presumed to have been duly given.

**14. Protection from personal liability**

No matter or thing done by a member of the Board or any officer, employee or agent of the Institute shall, if the matter or thing is done *bona fide* for executing the functions, powers or duties of the Institute, render the member, officer, employee or agent or any person acting on his directions personally liable to any action, claim or demand whatsoever.

**15. Liability of the Board for damages**

The provisions of section 14 shall not relieve the Institute of the liability to pay compensation or damages to any person for an injury to him, his property or any of his interests caused by the exercise of the powers conferred on the Board by this Act or by any other written law or by the failure, whether wholly or partially, of any works.

**16. Funds of the Institute**

(1) The funds of the Institute shall comprise of—

- (a) such sums as may be granted to the Institute by the Minister pursuant to subsection (2);
- (b) such monies or assets as may accrue to or vest in the Institute in the course of the exercise of its powers or the performance of its functions under this Act or under any other written law; and
- (c) all monies from any other source provided for or donated or lent to the Institute.

(2) There shall be made to the Institute, out of monies provided by Parliament for that purpose, grants towards the expenditure incurred by the Institute in the exercise of its powers or the performance of its functions under this Act.

**17. Financial year**

The financial year of the Institute shall be the period of twelve months ending on the thirtieth June in each year.

**18. Annual estimates**

(1) At least three months before the commencement of each financial year, the Board shall cause to be prepared estimates of the revenue and expenditure of the Institute for that year.

(2) The annual estimates shall make provision for all estimated expenditure of the Institute for the financial year and in particular, the estimates shall provide for—

- (a) the payment of the salaries, allowances and other charges in respect of the staff of the Institute;
- (b) the payment of pensions, gratuities and other charges in respect of the staff of the Institute;
- (c) the proper maintenance of the buildings and grounds of the Institute;
- (d) the maintenance, repair and replacement of the equipment and other property of the Institute; and
- (e) the creation of such reserve funds to meet future or contingent liabilities in respect of retirement benefits, insurance or replacement of buildings or equipment, or in respect of such other matter as the Board may deem appropriate.

(3) The annual estimates shall be approved by the Board before the commencement of the financial year to which they relate and shall be submitted to the Minister for approval and after the Minister's approval, the Board shall not increase the annual estimates without the consent of the Minister.

#### **19. Accounts and audit**

(1) The Board shall cause to be kept all proper books, and records of accounts of the income, expenditure and assets of the Institute.

(2) Within a period of four months from the end of each financial year, the Board shall submit to the Auditor-General (Corporations) or to an auditor appointed under this section, the accounts of the Institute together with—

- (a) a statement of the income and expenditure of the Institute during that year; and
- (b) a balance sheet of the Institute on the last day of that year.

(3) The accounts of the Institute shall be audited and reported upon in accordance with sections 29, 30A of the Exchequer and Audit Act (Cap. 412), by the Auditor-General (Corporations), or by an auditor appointed by the Board with the approval of the Auditor-General (Corporations) given in accordance with section 29(2)(b) of the Exchequer and Audit Act.

#### **20. Investment of funds**

(1) The Board may invest any of the funds of the Institute in securities in which for the time being trustees may by law invest trust funds, or in any other securities which the Treasury may, from time to time, approve for that purpose.

(2) The Board may, subject to the approval of the Treasury, place on deposit with such bank or banks as it may determine, any monies not immediately required for the purposes of the Institute.

### **PART III – PATENT: PATENTABILITY**

#### **21. Meaning of “invention”**

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

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

(3) The following shall not be regarded as inventions and shall be excluded from patent protection—

- (a) discoveries, scientific theories and mathematical methods;
- (b) schemes, rules or methods for doing business, performing purely mental acts or playing games;
- (c) methods for treatment of the human or animal body by surgery or therapy, as well as diagnostic methods practised in relation thereto, except products for use in any such methods;
- (d) mere presentation of information; and
- (e) public health related methods of use or uses of any molecule or other substance whatsoever used for the prevention or treatment of any disease which the Minister responsible for matters relating to Health may designate as a serious health hazard or as a life threatening disease.

## **22. Patentable inventions**

An invention is patentable if it is new, involves an inventive step, is industrially applicable or is a new use.

## **23. Novelty**

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

(2) For the purposes of this Act, everything made available to the public anywhere in the world by means of written disclosure (including drawings and other illustrations) or, by oral disclosure, use, exhibition or other non-written means shall be considered prior art:

Provided that such disclosure occurred before the date of filing of the application or, if priority is claimed, before the priority date validly claimed in respect thereof.

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

(4) For the purposes of subsection (2), a disclosure of the invention shall not be taken into consideration if it occurred not earlier than twelve months before the filing date or, where applicable, the priority date of the application and if it was by reason or in consequence of—

- (a) acts committed by the applicant or his predecessor in title; or
- (b) an evident abuse committed by a third party in relation to the applicant or his predecessor in title.

**24. Inventive step**

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

**25. Industrial application**

An invention shall be considered industrially applicable if, according to its nature, it can be made or used in any kind of industry, including agriculture, medicine, fishery and other services.

**26. Non-patentable inventions**

The following shall not be patentable—

- (a) plant varieties as provided for in the Seeds and Plant Varieties Act (Cap. 326), but not parts thereof or products of biotechnological processes; and
- (b) inventions contrary to public order, morality, public health and safety, principles of humanity and environmental conservation.

**27. Information prejudicial to defence of Kenya or safety of public**

(1) Where an application for a patent is filed with the Institute under this Act or under any international convention to which Kenya is a party, and it appears to the Managing Director that the application contains information of a description notified to him by the Minister responsible for Defence or the concerned Minister as being information the publication of which might be prejudicial to the defence of Kenya, the Managing Director may give directions prohibiting or restricting the publication of that information or its communication to any specified person or persons.

(2) If it appears to the Managing Director that any application so filed contains information the publication of which might be prejudicial to the safety of the public, he may give directions prohibiting or restricting the publication of that information or its communication to any specified person or persons until the end of a period not exceeding three months from the end of the period prescribed for the purposes of section 42.

(3) Where directions under this section are in force with respect to any application—

- (a) if the application is made under this Act, it may be processed to the stage where it is in order for the grant of a patent, but shall not be published and any information relating thereto shall not be communicated and no patent shall be granted in pursuance of the application;
- (b) if it is an application for an ARIPO patent, it shall not be sent to the ARIPO Office; and
- (c) if it is an international application for a patent, a copy thereof it shall not be sent to the International Bureau or to any international searching authority appointed under the Patent Co-operation Treaty.

(4) Where the Managing Director gives instructions under this section with respect to any application, he shall give notice of the application and of the directions to the Minister responsible for Defence or the concerned Minister and the following provisions shall then have effect—

- (a) the Minister responsible for Defence or the concerned Minister shall, on receipt of the notice, consider whether the publication of the application or the publication or communication of the information in question would be prejudicial to the defence of Kenya or the safety of the public;
- (b) if the Minister responsible for Defence or the concerned Minister determines that the publication of the application or the publication or communication of the information would be prejudicial to the safety of the public, he shall notify the Managing Director, who shall continue his directions under subsection (2) until they are revoked under paragraph (e);
- (c) if the Minister responsible for Defence or the concerned Minister determines that the publication of the application, or the publication or communication of the information would be prejudicial to the Defence of Kenya or the safety of the public, he shall (unless a notice under paragraph (d) has previously been given by the Minister responsible for Defence or the concerned Minister to the Managing Director) reconsider that question during the period of nine months from the date of filing the application and at least once in every subsequent period of twelve months;
- (d) if on the consideration of an application at any time it appears to the Minister responsible for defence or the concerned Minister that the publication of the application, or the publication or communication of the information, contained in it would not, or would no longer, be prejudicial to the defence of Kenya or the safety of the public, he shall give notice to the Managing Director to that effect; and
- (e) on receipt of a notice under paragraph (d), the Managing Director shall revoke the directions and may, subject to such conditions as he may deem fit, extend the time for doing anything required or authorised to be done by or under this Act in connection with the application, whether or not that time had previously expired.

(5) The Minister responsible for Defence or the concerned Minister may, in determining a question under paragraph (c) of subsection (4)—

- (a) at any time after, or, with the consent of the applicant, before the expiry of the period prescribed for the purposes of section 42, consider the application and any documents submitted in relation thereto; or
- (b) where the application contains information relating to the production or use of atomic energy or research into matters connected with such production or use, authorise the National Council for Science and Technology to study the application and any documents sent to the Managing Director in connection therewith and report to him as soon as reasonably practicable on the utility or otherwise of the patent applied for.



(6) Where directions have been given under this section in respect of an application for a patent for an invention and the period prescribed in relation thereto expires, and while such directions are still in force, an application is brought for the grant of a patent, then—

- (a) if while the directions are in force, the invention is used by or with the written authorization of or on the order of a Government Ministry, Department or agency, the provisions of section 80 shall apply as if—
  - (i) the use was made pursuant to the provisions of that section;
  - (ii) the application had been published at the end of that period; and
  - (iii) a patent had been granted for the invention at the time the application is brought for the grant of a patent (taking the terms of the patent to be those of the application as at the time it was so brought); and
- (b) if it appears to the Minister responsible for Defence or the concerned Minister that the applicant for the patent has suffered hardship by reason of the continuation in force of the directions, he may, with the consent of the Ministry responsible for Finance, make such payment by way of compensation to the applicant, as appears to be reasonable having regard to the inventive merit and utility of the invention, the purpose for which it is designed and any other relevant circumstances.

(7) If the applicant is dissatisfied with the amount of compensation paid to him under subsection (6), he may appeal to the Tribunal.

(8) Where a patent is granted in pursuance of an application in respect of which directions have been given under this section, no renewal fees shall be payable in respect of any period during which those directions remain in force.

(9) A person who fails to comply with any direction under this section shall be liable, on conviction, to imprisonment for a term not exceeding two years, or to a fine not exceeding twenty thousand shillings, or to both.

## **28. Restriction on applications abroad by Kenya residents**

(1) Subject to the provisions of this section, no person resident in Kenya shall, without written authority granted by the Managing Director, file or cause to be filed outside Kenya, an application for a patent for invention, unless—

- (a) an application for a patent for the same invention has been filed with the Institute not less than six weeks before the filing of the application outside Kenya; and
- (b) either no directions have been given under section 27 in relation to the application in Kenya or any such directions have been revoked.

(2) Subsection (1) shall not apply to an application for a patent for an invention in respect of which an application for a patent has first been filed in a country outside Kenya by a person resident outside Kenya.

(3) A person who files or causes to be filed an application for the grant of a patent in contravention of this section shall be liable on conviction, to a fine not exceeding two hundred thousand shillings, or to imprisonment for a term not exceeding two years, or to both.

(4) In this section—

- (a) any reference to an application for a patent includes a reference to an application for other protection for an invention;
- (b) any reference to either kind of application is a reference to an application under this Act, under the law of any country other than Kenya or under any international treaty or convention to which Kenya is a party.

## **29. Patents relating to living matter**

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

- (a) a culture of the micro-organism has been deposited with a depository institution not later than the date of filing of the application;
- (b) the application as filed gives such relevant information as is available to the applicant on the characteristics of the micro-organism; and
- (c) the depository institution and the file number of the culture deposit are stated in the application.

(2) The information referred to in paragraph (b) of subsection (1) may be submitted within a period of sixteen months after the date of filing of the application or, if priority is claimed, after the priority date.

(3) The deposited culture shall be made available upon request of any person having the right to inspect the files.

(4) If a deposited micro-organism ceases to be available from the institution with which it was deposited because—

- (a) the micro-organism is no longer viable; or
- (b) for any other reason the depository institution is unable to supply samples, and if the micro-organism has not been transferred to another depository institution from which it continues to be available, an interruption in availability shall not be deemed to have occurred if a new deposit of the micro-organism originally deposited is made within a period of three months from the date on which the depositor was notified of the interruption by the depository institution and a copy of the receipt of the deposit issued by the institution is forwarded to the Institute within four months from the date of the new deposit stating the number of the application or of the patent.

(5) A new deposit shall be accompanied by a statement signed by the depositor indicating that the newly deposited micro-organism is the same as originally deposited.

#### PART IV – RIGHT TO INVENTIONS AND NAMING OF INVENTOR

### 30. Right to a patent

(1) Subject to this section, the right to a patent shall belong to the inventor.

(2) If two or more persons have jointly made an invention the right to the patent shall belong to them jointly.

(3) If and to the extent to which two or more persons have made the same invention independently of each other, the person whose application has the earliest filing date, or if priority is claimed, the earliest validly claimed priority date that leads to the grant of a patent shall have the right to the patent.

(4) The right to a patent may be assigned or may be transferred by succession.

(5) Sections 64 to 80 shall apply *mutatis mutandis* to contracts assigning the right to a patent.

### 31. Unauthorized application based on an invention of another person

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

### 32. Inventions made in execution of commission or by employee

(1) Notwithstanding section 30 and in the absence of contractual provisions to the contrary, the right to a patent for an invention made in execution of a commission or of an employment contract shall belong to the person having commissioned the work or to the employer:

Provided that where the invention is of exceptional importance the employee shall have a right to equitable remuneration taking into consideration his salary and the benefit derived by the employer from the said invention.

(2) The provisions of subsection (1) shall apply where an employment contract does not require the employee to exercise any inventive activity but when the employee has made the invention by using data or means available to him during his employment.

(3) In the circumstances provided for in subsection (2), the employee shall have a right to equitable remuneration taking into account his salary, the importance of the invention and any benefit derived from the invention by the employer.

(4) In the absence of agreement between the parties, the remuneration shall be fixed by the Tribunal.

(5) Inventions made without any relation to an employment or service contract and without the use of the employer's resources, data, means, materials, installations or equipment shall belong solely to the employee or the person commissioned.

(6) This section shall, where relevant, apply directly or indirectly to governmental and other organizations.

### **33. Naming of inventor**

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

## **PART V – APPLICATION, GRANT AND REFUSAL OF GRANT OF PATENT**

### **34. Application**

(1) An application for a patent shall be filed with the Managing Director and shall contain—

- (a) a request;
- (b) a description;
- (c) one or more claims;
- (d) one or more drawings (where necessary); and
- (e) an abstract.

(2) Where the applicant's ordinary residence or principal place of business is outside Kenya, he shall be represented by an agent who shall be a citizen of Kenya admitted to practice before the Institute.

(3) The request shall state the name of, and prescribed data concerning the applicant, the inventor and the agent, if any, and the title of the invention; and where the applicant is not the inventor the request shall be accompanied by a statement justifying the applicant's right to the patent.

(4) The appointment of an agent shall be indicated by the designation of the agent in the request or by furnishing a power of attorney signed by the applicant and, where subsection (2) applies, the agent shall be designated in the request.

(5) The description shall disclose the invention and at least one mode for carrying out the invention, in such full, clear, concise and exact terms as to enable any person having ordinary skills in the art to make use and to evaluate the invention and that description shall include any drawing and relevant deposits as in the case of micro-organisms and self-replicable material which are essential for the understanding of the invention.

(6) The claim or claims shall define the matter for which protection is sought and shall be clear and concise and fully supported by the description.

(7) The abstract shall merely serve the purpose of technical information; in particular, it shall not be taken into account for the purpose of interpreting the scope of the protection sought.

(8) The details of the requirements with which the application must comply shall be prescribed by the regulations made under this Act.

### **35. Unity of inventions**

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

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

(3) The fact that a patent has been granted on an application that did not comply with the requirements of unity of invention shall not be a ground for the invalidation or revocation of the patent.

### **36. Amendment and division of application**

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

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

### **37. Right of priority**

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

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

### **38. Information concerning corresponding foreign applications and grants**

(1) At the request of the Managing Director, the concerning applicant shall furnish him with the date and corresponding number of any application for a patent or other foreign applications title of protection filed by the applicant with a national industrial property office of another country or with a regional industrial property office (in this Act referred to as a "foreign application"), relating to the same invention as that claimed in the application filed with the Managing Director.

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

- (a) copies of any communication received by the applicant concerning the results of any search or examination carried out in respect of the foreign application;
- (b) a copy of the patent or other title of protection granted on the foreign application; and

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

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

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

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

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

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

### **39. Payment of fees**

(1) The application shall be subject to the payment of the prescribed fees.

(2) The Board may waive whole or part of the fees in the manner and in the circumstances as may be prescribed.

### **40. Withdrawal of application**

The applicant may withdraw the application at any time before the grant of a patent or the notification of rejection of the application or of refusal to grant a patent.

### **41. Filing date and examination of application as to form, etc.**

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

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

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

(3) If, the applicant complies with the invitation referred to in subsection (2), the Managing Director shall accord as filing date the date of receipt of the required correction; otherwise he shall treat the application as if it had not been filed.

(4) Where the application refers to drawings which are not included in the application, the Managing Director shall invite the applicant to furnish the missing drawings, and, if the applicant complies with the invitation, the Managing Director

shall accord as the filing date the date of receipt of the missing drawings; otherwise he shall accord as the filing date the date of receipt of the application and shall treat any reference to the drawings as non-existent.

(5) Where no invitation under subsections (2) and (4) was sent to the applicant and the applicant nevertheless files a correction, pertaining to any of the requirements under subsection (1), to his application, the Managing Director shall accord as filing date the date of receipt of the correction, provided that the correction was received within thirty days from the date of application.

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

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

- (a) the request does not comply with the requirements of section 34(3) and the rules pertaining thereto;
- (b) the description, the claims and, where applicable, the drawings do not comply with the physical requirements prescribed by the regulations;
- (c) the application does not contain an abstract;
- (d) the applicant has not complied with a request of the Managing Director under section 38; or
- (e) the fees referred to in section 39 have not been paid as provided for in the regulations or the payment of such fees has been waived under that section.

(8) If the Managing Director finds any of the defects referred to under subsection (7), he shall invite the applicant to remedy such defects provided that any corrections made to the application shall not be such that they would require a change of the filing date and if the applicant does not comply with the invitation, the application shall be rejected by the Managing Director.

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

#### **42. Publication of application**

(1) The Managing Director shall publish the application as soon as possible after the expiration of eighteen months from the filing date or, where priority is claimed, the date of priority.

(2) For the purposes of subsection (1), in the case of applications claiming priority, the term of eighteen months shall be construed from the original filing date and in the case of applications with two or more priority claims, the period shall be construed from the earliest priority dates.

(3) The publication of the patent application shall be effected by publishing the particulars set out in the regulations, in the *Kenya Gazette* or in an Industrial Property Journal.



**43. International-type search**

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

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

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

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

(5) If it is apparent from the report on the international-type search or from the declaration on the non-establishment of the report, that—

- (a) the description, the claims or, where applicable, the drawings do not comply, in whole or in part, with the prescribed requirements to such an extent that no meaningful search could be carried out; or
- (b) the application does not comply, in whole or in part, with the requirements of unity of invention prescribed by section 35 and the rules pertaining thereto; or
- (c) the invention claimed in the application does not fulfil the requirements of novelty; the Managing Director shall reject the application unless the applicant either satisfies him that the requirements have been fulfilled or amends or divides the application so as to comply with the requirements.

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

**44. Examination as to substance**

(1) The Managing Director may, by notice in the Kenya *Gazette* or in the Industrial Property Journal—

- (a) direct that applications for patents relating to a specified field or specified technical fields shall be the subject of an examination as to substance; or
- (b) amend any direction issued pursuant to paragraph (a).

(2) Where an application for a patent satisfies the requirements specified in subsection (7) of section 41 and the subject matter thereof does not fall within a technical field specified under subsection (1) of this section, the Managing Director shall so notify the applicant who shall, within three years from the filing



date of the application, submit a request in the prescribed form for the examination of the application pursuant to the provisions of subsection (3):

Provided that where no request is made within the prescribed period, the application shall be deemed to be abandoned.

(3) Where a request is filed under subsection (2), the Managing Director shall cause an examination of the application to be made as to whether—

- (a) the invention in respect of which the application is made is patentable within the meaning of this Act; and
- (b) the application complies with the requirements of subsections (5) and (6) of section 34.

(4) For the purposes of the examination under subsection (3), the Managing Director may submit the application together with the relevant documents to an examiner or other competent authority for examination as to the patentability of the claimed invention and the examiner or other competent authority shall submit a report of the findings of the examination to the Managing Director who shall submit a copy thereof to the applicant.

(5) Save where an application is subject to an international-type search under section 43, the Managing Director shall cause an examination to be carried out as to whether the application complies with the requirements of unity of invention prescribed under section 35 and the rules pertaining thereto.

(6) If the Managing Director is of the opinion that the requirements of unity of invention have not been complied with, he shall invite the applicant to restrict or divide the application:

Provided that where the applicant fails to do so, the Managing Director shall reject the application.

(7) Where, taking due account of the conclusions of any report referred to in subsection (5), the Managing Director is of the opinion that any of the conditions referred to in subsection (2) are not fulfilled, he shall notify the applicant accordingly and invite him to submit his observations and, where applicable, to amend his application.

(8) Where, despite any observation or amendment submitted by the applicant, the Managing Director finds that any of the conditions referred to in subsection (2) are not fulfilled, he shall refuse the grant of a patent and notify the applicant accordingly.

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

#### **45. Grant, registration and publication of a patent**

(1) Unless an application has been rejected under or a patent has been refused under section 44, a patent shall be granted and issued to the applicant in the prescribed form.

(2) Every patent granted under subsection (1) shall be registered, and shall, as soon as reasonably practicable, be published by the Managing Director in the manner prescribed in the regulations.

**46. Register of patents**

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

(2) Any person may, during working hours, inspect the register maintained under subsection (1) and may, subject to the payment of the prescribed fee and any regulations made under this section, obtain extracts therefrom.

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

**47. Appeals**

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

**PART VI – INTERNATIONAL APPLICATIONS****48. Interpretation of Part VI**

For the purposes of this Part—

“**international application**” means an international application filed in accordance with the Patent Co-operation Treaty and the Regulations established thereunder;

“**Receiving Office**”, “**designated Office**”, “**elected Office**”, “**international publication**”, “**international search report**”, “**international preliminary examination report**”, and the words “**to designate**” and “**to elect**” have the meanings respectively assigned to them in the Patent Co-operation Treaty.

**49. Further functions of the Institute**

(1) The Institute shall act as a receiving Office where an international application is filed with it by a national or a resident of Kenya.

(2) The Institute shall act as a designated Office or an elected Office in the case of any international application in which Kenya is designated or elected for a national patent.

(3) The functions of the Institute under this Part shall be performed in accordance with the provisions of the Patent Co-operation Treaty, the regulations made there under and the administrative instructions issued under the said regulations and with the provisions of this Act and the regulations pertaining thereto:

Provided that in case of conflict, the provisions of the Patent Co-operation Treaty, the regulations and the administrative instructions issued hereunder shall apply.

**50. Unsearched or unexamined international applications, etc.**

(1) Where an international search report is not established or relates to only one or some of the claims of the international application, the Managing Director

shall reject the international application or consider withdrawn claim or claims not covered by the report, as the case may be, except to the extent that the applicant satisfies him that the non-establishment of the report in whole or in part was not justified.

(2) Where the international search report relates to only one or some of the claims due to the applicant's refusal to pay additional fees, those parts of the international application which consequently have not been searched shall be considered withdrawn unless the applicant divides out from the application as provided for in section 36(2) the parts concerned or satisfies the Managing Director that the invitation to pay the additional fees was not justified.

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

- (a) where, in the case of lack of compliance with the requirements of unity of invention, the international preliminary examination report indicates that the international preliminary examination was carried out on restricted claims, or was carried out on the main invention only, those parts of the international application indicated as not having been the subject of international preliminary examination shall be considered withdrawn unless the applicant divides out from the application as provided for in section 36(2) the parts concerned or satisfies the Managing Director that the invitation of the international preliminary examining authority was not justified; and
- (b) where the international preliminary examination report states, with respect to the entire international application or one or some of its claims only, the opinion that a defect under Article 34(4)(a) of the Patent Co-operation Treaty exists under the international application or the claim or claims, as the case may be, shall be considered withdrawn unless the applicant satisfies the Managing Director that the defects do not exist.

(4) The Managing Director may refuse to grant a patent upon the application if it is apparent from an international search report or an international preliminary examination report that an invention claimed in an international application does not fulfil the requirements of novelty, unless the applicant either satisfies him that the requirements have been fulfilled or amends the claims in such a way that fulfils the requirements.

## **51. Provisional protection of published international applications**

(1) Relief against infringement may be sought in respect of acts committed before the grant of the patent but after the date of international publication under the Patent Co-operation Treaty, where the said international publication was effected in English.

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

**52. Publication of international application**

Publication under Article 21 of the Patent Co-operation Treaty, an international application in which Kenya is designated for a national patent shall be treated as publication in terms of the provisions of section 42.

**PART VII – RIGHTS AND OBLIGATIONS OF THE APPLICANT OR THE OWNER OF THE INVENTION****53. Rights and obligations**

(1) The applicant or the owner of the invention shall have the following rights—

- (a) to be granted the patent, where the relevant requirements under this Act are fulfilled;
- (b) after the grant of the patent and within the limits defined in section 58 to preclude any person from exploiting the patented invention in the manner referred to in section 54; and
- (c) to conclude licence contracts as provided for in Part X of this Act, and subject to the obligations referred to in subsection (2).

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

- (a) to disclose the invention in a clear and complete manner, and in particular to indicate at least one mode for carrying out the invention, in accordance with the requirements, and subject to the sanctions, applicable under this Act;
- (b) to give information concerning corresponding foreign applications and grants;
- (c) to pay fees to the Managing Director, as prescribed in this Act and the regulations, subject to the sanctions provided for therein; and
- (d) in connection with licence contracts and contracts assigning patents or patent applications, to refrain from making undesirable provisions referred to in section 69.

**54. Rights of owner of patent**

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

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

(2) The rights conferred on the owner of the patent under this section shall not apply to acts by third parties necessary to obtain approval or registration of a product from the Institute, for the purpose of commercialising the product after expiry of the patent.

### **55. Enforcement of rights**

The owner of a patent shall have the right—

- (a) to obtain an injunction to restrain the performance or the likely performance, by any person without his authorization, of any of the acts referred to in section 54; and
- (b) to claim damages from any person who, having knowledge of the patent, performed any of the acts referred to in section 54, without the owner's authorization;
- (c) to claim compensation from any person who, without his authorization, performed any of the inventions, claimed in the published application, as if a patent had been granted for that invention:

Provided that the said person, at the time of the performance of the act, had—

- (i) actual knowledge that the invention that he was using was the subject matter of a published application; or
- (ii) received written notice that the invention that he was using was the subject matter of a published application, such application being identified in the said notice by its serial number.

