

KENYA - ANTI COUNTERFEIT AUTHORITY RECORDATION

This memorandum summarizes changes in Kenya law under the Anti-Counterfeit (Amendment) Regulations, 2021 and the Anti-Counterfeit (Recordation) Regulations, 2021 which require registration of Intellectual Property Rights (“IPR”) referred to below in a register maintained by the Kenya Anti-Counterfeit Authority.

Background

As a result of the amendments made to the Kenya Anti Counterfeit Act (the “**Act**”) in 2019, the Anti-Counterfeit Authority (“**ACA**”) drafted the Anti-Counterfeit (Amendment) Regulations, 2019 in order to implement the changes in the Act.

On 23rd July, 2021, the Anti-Counterfeit (Amendment) Regulations, 2021 were gazetted through Legal Notice No. 117 and the Anti-Counterfeit (Recordation) Regulations, 2021 were gazetted through Legal Notice 118 (both hereinafter referred to as the “**Regulations**”). No effective date for the commencement of the Regulations was published in the Regulations.

The main objective of the amendments to the Act and the implementation of the Regulations was to ensure the effective enforcement against counterfeit goods.



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Recordation

Section 34B of the Act provides a mandatory provision for IPR relating to goods to be imported into the country to be registered. Previously, under the Anti-Counterfeit Regulations 2010, the Anti-Counterfeit Agency (as it was then known) was merely mandated to maintain and make available for searches a database of IPR submitted to it by IPR owners. However, an application to make an application to record IPR was at the discretion of the intellectual property owner.

IPR as defined by the Act includes, copyright, trade marks, plant breeders rights, patents, industrial designs and utility models.

The ACA on 28th February 2022 begun the recordation of IPR through its online portal <https://public.aims.aca.go.ke/home>

The recordation will take place in three phases:

Phase 1 - Admission of agents and processing of applications to record IPR (currently ongoing).

Phase 2 - Implementation of IPR Particulars for Imported Goods. This phase shall be rolled out after the completion of phase 1. At this stage it is not known at which date this phase will be rolled out.

Phase 3 - Rollout of the anti-counterfeit security mark at a date to be advised by the ACA.

Kaplan & Stratton is in regular contact with the ACA recordation department and will

keep you updated of the developments when the roll out of phase 2 and 3 begin.

Time frame for recordation

The recordation process will take a maximum of 30 days. The ACA shall publish a monthly newsletter providing details of IPR that have been successfully recorded.

The recordation will be valid for a period of one year from the date of approval of the application for recordation or the current registration period of the IPR, whichever is shorter. A new application for recordation therefore has to be made upon the expiry of the one-year period.

Requirements for recordation

Before an agent or intellectual property owner can make an application for recordation, they must first create an account on the ACA's online portal and then complete an application for registration as an agent or an IP owner.

All agents will require a form of power of attorney to record IPR on behalf of an intellectual property owner.

To begin the recordation process, the following information will be required at hand:

1. The name, complete business address, and citizenship of the IPR owner or owners (if a partnership, the citizenship of each partner; if an association or corporation the State, country, or other political jurisdiction

within which it was organized, incorporated, or created).

2. The places of manufacture of goods bearing the recorded IPR.
3. A clear digital photographic representation of the goods bearing the IPR with appropriate details for identification and differentiation from any counterfeits.
4. The name and principal business address of each foreign person or business entity authorized or licensed to use the IPR and a statement as to the use authorized.
5. The identity of any parent or subsidiary company or other foreign company under common ownership or control which uses the IPR abroad.
6. A copy of the certificate of registration certified by the registering authority showing title to be presently in the name of the Applicant. These registering authorities are:
 - (a) The Kenya Industrial Property Institute ("KIPI") in respect of registered trade marks, patents, industrial designs and utility models.
 - (b) The Kenya Copyright Board ("KECOBO") in respect of registered copyrights.
 - (c) The Kenya Plant Health Inspectorate Service ("KEPHIS")

in respect of registered plant varieties.

Recordation fees

The standard cost of recordation for IPR is US\$90. However, for recordation of trade marks the US\$ 90 is for recordation of a mark in one class. A fee of US\$10 is applicable for each subsequent class. Payments can be made through cash, EFT, RTGS and bankers cheque.

Offences and Penalties

A party importing goods into Kenya bearing IPR that has not been recorded at the ACA or importing unbranded goods or items except raw unbranded materials commits an offence and shall be convicted in the case of a first conviction to imprisonment for a term not exceeding five years, or to a fine, in respect of each article or item involved in the particular act of dealing in counterfeit goods to which the offence relates, not less than three times the value of the prevailing retail price of the goods, or both. In the case of a second or any subsequent conviction, to imprisonment for a term not exceeding fifteen years, or to a fine, not less than five times the value of the prevailing retail price of the goods, or both.

Conclusion

Recordation is aimed at enabling border officers to take intervention measures against counterfeit goods in an efficient manner.

If you require any further information or clarification on the contents of this note, please contact:

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