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AN ACT OF PARLIAMENT TO PROVIDE FOR THE REGISTRATION AND PROTECTION OF GEOGRPAHICAL INDICATIONS

Date of Assent:

Date of Commencement:

ENACTED by the Parliament of Kenya as follows:-

PART I: PRELIMINARY

Short Title and
Commencement

1. This Act may be cited as The Geographical Indications Act and shall enter into force on such date as the Minister may, be notification in the Gazette, appoint:

Interpretation

2. For the purposes of this Act;
 - (a) "Agent" means an agent admitted to practice before Kenya Industrial Property Institute under the provisions of section 7(3) of this Act;
 - (b) "Assistant Registrars" means Assistant Registrars appointed under section 3(2);
 - (c) "Court" means the High Court of Kenya;
 - (d) "Deputy Registrar" means a Deputy Registrar appointed under section 3(2);
 - (e) "Examiners" means Examiners of Geographical Indications appointed under section 3(2);
 - (f) "Geographical Indication" in relation to goods or services, means a description or presentation used to indicate the geographical origin, in the territory of a country, or a region or locality in that territory, where a given quality, reputation or other characteristics of goods or services are exclusively or essentially attributable to geographical environment, including natural factors, human factors or both;
 - (g) "Goods" means natural or agricultural products or products of handicraft or industry;
 - (h) "Industrial Property Journal" means the Journal published under the Industrial Property Act;

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- (i) "minister" means Minister responsible for industrial property matters;
- (j) "Paris Convention" means the Paris Convention for the Protection of Industrial Property of March 20, 1883, as last revised;
- (k) "Producer" means:
 - (i) any producer of agricultural products or any other person exploiting natural products,
 - (ii) any manufacturer of products of handicraft, or industry, and
 - (iii) any trader dealing in the said products;
- (l) "Registrar" means the Managing Director of the Kenya Industrial Property Institute appointed under section 11 of the Industrial Property Act;
- (m) "Regulations" means regulations made under this Act.
- (n) "Tribunal" means the Industrial Property Tribunal established under Section 113 of the Industrial Property Act.

PART II: ADMINISTRATION.

Registrar, Deputy
Registrar, Assistant
Registers

3.(1) The Managing Director of the Kenya Industrial Property Institute appointed under the Industrial Property Act, or such other person as the Minister may appoint, shall be the Registrar of Geographical Indications under and for the purposes of this Act.

(2) There shall also be a Deputy Registrar of Geographical Indications, and such number of Assistant Registrars, Examiners and other officers as it may be considered necessary to appoint for the purposes of this Act.

(3) The Deputy Registrar and Assistant Registrars shall perform such duties and functions and exercise such powers as the Registrar may lawfully perform or exercise under this Act or any other enactment.

(4) The Registrar shall have a seal which he shall use to seal all certificates issued by him and all such other documents that he may deem fit to seal.

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(5) When the seal is lawfully affixed to a document and the same is duly authenticated, it shall be judicially and officially noticed.

PART III: PROTECTION OF GEOGRAPHICAL INDICATIONS.

Availability of
Protection
Regardless of
Registration;
Presumption

4. Protection under this Act shall be available:

(a) regardless of whether a geographical indication has been registered, however, registration of a geographical indication under Part II of this Act shall, in any proceedings under this Act, raise a presumption that such indication is a geographical indication within the meaning of section 2(f); and

(b) against a geographical indication which, although literally true as to the territory, region or locality in which the goods originate, falsely represents to the public that the goods originate in another territory.

Homonymous
Geographical
Indications for goods

5. In the case of homonymous geographical indications for goods, protection shall be accorded to each indication subject to paragraph (b) of Section 4. The Registrar, in cases of permitted concurrent use of such indications, shall determine the practical conditions under which the homonymous indications in question will be differentiated from each other, taking into account the need to ensure equitable treatment of the producers concerned and that consumers are not misled.