### **56. Right of a prior user**

(1) Notwithstanding the provisions of section 54, a prior user patent shall have no effect against any person (hereinafter referred to as "the prior user") who, in good faith, for the purposes of his enterprise or business, before the filing date or, where priority is claimed, the priority date of the application on which the patent is granted, and within the territory where the patent produces its effect, was using the invention or was making effective and serious preparations for such use; any such person shall have the right, for the purposes of his enterprise or business, to continue such use or to use the invention as envisaged in such preparations.

(2) The right of the prior user may only be transferred or devolve together with his enterprise or business, or with that part of his enterprise or business in which the use or preparations for use have been made.

### **57. Scope of protection**

The scope of the protection shall be determined by the terms of the claims but the description and the drawings included in the patent may be used to interpret the claims.

### **58. Limitation of rights**

(1) The rights under the patent shall extend only to acts done for industrial or commercial purposes and in particular not to acts done for scientific research.

(2) The rights under the patent shall not extend to acts in respect of articles which have been put on the market in Kenya or in any other country or imported into Kenya by the owner of the patent or with his express consent.

(3) The rights under the patent shall not extend to the use of articles on aircraft, land vehicles or vessels of other countries which temporarily or accidentally enter the airspace, territory or waters of Kenya.

(4) The rights under the patent shall be limited by the provisions of the terms of the patent.

(5) The rights under the patent shall be limited by the provisions on compulsory licences for reasons of public interest or based on interdependence of patents and by the provisions on State exploitation of patented inventions.

(6) The rights of the patent shall not extend to variants or mutants of living forms or replicable living matter that is distinctively different from the original for which patents were obtained where such mutants or variants are deserving of separate patents.

[Act No. 2 of 2002, Sch.]

## **59. ARIPO Protocol on Patents**

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

## **PART VIII – TERM OF PATENT AND ANNUAL FEES**

### **60. Term of patent**

A patent shall expire at the end of twenty years from the filing date of the application.

### **61. Annual fees**

(1) In order to maintain the application or the patent, an annual fee shall be paid in advance to the Institute which shall fall due on the eve of each anniversary of the date of filing of the application or the patent, and shall be paid in the manner prescribed.

(2) A grace period of six months shall be granted for the payment of the annual fee upon payment of such surcharge as may be prescribed from time to time.

(3) If an annual fee is not paid in accordance with this section, the application shall be deemed to have been withdrawn or the patent shall lapse and respective invention shall cease to be protected.

(4) The Managing Director shall forthwith publish the lapse of any patent under subsection (3).

(5) Within six months from the expiration of the grace period referred to in subsection (2), any interested person may, upon payment of the prescribed fee, request the Institute to restore an application that is deemed to have been withdrawn, or a patent that has lapsed, by virtue of subsection (3).

(6) Upon a request under subsection (5), the Managing Director shall if satisfied that the failure to pay the annual fee was not intended, subject to the payment of the annual fee, make an order restoring the application or the patent, as the case may be.

(7) Where a patent is restored, no proceedings shall be brought in respect of the patent—

- (a) with respect to any acts performed after the lapse of the patent and before the date of the order for restoration; or
- (b) with respect to any acts performed after the date of the order of restoration in relation to articles imported into or manufactured in Kenya, after the lapse of the patent and before the date of the order for restoration.

#### PART IX – CHANGE IN THE OWNERSHIP AND JOINT OWNERSHIP OF APPLICATIONS AND PATENTS

##### **62. Change in ownership of applications, etc.**

(1) All contracts assigning applications or patents shall be in writing and shall be signed by the parties thereto.

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

##### **63. Joint ownership of applications and patents**

In the absence of any agreement to the contrary between the parties, joint owners of an application or a patent may, separately, transfer their shares in the application or the application or the patent, exploit the protected patent and preclude any person from exploiting the patent but may only jointly grant permission to any third person to do any of the acts referred to in section 55.

#### PART X – CONTRACTUAL LICENSES

##### **64. Rights of licensee**

(1) In the absence of any provision to the contrary licensee, in the licence contract, the licensee shall be entitled to do any of the acts referred to in section 54 in respect of the invention, without limitation as to time, in the whole of Kenya and in any field of use of the invention, utility model or industrial design.

(2) In the absence of any provision to the contrary in the licence contract, the licensee may not grant to any third person to do any of the acts referred to in section 54.



**65. Rights of licensor to grant further licences and use of the invention**

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

(2) If the licence contract provides that such contract or the permission granted by it is exclusive, the licensor may neither grant permission to any third person to do any of the acts referred to in section 54 and covered by the licence contract, nor himself do any of those acts, and the licensee shall be considered an exclusive licensee for the purposes on this Act.

**66. Effects of patent not being granted, revoked or being invalidated**

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

- (a) the application is withdrawn;
- (b) the application is finally rejected; or
- (c) the patent is finally revoked or declared invalid,

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

**67. Form of licence contracts**

All licence contracts shall be in writing and shall be signed by the parties thereto.

**68. Petition for registration**

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

(2) A petition for registration under subsection (1) may be made by any party to the contract, and shall be accompanied by such documents and fees as may be prescribed.

(3) The Managing Director shall issue to the applicant a receipt, which shall be proof of the fact of filing the petition and of the date on which it was filed and if no receipt is issued within fourteen days from the date of the petition, the petitioner may rely on other evidence to prove the fact and date.

(4) Where—

- (a) section 67 or subsections (2) to (4) of this section, and the rules relating thereto, have not been complied with; or
- (b) the licence contract cannot be registered under section 69,

the Managing Director shall refuse to register the licence contract, stating the reasons for such refusal.

(5) Before refusing to register the licence contract, the Managing Director shall notify the petitioner and allow the parties—

- (a) to submit the observations, if any;



- (b) to correct any defect in the petition; or
- (c) to amend any term, or to correct any defect, in the licence contract that has been declared by the Managing Director to be a term or defect precluding registration, within forty-five days from the date of the notification.

(6) A licence contract shall be void if the registration has been refused by the Managing Director in accordance with the provisions of this Act.

#### **69. Prohibited terms in licence contracts**

The Managing Director may refuse to register a licence contract if he is of the opinion that any clause in a licence contract imposes unjustified restrictions on the licensee with the consequence that the contract, taken as a whole, is harmful to the economic interests of Kenya, and that the effect of any such term contained in the contract is—

- (i) to permit or require the importation of technology from outside Kenya when substantially similar or equivalent technology may be obtained on the same or more favourable conditions without importation from abroad;
- (ii) to require payment of a price, royalty or other consideration which is disproportionate to the value of the technology to which the contract relates;
- (iii) to require the licensee to acquire any materials from the licensor or from sources designated or approved by him, unless it is otherwise impossible, for all practical purposes, to ensure the quality of the products to be produced;
- (iv) to prohibit the licensee from acquiring, or to restrict his acquisition of, any materials from any source, unless it is otherwise impossible, for all practical purposes, to ensure the quality of the products to be produced;
- (v) to prohibit the licensee from using, or to restrict his or her use of any materials which are not supplied by the licensor or by sources designated or approved by him, unless it is otherwise impossible, for all practical purposes, to ensure the quality of the products to be produced;
- (vi) to require the licensee to sell products produced by him under the contract exclusively or principally to persons designated by the licensor;
- (vii) to require the licensee to make available to the licensor, without appropriate consideration any improvements made by the licensee with respect to the technology to which the contract relates;
- (viii) to limit the volume of the products produced by the licensee with the help of the technology to which the contract relates;
- (ix) to restrict or prohibit the export of the products produced by the licensee;

- (x) to oblige the licensee to employ persons designated by the transferor not needed for the efficient transfer of the technology to which the contract relates, provided that, for persons so needed, the contract shall provide for training of persons to replace them within a reasonable period;
- (xi) to impose restrictions on research or technological development carried out by the licensee to absorb or adapt the technology in connection with new products, processes or equipment;
- (xii) to prohibit or restrict the use by the licensee of any technology other than the technology to which the contract relates;
- (xiii) to extend the coverage of the contract to technology not required for the use of the technology which is the main subject of the contract and to require consideration for such additional technology;
- (xiv) to fix prices for the sale or resale of the products produced by the licensee with the help of the technology to which the contract relates;
- (xv) to exempt the licensor from any liability consequent upon any defect inherent in the technology to which the contract relates or restrict such liability;
- (xvi) to prohibit or restrict the use by the licensee, after the expiration of the contract, of the technology acquired as a result of the contract, subject, however, to any right of the licensor under the patent;
- (xvii) to require that disputes arising from the interpretation or performance of the contract be governed by a law other than the law of Kenya or that such disputes be brought before courts located in a country other than Kenya;
- (xviii) to establish the duration of the contract for a period which is unreasonably long in relation to the economic function of the contract, provided that any period which does not exceed the duration of the patent to which the contract relates shall not be regarded as unreasonably long;
- (xix) to restrict the licensee from entering into sales, representation or manufacturing agreements relating to similar or competing technologies, when such restrictions are not needed for protecting the legitimate interests of the licensor, including, in particular, protecting the licensor's industrial or intellectual property rights or ensuring that the licensee exercises his best efforts in respect of any manufacturing, distribution or promotional obligations;
- (xx) to prevent the licensee from adapting the technology to local conditions or introducing innovations in it or change to alternative inputs, or which require the licensee to introduce unnecessary designs or specification changes, if the licensee makes adaptations on his own responsibility and without using the licensor's name, trade or service marks or trade names, and except to the extent that this adaptation unsuitably affects those products, or the process for their manufacture, to be supplied by the licensor, his designates, or his other licensees, or to be used as a component or spare part in a product to be supplied to his customer;

- (xxi) to impose acceptance of additional technology, future inventions and improvements, goods or services not wanted by the licensee;
- (xxii) to impose restrictions on territories, quantities, prices, customers or markets arising out of patent pool or cross-licensing agreements or other international technology transfer interchange arrangements which unduly limit access to new technological developments or which would result in an abusing domination of an industry or market with adverse effects on the licensee, except for those restrictions appropriate and ancillary to co-operative arrangements such as co-operative research arrangements;
- (xxiii) to impose restrictions which regulate advertising or publicity by the licensee except where restriction of such publicity may be required to prevent injury to the licensor's goodwill or reputation where the advertising or publicity makes reference to the licensor's name, trade or service marks, trade names or other identifying items;
- (xxiv) to impose confidentiality after the expiry of the licence agreement or to impose unreasonably long periods for secrecy following the commissioning of manufacturing facilities using the licensed technology, or to impose measures which limit technological learning and mastery, except those which relate to industrial property rights;
- (xxv) to impose requirements for payments even under conditions of *force majeure*;
- (xxvi) to impose restrictions which prevent or hinder export by means of territorial or quantitative limitations or prior approval for export or export prices of products or increased rates of payments for exportable products resulting from the technology licensed;
- (xxvii) to impose quality control methods or standards not needed by licensee, except to meet the requirement of a guarantee or when the product bears a trade mark, service mark or trade name of the licensor;
- (xxviii) to allow the licensor to participate permanently in the management of the licensee's business as a condition for obtaining the technology;
- (xxix) to restrict the licensee from taking measures that will enhance local technological capability and which are not prejudicial to the licensor's industrial property rights;
- (xxx) to restrict the use of local expertise in management and consultancy or in any other positions;
- (xxxi) to require payment of royalty for patents granted outside Kenya;
- (xxxii) to apply dissimilar conditions to equivalent transactions with other trading parties, thereby placing the licensee at a competitive disadvantage; or
- (xxxiii) to make the contract subject to acceptance of supplementary obligations which, by their nature or according to commercial usage, have no connection with the subject of such contracts.

**70. Registration of the contract and issue of certification**

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

(2) If the Managing Director fails—

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

the licence contract shall be deemed to have been registered and the Managing Director shall issue a certificate of registration to the petitioner.

(3) The registration shall take effect—

- (a) if the petition was made within sixty days from the conclusion of the contract, on the date of the conclusion of the contract; and
- (b) in all other cases, on the date of the petition.

(4) When the petition is corrected or the licence contract is amended under section 68(5), the petition shall be deemed to have been received on the date when the correction or amendment was made.

(5) The registration and the certificate shall state—

- (a) the name of the parties to the contract and of the licensee if he is not a party;
- (b) the date of the petition;
- (c) the date of the registration; and
- (d) the registration number,

all of which shall be published in the *Kenya Gazette* or in the *Industrial Property Journal*.

(6) The contents of the contract shall be confidential, unless both parties to the contract agree to permit access thereto by third parties and such access shall only be to the extent of the permission so granted.

**71. Remedies**

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

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

**72. Compulsory licences for non-working and similar reasons**

(1) At any time after four years from the filing date compulsory of an application or three years from the grant of a patent, whichever period last expires, any person may apply to the Tribunal for a licence to exploit the patented invention on the grounds that a market for the patented invention is not being supplied on reasonable terms in Kenya.

(2) Notwithstanding subsection (1), a non-voluntary licence shall not be granted if the owner of the patent satisfies the Tribunal that circumstances exist which justify the fact that the market for the patented invention is not being supplied, or is not being supplied on reasonable terms, in Kenya.

**73. Compulsory licences based upon interdependence of patents**

(1) Where a patented invention cannot be worked without infringing the rights derived from an earlier patent, the owner of the latter patent may request the Tribunal at any time for the grant of a compulsory licence with respect to the earlier patent to the extent necessary for the working of his invention, if the invention constitutes an important technical advance of considerable economic significance in relation to the invention claimed in the earlier patent.

(2) The owner of the first patent shall be entitled to a cross-licence on reasonable terms to use the invention claimed in the second patent.

(3) The use authorized in respect of the first patent shall be non-assignable except with the assignment of the second patent.

(4) In this section, “**earlier patent**” or “**first patent**” means a patent granted on an earlier application or benefiting from an earlier validly claimed priority date, and “**latter patent**” or “**second patent**” shall be construed accordingly.

**74. Preconditions for grant of compulsory licences**

(1) A compulsory licence shall not be granted unless for grant of the person requesting the licence—

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

(2) The requirement under subsection (1)(a) shall be waived in the case of a national emergency or other circumstances of extreme urgency, provided the owner of the patent shall be so notified as soon as is reasonably practicable.

**75. Grants and terms of compulsory licences**

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

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

- (a) is limited, in scope and duration, to the purpose for which it was authorised, and in the case of semi-conductor technology, shall only be for public non-commercial use or to remedy a practice determined after a judicial or administrative process to be anti-competitive;
- (b) is limited predominantly for the supply of the domestic market;
- (c) does not entitle the licensee to grant further licences, without the consent of the owner of the patent;
- (d) is non-exclusive; and
- (e) provides for the payment to the owner of the patent of remuneration which is equitable with due regard to all the circumstances of the case, including the economic value of the licence.

(3) A representative of the Institute and of the Government shall have the right to appear and be heard at the hearing of an application for a compulsory licence, before the Tribunal.

#### **76. Transfer of compulsory licence**

A compulsory licence may be transferred only with that part of the industrial undertaking or its goodwill, in which the relevant invention is used and no such transfer shall be valid until the consent of the Tribunal has been obtained.

#### **77. Cancellation of compulsory licences**

(1) On the application of any interested party, the Tribunal may cancel a compulsory licence if—

- (a) the licensee fails to comply with the terms of the licence; or
- (b) the conditions which justified the grant of the licence have ceased to exist and are unlikely to recur; provided that the legitimate interests of the licensee are adequately protected.

(2) On the application of the Minister, or on the application of the owner of the patent, the Tribunal may, cancel the compulsory licence if, within two years from the grant of the licence, the licensee has not taken the necessary steps to work the relevant invention sufficiently so as to remedy the deficiencies or to satisfy the requirements which gave rise to his application for the said licence.

(3) On the application of the owner of the patent or the licensee, the Tribunal may vary the terms of a compulsory licence if new facts justify the variation and in particular if the patentee has granted contractual licence on more favourable terms.

#### **78. Registration of grants, cancellation or variation**

Where the Tribunal grants, cancels or varies the terms of a compulsory licence, the Tribunal shall instruct the Managing Director, to record the grant, cancellation or variation in the register without payment of any fee.

**79. Licences as of right**

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

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

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

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

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

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

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

(8) Section 77(3) shall apply, *mutatis mutandis*, where the terms of licence granted under subsection (5) have been fixed by the Tribunal.

PART XI – EXPLOITATION OF PATENTED INVENTIONS BY THE  
GOVERNMENT OR BY THIRD PERSON AUTHORIZED BY THE  
GOVERNMENT

**80. Exploitation of the patented inventions by the Government or by third persons authorized by the Government**

(1) Subject to this section, where—

- (a) the public interest, in particular, national security, nutrition, health, environmental conservation, or the development of other vital sector of the national economy so requires; or
- (b) the Managing Director determines that the manner of exploitation of an invention by the owner of the patent or his licensee is not competitive,

the Minister may, upon application to him in the prescribed form and after consultation with the Institute and the owner of the patent, order that the protected invention shall be exploited by a Government Ministry, Department, agency or other person as the Minister may designate in the order subject to the payment of adequate compensation to the owner of the patent in accordance with this section.



(1A) Upon exercising the powers conferred upon him under subsection (1), the Minister may, notwithstanding any of the measures set out in this section, authorise by written order the importation, manufacture or supply, or authorize the utilisation of any molecule or substance whatsoever by any individual, corporation or society as named or described by any individual, corporation or society as named or described in the order without notice to the patent holder or any other notifiable party, and such order shall remain in force until revoked by the Minister in writing, after giving six months' prior notice of his intention of such revocation to the party named or described in the order.

(1B) An order made under the subsection (1A) shall not require the payment of compensation to the owner of the patent or licence holder or any other party so interested.

(1C) The Minister shall, notwithstanding any of the measures set out in this section, authorise the utilisation of any process for the manufacture, sale or supply of any molecule or substance whatsoever by any individual, corporation or society as named or described in the order, and such order shall remain in force until revoked by the Minister in writing, giving six months prior notice of intention of such revocation to the party named or described in the order.

(2) No application shall be made under subsection (1) unless the applicant has unsuccessfully sought a contractual licence from the owner of the patent:

Provided that the provisions of this subsection shall not apply in cases of national emergency or other extreme urgency in which case the Minister shall cause the contents of the order to be communicated to the owner of the patent as soon as reasonably practicable.

(3) An order under this section shall be subject to such conditions as the Minister may deem necessary.

(4) Where an order under this section is made, the Managing Director shall fix the amount of the compensation to be paid to the owner of the patent, such compensation being equitable with due regard to all the circumstances of the case and in particular, the economic value of the patent.

(5) An order under this section shall not preclude the owner of the patent from concluding a licence contract or from exercising the powers conferred by section 54 of this Act.

(6) The Minister may, upon the request of the owner of the patent or the Government Ministry, Department, agency or other person designated by the Minister for the purposes of any order under this section and after hearing all interested parties, vary the terms of the order to the extent that changed circumstances justify such variation.

(7) The Minister may, upon the request of the owner of a patent and after hearing all interested parties, revoke an order under this section—

- (a) if satisfied that the circumstances necessitating the order have ceased and are unlikely to recur; or
- (b) where the Government Ministry, Department, agency or other person designated for the purposes of the order is in breach of any condition imposed under subsection (3).



(8) The authorization of any person in an order under this subsection shall not be transferable except to a business or enterprise owned or operated by that person.

(9) The exploitation of the invention pursuant to an order under this section shall be primarily for the supply of the market in Kenya.

(10) An order relating to the exploitation of an invention in the field of semiconductor technology shall only be made where the Tribunal has determined that the manner of exploitation of the patented invention, by the owner of the patent or his licensee, is not competitive and the Minister is satisfied that the issuance of such order would remedy such practice.

(11) Any person aggrieved by any decision of the Minister under this section may appeal to the Tribunal.

## PART XII – UTILITY MODELS

### 81. Applicability of provisions relating to patents

(1) Subject to section 82, the provisions of Parts III, IV, V, VII, VIII, IX, X, XI, XV and XVI shall apply, *mutatis mutandis*, to utility model certificates or applications therefor, as the case may be.

(2) Where the right to a patent conflicts with the right to a utility model certificate in the case referred to in section 30(3), the said provision shall apply as if the word “patent” were replaced by the words “utility model certificate”.

### 82. Special provisions relating to utility model certificates

(1) An invention qualifies for a utility model certificate if it is new and industrially applicable.

(2) Section 22, 24, 43, 44 and 60 shall not apply in the case of applications for utility model certificates.

(3) A registration certificate for a utility model shall expire at the end of the tenth year after the date of filing of the application in respect thereof, and shall not be renewable:

Provided that the registration certificates in respect of utility models which were issued under this Act before the commencement of this subsection shall expire at the end of the tenth year from the date of grant.

[Act No. 7 of 2007, Sch.]

### 83. Conversion of patent applications to applications for utility model certificate, and *vice versa*

(1) At any time before the grant or refusal of a patent an applicant for a patent may, upon payment of the prescribed fee, convert his application into an application for a utility model certificate, which shall be accorded the filing date of initial application.

(2) At any time before the grant or refusal of a utility model certificate, an applicant for a utility model certificate may, upon payment of the prescribed fee, convert his application into a patent application, which shall be accorded the filing date of the initial application.

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

## PART XIII – INDUSTRIAL DESIGNS

### 84. Definition of an industrial design

(1) For the purposes of this Part, “**an industrial design**” means any composition of lines or colours or any three dimensional form, whether or not associated with lines or colours:

Provided that such composition or form gives a special appearance to a product of industry or handicraft and can serve as a pattern for a product of industry or handicraft.

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

### 85. Right to industrial design; naming of creator

(1) Subject to the provisions of any other written law, the creator of an industrial design or his successors in title shall have the exclusive rights to sell or cause to be sold for commercial or industrial purposes the goods in which the design is incorporated, subject to the conditions of this Act.

(2) Sections 30, 32 and 33 shall apply *mutatis mutandis* to the rights of the creator of an industrial design.

### 86. Registrable industrial designs

(1) An industrial design is registrable if it is new.

(2) An industrial design shall be deemed to be new if it has not been disclosed to the public, anywhere in the world, by publication in tangible form or, in Kenya, by use or in any other way, prior to the filing date or, where applicable, the priority date of the application for registration.

(3) Section 23(4) shall apply *mutatis mutandis* in respect of priority dates of an industrial design.

(4) Industrial designs that are contrary to public order or morality shall not be registrable.

### 87. Application and examination

(1) Any person wishing to register an industrial design shall send to the Institute—

- (a) an application in the prescribed form;
- (b) a power of attorney, where the applicant is represented by an agent;
- (c) drawings, photographs or other graphic representations of the article embodying the industrial design and an indication of the kind of products for which the industrial design is to be used; and
- (d) the prescribed application fee.

(2) The request shall be accompanied by a specimen of the article embodying the industrial design.

(3) Where the applicant is not the creator, the request shall be accompanied by a statement justifying the applicant's right to the registration of the industrial design.

(4) Two or more industrial designs may be the subject of the same classification provided that they relate to the same class under international classification or to the same set or composition of articles.

(5) The applicant may at any time withdraw an application lodged under this section.

(6) The Managing Director shall accord as the filing date the date of receipt of the application:

Provided that, at the time of receipt, the application fee is paid and the application contains the name of the applicant and a graphic representation of the article embodying the industrial design or a specimen thereof.

(7) Section 37 and 41(2) and (3) shall apply *mutatis mutandis* in respect of priority dates and filing of corrections to the application.

(8) The Managing Director shall, if satisfied that an application meets the requirements of this section and of section 84 and 86, register the industrial design and issue a certificate of registration to the applicant.

(9) Subject to subsection (7) the date of the registration shall be that of the application.

#### **88. Duration and renewal of registration of an industrial design**

(1) Subject to subsection (2), the duration of the renewal of registration of an industrial design shall expire at the end of the fifth year following the date of the application for registration.

(2) The registration of a design may be renewed for two further consecutive periods of five years upon payment of a prescribed fee.

(3) The fee for the renewal of registration of an industrial design shall be paid within twelve months preceding expiration of the period of registration but a grace period of six months shall be allowed for the late payment of the renewal fee on payment of the surcharge, as may be prescribed.

#### **89. Restoration of registration of industrial designs**

(1) Where the protection granted to an industrial design has not been renewed due to circumstances beyond the control of the owner of the design, the latter or any other persons entitled may apply designs for its restoration on the payment of the prescribed renewal fee, as well as of the surcharge, within a period of one year from the date upon which renewal fee was due.

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

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

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

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

#### **90. Graphic representations, specimens, etc.**

(1) The application, including any drawings, photographs or other graphics representations and any specimen of registered industrial design shall be kept by the Institute and after publication of the registration they shall be communicated upon request made in the prescribed manner.

(2) Drawings, photographs or other graphic representations and specimens of industrial designs shall be kept by the Institute for a period of eight years after the expiry of the registration and may be examined by any interested person on payment of the prescribed fee.

(3) After publication, any person may obtain an official copy of the application, representations or specimens.

(4) Subsections (1), (2) and (3) shall apply to official copies furnished by applicants seeking to avail themselves of the priority of an earlier registration and to the documents enabling certain applicants to claim the priority.

(5) An applicant for registration of an industrial design seeking to avail himself outside Kenya of the priority of his registration before registration of the industrial design may obtain an official copy of his application.

#### **91. Publication of reference to registration of industrial designs**

(1) The Managing Director shall publish a reference to the registration of all industrial designs, which shall contain, in addition to the prescribed details—

- (a) the number of the industrial design;
- (b) the date of filing of the application;
- (c) the mention of any validly claimed priority; and
- (d) the drawings, photographs or other graphic representations of the industrial design and an indication whether a specimen has been deposited with the Institute.

(2) The Institute shall prescribe the conditions of publication of the representations of the industrial design.

#### **92. Rights conferred by registration of industrial designs, etc.**

(1) Registration of an industrial design shall confer upon its registered owner the right to preclude third parties from performing any of the following registration acts in Kenya—

- (a) reproducing the industrial design in the manufacture of a product;
- (b) importing, offering for sale and selling a product reproducing the protected industrial design; or

- (c) stocking of such a product for the purposes of offering it for sale or selling it.

(2) The rights conferred by the registration of an industrial design shall extend only to acts done for industrial or commercial purposes and shall not extend to acts in respect of a product embodying the protected industrial design after the product has been lawfully imported or sold in Kenya.

(3) The registered owner of an industrial design shall, in addition to any other rights, remedies or actions available to him, have the right to institute court proceedings against any person who infringes the industrial design by performing, without his consent, any of the acts referred to in subsection (1) or who performs acts which make it likely that infringement will occur.

(4) An industrial design in respect of which Kenya is a designated state registered by ARIPO by virtue of the ARIPO Protocol shall have the same effect in Kenya as an industrial design registered under this Act unless the Managing Director has communicated to ARIPO, in respect of an application thereof, a decision in accordance with the provisions of the ARIPO Protocol that if a registration is made by ARIPO that registration shall have no effect in Kenya.

### 93. Transfer and assignment of industrial designs; licences

(1) Rights subsisting in an industrial design may be transferred in whole or in part.

(2) The provisions of sections 62, 63, 64, 68 and 70 shall apply *mutatis mutandis* to this Part.

## PART XIV – TECHNOVATIONS

### 94. Definitions

For the purpose of this Part—

- (a) “**technovation**” means a solution to a specific problem in the field of technology, proposed by an employee of an enterprise in Kenya for use by that enterprise, and which relates to the activities of the enterprise but which, on the date of the proposal, has not been used or actively considered for use by that enterprise;
- (b) “**employee**” and “**enterprise**” mean the employee and the enterprise referred to in paragraph (a), and where several enterprises are owned or operated by one person, all such enterprises shall be considered as one enterprise;
- (c) “**date of the proposal**” means the date on which the employee makes a request in accordance with section 96;
- (d) “**technovation certificate**” means the document issued by the enterprise in accordance with section 95;
- (e) “**technovator**” means an employee to whom the enterprise has issued a technovation certificate.

**95. Right to technovation certificate**

(1) Subject to subsection (2), any employee of the enterprise on the date of the proposal shall be entitled to a technovation certificate as provided for in this Part.

(2) Where the duties of an employee comprise the making and proposing of technovations, he shall not be entitled to a technovation certificate for any technovation which pertains to the field of activities for which he is employed, unless the degree of the creative contribution inherent in the technovation exceeds that which is normally required of an employee having the said duties.

(3) Where employees severally request a technovation certificate for the same technovation, the employee who is the first to make the request shall be entitled to such certificate.

(4) Where a request for technovation certificate is made jointly by two or more employees, the certificate shall be issued in their joint names.

**96. Request**

A request for a technovation certificate signed by the employee shall be filed in writing with the enterprise and the enterprise shall assist the employee in filing the request and shall issue a receipt to him acknowledging that a request has been filed and indicating the date on which it has been filed.

**97. Issuance or refusal of technovation certificate**

(1) Where the requirements of this Part are satisfied, the enterprise shall, within a period of three months from the date of the proposal, issue a technovation certificate to the employee.

(2) The enterprise may refuse to issue the certificate if it is of the opinion that the requirements of this Part have not been satisfied and shall notify the employee of the reasons therefor within the time limit prescribed in subsection (1).

**98. Use of technovation**

(1) Where the enterprise issues a technovation certificate, it shall, at the same time, notify the technovator, in writing, whether or not it intends to use the technovation.

(2) Where the decision to make use of the technovation depends on testing the technovation in practice, the enterprise shall inform the technovator accordingly and may postpone the notification of its intention to use or not to use the technovation by not more than a year from the date of the proposal.

(3) The technovator shall be obliged to assist the enterprise, to the best of his ability, in any testing, development or use of the technovation.

(4) The enterprise shall be obliged to give adequate opportunity to the technovator to furnish the assistance referred to in subsection (3).

(5) Once the technovation certificate has been issued, the technovator, shall not communicate his technovation to anyone other than the enterprise and shall not use it.

(6) Where the enterprise declares that it does not intend to use the technovation or where the enterprise, having declared its intention to use the technovation, does not in fact start using it within six months from the issuance of the technovation certificate or the expiration of the time limit referred to in subsection (2), the technovator shall be exempted from the obligations referred to in subsections (3) and (4):

Provided that the technovator shall have the right to communicate his technovation to others only to the extent that such communication does not entail the communication of any know how or other knowledge that has acquired as an employee.

#### **99. Remuneration of the technovator**

Where the enterprise uses the technovation or communicates it to a third person, the technovator shall be entitled to a remuneration the amount and method of payment of which shall, in the absence of an applicable collective bargaining agreement, be fixed by mutual agreement between the technovator and the enterprise.

#### **100. Derogation by contract**

Any contractual provision which is less favourable to the employees or technovators than the provisions of this part shall be null and void.

#### **101. Disputes**

(1) Any dispute concerning the application of this part shall be submitted by any interested party to an arbitration board consisting of three members: one member appointed by the employee or technovator, one member appointed by the enterprise, and a chairman appointed by the two members. The arbitration board shall hear interested parties and thereafter deliver its ruling.

(2) Where the parties fail to agree on the appointment of the chairman, he shall be appointed by the Resident Magistrate Court having jurisdiction in the place where the enterprise is located.

(3) An aggrieved party may appeal against the decision of the arbitration board to the Tribunal.

### **PART XV – COMMON PROVISIONS: SURRENDER, REVOCATION AND INVALIDATION**

#### **102. Surrender**

(1) A patent, utility model or industrial design registration certificate may be surrendered by its owner to the Institute.

(2) The surrender may be limited to one or more claims of the patent or utility model or, in the case of industrial designs, one kind of product or class of products.

(3) The surrender shall promptly be recorded in the register and published by the Managing Director and the surrender shall be effective only after it has been published.



(4) If a licence has been recorded in the register, surrender shall only be registered upon the submission of a declaration by which the licensee consents to the surrender, unless the latter has expressly waived this right in the licence contract.

### **103. Revocation or invalidation**

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

(2) An interested person may, within a period of nine months from the date of the publication of the grant of a patent, utility model or industrial design request the Tribunal to revoke or invalidate the patent, utility model or industrial design registration.

(3) The Tribunal shall revoke or invalidate the registration of the patent or the utility model or industrial design on any of the following grounds—

- (a) that the owner of the patent is not entitled under section 30, 31 or 32 of the Act to apply for the grant of a patent;
- (b) that the owner of the patent is in infringement of the rights of the person filing an application for revocation of the patent or of any persons under or through whom he claims;
- (c) that the invention does not relate to an art (whether producing a physical effect or not), process, use, machine, manufacture or composition of matter which is capable of being applied in trade or industry;
- (d) that the invention is obvious in that it involves no inventive step having regard to what was common knowledge in the art at the effective date of the application;
- (e) that the invention, in so far as it is claimed in any claim of the application is not useful;
- (f) that the patent does not fully describe and ascertain the invention and the manner in which it is to be performed;
- (g) that the patent does not disclose the best method of performing the invention known to the owner of the patent at the time when the specification was lodged at the Institute;
- (h) that at the time the application for the grant of the patent was filed, the application form or any other documents filed in pursuance of the application contained a material misrepresentation; or
- (i) that the invention is not new in terms of section 23 of the Act.

(4) An application for revocation or invalidation of a patent shall—

- (a) state the grounds on which the applicant intends to rely on in his application for revocation or invalidation of the patent; and
- (b) be accompanied by—
  - (i) a statement setting out particulars of the facts alleged in support of the said grounds; and



- (ii) proof of service on the owner of the patent of notice of filing of the application under subsection (1) and (2) and such statement shall be furnished to the Tribunal.

(5) If the owner of the patent wishes to contest the application he shall, within such time as is prescribed or such further time as the Tribunal may allow, lodge with him a counter statement setting out particulars of the grounds upon which the application is to be contested.

(6) A copy of any counter-statement in terms of subsection (5) lodged with the Tribunal shall be served by the owner of the patent concerned.

(7) Particulars delivered in terms of this section may from time to time, with the leave of the Tribunal, be amended.

(8) No evidence shall be admitted in proof of any ground on which particulars have not been delivered in terms of this section, except by leave of the Tribunal.

(9) After receiving an application under subsection (1) and compliance with any other provisions of this section which are applicable, the Tribunal shall arrange for the matter to be heard in the manner prescribed and may make such order therein as it deems fit.

(10) The Tribunal shall publish the application for revocation or invalidation of the patent in the *Kenya Gazette* or in the *Industrial Property Journal*.

(11) An aggrieved party may appeal against the decision of the Tribunal to the High Court.

(12) Where the provisions of subsection (2) apply only to some of the claims or some parts of a claim, or some parts of a registered industrial design only those claims or parts may be revoked or invalidated by the Tribunal.

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

(14) The notice of the application referred to in subsection (1) shall be served on any licensee under the patent, the utility model or the industrial design who is entitled to join in the proceedings in the absence of any provision to the contrary in the licence contract.

(15) Where, before or during the proceedings, it is alleged or it appears to the Tribunal that the right to the patent, the utility model or the industrial design belongs to a person who is not a party to the proceedings, notice of the application referred to in subsection (1) shall be served on that person and such person who shall be entitled to join in the proceedings.

**104. Effect of revocation or invalidation**

(1) Any revoked or invalidated patent, utility model or or industrial design or claim or part of a claim of a registered industrial design shall be regarded as null and void from the date of the grant of the patent or certificate of registration for the utility model or the industrial design.

(2) As soon as the decision of the Tribunal is no longer subject to appeal, the Chairman of the Tribunal shall inform the Managing Director who shall register and publish it as soon as possible in the *Kenya Gazette* or in the *Industrial Property Journal*.

**PART XVI – INFRINGEMENT****105. Acts constituting infringement**

Subject to sections 21(3)(e), 58, 61(6), 72, 73, 80(1C) and 86, any act specified in section 54 or 92 and performed by a person other than the owner of the patent or of the registered utility model or industrial design without the owner's authorization, in relation to a product or a process falling within the scope of a validly granted patent or certificate of registration shall constitute an infringement.

**106. Relief**

On the request of the owner of the patent or the registered utility model or industrial design, the Tribunal shall grant the following relief—

- (a) an injunction to prevent infringement where infringement is imminent or to prohibit the continuation of the infringement, once infringement has started;
- (b) damages; or
- (c) any other remedy provided for in law.

**107. Declaration of non-infringement**

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

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

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

**108. Threat of infringement proceedings**

(1) Any person threatened with infringement proceedings who can prove that the acts performed or to be performed by him do not constitute infringement of

the patent or the registered utility model or industrial design may request the Tribunal to grant an injunction to prohibit such threats and to award damages for financial loss resulting from the threats.

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

#### **109. Criminal proceedings**

(1) Any intentional infringement of the patent or the registered utility model or industrial design shall constitute an offence under this Act.

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

#### **110. Presumption of use of patented process**

For the purposes of proceedings, other than criminal proceedings, in respect of the infringement of the rights of the owner of the patent, where the subject matter of the patent is a process for obtaining a product, the burden of establishing that an identical product was not made by the patented process shall be on the alleged infringer, if either of the following conditions is fulfilled—

- (a) the product is new; or
- (b) a substantial likelihood exists that the identical product was made by the process and the owner of the patent has been unable, through reasonable efforts, to determine the process actually used.

#### **111. Legal proceedings by licensee**

(1) Any exclusive licensee within the meaning of section 65(2) may, by registered letter, request the owner of the patent or the registered utility model or industrial design to institute legal proceedings for a specific relief with respect to any infringement specified by the licensee.

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

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

### **PART XVII – INDUSTRIAL PROPERTY TRIBUNAL**

#### **112. Appeal from decisions of the Managing Director**

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

**113. Industrial Property Tribunal**

(1) For the purposes of hearing and determining appeals in accordance with section 112 and of exercising the other powers conferred on it by this Act, there is established an Industrial Property Tribunal which shall consist of the chairman and four members appointed by the Minister.

(2) The chairman of the Tribunal shall be a person who has been a judge or who is qualified to be appointed a judge of the High Court of Kenya.

(3) At least two members of the Tribunal shall be persons who have, for not less than seven years, been qualified and entitled to practice as advocates in Kenya and the other two members must have experience and/or expertise in industrial, scientific and technological fields.

(4) The Tribunal shall sit at such times as it may appoint.

(5) There shall be paid to the Chairman and the members of the Tribunal such remuneration and allowances as the Minister may determine.

(6) The Board shall appoint a suitable legal officer to be secretary to the Tribunal.

(7) The chairman and every member appointed under this section shall hold office for a period of three years and shall be eligible for re-appointment.

(8) Any member appointed under subsection (1) shall cease to hold office if—

- (a) the Minister removes him from office on the grounds that he is incapacitated by mental or physical illness or is otherwise unable or unfit to discharge the functions of a member or is unable to continue as a member;
- (b) he delivers to the Minister a written resignation of his appointment;
- (c) he has been absent from three consecutive meetings of the Tribunal without leave or good cause;
- (d) he is adjudged bankrupt or enters into a scheme of composition or a scheme of arrangement with his creditors;
- (e) he is sentenced by a court to imprisonment for a term of six months or more; or
- (f) he is convicted of an offence involving dishonesty, fraud or moral turpitude.

(9) In the event of vacation of office of any member appointed under this section, the Minister may appoint another person to hold office for the unexpired period of the term of office of the member in whose place he is appointed.

(10) If any member of the Tribunal appointed under this section is temporarily unable to perform his duties, the Minister may appoint another person to act in his place during the period of his absence.

**114. Powers of the Tribunal**

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

- (2) Upon any appeal to the Tribunal under this Act, the Tribunal may—
- (a) confirm, set aside or vary the order or decision in question;
  - (b) exercise any of the powers which could have been exercised by the Managing Director in the proceedings in connection with which the appeal is brought; or
  - (c) make such orders as to costs as it may deem fit.

#### **115. Appeals to the High Court**

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

- (2) Upon the hearing of an appeal under this section, the High Court may—
- (a) confirm, set aside or vary the order or decision in question;
  - (b) remit the proceedings to the Tribunal with such instructions for further consideration, report, proceedings or evidence as the High Court may deem fit to give;
  - (c) exercise any of the powers which could have been exercised by the Tribunal in proceedings in connection with which the appeal is brought; or
  - (d) make such order as it may deem fit as to the costs of the appeal or of earlier proceedings in the matter before the Tribunal.

#### **116. Assessors**

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

#### **117. Rules and procedures of the Tribunal**

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

#### **118. Reference to the Tribunal by the Managing Director**

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

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

## PART XVIII – MISCELLANEOUS PROVISIONS

**119. Regulations**

The Minister may make regulations prescribing anything which under this Act may be prescribed and generally for the better carrying out of the objects and purposes of this Act.

**120. Annual Report**

(1) The Board shall, within four months after the end of each financial year, submit a report to the Minister on the activities of the Institute during the financial year.

(2) The Minister shall, within fourteen days after the receipt of the report, lay it before the National Assembly.

**121. Repeal of Cap. 509 and saving provisions**

(1) The Industrial Property Act is repealed.

(2) The transitional and saving provisions set out in the Second Schedule shall have effect upon the repeal of the Industrial Property Act.

**122. Exemption from stamp duty**

No duty shall be chargeable under the Stamp Duty Act (Cap. 480) in respect of any instrument executed by, or on behalf of, or in favour of the Institute which, but for this section, the Institute would be liable to pay.

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**SCHEDULES****FIRST SCHEDULE**

[Section 8.]

**PROVISIONS AS TO THE CONDUCT OF BUSINESS AND AFFAIRS OF THE BOARD****1. Tenure of office**

The chairman or a member of the Board other than an *ex officio* member shall, subject to the provisions of this Schedule, hold office for a period of three years, on such terms and conditions as may be specified in the instrument of appointment, but shall be eligible for re-appointment, subject to a maximum of three terms of office.

**2. Vacation of office**

The chairman or a member other than an *ex-officio* member may—

- (a) at any time resign from office by notice in writing to the Minister;
- (b) be removed from office by the Minister if the member—
  - (i) has been absent from three consecutive meetings of the Board without the permission of the Board;

- (ii) is convicted of a criminal offence and sentenced to imprisonment for a term exceeding six months or to a fine exceeding ten thousand shillings;
- (iii) is incapacitated by prolonged physical or mental illness for a period exceeding six months; or
- (iv) is otherwise unable or unfit to discharge his functions.

### **3. Meetings**

(1) The Board shall meet not less than four times in every financial year and not more than four months shall elapse between the date of one meeting and the date of the next meeting.

(2) Notwithstanding subparagraph (1), the chairman may, and upon requisition in writing by at least five members shall, convene a special meeting of the Board at any time for the transaction of the business of the Board.

(3) Unless three quarters of the total members of the Board otherwise agree, at least fourteen days' written notice of every meeting of the Board shall be given to every member of the Board.

(4) The quorum for the conduct of the business of the Board shall be seven members including the chairman or the person presiding.

(5) The chairman shall preside at every meeting of the Board at which he is present but in his absence, the members present shall elect one of their number to preside, who shall, with respect to that meeting and the business transacted thereat, have all the powers of the chairman.

(6) Unless a unanimous decision is reached, a decision on any matter before the Board shall be by a majority of the votes of the members present and voting and in the case of an equality of votes, the chairman or the person presiding shall have a casting vote.

(7) Subject to such subparagraph (4), no proceedings of the Board shall be invalid by reason only of a vacancy among the members thereof.

(8) Subject to the provisions of this Schedule, the Board may determine its own procedure and the procedure for any committee of the Board and for the attendance of other persons at its meetings and may make standing orders in respect thereof.

**4.** (1) The Board may establish such committees as it may deem appropriate to perform such functions and responsibilities as it may determine.

(2) The Board shall appoint the chairman of a committee established under subparagraph (1) from amongst its own members.

(3) The Board may where it deems appropriate, co-opt any person to attend the deliberations of any of its committees.

### **5. Disclosure of interest**

(1) If a member is directly or indirectly interested in any contract, proposed contract or other matter before the Board and is present at a meeting of the Board at which the contract, proposed contract or other matter is the subject of consideration, he shall, at the meeting and as soon as reasonably practicable

after the commencement thereof, disclose the fact and shall not take part in the consideration or discussion of, or vote on, any questions with respect to the contract or other matter, or be counted in the quorum of the meeting during consideration of the matter.

(2) A disclosure of interest made under this paragraph shall be recorded in the minutes of the meeting at which it is made.

(3) A member of the Board who contravenes subparagraph (1) commits an offence and is liable to a fine of one hundred thousand shillings, or to imprisonment for a term of six months, or to both.

## 6. The common seal

The affixing of the common seal of the Institute shall be authenticated by the signature of the chairman and the Managing Director and any document not required by law to be made under seal and all decisions of the Board may be authenticated by the signatures of the chairman and the Managing Director:

Provided that the Board shall, in the absence of either the chairman or the Managing Director in any particular matter, nominate one member to authenticate the seal on behalf of either the chairman or the Managing Director.

## 7. Contracts and instruments

Any contract or instrument which, if entered into or executed by a person not being a body corporate, would not require to be under seal, may be entered into or executed on behalf of the Board by any person generally or specially authorised by the Board for that purpose.

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## SECOND SCHEDULE

[Section 121(2), Act No. 7 of 2007, Sch.]

### TRANSITIONAL AND SAVING PROVISIONS

#### 1. In this Schedule—

“**former Act**” means the Industrial Property Act (Cap. 509) repealed by section 121 of this Act;

“**former Office**” means the Kenya Industrial Property Office existing immediately before the commencement of this Act.

2. Where a patent was registered in Kenya under the former Act or where it was saved under section 126(1) of that Act, and the privileges and rights conferred by the registration were effective immediately before the commencement of this Act, then, subject to this Schedule—

- (a) such a patent shall be treated in Kenya as if it had been granted under this Act;
- (b) such a patent shall expire as regards Kenya when those privileges and rights could have expired if this Act had not been made;



- (c) such a patent may be revoked or invalidated only where those privileges and rights could be declared as not having been acquired in Kenya if this Act had not been made;
- (d) the certificate of registration, or a certified copy of such patent, shall be admissible as *prima facie* evidence of the date and the fact of registration; and
- (e) an action for infringement of such patent shall be under this Act only if the alleged infringement occurred on or after the commencement of this Act, and in other cases may be instituted and disposed of as if this Act had not been enacted.

**3.** So far as is necessary for the purposes of paragraph 2, the register of patents under the former Act shall continue to be maintained and shall be deemed to be part of the register under this Act.

**4.** Where the registered proprietor of a design registered in the United Kingdom under the Registered Designs Act (Cap. 510), 1949 of the United Kingdom enjoyed the same privileges and rights in Kenya in respect of such design under the provisions of the repealed United Kingdom Industrial Designs Act immediately before commencement of the former Act, such design shall be deemed to have been registered under the former Act.

**5.** Applications for the grant of patents or the registration of utility models or industrial designs filed in Kenya between the date of the commencement of the former Act and the date of the commencement of this Act, shall be processed in accordance with the provisions of this Act and shall retain or be accorded the filing date or validly claimed priority date which was or would have been accorded under the former Act.

**6.** Section 62 of the Act shall not apply to licence contracts and contracts assigning the right to a patent or assigning applications or patents, provided that the said contracts were concluded before the commencement of this Act and are submitted for registration to the Managing Director within sixty days from the commencement of this Act.

**6A.** The registration of a utility model granted immediately before the commencement of this Act shall be deemed to be a registration under this Act and shall expire at the end of the tenth year after the date of such grant.

**7.** All the funds, assets and other property, movable and immovable, which immediately before the coming into operation of this Act, were held by the Government on behalf of the former Office shall, by virtue of this paragraph and without further assurance, vest in the Institute.

**8.** Every public officer having the power or duty to effect or amend any entry in a register relating to property, or to issue or amend any certificate or other document effecting or evidencing title to property, shall, without payment of any fee or other charge and upon request by or on behalf of the Institute, do all such things as are by law necessary to give final effect to the transfer of any property mentioned in paragraph 7 to the Institute.

**9.** All rights, powers, liabilities and duties, whether arising under any written law or otherwise, which immediately before the coming into operation of this Act were vested in, imposed on or enforceable by or against the Government in respect of the former Office shall by virtue of this paragraph, be transferred to, vested in, imposed on, or be enforceable by or against the Institute.

**10.** On and after the coming into operation of this Act, all actions, suits or legal proceedings by or against the Government pending in respect of the former Office shall be carried on or prosecuted by or against the Institute and no such suit, action or legal proceedings shall abate or be affected by the coming into operation of this Act.

**11.** The annual estimates approved for the former Office in respect of the financial year in which this Act comes into operation shall be deemed to be annual estimates of the Institute for the remainder of the financial year but those estimates may be varied by the Board in such manner as the Minister and the Treasury may approve.

**12.** Any person who is an officer or employee of the former Office immediately before coming into operation of this Act shall be deemed to be an officer or employee of the Institute:

Provided that—

- (a) any officer or employee of the former Office who does not wish to become an officer or employee of the Institute shall exercise his option within a period of thirty-six months from the date of coming into operation of this Act;
  - (b) subject to subparagraph (a), every officer or employee of the Institute shall enter into a written contract with the Institute within a period of twelve months with effect from the date of the appointment of the Board, whereupon his services with the Government shall be transferred to the Institute:  
Provided that the terms and conditions of service of the contract shall not be to the disadvantage of the officer or employee;
  - (c) any officer or employee of the former office who does not exercise his option under (a) shall be deemed to have been seconded to the Institute for a further period of twelve months, at the end of which he shall either exercise his option as provided under subparagraph (a) or enter into a contract with the Institute as provided for in subparagraph (b).
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**NO 3 OF 2001**

**INDUSTRIAL PROPERTY ACT**

SUBSIDIARY LEGISLATION

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**INDUSTRIAL PROPERTY TRIBUNAL RULES, 2002**

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-

**INDUSTRIAL PROPERTY TRIBUNAL RULES, 2002**

[L.N. 196/2002.]

**1. Citation**

These Rules may be cited as the Industrial Property Tribunal Rules, 2002.

**2. Definitions**

In these Rules, unless the context otherwise requires—

“**Chairman**” means the Chairman of the Tribunal;

“**Secretary**” means the Secretary to the Tribunal.

**3. Forms**

The forms referred to in these Rules are the forms set out in the First Schedule.

**4. Fees**

(1) The fees set out in the Second Schedule are prescribed.

(2) If, for a fee, a corresponding form is referred to in the Second Schedule, the fee is payable when the form is used.

(3) A fee paid in error may be refunded.

**PART II – APPEAL PROCEEDINGS****5. Notice of appeal**

(1) A person who may appeal to the Tribunal shall do so by filing a notice of appeal with the Tribunal.

(2) The notice of appeal shall set out—

(a) the decision appealed against;

(b) whether or not the appeal is against the entire decision or only part of the decision, and if the appeal is against only part of the decision, the part of the decision appealed against;

(c) the grounds of appeal; and

(d) the order or any other relief sought.

(3) The notice of appeal shall be in the following form—

(a) for an appeal from a decision of the Minister under section 27(7) of the Act, in Form IPT 1;

(b) for an appeal from a decision of the Managing Director under section 71 of the Act, in Form IPT 2;

(c) for an appeal from a decision of the Minister under section 80(11) of the Act, in Form IPT3;

(d) for an appeal from a decision of the arbitration board under section 101(3) of the Act, in Form IPT 4;

(e) for an appeal from a decision of the Managing Director, other than an appeal described in paragraph (b), in Form IPT 5.

[Subsidiary]

#### **6. Time limit for appeals**

(1) An appeal shall be made within 90 days after the date of the notification of the decision.

(2) Subrule (1) does not apply with respect to an appeal if a provision of the Act or the Industrial Property Regulations, 2002 provides a time limit for making the appeal.

#### **7. Parties**

(1) If a decision arising from a proceeding is appealed, each person who was a party to the proceeding is a party to the appeal.

(2) The Managing Director shall be a party to an appeal from a decision of the Minister or the Managing Director other than an appeal under regulation 49(20) of the Industrial Property Regulations, 2002.

(3) The Minister shall not be a party to an appeal from a decision of the Minister.

(4) The Tribunal may add persons as parties to an appeal.

#### **8. Service of notice of appeal**

The Secretary shall serve a notice of appeal upon each party other than the appellant.

#### **9. Reply**

(1) A party may oppose an appeal by filing with the Tribunal a reply setting out fully the grounds of opposition.

(2) The reply shall be in Form IPT 6.

(3) The reply shall be filed within 45 days after the notice of appeal is served.

(4) The Secretary shall serve a copy of the reply upon the appellant and the other parties.

### **PART III – PROCEEDINGS RELATING TO LICENCES**

#### **10. Application for repayment of royalties, etc.**

(1) An application for an order of the tribunal under section 66 of the Act shall be in Form IPT 7 and shall be filed with the Tribunal.

(2) The application shall set out the order being sought and shall be accompanied by a statement of the facts being relied upon.

(3) The Secretary shall serve a copy of the application and the accompanying statement of facts upon the person against whom the order is sought.

(4) The person against whom the order is sought may oppose the application by filing with the Tribunal a counter-statement setting out fully the grounds of opposition.

(5) The counter-statement shall be in Form IPT 6.

(6) The counter-statement shall be filed within 45 days after the application is served.

(7) The Secretary shall serve a copy of the counter-statement upon the applicant.

#### **11. Application and requests for compulsory licences**

(1) This rule applies with respect to an application under section 72(1) of the Act or a request under section 73(1) of the Act.

(2) The application or request shall be in Form IPT 8 and shall be filed with the Tribunal.



[Subsidiary]

(3) The application or request shall set out the relief being sought and shall be accompanied by a statement of the fact being relied upon and supporting evidence.

(4) The Tribunal shall consider the application or request and, if the Tribunal is of the view that a *prima facie* case has not been made out for the relief sought, the following shall apply—

- (a) the Tribunal shall notify the person who made the application or request that the Tribunal is of the view that a *prima facie* case has not been made out and that the person may, within thirty days after the notification, request an opportunity to be heard;
- (b) if the person who made the application or request requests an opportunity to be heard within the time period described in sub-rule (a), the Tribunal shall give the person such an opportunity and, if the Tribunal is still of the view that a *prima facie* case has not been made out, the Tribunal shall dismiss the application or request; and
- (c) if the person who made the application or request does not request an opportunity to be heard within the time period described in sub-rule (a), the Tribunal shall dismiss the application or request.

(5) Unless the Tribunal dismisses the application or request under sub-rule (4)(b) or (c)—

- (a) the Tribunal shall publish the application or request in the Kenya *Gazette* or in the Industrial Property Journal; and
- (b) the Secretary shall serve a copy of the application or request and the accompanying statement of facts and supporting evidence required under sub-rule (3) upon the owner of the patent and anyone else shown in the patent register as having an interest in the patent.

(6) Before an application or request is published under sub-rule (5)(a), the person who made the application or request shall pay the publication fee.

(7) A person may oppose the application or request by filing with the Tribunal a reply in Form IPT 9 setting out fully the grounds of opposition.

(8) The reply shall be accompanied by a statement of the facts being relied upon and supporting evidence.

(9) The reply shall be filed within 45 days after the application or request is published.

(10) The Secretary shall serve a copy of the reply and the accompanying statement of facts and supporting evidence required under sub-rule (8) upon the person who made the application or request.

(11) The person who made the application or request may, within 45 days after being served under sub-rule (10), file with the Tribunal further evidence confined to matters strictly in reply.

(12) The Secretary shall serve a copy of evidence filed under sub-rule (11) upon the person opposing the application or request.

(13) No further evidence shall be filed except by leave or direction of the Tribunal.

(14) Evidence filed under this rule shall be by way of a statutory declaration or affidavit.

(15) Rule 24 does not apply with respect to an application or request with respect to which this rule applies.

[Subsidiary]

## **12. Application for cancellation of a compulsory licence**

(1) An application for the cancellation of a compulsory licence under section 77(1) or (2) of the Act shall be in Form IPT 10 and shall be filed with the Tribunal.

(2) The application shall be accompanied by a statement of the facts being relied upon.

(3) The Secretary shall serve a copy of the application and the accompanying statement of facts upon the licensee.

(4) The licensee may oppose the application by filing with the Tribunal a counter-statement setting out fully the grounds of opposition.

(5) The counter-statement shall be in Form IPT 6.

(6) The counter-statement shall be filed within 45 days after the application is served.

(7) The Secretary shall serve a copy of the counter-statement upon the applicant.

## **13. Application for variation of terms of a compulsory licence**

(1) An application for the variation of terms of a compulsory licence under section 77(3) of the Act shall be in Form IPT 11 and shall be filed with the Tribunal.

(2) The application shall set out the variation of terms being sought and shall be accompanied by a statement of the facts being relied upon.

(3) The Secretary shall serve a copy of the application and the accompanying statement of facts upon the other party to the licence.

(4) The other party to the licence may oppose the application by filing with the Tribunal a counter-statement setting out fully the grounds of opposition.

(5) The counter-statement shall be in Form IPT 6.

(6) The counter-statement shall be filed within 45 days after the application is served.

(7) The Secretary shall serve a copy of the counter-statement upon the applicant.

## **14. Form of instruction under section 78 of the Act**

An instruction under section 78 of the Act with respect to the recording of a grant, cancellation or variation shall be in Form IPT 12.

## **15. Application for fixing of terms**

(1) An application to have the Tribunal fix the terms of a non-exclusive licence under section 79(5) of the Act shall be in Form IPT 13 and shall be filed with the Tribunal.

(2) The application shall set out the terms being sought and shall be accompanied by a statement of the facts being relied upon.

(3) The Secretary shall serve a copy of the application and the accompanying statement of facts upon the other party to the licence.

(4) The other party to the licence may oppose the application by filing with the Tribunal a counter-statement setting out fully the grounds of opposition.

(5) The counter-statement shall be in Form IPT 6.

(6) The counter-statement shall be filed within 45 days after the application is served.

(7) The Secretary shall serve a copy of the counter-statement upon the applicant.

## PART IV – REVOCATION OR INVALIDATION PROCEEDINGS

**16. Request for revocation or invalidation**

(1) A request under subsection (1) or (2) of section 103 of the Act for the revocation or invalidation of a patent, utility model or industrial design registration shall be in Form IPT 14.

(2) The request shall be filed with the Tribunal after notice of the filing is given to the owner of the patent, utility model or industrial design registration by serving a copy of the request on the owner.

**17. Counter-statement**

(1) A period of 45 days beginning when the owner of the patent is served is prescribed, for the purpose of section 103(5) of the Act, as the time within which a counter-statement may be lodged.

(2) The counter-statement shall be in Form IPT 6.

**18. Publication fee for application**

Before an application is published under section 103(10) of the Act, the applicant shall pay the publication fee.

**19. Form of information under section 104(2) of the Act**

The Chairman shall use Form IPT 15 to inform the Managing Director under section 104(2) of the Act.

## PART V – PROCEEDINGS RELATING TO INFRINGEMENT

**20. Requests under section 106 of the Act**

(1) A request under section 106 of the Act shall be in form IPT 16 and shall be filed with the Tribunal.

(2) The request shall set out the relief being sought and shall be accompanied by a statement of the facts being relied upon.

(3) The Secretary shall serve a copy of the request and the accompanying statement of facts upon the person against whom the relief is sought.

(4) The person against whom the relief is sought may oppose the request by filing with the Tribunal a counter-statement setting out fully the grounds of opposition.

(5) The counter-statement shall be in Form IPT 6.

(6) The counter-statement shall be filed within 45 days after the request is served.

(7) The Secretary shall serve a copy of the counter-statement upon the person who made the request.

(8) If a counter-statement includes a request under section 103 of the Act the Tribunal shall, at the request of a party, give directions with respect to the procedure to be followed.

**21. Requests under section 107(1) of the Act**

(1) A request under section 107(1) of the Act shall be in Form IPT 17 and shall be filed with the Tribunal.

(2) The request shall set out the declaration being sought and shall be accompanied by a statement of the facts being relied upon.

**[Subsidiary]**

(3) The Secretary shall serve a copy of the request and the accompanying statement of facts upon the owner of the patent or registered utility model or industrial design and any licensee.

(4) The owner or a licensee may oppose the request by filing with the Tribunal a counter-statement setting out fully the grounds of opposition.

(5) The counter-statement shall be in Form IPT 6.

(6) The counter-statement shall be filed within 45 days after the request is served.

(7) The Secretary shall serve a copy of the counter-statement upon the person who made the request.

**22. Requests under section 108(1) of the Act**

(1) A request under section 108(1) of the Act shall be in Form IPT 18 and shall be filed with the Tribunal.

(2) The request shall set out the relief being sought and shall be accompanied by a statement of the facts being relied upon.

(3) The Secretary shall serve a copy of the request and the accompanying statement of facts upon the person threatening infringement proceedings.

(4) The person threatening infringement proceedings may oppose the request by filing with the Tribunal a counter-statement setting out fully the grounds of opposition.

(5) The counter-statement shall be in Form IPT 6.

(6) The counter-statement shall be filed within 45 days after the request is served.

(7) The Secretary shall serve a copy of the counter-statement upon the person who made the request.

**PART VI – GENERAL RULES APPLICABLE TO ALL PROCEEDINGS****23. Frivolous or vexatious proceedings**

If a notice of appeal, application or request discloses no reasonable grounds and it appears to the Tribunal that it is frivolous or vexatious, the Tribunal may dismiss the appeal, application or request without a hearing.

**24. Evidence**

(1) This rule applies with respect to evidence in an appeal, application or request to the Tribunal.

(2) The person initiating the proceedings shall, within 45 days after being served with a copy of the respondent's reply or counter-statement, file either—

- (a) evidence in support of his case; or
- (b) a statement that no evidence is to be adduced.

(3) The Secretary shall serve a copy of the evidence or statement filed under sub-rule (2) upon the respondent.

(4) The respondent shall, within 45 days after being served with a copy of the evidence or statement under sub-rule (3), file either—

- (a) evidence in support of his case; or
- (b) a statement that no evidence is to be adduced.

(5) The Secretary shall serve a copy of the evidence or statement filed under sub-rule (4) upon the other parties.

[Subsidiary]

(6) The person initiating the proceedings may, within 45 days after being served with a copy of evidence under sub-rule (5), file further evidence confined to matters strictly in reply.

(7) The Secretary shall serve a copy of evidence filed under sub-rule (6) upon the respondent.

(8) No further evidence shall be filed except by leave or direction of the Tribunal.

(9) Evidence filed under this rule shall be filed with the Tribunal and shall be by way of a statutory declaration or affidavit.

(10) In this rule—

“**a person initiating the proceedings**” means the person making the appeal, application or request to the Tribunal;

“**respondent**” means the party or parties to the proceedings, other than the person initiating the proceedings.

## 25. Security for costs

(1) The Tribunal may order the person making an appeal, application or request to provide security for costs.

(2) A party may apply for an order under sub-rule (1) by filing a notice of application with the Tribunal.

(3) The Secretary shall serve a copy of the notice of application upon the party against whom the order is sought.

(4) The Tribunal may order that security be provided and may specify the amount of the security and how and when it shall be provided.

(5) A party who is ordered to pay security may apply for an extension of the time within which the security is to be given.

(6) If the Tribunal has ordered a party to provide security, the proceedings shall be stayed until the security is provided and, if the security is not provided within the time specified, the Tribunal may dismiss the appeal, application or request.

## 26. Hearings, scheduling, etc.

(1) The time and place of a hearing in a proceeding shall be determined by the Secretary in consultation with the Chairman.

(2) The Secretary shall give the parties at least fourteen days notice of a hearing.

(3) The Chairman may allow less than fourteen days notice to be given under sub-rule (2).

(4) The hearing shall be held in Nairobi unless the Tribunal directs otherwise under sub-rule (5).

(5) The Tribunal may, on the application of a party and after giving the other parties an opportunity to be heard, direct that a hearing be held at a place that is not in Nairobi.

(6) An application for a direction under sub-rule (5) shall be filed with the Tribunal at least fourteen days before the hearing is scheduled to be held.

(7) In making a direction under sub-rule (5), the Tribunal may also give such directions with respect to notice and costs as it deems fit.

(8) A hearing may be adjourned by the Tribunal on such terms as the Tribunal deems fit.

[Subsidiary]

**27. Hearings, particular provisions**

The following apply with respect to a hearing before the Tribunal—

- (a) at the hearing the Tribunal may allow oral evidence and shall allow the cross examination of a person on his statutory declaration or affidavit;
- (b) the Tribunal may, on such terms as it may specify, allow a document to be amended or a procedural irregularity to be rectified;
- (c) the Tribunal may, on such terms as it may specify, dispense with or modify any requirement to do anything, including a requirement to provide a document, and
- (d) the Tribunal may require a party to pay all or part of the costs of another party and specify how the costs are to be determined and how they are to be paid.

**28. Witness allowances**

(1) A witness before the Tribunal shall be entitled to such allowances for food, accommodation and other incidental expenses as the Tribunal may direct.

(2) The allowances of a witness shall be paid by the party producing or summoning the witness.

(3) If a person is a witness in more than one proceeding in the same place on the same day, the following shall apply—

- (a) the person shall be entitled only to the allowances that would be payable if the person was a witness in a single proceeding; and
- (b) the costs of the allowances shall be shared equally among the parties producing or summoning the witness in the proceedings.

(4) Sub-rules (2) and (3) do not limit the power of the Tribunal, in making an order with respect to costs, to order another party to pay the costs of the allowances of a witness.

**29. Withdrawal**

(1) The person making an appeal, application or request may, at any time, withdraw the appeal, application or request by giving notice to the Tribunal in Form IPT 19.

(2) The Secretary shall serve a copy of the notice on the other party.

(3) A party may request the Tribunal to order costs to be paid by the party withdrawing the appeal, application or request.

**30. Number of copies of documents to be signed**

(1) If a person files a document with the Tribunal that is to be served on one or more other persons, the person filing the document shall file sufficient copies so that there is one copy for each person to be served and one copy for the Tribunal.

(2) If the document is signed, each copy required under sub-rule (1) shall be signed.

**31. Documents in English**

(1) Documents provided to the Tribunal shall be in English.

(2) Notwithstanding sub-rule (1), a document that is not in English may be included as an exhibit to a statutory declaration or affidavit if—

- (a) an English translation of the document is also included as an exhibit to the statutory declaration or affidavit; and
- (b) the translation is certified to be an accurate translation.

**32. Rules for giving notices, etc.**

- (1) A notice or other document that is to be served on a person may be served—
  - (a) by mailing or delivering the notice or document to the address of service provided by the person;
  - (b) by giving the notice or document personally to the person or by mailing or delivering the notice or document to the person's residence or place of business or employment; or
  - (c) by giving the notice or document personally to the person's agent or by mailing or delivering the notice or document to the agent's place of business.

(2) Proof that a notice or other document was served shall be in Form IPT 20.

(3) A notice or document that is mailed shall be deemed to have been served on the day the notice or document would be delivered in the ordinary course of post.

**33. Extension of time**

- (1) The Tribunal may extend, on such conditions as it may specify—
  - (a) a time limit under these Rules; or
  - (b) a time limit under the Act or the Industrial Property Regulations, 2002 for making an appeal.

(2) An application to the Tribunal for an extension of a time limit under sub-rule (1) shall be in Form IPT 21 and shall be filed with the Tribunal.

(3) The application shall state the grounds on which the application is based and shall be supported by a statutory declaration or affidavit.

(4) An application for an extension of a time limit may be made even though the time limit has expired.

(5) The Secretary shall serve a copy of the application and the accompanying statutory declaration or affidavit upon the other party to the application.

(6) The other party to the application may oppose the application by filing with the Tribunal a counter-statement.

(7) The counter-statement shall be in Form IPT 6.

(8) The counter-statement shall state the grounds of opposition and shall be supported by a statutory declaration or affidavit.

(9) The counter-statement shall be filed within 45 days after the application is served.

(10) The Secretary shall serve a copy of the counter-statement and the accompanying statutory declaration or affidavit upon the applicant.

(11) Rule 24 does not apply with respect to an application for an extension of a time limit under sub-rule (1).

**34. Signing of forms on behalf of certain bodies**

(1) A form that is required to be signed on behalf of a corporation shall, unless it is signed by an agent, be signed by a director of the corporation or the secretary of the corporation.

**[Subsidiary]**

- (2) The following apply if a form is required to be signed on behalf of a partnership—
- (a) unless the form is signed by an agent, the form shall be signed by a partner or by a person who satisfies the Tribunal that the person is authorised by the partnership to sign on its behalf; and
  - (b) the form shall set out the names of the partners in full.

**35. Statutory declarations and affidavits**

The following apply with respect to a statutory declaration or affidavit under these Rules—

- (a) the statutory declaration or affidavit shall have a heading indicating the matter or matters to which it relates;
- (b) the statutory declaration or affidavit shall be divided into consecutively numbered paragraphs, each of which shall, if possible, be confined to a single subject-matter; and
- (c) the statutory declaration or affidavit shall fully identify the person making it and shall set out where the person resides.

**36. Application for order under section 114(1) of the Act**

(1) An application for an order under section 114(1) of the Act shall be in Form IPT 22 and shall be filed with the Tribunal.

(2) The application shall set out the order being sought and shall be accompanied by a statutory declaration or affidavit setting out the facts being relied upon.

(3) Rules 23 to 30 do not apply with respect to an application described in sub-rule (1).

**37. Directions with respect to procedure**

(1) The Tribunal may give directions with respect to the procedure to be followed in any proceedings, including directions with respect to the form to be used where no form is otherwise provided for under these Rules.

(2) No direction may be inconsistent with any provision of the Act or these Rules.

**PART VII – MISCELLANEOUS PROVISIONS****38. Application to fix remuneration under section 32(4) of the Act**

(1) An application to have the Tribunal fix remuneration under section 32(4) of the Act shall be in Form IPT 23 and shall be filed with the Tribunal.

(2) The application shall set out the remuneration being sought and shall be accompanied by a statement of the facts being relied upon.

(3) The Secretary shall serve a copy of the application and the accompanying statement of facts upon the other party.

(4) The other party may oppose the application by filing with the Tribunal a counter-statement setting out fully the grounds of opposition.

(5) The counter-statement shall be in Form IPT 6.

(6) The counter-statement shall be filed within 45 days after the application is served.

(7) The Secretary shall serve a copy of the counter-statement upon the applicant.



**39. Reference under section 118 of the Act**

(1) A reference of a matter by the Managing Director to the Tribunal under section 118(1) of the Act shall be in Form IPT 24 and shall be filed with the Tribunal.

(2) A reference shall be accompanied by a statement setting out the facts of the matter and the directions being sought.

(3) A party may reply to the reference by filing a reply with the Tribunal.

(4) The reply shall be in Form IPT 6.

(5) The reply shall be filed within 45 days after notice of the reference is served on the party under section 118(1) of the Act.

(6) The Secretary shall serve a copy of the reply on the Managing Director and the other parties.

**40. Form for appointment of assessors**

An appointment of an assessor under section 116 of the Act shall be in Form IPT 25.

**41. Representation by agent**

(1) A person may be represented before the Tribunal by an agent in respect of a matter if—

- (a) an appointment of the agent in respect of the matter has been filed with the Tribunal; and
- (b) the agent is an advocate.

(2) An appointment of an agent shall be in Form IPT 26.

**42. Copies of documents**

A person who wishes to obtain a copy of a document kept by the Tribunal shall use Form IPT 27.

**43. Transition matters before the Tribunal**

(1) In this rule—

“**former Act**” means the Industrial Property Act (Cap. 509) repealed by section 121(1) of the Industrial Property Act, 2001;

“**former Tribunal**” means the Industrial Property Tribunal under the former Act.

(2) The following apply with respect to a matter still before the former Tribunal at the time the former Act was repealed—

- (a) the matter shall be continued before the Tribunal; and
- (b) the procedure under the Act and these Rules shall apply with necessary modifications and with such other modifications as the Tribunal may direct.

(3) The following apply with respect to a matter that, under the former Act, could have been brought before the former Tribunal before the repeal of the former Act—

- (a) the matter may be brought before the Tribunal subject to any limitations under the former Act; and
- (b) the procedure under the Act and these Rules shall apply with necessary modifications and with such other modifications as the Tribunal may direct.

(4) The application of this rule is subject to paragraph 2(e) of the Second Schedule to the Act.

*Industrial Property*

[Subsidiary]

(5) This rule shall not apply to shorten any time limit for doing anything if the time limit has already started to run before these Rules come into operation.

**44. Former rules repealed**

The Industrial Property Tribunal Rules, 1998 are repealed.

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SCHEDULES

FIRST SCHEDULE

FORMS

Form IPT1

(Rule 3)

[Rule 5(3)(a).]

**INDUSTRIAL PROPERTY ACT, 2001**

To: The Secretary  
Industrial Property Tribunal

NOTICE OF AN APPEAL UNDER SECTION 27(7) OF THE ACT

This is a notice of appeal to the Industrial Property Tribunal.

Name and address for service of appellant:

Decision appealed against:

If only part of the decision is appealed against, description of that part of the decision:

Grounds of the appeal:

Order or other relief sought:

Names and addresses of other parties to the appeal:

Signature of appellant or agent: .....

Date: .....

Industrial Property

[Subsidiary]

FIRST SCHEDULE—continued

Form IPT2

(Rule 5(3)(b))

INDUSTRIAL PROPERTY ACT, 2001

To: The Secretary  
Industrial Property Tribunal

NOTICE OF AN APPEAL FROM A DECISION OF THE MANAGING DIRECTOR  
UNDER SECTION 71 OF THE ACT

This is a notice of appeal to the Industrial Property Tribunal.

Name and address for service of appellant:

Decision appealed against:

If only part of the decision is appealed against, description of that part of the decision:

Grounds of the appeal:

Order or other relief sought:

Names and addresses of other parties to the appeal:

Signature of appellant or agent: .....

Date: .....

Form IPT3

(Rule 5(3)(c))

INDUSTRIAL PROPERTY ACT, 2001

To: The Secretary  
Industrial Property Tribunal

NOTICE OF AN APPEAL FROM A DECISION OF THE MINISTER  
UNDER SECTION 80(11) OF THE ACT

This is a notice of appeal to the Industrial Property Tribunal

Name and address for service of appellant:

Industrial Property

[Subsidiary]

FIRST SCHEDULE—continued

Decision appealed against:

If only part of the decision is appealed against, description of that part of the decision:

Grounds of the appeal:

Order or other relief sought:

Names and addresses of other parties to the appeal:

Signature of appellant or agent: .....

Date: .....

Form IPT4

(Rule 5(3)(d))

INDUSTRIAL PROPERTY ACT, 2001

To: The Secretary
Industrial Property Tribunal

NOTICE OF AN APPEAL FROM A DECISION OF THE ARBITRATION BOARD
UNDER SECTION 101(3) OF THE ACT

This is a notice of appeal to the Industrial Property Tribunal

Name and address for service of appellant:

Decision appealed against:

If only part of the decision is appealed against, description of that part of the decision:

Grounds of the appeal:

Order or other relief sought:

FIRST SCHEDULE—continued

Names and addresses of other parties to the appeal:

Signature of appellant or agent: .....

Date: .....

Form IPT5

(Rule 5(3)(e))

INDUSTRIAL PROPERTY ACT, 2001

To: The Secretary
Industrial Property Tribunal

NOTICE OF AN APPEAL FROM A DECISION OF THE MANAGING DIRECTOR
(OTHER THAN A DECISION UNDER SECTION 71 OF THE ACT)

This is a notice of appeal to the Industrial Property Tribunal

Name and address for service of appellant:

Decision appealed against:

If only part of the decision is appealed against, description of that part of the decision:

Grounds of the appeal:

Order or other relief sought:

Names and addresses of other parties to the appeal:

Signature of appellant or agent: .....

Date: .....

Industrial Property

[Subsidiary]

FIRST SCHEDULE—continued

Form IPT6

[Rules 9(2), 10(5), 12(5), 13(5), 15(5), 17(2), 20(5), 21(5), 22(5), 33(7), 38(5), 39(4).]

INDUSTRIAL PROPERTY ACT, 2001

To: The Secretary
Industrial Property Tribunal

REPLY/COUNTER-STATEMENT

In the matter of

This is a reply/counter-statement to the appeal, application or request described above.

Name and address for service of person filing the reply/counter-statement:

Grounds of opposition:

Signature of person filing reply/counter-statement or agent: .....

Date: .....

Form IPT7

(Rule 10(1))

INDUSTRIAL PROPERTY ACT, 2001

To: The Secretary
Industrial Property Tribunal

APPLICATION FOR AN ORDER OF THE TRIBUNAL UNDER SECTION 66 OF THE ACT

This is an application for an order of the Tribunal under section 66 of the Act.

Name and address for service of applicant:

Description of licence contract with respect to which the application relates:

Description of patent application or patent referred to in licence contract:

I, the applicant, declare that (tick the relevant box):

The application has been withdrawn;

The application has been finally rejected; or

The patent has been finally revoked or declared invalid.

Three vertically stacked empty boxes for tick marks.

Industrial Property

[Subsidiary]

FIRST SCHEDULE—continued

Order sought:

Name and address of person against whom order is sought:

A statement of the facts relied upon is attached.

Signature of applicant or agent: .....

Date: .....

Form IPT8

(Rule 11(2))

INDUSTRIAL PROPERTY ACT, 2001

To: The Secretary
Industrial Property Tribunal

APPLICATION FOR A COMPULSORY LICENCE UNDER SECTION 72(1) OF THE ACT OR
REQUEST FOR A COMPULSORY LICENCE UNDER SECTION 73(1) OF THE ACT

This is (tick the relevant box):

An application for a compulsory licence under section 72(1) of the Act;

Two empty checkboxes stacked vertically.

a request for a compulsory licence under section 73(1) of the Act.

One empty checkbox.

Name and address for service of applicant or requester:

Description of patent or patent application under which the compulsory licence is sought:

Relief sought:

A statement of the facts relied upon and supporting evidence, by way of a statutory declaration or affidavit, is attached.

Signature of applicant or requester or agent: .....

Date: .....

Industrial Property

[Subsidiary]

FIRST SCHEDULE—continued

Form IPT9

(Rule 11(7))

INDUSTRIAL PROPERTY ACT, 2001

To: The Secretary
Industrial Property Tribunal

REPLY TO AN APPLICATION FOR A COMPULSORY LICENCE UNDER SECTION 72(1) OF THE ACT OR REQUEST FOR A COMPULSORY LICENCE UNDER SECTION 73(1) OF THE ACT

In the matter of

This is a reply to the application or request for a compulsory licence described above.

Name and address for service of person filing the reply:

Grounds of opposition:

A statement of the facts relied upon and supporting evidence, by way of a statutory declaration or affidavit, is attached.

Signature of person filing reply or agent: .....

Date: .....

Form IPT10

(Rule 12(1))

INDUSTRIAL PROPERTY ACT, 2001

To: The Secretary
Industrial Property Tribunal

APPLICATION FOR CANCELLATION OF A COMPULSORY LICENCE UNDER SECTION 77(1) OR (2) OF THE ACT

This is an application for the cancellation of a compulsory licence under (tick the relevant box):

- Section 77 (1) of the Act;
Section 77(2) of the Act.

Name and address for service of applicant:

Licence for which application is made for cancellation:
Date of issue of licence:
Patent number:



FIRST SCHEDULE—continued

Grounds on which the application is based:

Name and addresses of other parties:

A statement of the facts relied upon is attached.

Signature of applicant or agent:.....

Date: .....

Form IPT11

(Rule 13(1))

INDUSTRIAL PROPERTY ACT, 2001

To: The Secretary
Industrial Property Tribunal

APPLICATION FOR VARIATION OF TERMS OF A COMPULSORY LICENCE
UNDER SECTION 77(3) OF THE ACT

This is an application for variation of the terms of a compulsory licence under section 77(3) of the Act.

Name and address for service of applicant:

Licence for which application is made for variation of terms:
Date of issue of licence:
Patent number:

Variation of terms being sought:

Grounds on which the application is based:

Names and addresses of other parties:

Industrial Property

[Subsidiary]

FIRST SCHEDULE—continued

A statement of the facts relied upon is attached.

Signature of applicant or agent: .....

Date: .....

Form IPT12

(Rule 14)

INDUSTRIAL PROPERTY ACT, 2001

To: The Managing Director  
Kenya Industrial Property Institute

INSTRUCTION UNDER SECTION 78 OF THE ACT TO RECORD A GRANT,  
CANCELLATION OR VARIATION

The Industrial Property Tribunal has granted, cancelled or varied the terms of a compulsory licence. The specifics of the grant, cancellation or variation are set out in the attached document.

The Tribunal hereby instructs you to record the appropriate particulars in the patent register upon a petition for registration being made under section 78 of the Act by one of the parties to the contract.

Signature of Chairman of Tribunal: .....

Date: .....

Form IPT13

(Rule 15(1))

INDUSTRIAL PROPERTY ACT, 2001

To: The Secretary  
Industrial Property Tribunal

APPLICATION FOR FIXING TERMS OF A NON-EXCLUSIVE LICENCE  
UNDER SECTION 79(5) OF THE ACT

This is an application to have the Tribunal fix the terms of a non-exclusive licence under section 79(5) of the Act.

Name and address for service of applicant:

Patent to which application relates:  
Patent number:

Terms being sought:

FIRST SCHEDULE—continued

Name and addresses of other parties:

Signature of applicant or agent: .....

Date: .....

Form IPT14

(Rule 16(1))

**INDUSTRIAL PROPERTY ACT, 2001**

To: The Secretary  
Industrial Property Tribunal

REQUEST UNDER SECTION 103(1) OR (2) OF THE ACT FOR REVOCATION OR  
INVALIDATION OF A PATENT OR UTILITY MODEL OR INDUSTRIAL DESIGN REGISTRATION

This is a request for the revocation or invalidation of a patent or utility model or industrial design registration on under section 103(1) or (2) of the Act.

If this request is made in an existing proceeding, set out a description of the proceeding:

Name and address for service of requester:

Patent or utility model or industrial design registration for which revocation or invalidation is requested:  
Date of issue of patent or registration:  
Patent or registration number:

Grounds on which the request if based:

Names and addresses of other parties:

Industrial Property

[Subsidiary]

FIRST SCHEDULE—continued

The following are attached as required under section 103(4)(b) of the Act:

- 1. a statement setting out particulars of the facts alleged in support of the grounds; and
- 2. proof of service, on the owner of the patent, of notice of filing of this request.

Signature of requester or agent: .....

Date: .....

Form IPT15

(Rule 19)

INDUSTRIAL PROPERTY ACT, 2001

To: The Managing Director  
Kenya Industrial Property Institute

INFORMATION, UNDER SECTION 104(2) OF THE ACT, OF TRIBUNAL DECISION

I hereby inform you, under section 104(2) of the Act, of the decision of the Tribunal, set out in the attached document. The decision is not longer subject to appeal.

Section 104(2) of the Act requires you to register and publish this decision.

Signature of Chairman of Tribunal: .....

Date: .....

Form IPT16

(Rule 20(1))

INDUSTRIAL PROPERTY ACT, 2001

To: The Secretary  
Industrial Property Tribunal

REQUEST UNDER SECTION 106 OF THE ACT

This is a request under section 106 of the Act.

Name and address for service of requester:
--

Patent, registered utility model or industrial design which requester owns and in respect of which relief is sought:
Date of issue:
Patent or registration number:

FIRST SCHEDULE—continued

Relief sought:

Names and addresses of person against whom relief is sought:

A statement of the facts relied upon is attached.

Signature of requester or agent: .....

Date: .....

Form IPT17

(Rule 21(1))

INDUSTRIAL PROPERTY ACT, 2001

To: The Secretary
Industrial Property Tribunal

REQUEST UNDER SECTION 107(1) OF THE ACT FOR A DECLARATION OF NON-INFRINGEMENT

This is a request under section 107(1) of the Act for a declaration that the performance of a specific act does not infringe a patent or registered utility model or industrial design.

Name and address for service of requester:

Patent, registered utility model or industrial design in respect of which the declaration is sought:
Date of issue:
Patent or registration number:

Declaration sought:

Names and addresses of owner of patent or registered utility model or Industrial design and any licensees:

A statement of the facts relied upon is attached.

Signature of requester or agent: .....

Date: .....

Industrial Property

[Subsidiary]

FIRST SCHEDULE—continued

Form IPT18

(Rule 22(1))

INDUSTRIAL PROPERTY ACT, 2001

To: The Secretary
Industrial Property Tribunal

REQUEST UNDER SECTION 108(1) OF THE ACT FOR AN INJUNCTION AND DAMAGES

This is a request under section 108(1) of the Act for an injunction and damages relating to threats of infringement proceedings.

Name and address for service of requester:

Patent, registered utility model or industrial design in respect of which the threat of infringement proceedings was made:
Date of issue:
Patent or registration number:

Relief sought:

Name and address of the person threatening infringement proceedings:

A statement of the facts relied upon is attached.

Signature of requester or agent: .....

Date: .....

Form IPT19

(Rule 29(1))

INDUSTRIAL PROPERTY ACT, 2001

To: The Secretary
Industrial Property Tribunal

NOTICE OF A WITHDRAWAL OF AN APPEAL, APPLICATION OR REQUEST

In the Matter of

This is a notice that the appeal, application or request described above is being withdrawn.

Name and address for service of person who made the appeal, application or request being withdrawn:

FIRST SCHEDULE—continued

Name and address for service of other party:

Signature of person withdrawing the appeal, application or request or his agent: .....

Date: .....

Form IPT20

(Rule 32(2))

INDUSTRIAL PROPERTY ACT, 2001

To: The Secretary  
Industrial Property Tribunal

PROOF OF SERVICE

I ..... of ..... hereby certify that at (see note 1) ..... on the ..... day of ....., 20 ..... at ..... o'clock in the ....., I served the documents, copies of which are attached, on ..... by (see note 2) .....

Dated at ..... this ..... day of ....., 20 .....

Signature (see note 3): .....

Notes:

- 1. State precisely where service was effected.
- 2. Describe the method of service used.
- 3. To be signed by the person effecting service.

Form IPT21

(Rule 33(2))

INDUSTRIAL PROPERTY ACT, 2001

To: The Secretary  
Industrial Property Tribunal

APPLICATION FOR EXTENSION OF TIME LIMIT

This is an application for an extension of a time limit.

Name and address for service of applicant:

Description of the matter with respect to which the time limit relates:

Industrial Property

[Subsidiary]

FIRST SCHEDULE—continued

Extension sought:

Grounds on which the application is based:

Names and addresses of other parties:

A statutory declaration or affidavit supporting this application is attached.

Signature of applicant or agent: .....

Date: .....

Extension granted:

.....

.....

Signature of Secretary of Tribunal: .....

Date: .....

Form IPT22

(Rule 36(1))

INDUSTRIAL PROPERTY ACT, 2001

To: The Secretary  
Industrial Property Tribunal

APPLICATION FOR AN ORDER UNDER SECTION 114(1) OF THE ACT

In the Matter of

This is an application for an order under section 114(1) of the Act.

Order sought:

Name and address for service of applicant:



Industrial Property

[Subsidiary]

FIRST SCHEDULE—continued

Names and addresses for service of other parties:

A statutory declaration or affidavit supporting this application is attached.

Signature of applicant or agent: .....

Date: .....

Form IPT23

(Rule 38(1))

INDUSTRIAL PROPERTY ACT, 2001

To: The Secretary  
Industrial Property Tribunal

APPLICATION TO HAVE EMPLOYEE'S REMUNERATION FOR INVENTION FIXED

This is an application to have the Tribunal fix remuneration under section 32(4) of the Act.

Name and address for service of applicant:

Patent to which application relates:  
Patent number:

Remuneration being sought:

Names and addresses of other parties:

Signature of applicant or agent: .....

Date: .....

Form IPT24

(Rule 39(1))

INDUSTRIAL PROPERTY ACT, 2001

To: The Secretary  
Industrial Property Tribunal

REFERENCE OF A MATTER BY THE MANAGING DIRECTOR UNDER  
SECTION 118(1) OF THE ACT

This is a reference of a matter by the Managing Director to the Tribunal under section 118(1) of the Act.

Industrial Property

[Subsidiary]

FIRST SCHEDULE—continued

Description of the matter being referred and directions sought:

Names and addresses of other parties:

Signature of Managing Director: .....

Date: .....

Form IPT25

(Rule 40)

INDUSTRIAL PROPERTY ACT, 2001

APPOINTMENT OF AN ASSESSOR UNDER SECTION 116 OF THE ACT

I hereby appoint ....., under section 116 of the Act, to act as an assessor in an advisory capacity in the following case:

.....

Signature of Chairman of Tribunal: .....

Date: .....

Form IPT26

(Rule 41(2))

INDUSTRIAL PROPERTY ACT, 2001

To: The Secretary
Industrial Property Tribunal

APPOINTMENT OF AN AGENT

Name and address of person appointing agent:

Name and address of agent:

Matter in respect of which agent is appointed:

I/We, the person(s) identified above, have appointed the above agent to act on my/our behalf in the matter described above and request that all communications relating thereto be sent to the agent at his address given above.

Industrial Property

[Subsidiary]

FIRST SCHEDULE—continued

I/We revoke all previous appointments in respect of the same matter.

Signature of person appointing agent: .....

Date: .....

Form IPT27

(Rule 42)

INDUSTRIAL PROPERTY ACT, 2001

To: The Secretary
Industrial Property Tribunal

ORDER FOR COPY OF DOCUMENT

Name and address of person seeking copy:

I wish to obtain a copy of a document of the following type (tick the relevant box):

a judgment or order of the Tribunal or other document used in a proceeding before the Tribunal

another document

Description of document:

I wish to have the copy of the document certified (tick the relevant box):

Yes

No

Signature of person seeking copy: .....

Date: .....

SECOND SCHEDULE

[Rule 4.]

FEES

Notes:

- 1. A foreign fee is payable if the person paying the fee or on whose behalf the fee is being paid does not reside in Kenya and does not have a principal place of business in Kenya.

Table with 4 columns: Description of fee, Local Fee KSh, Foreign Fee US\$, Corresponding Form. It lists 5 types of fees for appeals under various sections of the Act.

## Industrial Property

[Subsidiary]

## SECOND SCHEDULE—continued

<i>Description of fee</i>	<i>Local Fee KSh.</i>	<i>Foreign Fee US\$</i>	<i>Corresponding Form</i>
6. Fee for filing a reply or counter-statement (other than a reply described in item 10)			6
For a counter-statement to an application to extent a time limit	2,000	50	6
For other reply or counter-statement	10,000	300	7
7. Fee for application for order under section 66 of the Act	15,000	400	8
8. Fee for application under section 72(1) of the Act or request under section 73(1) of the Act	15,000	400	N/A
9. Publication fee (see rule 11(6), 18)	3,000	50	9
10. Fee for reply to application under section 72(1) of the Act or request under section 73(1) of the Act	15,000	400	10
11. Fee for application for cancellation of a compulsory licence under section 77(1) or (2) of the Act.	15,000	400	11
12. Fee for application for variation of terms of a compulsory licence under section 77(3) of the Act	15,000	400	13
13. Fee for application for fixing of terms under section 79(5) of the Act.	12,000	3,000	14
14. Fee for request under section 103(1) or (2) of the Act	15,000	400	16
15. Fee for request under section 106 of the Act	15,000	400	17
16. Fee for request under section 107(1) of the Act	15,000	400	18
17. Fee for request under section 108(1) of the Act	15,000	400	19
18. Fee for withdrawal of appeal, application or request	1,000	50	21
19. Fee for application to extend time limit	2,000	50	22
20. Fee for application for order under section 114(1) of the Act	6,000	150	23
21. Fee for application to fix remuneration under section 34(5) of Act	8,000	200	
22. Fee for reference under section 118(1) of the Act	10,000	—	24
23. Fee for appointment of agent	1,000	50	26
24. Fee for copies			27
For judgments, orders or other documents used in a proceeding before the tribunal, per page:	20	5	
For other documents, per document:	500	10	
Additional fee for certification, per document	1,000	50	

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**INDUSTRIAL PROPERTY REGULATIONS, 2002**

ARRANGEMENT OF REGULATIONS

PART I – PRELIMINARY

*Regulation*

1. Citation and commencement.
2. Forms.
3. Fees.

PART II – ADMINISTRATION

4. Training, competitions and awards.
5. Client deposit accounts.
6. Office hours of the Institute.
7. Publications of the Institute.
8. Appointment of advisors, etc.

PART III – PATENTS: PATENTABILITY

9. Certain notices, etc., in writing.
10. Request for authority.
11. Patents relating to living matter.

PART IV – APPLICATION, GRANT AND REFUSAL OF PATENT

12. Request.
13. Description.
14. Claims.
15. Drawings.
16. Abstract.
17. General requirements.
18. Provisional specification.
19. Unity of invention.
20. Amendment or division.
21. Declaration claiming priority.
22. Waiver of fees.
23. Withdrawal of application.
24. Filing date and examination.
25. Publication of application.
26. Confidentiality of application before publication.
27. International-type search.
28. Examination as to substance.
29. Grant of patent.
30. Register of patents.

PART V – INTERNATIONAL AND REGIONAL APPLICATIONS

31. Filing requirements for international or regional application.
32. Entry of international application to national phase.

**[Subsidiary]***Regulation*

33. Conversion of refused international application.
34. Conversion of refused regional application.
35. Publication of certain international and regional applications.

**PART VI – RIGHTS AND OBLIGATIONS OF THE APPLICANT OR THE OWNER OF THE INVENTION**

36. Clarification of application to new use.
37. “Parallel importation”.

**PART VII – ANNUAL FEES**

38. Annual fees.

**PART VIII – CHANGE IN OWNERSHIP**

39. Change of ownership of application or patent section 62 of the Act.

**PART IX – CONTRACTUAL LICENCES**

40. Petition to register licence contracts.
41. Registration of contracts.
42. Licences as of right.

**PART X – EXPLOITATION BY GOVERNMENT**

43. Exploitation by Government.

**PART XI – UTILITY MODELS**

44. Application of Regulations to utility models.

**PART XII – INDUSTRIAL DESIGNS**

45. Register of industrial designs.
46. Copyrighted designs not registrable.
47. Application.
48. Publication of application.
49. Procedure if opposition to application.
50. Procedure if no opposition to application.
51. Registration of industrial design.
52. Duration and renewal of registration.
53. Restoration of lapsed right.
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55. Publication relating to registration.
56. Application of regulations under.

**PART XIII – REGISTRATION OF TECHNOVATION CERTIFICATES**

57. Form of certificate.
58. Register of technovation certificates.
59. Application for registration.
60. Certificate of registration.

**PART XIV – SURRENDER**

61. Surrender.

PART XV – AGENTS

*Regulation*

- 62. Representation by agent.
- 63. Admission to practice as agent.
- 64. Annual fees for admitted persons.
- 65. Advocates Act restrictions preserved.
- 66. Revocation of admission to practice.
- 67. Offence acting as agent without admission.

PART XVI – GENERAL AND MISCELLANEOUS PROVISIONS

- 68. Copies of documents.
- 69. Copy of lost or destroyed certificate.
- 70. Request for a search.
- 71. Request to amend a name, etc., in a register.
- 72. Caution or notice in a register.
- 73. Rules for giving notices, etc.
- 74. Opportunity to be heard.
- 75. Hearings, particular provisions.
- 76. Extensions of time.
- 77. Signing of forms on behalf of certain bodies.
- 78. Statutory declarations and affidavits.
- 79. Documents in English or translated.
- 80. Repeal of former regulations.

SCHEDULES

- FIRST SCHEDULE – FORMS
  - SECOND SCHEDULE – FEES
-

[Subsidiary]

**INDUSTRIAL PROPERTY REGULATIONS, 2002**

[L.N. 50/2002.]

**PART I – PRELIMINARY****1. Citation and commencement**

These Regulations may be cited as the Industrial Property Regulations, 2002 and shall come into operation on the 1st May, 2002.

**2. Forms**

The forms referred to in these Regulations are the forms set out in the First Schedule.

**3. Fees**

(1) The fees set out in the Second Schedule shall be the prescribed fees for the purposes of these Regulations.

(2) If, for a fee, a corresponding form is referred to in the Second Schedule, the fee is payable when the form is used, unless the Act or these Regulations provide for the fee to be payable at another time.

(3) A fee paid in error may be refunded.

**PART II – ADMINISTRATION****4. Training, competitions and awards**

In carrying out its functions under paragraphs (c) and (d) of section 5 of the Act, the Institute shall—

- (a) organise and conduct training relating to industrial property matters at all levels in Kenya, in collaboration or association with other relevant institutions, if necessary; and
- (b) organise competitions and contests and award trophies and awards.

**5. Client deposit accounts**

(1) The Institute shall have one or more separate banking accounts for funds that the Institute receives to be held temporarily for other persons.

(2) All funds described in paragraph (1) shall be paid into an account required under that subregulation.

**6. Office hours of the Institute**

The offices of the Institute and the records and documents kept by the Managing Director shall be open to the public each day, other than on a Saturday, Sunday or public holiday, from 9 a.m. to 1 p.m. and from 2 p.m. to 4 p.m.

**7. Publications of the Institute**

(1) This regulation applies with respect to publications of the Institute.

(2) The Institute shall publish a journal to be called “The Industrial Property Journal”.

(3) Unless the Managing Director otherwise directs, the Industrial Property Journal shall be published monthly.



[Subsidiary]

(4) The Institute shall publish, from time to time, reports of cases relating to industrial property rights including decisions by the Tribunal or a court or other body, whether in Kenya or elsewhere.

(5) The Institute may publish such other documents as it considers appropriate.

(6) The Institute may provide for the sale of any of its publications.

#### **8. Appointment of advisors, etc.**

(1) The Managing Director may appoint a person to act as an advisor in relation to a proceeding or to perform any other function specified by the Managing Director.

(2) Paragraph (1) does not authorize the Managing Director to make an appointment that the Board is authorised to make under section 12 of the Act.

### PART III – PATENTS: PATENTABILITY

#### **9. Certain notices, etc., in writing**

The following shall be in writing—

- (a) a notification or notice under section 27 of the Act;
- (b) directions or instructions under section 27 of the Act; and
- (c) the report referred to in section 27(5)(b) of the Act.

#### **10. Request for authority**

A request for written authority referred to in section 28(1) of the Act shall be in Form IP 1.

#### **11. Patents relating to living matter**

(1) This regulation applies with respect to section 29 of the Act.

(2) The following are depository institutions for the purposes of section 29(1)(a) of the Act—

- (a) the Kenya Agricultural Research Institute; and
- (b) the Kenya Medical Research Institute.

(3) The Managing Director shall, on request, issue a certificate certifying that a person has a right to inspect the files for the purposes of section 29(3) of the Act if the Managing Director is satisfied that the person has such a right.

(4) A request for a certificate under paragraph (3) shall be in Form IP 2.

(5) A person to whom a deposited culture is made available under section 29(3) of the Act shall not do any of the following until the application is refused or withdrawn or, if a patent is granted, until after the patent ceases to have effect—

- (a) make the culture available to any other person; or
- (b) use the culture other than for experimental purposes.

(6) Paragraph (5)(b) does not apply with respect to anything done for the service of the Government by the Government or a person authorized in writing by the Government.

(7) A person who contravenes paragraph (5) is guilty of an offence and is liable, on conviction, to a fine not exceeding six thousand shillings or, to imprisonment for a term not exceeding six months or to both.

[Subsidiary]

## PART IV – APPLICATION, GRANT AND REFUSAL OF PATENT

**12. Request**

(1) This regulation applies with respect to a request referred to in section 34(1)(a) of the Act.

(2) The request shall be in Form IP 3.

(3) The following data concerning the applicant, inventor or agent is prescribed for the purposes of section 34(3) of the Act—

- (a) for the applicant, the applicant, the applicant's name, address, nationality and country of residence;
- (b) for the inventor, the inventor's name and address; and
- (c) for the agent, the agent's name and address.

(4) If there is more than one applicant, the request shall set out, in addition to an address for each applicant, a single address at which all the applicants can be contacted.

(5) The following apply with respect to names of persons set out in the request—

- (a) if the person is a natural person, the person's family name shall be set out first followed by the given names; and
- (b) if the person is not a natural person, the full name of the person shall be set out.

(6) The following apply with respect to addresses of persons set out in the request—

- (a) the address shall be sufficient to allow prompt postal delivery; and
- (b) only one address shall be set out for each person, except as required under paragraph (4).

(7) The title of the invention, required under section 34(3) of the Act, shall be short and precise.

(8) The statement justifying the applicant's right to the patent, required under section 34 (3) of the Act if the applicant is not the inventor, shall be in Form IP 4.

(9) The request shall be accompanied by an extra copy of the statement referred to in subregulation (8) for the inventor, or if.

(10) The request shall not include anything that is not provided for in Form IP 3 or that is not required or allowed under the Act or these Regulations.

(11) The Managing Director shall require the applicant to delete anything included contrary to subregulation (10).

**13. Description**

(1) This regulation applies with respect to a description referred to in section 34(1)(b) of the Act.

(2) In addition to the requirements under section 34(5) of the Act, the description shall—

- (a) state the title of the invention;
- (b) specify the technical field to which the invention relates;
- (c) indicate the background art which, as far as it is known to the applicant, can be regarded as useful for the understanding, searching and examination of the invention; and
- (d) indicate how the invention is industrially applicable.

**14. Claims**

(1) This regulation applies with respect to claims referred to in section 34(1)(c) of the Act.

(2) In defining, under section 34(6) of the Act, the matter for which protection is sought, a claim shall set out—

- (a) the technical features that are necessary to define the subject matter of the invention but that are part of the prior art; and
- (b) the technical features that, in combination with the features referred to in subparagraph (a), define that for which protection is sought.

(3) The features set out in the claim under paragraph (2)(b) shall be preceded by the words “characterized in that”, “characterized by”, “wherein the improvement comprises” or any other words to the same effect.

(4) A technical feature set out in a claim shall not rely on a reference to the description or drawings but a reference to a feature may be included in parentheses if the intelligibility of the claim can be increased by doing so.

(5) The reference to a feature included under paragraph (4) shall be deemed to be included only for convenience.

(6) A claim shall not include a drawing.

(7) If more than one claim is included in the application, the claims shall be numbered consecutively in Arabic numerals.

(8) An application may include two or more independent claims if each independent claim relates to a single product or a single process.

(9) An application may include a claim stating the essential technical features of an invention with one or more following claims setting out particular embodiments of the invention.

(10) The following apply to claims described in paragraph (9)—

- (a) the claims setting out particular embodiments of the invention shall include a reference to the claim stating the essential technical features of the invention;
- (b) the claims setting out particular embodiments of the invention shall state the features that it is desired that those claims protect; and
- (c) the claims shall be grouped together to the extent possible and in the most appropriate way.

(11) If more than ten claims are included in the application, the application fee shall be increased by the excess claims fee payable for each of the claims in excess of ten.

**15. Drawings**

(1) This regulation applies with respect to drawings referred to in section 34(1)(d) of the Act.

(2) The sheets of paper that drawings appear on shall comply with the following—

- (a) the minimum margins shall be as follows—
  - (i) top margin, 2.5 centimetres;
  - (ii) left margin, 2.5 centimetres;
  - (iii) right margin, 1.5 centimetres; and
  - (iv) bottom margin, 1.0 centimetres;

**[Subsidiary]**

- (b) the area within the margins shall not exceed 26.2 centimetres by 17 centimetres; and
  - (c) there shall not be a frame around the area of the sheet that is used or useable.
- (3) The drawings shall comply with the following—
- (a) the drawings shall not be coloured;
  - (b) the lines of the drawings shall be black, durable, uniformly thick and well-defined and shall be drawn with the aid of drafting instruments;
  - (c) the drawings, including their scale and the distinctness of their lines, shall be such that all details can be distinguished without difficulty when the drawings are reproduced photographically at two-thirds their actual size;
  - (d) if the scale is given on a drawing, it shall be given graphically;
  - (e) cross sections shall be indicated by hatching that does not impede the clear reading of the reference signs and reading lines;
  - (f) all numbers, letters and other references signs shall be at least 32 centimetres high and shall be circled or within brackets or inverted commas;
  - (g) if the drawings show a feature mentioned in the description, that feature shall be denoted in the drawings by a reference sign and that reference sign shall be used throughout the application to denote that feature;
  - (h) except as required under paragraph (g), no feature shall be denoted in the drawings by a reference sign;
  - (i) the lettering on drawings shall use the Latin alphabet or, where customary, the Greek alphabet;
  - (j) the different figures in the drawings shall be numbered consecutively in Arabic numerals independently of the numbering of the sheets on which the drawings appear; and
  - (k) the drawings shall not include text other than single words or phrases.

**16. Abstract**

(1) This regulation applies with respect to an abstract referred to in section 34(1)(e) of the Act.

(2) The abstract shall include—

- (a) the title of the invention; and
- (b) a summary of the disclosure included in the description under section 34(5) of the Act.

(3) The summary required under paragraph (2)(b) shall indicate the technical field to which the invention relates and the principal use or uses of the invention.

(4) The abstract shall be drafted in a way that it can be used efficiently for searching in the relevant technical field and so that it is possible for a reader to assess, from the abstract, whether the description should be consulted.

(5) The abstract shall not include statements about the merits or value of the invention or about uses that are speculative.

(6) If applicable, the abstract shall include the formula that best characterizes the invention.

[Subsidiary]

- (7) The abstract shall not include a drawing, but if the application includes drawings—
- (a) the applicant shall indicate which drawing the applicant suggests should accompany the publication of the abstract; and
  - (b) a feature referred to in the abstract shall, if the feature is illustrated in a drawing, be followed, in the abstract, by the reference sign used in the drawing.

(8) Unless it is impractical, the abstract shall not contain more than one hundred and fifty words.

#### **17. General requirements**

(1) This regulation sets out general requirements for an application under section 34 of the Act.

(2) All parts of the application shall be in English.

(3) All pages of the application shall be on durable white paper with a matt finish of the size known as A4 paper (29.7 centimetres by 21 centimetres).

(4) Each page of the application shall be oriented with the short side at the top.

(5) Each page of the application, other than the request and the drawings, shall have margins as follows—

- (a) top margin, 2.0 centimetres;
- (b) left margin, 2.5 centimetres;
- (c) right margin, 2.0 centimetres; and
- (d) bottom margin, 2.0 centimetres.

(6) The margins shall be completely blank.

(7) Only one side of each page of the application, other than the request, shall be used.

(8) The pages of the application shall be bound so that they can be easily separated and rejoined.

(9) The pages of the application shall be free of cracks, creases and folds.

(10) Each of the following shall start on a new page—

- (a) the request;
- (b) the description;
- (c) the claim or claims;
- (d) the drawing or drawings; and
- (e) the abstract.

(11) The application shall be in triplicate.

(12) Each of the following shall be numbered as a separate series, using Arabic numerals with the numbers centred at the top of the sheets but not in the top margin—

- (a) the request;
- (b) the description, claims and abstract; and
- (c) the drawings.

(13) Every fifth line of the description and the claims shall be numbered with the number appearing to the left of the line but not in the margin.

**[Subsidiary]**

(14) All parts of the application, other than the drawings and the request, shall be typed or printed rather than hand-written and the following apply to the appearance of the text—

- (a) the text shall be dark and indelible;
- (b) the line spacing of the text shall be at least one and one half; and
- (c) the capital letters shall be at least 20 centimetres high.

(15) All parts of the application must be prepared so that they are legible when they are photocopied or otherwise reproduced.

(16) Notwithstanding paragraph (14), graphic symbols and characters, and chemical and mathematical formulae may be hand-written but must be dark and indelible.

(17) The request may be hand-written, typed or printed but the text must be dark and indelible.

(18) All parts of the application shall be reasonably free of over-writings, insertions between lines, deletions or other alterations.

(19) All terms, signs and symbols used in the application shall be used consistently throughout the application and shall be the terms, signs and symbols generally accepted in the relevant field.

(20) If anything is expressed in units other than metric units the equivalent in metric units shall also be given.

**18. Provisional specification**

(1) In this regulation, “**specification**” means the description, claims, drawings and abstract.

(2) An application may be filed with a provisional specification.

(3) The following apply if an application is filed with a provisional specification—

- (a) unless the applicant files a final specification within one year after the application is filed, the application shall be deemed to have been withdrawn;
- (b) the Managing Director shall take no steps with respect to the application until the final specification is filed, except under section 41(1) to (3) of the Act;
- (c) the final specification shall be filed using Form IP 3;
- (d) the final specification shall not go beyond the disclosure in the provisional specification; and
- (e) the filing of the final specification shall not affect the filing date accorded under section 41 of the Act.

**19. Unity of invention**

(1) For the purposes of section 35 of the Act, a group of inventions forms a single general inventive concept if there exists between or among those inventions a technical relationship that involves one or more of the same or corresponding special technical features.

(2) In paragraph (1), “**special technical features**” means those technical features that define a contribution that each of the claimed inventions, considered as a whole, makes over the prior art.

**20. Amendment or division**

(1) This section applies with respect to an amendment or division of an application under section 36 of the Act.

(2) A request for amendment or division of an application shall be in Form IP 5.

(3) If the request is to amend a name, address or other contact information, the request shall be in Form IP 6.

(4) The Managing Director may require proof that it is appropriate to make the requested amendment to a name, address or other contact information.

(5) The following apply with respect to an amendment—

- (a) the amendment shall be in the form of a letter of explanation and pages to replace pages of the application;
- (b) the letter of explanation shall draw attention to the differences between any new pages and the pages being replaced; and
- (c) the letter of explanation shall specify any pages that are to be removed from the application without being replaced.

(6) If an application is divided under section 36(2) of the Act—

- (a) the filing date for each divisional application shall be the filing date of the initial application;
- (b) any declaration of priority in the initial application shall be deemed to be included in each divisional application; and
- (c) the applicant shall pay the application fee and any other fees payable in respect of the additional applications resulting from the division.

**21. Declaration claiming priority**

(1) This regulation applies with respect to a declaration, referred to in section 37(1) of the Act, claiming the priority, as provided for in the Paris Convention, of one or more earlier national, regional or international applications.

(2) The declaration shall include, in respect of each earlier application—

- (a) the date and number of the earlier application;
- (b) the symbol of the international patent classification that was assigned to the earlier application or, if no such symbol has been assigned, a statement of that fact;
- (c) if the earlier application was a national application, the name of the state in which it was filed; and
- (d) if the earlier application was a regional or international application, the name of the office in which it was filed and the name of the state for which it was filed.

(3) If the number of the earlier application, as required under paragraph (2)(a), is not known at the time of making the declaration, a statement of that fact shall be included in the declaration and the declaration shall be amended to include the number within ninety days after the application containing the declaration is made.

(4) A certified copy of the earlier application required by the Managing Director under section 37(2) of the Act shall be furnished within ninety days after the requirement was made.

**[Subsidiary]**

(5) If it is discovered that the date given to the earlier application was incorrect, the following apply—

- (a) the Managing Director shall invite the applicant to provide the correct date; and
- (b) the Managing Director shall disregard the claim for priority unless the applicant provides the correct date within ninety days after the date of the invitation to provide the correct date and that correct date is within the period of priority provided under the Paris Convention.

**22. Waiver of fees**

(1) This regulation applies with respect to a waiver of fees under section 39 (2) of the Act.

(2) The Board may waive fees under section 39 (2) of the Act, in whole or in part, for a natural person who is unable to pay the fees.

(3) A request for a waiver by the Board shall be submitted to the Managing Director in writing.

(4) The payment of any fees for which a waiver is sought shall be deferred pending the decision by the Board.

(5) The Managing Director shall communicate the Board's decision to the applicant and any deferred fees that have not been waived shall be paid within 60 days after the date of that communication.

**23. Withdrawal of application**

(1) A withdrawal of an application under section 40 of the Act shall be in writing.

(2) If there is more than one applicant, the application may only be withdrawn by all of the applicants.

**24. Filing date and examination**

(1) This regulation prescribes the details of the requirements and procedure under section 41 of the Act.

(2) The following apply with respect to an invitation referred to in section 41(2) of the Act—

- (a) the invitation shall be given within fourteen days after the Managing Director makes the finding referred to in section 41(2) of the Act; and
- (b) the invitation shall indicate that the applicant has until sixty days after the date of the invitation to comply with the invitation.

(3) If the Managing Director determines that the applicant has not complied with an invitation referred to in section 41(2) of the Act and, as a result, treats the application as if it had not been filed under section 41(3) of the Act, the Managing Director shall, within fourteen days after his determination, inform the applicant of the reasons for that determination.

(4) The following apply with respect to an invitation referred to in section 41(8) of the Act—

- (a) the invitation shall indicate that the applicant has until ninety days after the date of the invitation to remedy the defects;
- (b) the ninety day period may be extended by the Managing Director for a period not exceeding sixty days; and
- (c) a request for an extension under subparagraph (b) shall be in Form IP 7.



[Subsidiary]

(5) If the Managing Director accords a filing date to the application under section 41 of the Act, the Managing Director shall send the applicant a certificate of filing, which shall be a copy of the request with the filing date and number marked on it.

## **25. Publication of application**

(1) This regulation applies with respect to the publication of a patent application under section 42 of the Act.

(2) Before the patent application is published, the applicant shall pay the publication fee.

(3) The following are the particulars to be published to effect the publication of a patent application under section 42(3) of the Act—

- (a) the application number;
- (b) the name and address of the applicant;
- (c) the name and address of the inventor unless he has indicated that he wishes not to be named in the application under section 33 of the Act;
- (d) the name and address of the agent, if any;
- (e) the filing date of the application;
- (f) if priority is claimed, the priority date and the name of the state in which or for which the earlier application was filed;
- (g) the symbol of the international patent classification;
- (h) the title of the invention;
- (i) the abstract; and
- (j) if applicable, the drawing the applicant suggested, under regulation 16(7)(a), should accompany the publication of the abstract or, another drawing, if the Managing Director decides it would better characterise the invention.

## **26. Confidentiality of application before publication**

(1) The Managing Director shall ensure that information about a patent application is kept confidential until the application is published.

(2) Paragraph (1) does not apply to the following—

- (a) the application number;
- (b) the name of the applicant;
- (c) the filing date of the application;
- (d) if priority is claimed, the priority date and the name of the state in which or for which the earlier application was filed and the number of the earlier application; and
- (e) the title of the invention.

## **27. International-type search**

(1) This regulation prescribes the details of the requirements and procedure under section 43 of the Act.

(2) Within thirty days after receiving a report on an international-type search, the Managing Director shall send a copy of the report to the applicant.

(3) The time limit, referred to in section 43(3) of the Act, for the applicant to furnish a requested copy of a document, is ninety days after the date of the request.

**[Subsidiary]**

(4) If an applicant has a lawful reason under section 43(3) of the Act for not furnishing a requested copy of a document, the applicant shall inform the Managing Director of that reason within ninety days after the date of the request.

(5) If the Managing Director rejects an application under subsection (2), (3), (4) or (5) of section 43 of the Act, the Managing Director shall, within thirty days after doing so, send the applicant a notice of the rejection.

(6) The time limit for appealing to the Tribunal against a decision by which the Managing Director rejects an application under subsection (2), (3), (4) or (5) of section 43 of the Act is ninety days after the date of the notice of the rejection.

**28. Examination as to substance**

(1) This regulation prescribes the details of the requirements and procedure under section 44 of the Act.

(2) A request for an examination of an application, submitted under section 44 (2) of the Act, shall be in Form IP 8.

(3) If an application is withdrawn after a request for an examination has been submitted but before the examination has begun, the fee paid with the request shall be refunded.

(4) The following are relevant documents for the purposes of section 44 (4) of the Act—

- (a) the report of any search;
- (b) if priority is claimed, foreign documents relating to the invention; and
- (c) any other document the Managing Director considers relevant.

(5) The following apply with respect to the submission of the copy of the report of the findings of the examination by the Managing Director to the applicant under section 44 (4) of the Act—

- (a) the Managing Director shall submit the copy within thirty days after the report is submitted to the Managing Director; and
- (b) the Managing Director shall include with the copy an explanation of whether or not the invention is patentable.

(6) The following apply with respect to an invitation referred to in section 44 (7) of the Act—

- (a) the invitation shall indicate that the applicant has until sixty days after the date of the invitation to remedy the defects;
- (b) the sixty day period may be extended by the Managing Director for a period not exceeding ninety days; and
- (c) a request for an extension under paragraph (b) shall be in Form IP 7.

(7) A notification by the Managing Director under section 44(8) of the Act of a refusal of a grant of a patent shall include written reasons for the refusal.

**29. Grant of patent**

(1) This regulation applies with respect to a patent granted under section 45 of the Act.

(2) Before a patent is granted, the applicant shall pay the grant fee.

(3) The patent shall be in Form IP 9 with a copy of the description, claims and drawings attached.

[Subsidiary]

(4) When a patent is issued, a certificate of a grant of a patent in Form IP 10 shall also be issued.

(5) The patent shall be published under section 45(2) of the Act by publishing the following particulars in the Kenya *Gazette* or in the Industrial Property Journal—

- (a) the number of the patent;
- (b) the name and address of the owner of the patent;
- (c) the name and address of the inventor unless he has indicated that he wishes not to be named in the application under section 33 of the Act;
- (d) the name and address of the agent, if any;
- (e) the filing date of the application;
- (f) if priority was claimed and accepted, a statement of the priority, the priority date and the name of the state in which or for which the earlier application was filed;
- (g) the date of the grant of the patent;
- (h) the symbol of the international patent classification;
- (i) the title of the invention;
- (j) the abstract; and
- (k) if there are drawings, the most illustrative drawing.

### 30. Register of patents

(1) This regulation prescribes the details concerning the patent register under section 46 of the Act.

(2) The following shall be included in the patent register for each application for a patent—

- (a) the application number and the filing date of the application;
- (b) the name and address of the applicant;
- (c) the title of the invention;
- (d) the name and address of the inventor unless he has indicated that he wishes not to be named in the application under section 33 of the Act;
- (e) if priority is claimed, the priority date and the name of the state in which or for which the earlier application was filed;
- (f) the date of the request for an examination submitted under section 44(2) of the Act;
- (g) the publication date of the application;
- (h) the address for service of the applicant;
- (i) a notice of every document effecting a change in ownership of the application or purporting to give the application or an interest in it as security;
- (j) if the applicant dies, a notice of that fact; and
- (k) any other information required under the Act or these Regulations or that the Managing Director considers appropriate.

(3) The following shall be included in the patent register for each patent—

- (a) the information included, under paragraph (2), for the application for the patent;
- (b) the number of the patent;

**[Subsidiary]**

- (c) the name and address of the owner of the patent;
- (d) the date of the grant of the patent;
- (e) the address for service of the owner;
- (f) a notice of every document effecting a change in ownership of the patent or purporting to give the patent or an interest in it as security;
- (g) a notice of every document effecting a change in ownership of a licence or purporting to give a licence or an interest in it as security;
- (h) if the owner of the patent dies, a notice of that fact; and
- (i) any other information required under the Act or these Regulations or that the Managing Director considers appropriate.

(4) A person who wishes to obtain an extract from the patent register shall make a request in Form IP 11 for a certified copy or in Form IP 12 for an uncertified copy.

**PART V – INTERNATIONAL AND REGIONAL APPLICATIONS****31. Filing requirements for international or regional application**

- (1) This regulation applies with respect to the following applications—
  - (a) an international application filed with the Institute as the receiving office under the Patent Co-operation Treaty; or
  - (b) a regional application filed with the Institute under section 2 of the ARIPO Protocol.
- (2) An application described in paragraph (1)—
  - (a) shall be in triplicate;
  - (b) shall be in English; and
  - (c) shall be accompanied by the transmittal fee.

**32. Entry of international application to national phase**

(1) An international application in which Kenya is designated shall, on request, be treated as an application under the Act if the conditions set out in Article 22 or 39 of the Patent Co-operation Treaty and the applicable rules under that Treaty are satisfied.

- (2) A request under paragraph (1) shall be in Form IP 13.

**33. Conversion of refused international application**

(1) An international application in which Kenya is designated shall, on request, be treated as an application under the Act if a refusal, declaration or finding described in Article 25 of the Patent Co-operation Treaty was made and the refusal, declaration or finding was the result of an error or omission on the part of the receiving Office or the International Bureau.

(2) A request under paragraph (1) shall be in Form IP 14 and shall be accompanied by a statement of the facts upon which the applicant relies.

(3) The date of filing, for the purposes of the treatment of an international application as a national application, shall be the date of filing of the international application under the Patent Co-operation Treaty.

**34. Conversion of refused regional application**

(1) A regional application in which Kenya is designated and that has been refused by the Secretariat of ARIPO shall, on request, be treated as an application under the Act if the Secretariat of ARIPO transmits to the Institute—

- (a) a request made by the applicant to the Secretariat of ARIPO that the application be treated, in Kenya, as an application under Kenyan law; and
- (b) a copy of the files relating to the application.

(2) A request to have a regional application treated as an application under the Act shall be in Form IP 15.

(3) The date of filing, for the purposes of the treatment of a regional application as a national application, shall be the date of filing of the regional application under the ARIPO Protocol.

**35. Publication of certain international and regional applications**

(1) The Managing Director shall publish—

- (a) an international application in which Kenya is designated within two months after the application enters the national phase; and
- (b) a regional application in which Kenya is designated within two months after Kenya is notified of being designated in the regional application under the ARIPO Protocol.

(2) The publication of an application under paragraph (1) shall be in the Kenya *Gazette* or in the Industrial Property Journal.

**PART VI – RIGHTS AND OBLIGATIONS OF THE APPLICANT OR THE OWNER OF THE INVENTION****36. Clarification of application to new use**

For greater certainty, section 54 (1)(b) of the Act applies with respect to a patent that has been granted in respect to a new use as though the new use were a process.

**37. “Parallel importation”**

The limitation on the rights under a patent in section 58(2) of the Act extends to acts in respect of articles that are imported from a country where the articles were legitimately put on the market.

**PART VII – ANNUAL FEES****38. Annual fees**

(1) This regulation applies with respect to annual fees under section 61 of the Act.

(2) A fee shall be paid by submitting the fee along with Form IP 16.

(3) At least one month before a fee is due, the Managing Director shall send a reminder that the fee is due to the applicant or the owner of the patent.

(4) A fee paid after it was due but within the grace period granted under section 61(2) of the Act shall be paid by submitting it along with—

- (a) the form required under paragraph (2); and
- (b) the prescribed surcharge.

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**[Subsidiary]**

(5) If, under section 61(3) of the Act, an application is deemed to have been withdrawn or a patent lapses, the Managing Director shall send a notification to the persons specified in paragraph (6), within thirty days after the application is deemed to have been withdrawn or the patent lapses.

(6) A notification under paragraph (5) shall be sent to the following persons—

- (a) the applicant or owner of the patent; and
- (b) every registered licensee.

(7) The following apply with respect to a request under section 61(5) of the Act to restore an application or patent—

- (a) the request shall be in Form IP 17 and shall be accompanied by a statutory declaration or affidavit supporting the statements made in the request;
- (b) if after considering the request, the Managing Director is not satisfied that the failure to pay the annual fee was not intended, the Managing Director shall notify the person who made the request;
- (c) the person notified under paragraph (b) may request a hearing with the Managing Director within sixty days after the date of the notification and, if the person does so, the Managing Director shall hear the person before finally deciding whether or not the Managing Director is satisfied, under section 61(6) of the Act, that the failure to pay the annual fee was not intended; and
- (d) if the Director makes an order restoring the application or patent—
  - (i) paragraph (4) applies with respect to the payment of the annual fee under section 61(6) of the Act; and
  - (ii) the Managing Director shall advertise the restoration of the application or patent in the *Kenya Gazette* or in the *Industrial Property Journal*.

(8) If an application or patent has lapsed and the time for making a request under section 61(5) of the Act to restore the application or patent has expired without a request being made or a request was made but was denied, the Managing Director shall, within forty-five days after the time expired or the request was denied, notify the applicant or owner of the lapse and draw their attention to the provisions of section 61(3) of the Act.

(9) There is no fee for the first year following the date of filing of the application.

(10) For an international application, the only annual fees that are payable are those due after the application enters the national phase.

#### PART VIII – CHANGE IN OWNERSHIP

### **39. Change of ownership of application or patent section 62 of the Act**

(1) This regulation applies with respect to section 62 of the Act.

(2) An application to have a change of ownership recorded in the patent register shall be in Form IP 18.

(3) An application to have a change of ownership recorded may be made by the former owner or the new owner.

(4) A copy of the following shall accompany the application—

- (a) the instrument effecting the change in ownership; or
- (b) a certificate issued by a competent authority of the change in ownership.

[Subsidiary]

(5) When a change in ownership is recorded in the patent register the Managing Director shall—

- (a) issue a certificate of the registration of a change in ownership, in Form IP 19, to the new owner; and
- (b) publish, in the Kenya *Gazette* or in the Industrial Property Journal, the following information—
  - (i) the date of the application to have the change of ownership recorded;
  - (ii) the name of the former owner;
  - (iii) the name of the new owner; and
  - (iv) the registration number and date of registration of the change in ownership.

(6) The Managing Director shall ensure that the instrument described in paragraph (4)(a), and its contents, is kept confidential except to the extent that the new owner agrees otherwise.

(7) If the ownership of an application is changed, the new owner shall be deemed to be the applicant.

#### PART IX – CONTRACTUAL LICENCES

##### **40. Petition to register licence contracts**

(1) This regulation applies with respect to petitions for registration of licence contracts or modifications to licence contracts in the patent register under section 68 of the Act.

(2) A petition shall be in Form IP 20.

(3) The following are prescribed as documents that shall accompany the petition under section 68(2) of the Act—

- (a) the documents constituting the contract; and
- (b) any documents relating to the contract that are necessary to understand or interpret the contract.

##### **41. Registration of contracts**

(1) This regulation applies with respect to licence contracts registered under section 70 of the Act.

(2) The certificate of registration under section 70(1) of the Act shall be in Form IP 21.

(3) In addition to the information required under section 70(5) of the Act, the following shall be set out in the patent register—

- (a) the addresses of the persons referred to in section 70(5)(a) of the Act;
- (b) the date the registration takes effect;
- (c) the duration of the contract; and
- (d) if the contract was submitted for registration by an agent, the name and address of the agent.

(4) The additional information set out in paragraph (3) shall be published along with the information that is required to be published under section 70(5) of the Act.

(5) The information required to be published under section 70(5) of the Act shall be published by the Managing Director.

[Subsidiary]

**42. Licences as of right**

(1) This regulation applies with respect to entries in the patent register under section 79 of the Act to the effect that licences are to be available as of right.

(2) A request under section 79(1) of the Act to have an entry made shall be in Form IP 22.

(3) The request shall be accompanied by an undertaking of the owner to grant licences under section 79 of the Act.

(4) When the Managing Director notifies the licensees of the request under section 79(2) of the Act he shall also notify them of their right to object under section 79(3) of the Act.

(5) The period within which a licensee may object under section 79(3) of the Act is 45 days after the date of the Managing Director's notification to the licensee of the request.

(6) A licensee may object under section 79(3) of the Act by giving a notice of opposition in Form IP 23 in duplicate to the Managing Director.

(7) Paragraph (3) to (20) of regulation 49 apply, with necessary modifications, with respect to an objection under section 79(3) of the Act.

(8) The publication of an entry under section 79(4) of the Act shall be in the *Kenya Gazette* or in the *Industrial Property Journal*.

(9) A request under section 79 (7) of the Act to cancel an entry shall be in Form IP 24.

(10) The publication of a cancellation under section 79(7) of the Act shall be in the *Kenya Gazette* or in the *Industrial Property Journal*.

**PART X – EXPLOITATION BY GOVERNMENT****43. Exploitation by Government**

(1) This regulation applies with respect to section 80 of the Act.

(2) An application to the Minister for an order under section 80(1) of the Act shall be in Form IP 25.

(3) A request under section 80(7) of the Act to have an order revoked shall be in writing.

**PART XI – UTILITY MODELS****44. Application of Regulations to utility models**

(1) Subject to paragraph (2), these Regulations apply, with necessary modifications, with respect to utility model certificates as though these Regulations referred to utility model certificates instead of to patents.

(2) Regulations 27, 28, 29(3) and (4) and 31 to 35 do not apply with respect to utility model certificates.

(3) A utility model certificate shall be in Form IP 26.

**PART XII – INDUSTRIAL DESIGNS****45. Register of industrial designs**

(1) The Managing Director shall maintain a register of industrial designs for the registration of industrial designs under Part XIII of the Act.



[Subsidiary]

(2) For each registered industrial design, the following shall be recorded in the register of industrial designs—

- (a) the registration number of the industrial design;
- (b) the name and address of the owner of the industrial design;
- (c) the title of the industrial design;
- (d) any disclaimer by the applicant limiting the rights conferred by registration; and
- (e) any other information required under these Regulations or that the Managing Director considers appropriate.

(3) A person who wishes to obtain an extract from the register of industrial designs shall make a request in Form IP 11 for a certified copy or in Form IP 12 for an uncertified copy.

#### **46. Copyrighted designs not registrable**

An industrial design is not registrable if it is protected under the Copyright Act, No. 12 of 2001.

#### **47. Application**

(1) This regulation applies with respect to an application to register an industrial design under section 87 of the Act.

(2) The application under section 87(1)(a) of the Act shall be in Form IP 27.

(3) Subject to paragraph (4), there shall be a separate application for each article embodying the industrial design.

(4) There may be a single application for a set of articles embodying the industrial design if the articles in the set are intended to be used together.

(5) The application shall be accompanied by—

- (a) an additional copy of the representations required under section 87(1)(c) of the Act; and
- (b) a second specimen in addition to the specimen required under section 87(2) of the Act.

(6) The application, representations and all documents provided with them shall be on paper of a size known as A4 paper (29.7 centimetres by 21 centimetres) with a weight of at least 80 grams per square metre and each page shall have a left hand margin of approximately 2.5 centimetres.

(7) The following apply with respect to the representations required under section 87(1)(c) of the Act—

- (a) if the application is for a set of articles the representations shall include representations of each article in the set embodying the industrial design;
- (b) figures used in the representations shall be in an upright position, unless the Managing Director is satisfied that it is impractical to do so;
- (c) if more than one figure is used to represent an article, all the figures representing the same article shall, unless it is impractical to do so, appear on the same page and shall be labelled to indicate the view they represent;
- (d) if the representations are drawings they shall be in ink;
- (e) if the industrial design consists of a repeating surface pattern, the representation shall show all of the pattern that is repeated;

**[Subsidiary]**

- (f) only one side of each page of the representations shall be used;
- (g) the name of the applicant shall be set out in the top left hand corner of each page; and
- (h) the pages shall be numbered and the page number and the total number of pages shall be set out in the top right hand corner of each page.

(8) A statement describing the features of the design which it is claimed are new shall be included on—

- (a) the representations required under section 87(1)(c) of the Act; and
- (b) the specimen required under section 87(2) of the Act.

(9) If the design includes a reproduction of arms registered under the College of Arms Act (Cap. 98) or a specified emblem within the meaning of that Act, the application shall be accompanied by the consent to the registration of the reproduction of the arms or specified emblem from such person as appears to the Managing Director to be entitled to give such consent.

(10) The following apply if the design includes the name or portrait of a person—

- (a) if the person is living, the application shall be accompanied by the consent of the person to the registration; or
- (b) if the person is dead, the Managing Director may require the application to be accompanied by the consent of such person as the Managing Director considers appropriate.

(11) Regulations 21 and 24(2), (3) and (5) apply, with necessary modifications, with respect to the application, under section 87(7) of the Act, of sections 37 and 41(2) and (3) of the Act.

**48. Publication of application**

(1) The Managing Director shall publish a notice of an application to register an industrial design in the Kenya *Gazette* or in the Industrial Property Journal.

(2) Before the notice is published, the applicant shall pay the publication fee.

**49. Procedure if opposition to application**

(1) This regulation applies with respect to opposition to an application to register an industrial design under section 87 of the Act.

(2) Within 60 days after the notice of the application is published a person may oppose the application by giving a notice of opposition in Form IP 23 in duplicate to the Managing Director.

(3) The notice of opposition shall set out the grounds for opposing the application.

(4) The Managing Director shall give one copy of the notice of opposition to the applicant.

(5) Within 42 days after receiving the notice of opposition, the applicant shall give a counter-statement in Form IP 28 in duplicate to the Managing Director.

(6) The counter-statement shall set out the grounds the applicant relies upon to support the application and shall set out any facts alleged in the notice of opposition that the applicant admits.

(7) The Managing Director shall give one copy of the counter-statement to the person opposing the application.

[Subsidiary]

(8) Within 42 days after receiving the counter-statement, the person opposing the application shall give to the Managing Director and to the applicant a statutory declaration or affidavit supporting the opposition to the application.

(9) Within 42 days after receiving the statutory declaration or affidavit of the person opposing the application, the applicant shall give to the Managing Director and to the person opposing the application a statutory declaration or affidavit supporting the application.

(10) Within one month after receiving the statutory declaration or affidavit of the applicant, the person opposing the application may give to the Managing Director and to the applicant a statutory declaration or affidavit replying to the applicant's statutory declaration or affidavit.

(11) A statutory declaration or affidavit replying to the applicant's statutory declaration or affidavit shall be confined to matters strictly in reply.

(12) If the applicant fails to provide a counter-statement under paragraph (5) or a statutory declaration or affidavit under paragraph (9) the application shall be deemed to have been withdrawn.

(13) If the person opposing the application fails to provide a statutory declaration or affidavit under paragraph (8), the opposition to the application shall be deemed to have been withdrawn.

(14) After all documents have been provided the Managing Director shall conduct a hearing of the matter.

(15) The Managing Director shall give at least 14 days notice of the hearing to each party.

(16) A party may be heard at the hearing only if the party provides the Managing Director with a notice in Form IP 29 at least seven days before the date of the hearing.

(17) At the hearing no evidence other than the evidence provided by statutory declaration or affidavit may be introduced without the leave of the Managing Director.

(18) The Managing Director shall give each party a written notice of his decision together with written reasons.

(19) If there is more than one person opposing the application the Managing Director may provide for the objections to be dealt with at the same hearing.

(20) A party may appeal the Managing Director's decision to the Tribunal within ninety days after the date of the notification of the decision.

#### **50. Procedure if no opposition to application**

(1) This regulation applies if there is no opposition to an application to register an industrial design under section 87 of the Act.

(2) If the Managing Director proposes to reject the application, the Managing Director shall send a written notice to the applicant explaining the reasons for proposing to refuse to register the industrial design and inviting the applicant to do one of the following within sixty days after the date of the invitation—

- (a) submit written submissions; or
- (b) request a hearing.

(3) If the Managing Director has sent a notice under paragraph (2), the Managing Director shall not make his decision as to whether or not to register the industrial design until—

- (a) if the applicant requests a hearing, after holding the hearing;

**[Subsidiary]**

- (b) if the applicant submits observations, after considering the observations; or
- (c) if the applicant does not request a hearing or submit observations, after the expiry of the sixty day period referred to in paragraph (2).

(4) The Managing Director shall notify the applicant in writing of his decision.

(5) If the Managing Director decides to refuse to register the industrial design, the applicant may, within thirty days after the date of the notification of the decision, request that the Managing Director provide written reasons for his decision.

(6) A request under paragraph (5) shall be in Form IP 30.

(7) The Managing Director shall comply with a request under paragraph (5) within forty-five days after the request is made.

(8) The applicant may appeal the Managing Director's decision to the Tribunal within ninety days after—

- (a) the date of the notification of the decision; or
- (b) if written reasons are requested, the date of the reasons.

**51. Registration of industrial design**

(1) This regulation applies with respect to section 87(8) of the Act.

(2) Before an industrial design is registered under section 87(8) of the Act, the applicant shall pay the registration fee.

(3) A certificate of registration issued under section 87(8) of the Act shall be in Form IP 31.

**52. Duration and renewal of registration**

(1) This regulation applies with respect to section 88 of the Act.

(2) At least ninety days before the expiry of the registration of an industrial design, the Managing Director shall send a reminder of the impending expiry to the owner.

(3) An application for a renewal under section 88(2) of the Act shall be in Form IP 32.

(4) If a registration is renewed, the Managing Director shall register the renewal and issue a certificate of renewal.

**53. Restoration of lapsed right**

(1) This regulation applies with respect to section 89 of the Act.

(2) An application for restoration of the protection granted to an industrial design under section 89 (1) of the Act shall be in Form IP 33.

(3) The application shall be accompanied by a statutory declaration or affidavit supporting the application and by an application for renewal in Form IP 32.

(4) Before rejecting an application, the Managing Director shall send a written notice to the applicant explaining the reasons for proposing to reject the application and inviting the applicant to request a hearing within sixty days after the date of the invitation.

(5) If the Managing Director sends a notice under paragraph (4), the Managing Director shall not make his decision as to whether to restore the design or reject the application until—

- (a) if the applicant requests a hearing, after holding the hearing; or
- (b) if the applicant does not request a hearing, after the expiry of the sixty day period referred to in paragraph (4).

[Subsidiary]

(6) The Managing Director shall notify the applicant in writing of his decision and, if the Managing Director decides to reject the application, the notification shall include written reasons for his decision.

(7) The applicant may appeal the Managing Director's decision to the Tribunal within ninety days after the date of the notification of the decision.

(8) Publication of a restored design under section 89(5) of the Act shall be in the *Kenya Gazette* or in the *Industrial Property Journal*.

#### **54. Request to examine representations etc.**

A request to examine representations or specimens under section 90(2) of the Act shall be in Form IP 34.

#### **55. Publication relating to registration**

The publication under section 91(1) of the Act relating to a registration shall be in the *Kenya Gazette* or in the *Industrial Property Journal*.

#### **56. Application of regulations under**

Regulations 39, 40 and 41 apply, with necessary modifications, with respect to the application, under section 93(2) of the Act, of sections 62, 68 and 70 of the Act.

### PART XIII – REGISTRATION OF TECHNOVATION CERTIFICATES

#### **57. Form of certificate**

A technovation certificate shall be in Form IP 35.

#### **58. Register of technovation certificates**

(1) The Managing Director shall maintain a register of technovation certificates for the registration of technovation certificates under Part XIV of the Act.

(2) For each registered technovation certificate, the following shall be recorded in the register of technovation certificates—

- (a) the registration number of the technovation certificate;
- (b) the name and address of the technovator;
- (c) the date of the request for registration;
- (d) the name and address of the enterprise that issued the technovation certificate;
- (e) the title of the technovation;
- (f) the technical field to which the technovation relates; and
- (g) any other information that the Managing Director considers appropriate.

(3) The Managing Director shall ensure that the register of technovation certificates is kept confidential.

#### **59. Application for registration**

(1) A technovator may apply to the Managing Director to have his technovation certificate registered.

(2) An application under paragraph (1) shall be in Form IP 36.

(3) The application shall be accompanied by a certified copy of the technovation certificate.

[Subsidiary]

**60. Certificate of registration**

Upon registration of a technovation certificate the Managing Director shall issue a certificate of that registration in Form IP 37.

## PART XIV – SURRENDER

**61. Surrender**

(1) This regulation applies with respect to the surrender of a patent, utility model or industrial design registration certificate under section 102 of the Act.

(2) A surrender shall be in Form IP 38.

(3) The publication of a surrender under section 102(3) of the Act shall be in the Kenya *Gazette* or in the Industrial Property Journal.

## PART XV – AGENTS

**62. Representation by agent**

(1) A person may be represented by an agent in respect of a matter if—

- (a) an appointment of the agent in respect of the matter has been filed with the Managing Director; and
- (b) the agent is admitted to practice before the Institute.

(2) An appointment of an agent shall be in Form IP 39.

(3) Unless the Managing Director otherwise directs, if a person is represented by an agent—

- (a) the agent may attend upon the Managing Director in place of the person; and
- (b) the agent may sign any document under this Act on behalf of the person.

**63. Admission to practice as agent**

(1) The Managing Director may admit a person to practice before the Institute as an agent if the person resides in, and is a citizen of, Kenya and—

- (a) the person is an advocate practising in Kenya; or
- (b) the person has a university degree in science or a technical field and is conversant with industrial property matters.

(2) An application for admission to practice before the Institute shall be in Form IP 40.

(3) The Managing Director shall maintain a register in which the persons admitted to practice before the Institute are recorded.

**64. Annual fees for admitted persons**

(1) Each person admitted to practice before the Institute shall pay an annual fee to maintain his admission.

(2) No annual fee is required for the first year of admission.

(3) A person's admission expires on the anniversary of his admission unless the annual fee for the upcoming year has been paid.

(4) An annual fee shall be paid by submitting the fee along with Form IP 41.

**65. Advocates Act restrictions preserved**

Nothing in this Part allows an agent to do anything that he would be prohibited from doing under the Advocates Act (Cap. 16).

**66. Revocation of admission to practice**

The Managing Director may revoke a person's admission to practice before the Institute if—

- (a) the person has been convicted of an offence under any Act; or
- (b) the person has been found to be guilty of misconduct by a competent authority.

**67. Offence, acting as agent without admission**

A person who purports to act as an agent under the Act without being admitted to practice before the Institute is guilty of an offence and is liable, on conviction, to a fine not exceeding six thousand shillings or to imprisonment for a term not exceeding six months or to both.

**PART XVI – GENERAL AND MISCELLANEOUS PROVISIONS****68. Copies of documents**

A person who wishes to obtain a copy of a document kept by the Institute shall make a request in Form IP 11 for a certified copy or in Form IP 12 for an uncertified copy.

**69. Copy of lost or destroyed certificate**

(1) The Managing Director may issue a copy of one of the following certificates if the certificate is lost or destroyed—

- (a) a certificate of a grant of a patent;
- (b) a certificate of registration of a change in ownership;
- (c) a certificate of registration of a licence;
- (d) a utility model certificate;
- (e) a certificate of registration of an industrial design; or
- (f) a certificate of registration of a technovation certificate.

(2) A request for a copy of a lost or destroyed certificate shall be in Form IP 42.

(3) A request for a copy of a lost or destroyed certificate shall be accompanied by a statutory declaration or affidavit supporting the assertion that the certificate has been lost or destroyed.

**70. Request for a search**

A request to have a search done for an industrial property right shall be in Form IP 43.

**71. Request to amend a name, etc., in a register**

A request to amend a name, address or other contact information in a register shall be in Form IP 44.

**72. Caution or notice in a register**

A request to have a caution or notice included in or removed from a register shall be in Form IP 45.

[Subsidiary]

**73. Rules for giving notices, etc.**

(1) A notice or other document that is to be given or sent to or served on, a person may be given, sent or served—

- (a) by mailing or delivering the notice or document to the address of service provided by the person;
- (b) by giving the notice or document personally to the person or by mailing or delivering the notice or document to the person's residence or place of business or employment; or
- (c) by giving the notice or document personally to the person's agent or by mailing or delivering the notice or document to the agent's place of business.

(2) Proof that a notice or other document was given, sent or served shall be in Form IP 46.

(3) A notice or document that is mailed shall be deemed to have been given, sent or served on the day the notice or document would be delivered in the ordinary course of post.

**74. Opportunity to be heard**

Before exercising a power or making a decision the Managing Director may give a person who would be adversely affected an opportunity to be heard.

**75. Hearings, particular provisions**

The following apply with respect to a hearing before the Managing Director—

- (a) at the hearing the Managing Director may allow oral evidence and shall allow the cross examination of a person on his statutory declaration or affidavit;
- (b) the Managing Director may, on such terms as he may specify, allow a document to be amended or a procedural irregularity to be rectified;
- (c) the Managing Director may, on such terms as he may specify, dispense with or modify any requirement to do anything, including a requirement to provide a document;
- (d) the Managing Director may require a party to pay all or part of the costs of another party and determine how the costs are to be determined and how they are to be paid; and
- (e) the Managing Director may require a party to give security for costs that the party may be required to pay under subparagraph (d).

**76. Extensions of time**

The Managing Director may extend the time for doing an act or taking a proceeding, other than a time expressly provided in the Act, on such conditions as he may specify.

**77. Signing of forms on behalf of certain bodies**

(1) A form that is required to be signed on behalf of a corporation shall, unless it is signed by an agent, be signed by a director of the corporation or the secretary of the corporation.

(2) The following apply if a form is required to be signed on behalf of a partnership—

- (a) unless the form is signed by an agent, the form shall be signed by a partner or by a person who satisfies the Managing Director that the person is authorized by the partnership to sign on its behalf; and



- (b) the form shall set out the names of the partners in full.

#### 78. Statutory declarations and affidavits

The following apply with respect to a statutory declaration or affidavit under the Act or these regulations—

- (a) the statutory declaration or affidavit shall have a heading indicating the matter or matters to which it relates;
- (b) the statutory declaration or affidavit shall be divided into consecutively numbered paragraphs, each of which shall, if possible, be confined to a single subject-matter; and
- (c) the statutory declaration or affidavit shall fully identify the person making it and shall set out where the person resides.

#### 79. Documents in English or translated

- (1) Documents provided to the Managing Director shall be in English.

(2) If a copy of a document that is not in English is required to be provided to the Managing Director the following apply—

- (a) an English translation of the document shall be provided along with the copy of the document;
- (b) the translation shall be certified to be an accurate translation;
- (c) if more than one copy of the document is required, one copy of the translation shall be provided for every copy of the document required;
- (d) if the Managing Director believes the translation is not accurate the Managing Director may refuse it and require an accurate translation; and
- (e) the copy of the document shall be deemed not to have been provided until the required translation and copies are provided.

#### 80. Repeal of former regulations

The Industrial Property Regulations, 1993, are repealed.

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### SCHEDULES

#### FIRST SCHEDULE

[Rule 2.]

#### FORMS

Form IP 1

(Rule 10)

### INDUSTRIAL PROPERTY ACT, 2001

The Managing Director,  
Kenya Industrial Property Institute.

REQUEST FOR WRITTEN AUTHORITY REFERRED TO IN SECTION 28(1) OF THE ACT

Name and address of applicant(s)	
Name and address of agent (if any)	
Title of invention	

Industrial Property

[Subsidiary]

FIRST SCHEDULE—continued

I/We, the applicant(s) identified above, apply for authority to file a patent application outside Kenya. My/Our reasons for making this request are as follows:

[Empty rectangular box for reasons]

Dated at ..... this ..... day of ....., 20 .....

Signature .....

Form IP 2

(Rule 11)

INDUSTRIAL PROPERTY ACT, 2001

The Managing Director, Kenya Industrial Property Institute.

REQUEST FOR A CERTIFICATE OF RIGHT TO INSPECT FILES FOR PURPOSE OF SECTION 29(3) OF THE ACT

Table with 2 columns and 3 rows: Name and address of applicant, Name and address of agent (if any), Title of invention

I/We the applicant(s) identified above,

(a) declare as follows—

- (i) that the culture deposited at ..... under the file number ..... is referred to in the specification of Patent application/Patent No. ...., and (ii) that, I am/we are for the reasons established by the accompanying evidence entitled to inspect the files for the purposes of section 29(3) of the Act; and

(b) undertake, if a sample of the deposited culture is released to me/us, not to do anything prohibited by Regulation 11(5).

(c) accordingly request that a certificate of right to inspect files for purposes of section 29 (3) of the Act be forwarded to me/us.

Dated at ..... this ..... day of ....., 20 .....

Signature .....

NOTES:

- 1. Evidence establishing the entitlement to inspect the files for the purposes of section 29 (3) of the Act shall accompany the request.

FIRST SCHEDULE—continued

Form IP 3

(Rules 12, 18)

**INDUSTRIAL PROPERTY ACT, 2001**

The Managing Director,  
Kenya Industrial Property Institute.

REQUEST FOR A GRANT OF A PATENT

REQUEST FOR REGISTRATION OF A UTILITY MODEL  
(please choose one)

The grant of a patent/registration of a Utility Model is requested by the undersigned on the basis of the present

Provisional specification

Final specification (Please choose one)

I	Applicant's or agent's reference (Please insert if available)		
II	Title of invention		
III	Applicant (First or only applicant) (see note 2)		
IV	Address		
	Nationality (Country)		Residence (Country)
	Telephone number (if any)	Facsimile number (if any)	E-mail address (if any)
	Name of second applicant (if more than one)		
	Address		
	Nationality (Country)		Residence (Country)
	Telephone number (if any)	Facsimile number (if any)	E-mail address (if any)
V	(a) The applicant(s) is/are <input type="checkbox"/> the sole <input type="checkbox"/> joint inventor(s) or		
	(b) <input type="checkbox"/> A statement in Form IP 4 is furnished.		
VI	Name and address of agent (if any) (see note 4)		
VII	Address for service (see note 5)		

Industrial Property

[Subsidiary]

FIRST SCHEDULE—continued

	Tele phone number (if any)	Facsimile number (if any)	E-mail address (if any)
VIII.	Declaration of priority (see note 6)		
IX.	It is suggested that Figure No. .... of the drawing (if any) should accompany the abstract when published.		
X.	Check list to be filled in by applicant or agent		
(A)	The application contains the following number of sheet(s)	(B) The application as filed is accompanied by:	
	<b>Item</b>	<b>No. of sheets</b>	<b>Item</b> <b>(Tick)</b>
	Request		Declaration claiming priority
	Description		Copy of earlier application
	Claim(s)		Form IP 4 (Statement justifying right to patent/utility model certificate)
	Drawing(s)		Form IP 39 (Appointment of agent)
	Abstract		Other document(s) (specify)

Dated at ..... this ..... day of ....., 20 .....

Signature .....

NOTES:

1. This form, when completed, should be brought or sent to the Managing Director, Kenya Industrial Property Institute, together with the prescribed fee and three copies of the description, claims, abstract and drawings. The form should be in triplicate.
2. Enter the name and address of each applicant. Names of individuals should be indicated in full with the surname or family name given first and underlined. The names of all partners in a firm must be given in full. Bodies corporate should be designated by their corporate name and the country of incorporation should be entered where provided. Full corporate details e.g. "a limited liability company incorporated in Kenya", trading styles, e.g. "trading as xyz company", nationality, and former names, e.g. "formerly (known as) ABC Ltd." are not required and should not be given.
3. Where the applicant(s) is/are the sole inventor(s) or the joint inventor(s), the declaration to that effect at IV(a) should be completed and the alternative statement IV(b) deleted. If, however, this is not the case then declaration IV(a) should be struck out and a statement in Form IP 4 provided.
4. If the applicant has appointed an agent to act on his behalf, the agent's name and address of his place of business should be indicated in the space available at V.
5. An address for service in Kenya to which all documents may be sent must be stated at VI.
6. The declaration of priority at VII should comply with requirements in Regulation 21.

SUPPLEMENTAL SHEET

(To be used if the space provided above is not large enough to contain information to be furnished)

Additional Applicant (s)	
Additional Inventor(s)	

FIRST SCHEDULE—*continued*

Additional Priority	
Other	

For official use only

Date of actual receipt of application under section 41 (1) of the Act	
Date of receipt of correction under section 41(3) or 41(5) of the Act or drawings under section 41(4) of the Act	
Application number	
Filing date	

Form IP 4

(Rule 12)

**INDUSTRIAL PROPERTY ACT, 2001**

The Managing Director,  
Kenya Industrial Property Institute.

STATEMENT JUSTIFYING APPLICANT'S RIGHT TO PATENT/UTILITY MODEL CERTIFICATE

Name and address of applicant(s)	
Name and address of agent (if any)	
Title of invention	

I/We, the applicant(s) in respect of the above mentioned application for a patent/utility model, declare as follows:

- (i) I/We believe that person(s) below (and on supplementary sheet if necessary) is/are the inventor(s) of the invention in request of which the above-mentioned application is made.

Name of inventor	Address

- (ii) The derivation of my/our right to be granted a patent upon the said application is as follows:

Industrial Property

[Subsidiary]

FIRST SCHEDULE—continued

(iii) I/We consent to the publication of the details contained herein to each of the inventors named above.

Dated at ..... this ..... day of ....., 20 .....

Signature .....

Form IP 5

(Rule 20)

INDUSTRIAL PROPERTY ACT, 2001

The Managing Director, Kenya Industrial Property Institute.

REQUEST TO AMEND OR DIVIDE APPLICATION

Name and address of applicant(s)	
Name and address of agent (if any)	
Application number	

I/We, the applicants identified above, request to

Amend my/our Application or

Divide my/our Application

My/Our reasons for making this amendment are as follows:

[Empty box for reasons]

The details of the requested amendment/division are attached.

Dated at ..... this ..... day of ....., 20 .....

Signature .....

Form IP 6

(Rule 20)

INDUSTRIAL PROPERTY ACT, 2001

The Managing Director, Kenya Industrial Property Institute.

REQUEST TO AMEND NAME, ADDRESS OR OTHER CONTACT INFORMATION IN APPLICATION

Name and address of applicant(s)	
Name and address of agent (if any)	

Industrial Property

[Subsidiary]

FIRST SCHEDULE—continued

Application number	
--------------------	--

I/We, the applicants identified above, request to amend to amend the following in the above application.

--

My/Our reasons for making this amendment are as follows:

--

The details of the requested amendment are attached.

Dated at ..... this ..... day of ....., 20 .....

Signature .....

\_\_\_\_\_

Form IP 7

(Rules 24 and 28)

INDUSTRIAL PROPERTY ACT, 2001

The Managing Director,  
Kenya Industrial Property Institute.

REQUEST FOR EXTENSION OF TIME

Name and address of applicant(s)	
Name and address of agent (if any)	
Application or patent number	

IN THE MATTER OF .....

I/We, the applicant(s) identified above, apply for an extension of time.

- (i) The period of the requested extension is .....
- (ii) The grounds or reasons for the request are as below:

--

Dated this ..... day of ....., 20 .....

Signature .....

\_\_\_\_\_

*Industrial Property*

[Subsidiary]

FIRST SCHEDULE—*continued*

Form IP 8

(Rule 28)

**INDUSTRIAL PROPERTY ACT, 2001**

The Managing Director.  
Kenya Industrial Property Institute.

REQUEST FOR EXAMINATION UNDER SECTION 44 OF THE ACT

Name and address of applicant(s)	
Name and address of agent (if any)	
Application number	

I/We, the applicants identified above, request the examination of the above quoted application under section 44 of the Act.

Dated at ..... this ..... day of ....., 20 .....

Signature .....

Form IP 9

(Rule 29)

**INDUSTRIAL PROPERTY ACT, 2001**

Kenya Industrial Property Institute

Patent Number:  
Date of grant/Publication:

PATENT

International Patent Classification:	
--------------------------------------	--

Application Number:	International Publication number:
Filing Date:	
Priority Number:	
Priority Date:	
Priority Country:	
Owner(s):	
Inventor(s):	
Agent:	



FIRST SCHEDULE—continued

Title:	
Abstract:	
Cited Documents:	

Form IP 10

(Rule 29)

**INDUSTRIAL PROPERTY ACT, 2001**

CERTIFICATE OF GRANT OF A PATENT

It is hereby certified that a patent with patent number ..... has been granted to in respect of an invention disclosed in an application number ..... having a date of filing of ..... and priority date of ..... being an invention titled .....

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

Dated at ....., this ..... day of ....., 20 .....

.....  
 Managing Director,  
 Kenya Industrial Property Institute

Form IP 11

(Rules 30, 45, 68)

**INDUSTRIAL PROPERTY ACT, 2001**

The Managing Director,  
 Kenya Industrial Property Institute.

REQUEST FOR CERTIFIED COPY

Name and address of person making request	
Name and address of agent (if any)	
What is the Managing Director requested to certify? (Please include specific information sufficient to identify what is to be certified)	

Dated at ..... this ..... day of ....., 20 .....

Signature .....

Industrial Property

[Subsidiary]

FIRST SCHEDULE—continued

NOTES:

- 1. Please use a separate form for each industrial property right.
- 2. This form may be used to obtain certified copies of documents or extracts.
- 3. Please describe any special requirements. If space provided is not sufficient, please use a separate sheet of paper.

Form IP 12

(Rules 30, 45, 68)

INDUSTRIAL PROPERTY ACT, 2001

The Managing Director,  
Kenya Industrial Property Institute.

REQUEST FOR CERTIFIED COPY

Name and address of person making request	
Name and address of agent (if any)	
Give particulars of the industrial property right, a copy of which is requested	

Dated at ..... this ..... day of ....., 20 .....

Signature .....

NOTES:

- 1. Please use a separate form for each industrial property right.
- 2. This form may be used to obtain uncertified copies of documents or extracts.
- 3. Please describe any special requirements. If space provided is not sufficient, please use a separate sheet of paper.

Form IP 13

(Rule 32)

INDUSTRIAL PROPERTY ACT, 2001

The Managing Director,  
Kenya Industrial Property Institute.

REQUEST FOR NATIONAL PROCESSING OF AN INTERNATIONAL APPLICATION FOR A PATENT

I/We, the applicants named below, request that our international application identified below be treated as an application under the Act.

Name and address of applicants(s)	
International Application Number	

Industrial Property

[Subsidiary]

FIRST SCHEDULE—continued

Name and address of agent (if any)	
This application is made by virtue of the fact that the Institute is	<input type="checkbox"/> A designated office under chapter 1 of the Patent Cooperation Treaty
	<input type="checkbox"/> An elected office under chapter 11 of the Patent Cooperation Treaty
Documents accompanying the application	<input type="checkbox"/> Search report
	<input type="checkbox"/> International Preliminary Examination report
	<input type="checkbox"/> Cited Documents
	<input type="checkbox"/> FORM IP 4
	<input type="checkbox"/> FORM IP 39
	<input type="checkbox"/> Any other (specify)

Dated at ..... this ..... day of ....., 20 .....

Signature .....

Form IP 14

(Rule 33)

INDUSTRIAL PROPERTY ACT, 2001

The Managing Director,  
Kenya Industrial Property Institute.

REQUEST TO HAVE A REFUSED INTERNATIONAL APPLICATION TREATED AS AN APPLICATION UNDER THE ACT

Name and address of applicant(s)	
International Application number	
International filing date	
Name of agent and address (if any)	

I/We, the above-identified applicant(s), request the Managing Director to treat the above quoted international application as an application under the Act.

Industrial Property

[Subsidiary]

FIRST SCHEDULE—continued

The following are the facts upon which I/we rely:

[Empty box for facts]

Dated at ..... this ..... day of ....., 20 .....

Signature .....

Form IP 15

(Rule 34)

INDUSTRIAL PROPERTY ACT, 2001

The Managing Director, Kenya Industrial Property Institute.

REQUEST TO HAVE A REFUSED REGIONAL APPLICATION TREATED AS AN APPLICATION UNDER THE ACT

Table with 2 columns: Field Name, Value. Fields include Name and address of applicant(s), International Application number, International filing date, Name of agent and address (if any).

I/We, the applicant(s) identified above, request the Managing Director to treat the above quoted African Regional Industrial Property Organisation application as an application under the Act.

The following are the facts upon which I/we rely:

[Empty box for facts]

Dated at ..... this ..... day of ....., 20 .....

Signature .....

Form IP 16

(Rule 38)

INDUSTRIAL PROPERTY ACT, 2001

The Managing Director, Kenya Industrial Property Institute.

PAYMENT OF ANNUAL FEE FOR AN APPLICATION/PATENT

I/We (insert name and address of the person making the payment)

FIRST SCHEDULE—continued

transmit the annual fee for the ..... year of	Patent application number or
	Patent number
which is/was due on	
Name of the applicant owner of patent	

Dated at ..... this ..... day of ....., 20 .....

Signature .....

CERTIFICATE OF ANNUAL FEE FOR AN APPLICATION/PATENT

This is to certify that the annual fee for the application/patent number .....  
..... has been paid for the period up to  
..... when the next annual fee will be due.



Dated at ..... this ..... day of ....., 20 .....

Signature .....

Kenya Industrial Property Institute Stamp

Form IP 17

(Rule 38)

INDUSTRIAL PROPERTY ACT, 2001

The Managing Director.  
Kenya Industrial Property Institute.

REQUEST TO RESTORE AN APPLICATION/PATENT

Name and address of person making request	
Name and address of agent (if any)	
Application/patent number	

I/We, the applicants identified above, apply for an order restoring the above quoted  
application/patent.

The failure to pay the annual fee was not intended. A statutory declaration or affidavit supporting the  
statements made in this request is attached

Dated at ..... this ..... day of ....., 20 .....

Signature .....

Industrial Property

[Subsidiary]

FIRST SCHEDULE—continued

Form IP 18

(Rule 39)

INDUSTRIAL PROPERTY ACT, 2001

The Managing Director.
Kenya Industrial Property Institute.

APPLICATION TO HAVE CHANGE OF OWNERSHIP RECORDED IN REGISTER

Table with 2 columns and 5 rows: Name and address of applicant(s), Name and address of agent (if any), Application/patent number, Name and address Former owner(s), Name and address New owner(s)

I/We, the applicants identified above, hereby apply to have a change of ownership recorded in the register for the above quoted application/patent.

The change in ownership was effected by:

[ ] A contract assigning the application or patent

[ ] Any other way

I/We attach copies of the documents required under Regulation 39 (4).

Dated at ..... this ..... day ....., 20 .....

Signature .....

Form IP 19

(Rules 39)

INDUSTRIAL PROPERTY ACT, 2001

CERTIFICATE OF REGISTRATION OF CHANGE OF OWNERSHIP

It is hereby certified that the change of ownership of application/patent number ..... has been registered on .....

Name and address of former owner(s) .....
.....
.....
.....
.....

Industrial Property

[Subsidiary]

FIRST SCHEDULE—continued

Name and address of the new owner(s) .....

Registration number of change of ownership .....

Dated at ..... this ..... day of ....., 20 .....

Managing Director, Kenya Industrial Property Institute

Form IP 20

(Rules 40)

INDUSTRIAL PROPERTY ACT, 2001

The Managing Director, Kenya Industrial Property Institute.

[ ] PETITION FOR REGISTRATION OF A LICENCE CONTRACT; OR

[ ] PETITION FOR REGISTRATION OF MODIFICATION TO LICENCE CONTRACT

Table with 6 rows and 3-4 columns for registration details including applicant reference, petitioner name/address, agent info, contract title, parties, and date.

The following document required under Regulation 40(3), accompany this petition.

.....

Dated at ..... this ..... day of ....., 20 .....

Signature .....

Industrial Property

[Subsidiary]

FIRST SCHEDULE—continued

Form IP 21

(Rules 41)

INDUSTRIAL PROPERTY ACT, 2001

CERTIFICATE OF REGISTRATION OF LICENCE CONTRACT OR MODIFICATION TO LICENCE CONTRACT

It is hereby certified that the licence contract/modification described below has been registered.

Description of registered licence contract or modification .....

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

Names and addresses of parties:

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

Dated at ..... this ..... day of ....., 20 .....

.....  
Managing Director,  
Kenya Industrial Property Institute

Form IP 22

(Rule 42)

INDUSTRIAL PROPERTY ACT, 2001

The Managing Director,  
Kenya Industrial Property Institute.

REQUEST FOR AN ENTRY IN THE REGISTER THAT LICENCES TO BE AVAILABLE AS OF RIGHT

Name and address of owner(s) of patent	
Name and address of agent (if any)	
Patent number	

I/We, the owner(s) identified above, request that an entry may be made in the register in the respect of the above quoted patent to the effect that licences under the patent are to be available as of right.

I/We are not precluded by contract from granting licences under the patent.

Dated at ..... this ..... day of ....., 20 .....

Signature .....



FIRST SCHEDULE—continued

✂ -----

CONFIRMATION OF MAKING AN ENTRY

This is to confirm that an entry has been made in the register of patent to the effect that licences under patent No. .... are to be available as of right.

Dated at ..... this ..... day of ....., 20 .....

Signature .....

Kenya Industrial Property Institute Stamp.

Form IP 23

(Rules 42 and 49)

INDUSTRIAL PROPERTY ACT, 2001

The Managing Director,  
Kenya Industrial Property Institute.

NOTICE OF OPPOSITION

Name and address of opponent/licensee	
Name and address of agent (if any)	

I/We, the opponent/licensee identified above, hereby give notice of opposition under Regulation ..... to the following application/request:

The grounds of opposition are as follows:

Dated at ..... this ..... day of ....., 20 .....

Signature .....

Form IP 24

(Rule 42)

INDUSTRIAL PROPERTY ACT, 2001

The Managing Director,  
Kenya Industrial Property Institute.

REQUEST TO CANCEL AN ENTRY IN THE REGISTER THAT LICENCES TO BE AVAILABLE AS OF RIGHT

Name and address of owner(s) of patent	
Name and address of agent (if any)	

Industrial Property

[Subsidiary]

FIRST SCHEDULE—continued

Patent number	
---------------	--

I/We, the owner(s) identified above, request the cancellation of the entry in the register to the effect that licences under the above-mentioned patent are to be available as of right.

Dated at ..... this ..... day of ....., 20 .....

Signature .....

✕ -----

CONFIRMATION OF MAKING AN ENTRY

This is to confirm the cancellation of the entry in the register of patent to the effect that licences under patent number ..... were to be available as of right.

--

Dated at ..... this ..... day of ....., 20 .....

Signature .....

Kenya Industrial Property Institute Stamp.

Form IP 25

(Rule 43)

INDUSTRIAL PROPERTY ACT, 2001

APPLICATION TO MINISTER FOR ORDER UNDER SECTION 80 OF THE ACT THAT INVENTION BE EXPLOITED

Name and address of applicant	
Name and address of agent (if any)	
Patent number	

I/We, the above identified person(s), hereby request the Minister to make an order under section 80 of the Act, authorising the exploitation of the above patent.

My/Our reasons are as follows:

--

Dated at ..... this ..... day of ....., 20 .....

Signature .....

FIRST SCHEDULE—*continued*

Form IP 26

(Rule 44)

**INDUSTRIAL PROPERTY ACT, 2001**

UTILITY MODEL CERTIFICATE

It is hereby certified that a utility model number ..... has been registered in the name of ..... in respect of an invention disclosed in an application number ..... having a date of filing of ..... and priority date of ..... being an invention titled .....

Dated at ..... this ..... day of ....., 20 .....

.....  
 Managing Director,  
 Kenya Industrial Property Institute

Form IP 27

(Rule 47)

**INDUSTRIAL PROPERTY ACT, 2001**

The Managing Director,  
 Kenya Industrial Property Institute.

APPLICATION FOR REGISTRATION OF AN INDUSTRIAL DESIGN

Applicant's/agent's reference		
Name and address of applicant(s)		
Nationality (country)	Residence (country)	
Telephone number	Facsimile number	E-mail address
Name and Address of the creator(s)		
Name and address of agent (if any)		
Address for service		
What article is the design to be applied to?		
Is the design to be applied to—	<input type="checkbox"/> A single article? Or <input type="checkbox"/> A set of articles?	
Declaration of priority (see note 4)		

Industrial Property

[Subsidiary]

FIRST SCHEDULE—continued

Disclaimer (if any) limiting rights applicant is seeking	
--	--

Reminder:

Have you attached?

Representations or specimens of the design?	
Any continuation sheet if appropriate?	
The prescribed fee?	

NOTES:

1. If space provided is not sufficient, use a separate sheet of paper.
2. Please enter the names of each applicant. Names of individuals should be entered in full and the surname or family name should be underlined.
3. Please name concisely the specific articles as shown in the representations for which protection is required.
4. The declaration of priority should comply with the requirements in Regulation 21.

Dated at ..... this ..... day of ....., 20 .....

Signature .....

Form IP 28

(Rule 49)

INDUSTRIAL PROPERTY ACT, 2001

The Managing Director,  
Kenya Industrial Property Institute.

COUNTER-STATEMENT

Name and address of applicant/owner	
Name and address of agent (if any)	

In the matter .....

I/We, the applicant/owner identified above, hereby give notice that the following are the grounds that I/We rely on to support our application/request.

--

(Statement may be continued on separate sheets of paper of foolscap folio size or international standard A4 size – only one side should be used).

Dated this ..... day of ....., 20 .....

Signature .....

FIRST SCHEDULE—continued

Form IP 29

(Rule 49)

INDUSTRIAL PROPERTY ACT, 2001

The Managing Director,  
Kenya Industrial Property Institute.

NOTICE TO THE MANAGING DIRECTOR OF INTENTION TO BE HEARD AT HEARING

Name and address of party	
Name and address of agent (if any)	

I/We, the party identified above, hereby give notice that I/We intend to be heard at .....  
..... relating to:

Dated at ..... this ..... day of ....., 20 .....

Signature .....

Form IP 30

(Rule 50)

INDUSTRIAL PROPERTY ACT, 2001

The Managing Director,  
Kenya Industrial Property Institute.

REQUEST FOR REASONS FOR REFUSAL TO REGISTER WHERE THERE IS NO OPPOSITION

Applicant's reference	
Application number	
Name and address of applicant(s)	
Name and address of agent (if any)	
Date of hearing (if any)	
Date of Managing Director's decision to refuse to register	

I/We, the above-identified applicant, hereby request the Managing Director to provide written reasons for the Managing Director's decision.

Dated at ..... this ..... day of ....., 20 .....

Signature .....

Industrial Property

[Subsidiary]

FIRST SCHEDULE—continued

Form IP 31

(Rule 51)

THE INDUSTRIAL PROPERTY ACT, 2001

CERTIFICATE OF REGISTRATION OF AN INDUSTRIAL DESIGN

It is hereby certified that an industrial design number ..... of which a representation or specimen is attached, has been registered in the name of:

In respect of an application filed on ..... and application number ..... and claiming a priority date of .....

Dated at ..... this ..... day of ....., 20 .....

.....  
Managing Director,  
Kenya Industrial Property Institute

Form IP 32

(Rule 52)

INDUSTRIAL PROPERTY ACT, 2001

The Managing Director,  
Kenya Industrial Property Institute.

APPLICATION FOR RENEWAL OF THE REGISTRATION OF AN INDUSTRIAL DESIGN

I/We	
Transmit the renewal fee for industrial design number	
Which is/was due on	
Name and address of registered owner	

Dated at ..... this ..... day of ....., 20 .....

Signature .....

✂

Certificate of Renewal

This is to certify that registration of the Industrial Design with registration number ..... has been renewed. The renewed registration will expire on .....

Dated at ..... this ..... day of ....., 20.....



Signature .....

Kenya Industrial Property Institute stamp

FIRST SCHEDULE—continued

Form IP 33

(Rule 53)

INDUSTRIAL PROPERTY ACT, 2001

The Managing Director,  
Kenya Industrial Property Institute.

APPLICATION FOR RESTORATION OF PROTECTION GRANTED TO AN INDUSTRIAL DESIGN

Applicant's/agent's reference	
Registered industrial design number	
Name and address of owner	
Name and address of agent (if any)	
Give statement of grounds required under section 89(2) of the Act	

This application is accompanied by a statutory declaration or affidavit and an application for renewal as required under Regulation 53(3).

Dated at ..... this ..... day of ....., 20 .....

Signature .....

Form IP 34

(Rule 54)

INDUSTRIAL PROPERTY ACT, 2001

The Managing Director,  
Kenya Industrial Property Institute.

REQUEST TO EXAMINE REPRESENTATIONS OR SPECIMENS  
UNDER SECTION 90(2) OF THE ACT

Applicant's/agent's reference	
Name and address of applicant	
Name and address of agent (if any)	
Please give registered right number	

I/We, the above-identified applicant(s), hereby make a request to examine representations or specimens of the above quoted industrial design.

Dated at ..... this ..... day of ....., 20 .....

Signature .....

Industrial Property

[Subsidiary]

FIRST SCHEDULE—continued

Form IP 35

(Rule 57)

INDUSTRIAL PROPERTY ACT, 2001

TECHNOVATION CERTIFICATE

This technovation certificate is issued to:

Name and address of technovator: .....

By

Name and address of enterprise issuing certificate: .....

In respect of a technovation titled .....

and relating to the following .....

Dated at ..... this ..... day of ....., 20 .....

Signature .....

(To be signed on behalf of enterprise issuing certificate)

Form IP 36

(Rule 59)

INDUSTRIAL PROPERTY ACT, 2001

The Managing Director, Kenya Industrial Property Institute.

APPLICATION FOR REGISTRATION OF TECHNOVATION CERTIFICATE

Table with 2 columns and 3 rows: Applicant's or agent's reference, Name and address of applicant(s), Name and address of agent (if any)

A certified copy of the technovation certificate is attached.

Dated at ..... this ..... day of ....., 20 .....

Signature .....



FIRST SCHEDULE—continued

Form IP 37

(Rule 60)

INDUSTRIAL PROPERTY ACT, 2001

CERTIFICATE OF REGISTRATION OF TECHNOVATION CERTIFICATE

It is hereby certified that the technovation certificate described below has been registered with the registration number .....

Description of registered technovation certificate:

Name and address of technovator .....

Name and address of enterprise that issued technovation certificate: .....

Title of technovation .....

Dated at ..... this ..... day of ....., 20 .....

Managing Director, Kenya Industrial Property Institute

Form IP 38

(Rules 61)

INDUSTRIAL PROPERTY ACT, 2001

The Managing Director, Kenya Industrial Property Institute.

OFFER TO SURRENDER A PATENT OR UTILITY MODEL OR INDUSTRIAL DESIGN REGISTRATION

Table with 2 columns and 3 rows: Names and addresses of owners of patent/utility model or industrial design certificate; Name and address of agent (if any); Patent/Utility model/Industrial design number

I/We, the above-identified owner(s), hereby offer to surrender the above identified patent/utility model or industrial design certificate.

If a licence is recorded in the register, proof that the surrender can be registered under section 102(4) of the Act is attached.

Dated at ..... this ..... day of ....., 20 .....

Signature .....

*Industrial Property*

[Subsidiary]

FIRST SCHEDULE—*continued*

Form IP 39

(Rule 62)

**INDUSTRIAL PROPERTY ACT, 2001**

The Managing Director,  
Kenya Industrial Property Institute.

APPOINTMENT OF AN AGENT

Name and address of person appointing agent	
Name and address of agent	
Matter in respect of which agent is appointed (see note 1)	

I/We, the person(s) identified above, have appointed the above agent to act on my/our behalf in the matter described above, and request that all communications relating thereto be sent to the agent at his/their address given above.

I/We revoke all previous authorisations in respect of the same matter.

Dated at ..... this ..... day of ....., 20 .....

Signature .....

NOTE:

1. State the application or other matter in respect of which the appointment is made, quoting the application number or patent number or title as appropriate.

Form IP 40

(Rule 63)

**INDUSTRIAL PROPERTY ACT, 2001**

The Managing Director,  
Kenya Industrial Property Institute.

APPLICATION FOR ADMISSION TO PRACTICE BEFORE THE INSTITUTE

Name of applicant	
Address	

I, the applicant identified above, apply to be admitted to practice before the Institute.

- (i) I attach a copy of my identity card.
- (ii) I attach evidence that I satisfy the requirements of Regulation 63.

Dated at ..... this ..... day of ....., 20 .....

Signature .....

[Subsidiary]

FIRST SCHEDULE—continued

Form IP 41

(Rule 64)

INDUSTRIAL PROPERTY ACT, 2001

The Managing Director, Kenya Industrial Property Institute.

PAYMENT OF ANNUAL FEE FOR AN AGENT

I ..... of ..... hereby submit the prescribed annual fee to maintain my admission to practice before the Institute for the year ..... Dated at ..... this ..... day of ....., 20 ..... Signature .....

✂ -----

CERTIFICATE OF MAINTENANCE OF ADMISSION AS A PATENT AGENT

This is to certify that ..... has paid the prescribed fee to maintain his admission to practice before the Institute for the year .....

Dated at ..... this ..... day of ....., 20 .....



Signature .....

Kenya Industrial Property Institute Stamp

Form IP 42

(Rule 69)

INDUSTRIAL PROPERTY ACT, 2001

The Managing Director, Kenya Industrial Property Institute.

REQUEST FOR A COPY OF LOST OR DESTROYED CERTIFICATE

Table with 2 columns and 5 rows: Applicant's/agent's reference, Name and address of applicant, Name and address of agent (if any), Please give registered right number, Name of certificate, a copy of which is required

*Industrial Property*

[Subsidiary]

FIRST SCHEDULE—*continued*

I/We, the above identified applicant, hereby apply for a copy of the above quoted certificate that has been lost or destroyed.

The statutory declaration or affidavit required under Regulation 69(3) is attached.

Dated at ..... this ..... day of ....., 20 .....

Signature .....

Form IP 43

(Rule 70)

**INDUSTRIAL PROPERTY ACT, 2001**

The Managing Director,  
Kenya Industrial Property Institute.

REQUEST FOR SEARCH FOR AN INDUSTRIAL PROPERTY RIGHT

Applicant's or agent's reference		
Name and address of applicant for search		
Telephone	Fax	E-mail
Name and address of agent (if any)		
Brief description, giving particulars of the subject matter of the information sought. (A detailed description together with drawings, if applicable, should be given on a separate sheet)		

Dated at ..... this ..... day of ....., 20 .....

Signature .....

Form IP 44

(Rule 71)

**INDUSTRIAL PROPERTY ACT, 2001**

The Managing Director,  
Kenya Industrial Property Institute.

REQUEST TO AMEND NAME, ADDRESS OR OTHER CONTACT INFORMATION IN THE REGISTER

Name and address of applicant(s)/owner(s) of right	
Name and address of agent (if any)	
Number of application/right	

FIRST SCHEDULE—continued

I/We, the applicant(s)/owners identified above, request to amend the following:

[Empty rectangular box for amendment details]

in the register with respect to the above quoted right.

My/Our reasons for making this amendment are as follows:

[Empty rectangular box for reasons for amendment]

The details of the requested amendment are attached.

Dated at ..... this ..... day of ....., 20 .....

Signature .....

\_\_\_\_\_

Form IP 45

(Rule 72)

INDUSTRIAL PROPERTY ACT, 2001

The Managing Director,  
Kenya Industrial Property Institute.

REQUEST TO HAVE A CAUTION OR NOTICE INCLUDED IN/REMOVED FROM THE REGISTER

Name and Address of person making request	
Name and address of agent (if any)	
Give description of registration or application with respect to which the caution or notice is to be included or removed, including the registration or application number	

I/We, the above-identified applicant, hereby request the Managing Director to:

Include; or

Remove

a caution or notice in relation to the above quoted application/registration.

The caution or notice that is to be included or removed is as follows:

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

Dated at ..... this ..... day of ....., 20 .....

Signature .....

\_\_\_\_\_

*Industrial Property*

[Subsidiary]

FIRST SCHEDULE—*continued*

Form IP 46

(Rule 73)

**INDUSTRIAL PROPERTY ACT, 2001**

The Managing Director,  
Kenya Industrial Property Institute.

CERTIFICATE OF SERVICE

I/We ..... of .....  
hereby certify that at (see note 1) .....  
on the ..... day of ....., 20 .....  
at ..... o'clock in the .....  
I/We gave or sent the attached documents to, or served them .....  
on, .....  
by (see note 2) .....  
Dated at ..... this ..... day of ....., 20 .....

Signature (see note 3) .....

NOTES:

1. State precisely where service was effected.
2. Describe the method of service used.
3. To be signed by the person effecting service.

SECOND SCHEDULE

[Rule 3.]

FEES

Notes:

1. A foreign fee is payable if the person paying the fee or on whose behalf the fee is being paid does not reside in Kenya and does not have a principal place of business in Kenya.

PART A – GENERAL FEES

<i>Description of fee</i>	<i>Local Fee KSh</i>	<i>Foreign Fee US\$</i>	<i>Corresponding form</i>
1. Fee for a request for written authority under section 28(1) of the Act	1,000	N/A	1
2. Fee for a request for certificate that person has right to inspect files	1,000	50	2
3. Fee for application for a patent			
With a provisional specification	1,000	50	3
With a final specification	3,000	150	3
4. Excess claims fee, for each claim in excess of ten (see Regulation 14(11))	100	20	3

## SECOND SCHEDULE—continued

<i>Description of fee</i>	<i>Local Fee KSh</i>	<i>Foreign Fee US\$</i>	<i>Corresponding form</i>
5. Fee for filing a final specification	3,000	150	3
6. Fee for a request for amendment or division of an application	2,000	100	5
7. Fee for request for amendment of application to change name, address or other contact information	1,000	50	6
8. Fee for a request for extension of time	1,000	50	7
9. Fee for publication of patent application (see Regulation 25)	3,000	150	N/A
10. Fee for a request for a substantive examination	5,000	250	8
11. Fee for grant of a patent (see Regulation 29)	3,000	150	N/A
12. Fee for a request for a certified copy	2,000	100	11
13. Fee for a request for an uncertified copy	500	50	12
14. Transmittal fee (see Regulation 31) Plus actual cost of transmittal	5,000	250	N/A
15. Fee for request to have an international application treated as an application under the Act (refused application)	3,000	150	13
16. Fee for request to have an international application treated as an application under the Act (entry into national phase)	3,000	150	14
17. Fee for request to have a regional application treated as an application under the Act (refused application)	3,000	150	15
18. Annual fee for an application or patent:			
For 2nd year	2,000	300	16
For 3rd year	2,000	300	16
For 4th year	2,000	300	16
For 5th year	2,000	300	16
For 6th year	2,000	300	16
For 7th year	2,000	300	16
For 8th year	6,000	300	16
For 9th year	7,000	350	16
For 10th year	8,000	400	16
For 11th year	10,000	500	16
For 12th year	12,000	600	16
For 13th year	14,000	700	16
For 14th year	16,000	800	16
For 15th year	18,000	900	16
For 16th year	20,000	1,000	16
For 17th year	30,000	1,500	16
For 18th year	35,000	1,750	16
For 19th year	40,000	2,000	16
For 20th year	50,000	2,500	16
19. Surcharge under section 61(2) of the Act	3,000	150	16
20. Fee for a request to restore an application or patent	6,000	300	17

## Industrial Property

[Subsidiary]

SECOND SCHEDULE—*continued*

<i>Description of fee</i>	<i>Local Fee KSh</i>	<i>Foreign Fee US\$</i>	<i>Corresponding form</i>
21. Fee for an application to have a change of ownership recorded in the register:			
For a change effected by a contract assigning the application or patent	7,000	350	18
For a change effected in any other way	5,000	250	18
22. Fee for a petition for registration of a licence contract or modification to a registered licence contract	30,000	1,500	20
23. Fee for a request for an entry that licences are to be available as of right	1,000	50	22
24. Fee for notice of opposition to an entry that licences are to be available as of right	5,000	250	23
25. Fee for a request for a cancellation of an entry that licences are to be available as of right	3,000	150	24
26. Fee to convert patent application into application for utility model certificate under section 83 1) of the Act	500	50	N/A
27. Fee to convert application for utility model certificate into patent application under section 83(2) of the Act	2,500	150	N/A
28. Fee for an application for registration of an industrial design	3,000	150	27
29. Publication fee for notice of application to register an industrial design (see Regulation 48)	3,000	150	N/A
30. Fee for notice of opposition to an application for registration of an industrial design	5,000	250	23
31. Fee for a counter-statement (in relation to an application for registration of an industrial design or a request for an entry that licences are to be available as of right)	4,000	200	28
32. Fee for a notice to appear at a hearing (in relation to an application for registration of an industrial design or a request for an entry that licences are to be available as of right)	5,000	250	29
33. Fee for a request for reasons for a decision to refuse to register an industrial design	1,000	50	30
34. Fee for registration of an industrial design (see Regulation 51)	1,000	50	N/A
35. Fee for an application for a renewal of an industrial design	10,000	500	32
36. Fee for an application for the restoration of protection granted to an industrial design	2,000	100	33
37. Surcharge under section 88(3) of the Act for late renewal	3,000	150	N/A
38. Fee for a request to examine representations or specimens	1,000	50	34
39. Fee for an application to register a technovation certificate	1,000	(same as local fee)	36
40. Fee for a surrender of a patent or utility model, industrial design certificate	1,000	50	38
41. Fee for an appointment of an agent	1,000	50	39
42. Fee for application for admission to practice before the Institute	10,000	500	40



[Subsidiary]

SECOND SCHEDULE—continued

<i>Description of fee</i>	<i>Local Fee KSh</i>	<i>Foreign Fee US\$</i>	<i>Corresponding form</i>
43. Annual fee to maintain admission to practice before the Institute	2,000	100	41
44. Fee for a request for a lost or destroyed certificate	2,000	100	42
45. Fee for a search	2,000	100	43
46. Fee for request for amendment of register to change name, address or other contact information	2,000	100	44
47. Fee for request to have a caution or notice included in or removed from a register	1,000	50	45

PART B – FEES FOR UTILITIES MODELS THAT ARE DIFFERENT FROM FEES IN PART A

<i>Description of fee</i>	<i>Local Fee KSh</i>	<i>Foreign Fee US\$</i>	<i>Corresponding form</i>
1. Fee for application for a utility model certificate			
With a provisional specification	500	50	3
With a final specification	1,000	50	3
2. Fee for filing a final specification	1,000	50	3
3. Fee for a request for amendment of division of an application	500	50	5
4. Fee for request for amendment of application to change name, address or other contact information	500	50	6
5. Fee for a request for extension of time	500	50	7
6. Annual fee for an application for a utility model certificate, after the first year	1,000	50	16
7. Annual fee for a utility model certificate			
Fee due in 1st year after grant	1,000	50	16
Fee due in 2nd year after grant	1,500	75	16
Fee due in 3rd year after grant	2,000	100	16
Fee due in 4th year after grant	2,500	125	16
Fee due in 5th year after grant	3,000	150	16
Fee due in 6th year after grant	3,500	175	16
Fee due in 7th year after grant	4,000	200	16
Fee due in 8th year after grant	4,500	225	16
Fee due in 9th year after grant	5,000	250	16
Fee due in 10th year after grant	5,500	275	16
8. Fee for a request to restore an application or utility model certificate	2,000	100	17
9. Fee for an application to have a change of ownership recorded in the register:			
For a change effected by a contract assigning the application or patent	2,000	100	18
For a change effected in any other way	1,000	50	18