Exclusion from
Protection

6. The following shall not be protected as geographical indications:

(a) indications which do not correspond to the definition in Section 2(f);

(b) indications which are contrary to public order or morality;

(c) geographical indications which are not or cease to be protected in their country of origin, or which have fallen into disuse in that country.

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PART IV: REGISTRATION OF GEOGRAPIDCAL INDICATIONS.

Application
for
registration
and Right to
File
Application

7. (1) The application for registration of a geographical indication shall be filed with the Registrar.
- (2) The following shall have the right to file an application:
- (a) natural persons or legal entities carrying on activities as producers in the geographical area specified in the application, with respect to the goods specified in the application, as well as groups of such persons;
 - (b) groups of producers;
 - (c) any competent authority.
- (3) Where an 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 practise before the Kenya Industrial Property Institute, who shall be:
- (i) a legal practitioner resident and practising in Kenya, or
 - (ii) for purposes of filing applications only, a person who has served in an industrial property office in the capacity of an examiner or above for a period of not less than seven years.

Contents of
Application

8. The application shall specify:
- (a) the name, address and nationality of the natural person or legal entity filing the application, and the capacity in which the applicant is applying for registration;
 - (b) the geographical indication for which registration is sought;
 - (c) the geographical area to which the geographical indication applies;
 - (d) the goods for which the geographical indication applies;
 - (e) the quality, reputation or other characteristic of the goods for which the geographical indication is used;

and shall be subject to payment of the fees prescribed in the Regulations.

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Examination;
Opposition;
Registration
Of Geographical
Indication

9.(1) The Registrar shall examine whether the application complies with the requirements of Sections 6(b), 7(2) and 8.

(2)(a) Where the Registrar finds that the conditions referred to in subsection (1) hereof are fulfilled, he shall accept the application, and publish it in the prescribed manner.

(b) Any interested person or competent authority may, within the prescribed and in the prescribed manner, give notice to the Registrar of Opposition to the Registrar of a geographical indication on the grounds that one or more of the requirements of Sections 6, 7(2) and 8 are not fulfilled,

(c) The Registrar shall send a copy of such a notice to the applicant, and, within the prescribed period and in the prescribed manner, the applicant shall send to the Registrar a counterstatement of the grounds on which he relies in support of his application; if he does not do so, he shall be deemed to have abandoned the application,

(d) If the applicant sends a counter-statement, the Registrar shall furnish a copy thereof to the person giving notice of opposition and, after hearing the parties, if either or both wish to be heard, and considering the merits of the case, shall decide whether the geographical indication should be registered,

(3) Where the Registrar finds that the conditions referred to in subsection (1) are fulfilled, and either:

(a) the registration of the geographical indication has not been opposed within the prescribed time limit; or

(b) the registration of the geographical indication has been opposed and the opposition has been decided in the applicant's favour,;

he shall register the geographical indication, publish a reference to the registration in the Industrial Property Journal and issue to the applicant a certificate of registration, Otherwise, he shall refuse the application,

Duration and
renewal of
registration

10, (1) The registration of a geographical indication shall be for a period of ten years, but may be renewed from time to time in accordance with the provisions of this section and the Regulations.

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(2) The Registrar shall, on indication made by the registered proprietor of a geographical indication in the manner prescribed in the Regulations and within the, prescribed period, renew the registration of the geographical indications for a period of ten years from the date of expiration of the original registration or of the last

renewal of registration, as the case may be, which date is in this section referred to as the expiration of the last registration.

(3) At the prescribed time before the expiration of the last registration of a geographical indication, the Registrar shall send notice in the prescribed manner to the registered proprietor of the date of expiration and the conditions as to payment of fees and otherwise upon which a renewal of registration may be obtained, and, if at the expiration of the time prescribed in that behalf those conditions have not been duly complied with, the Registrar may remove the geographical indication from the register, subject to such conditions, if any, as to its restoration to the register as may be prescribed.

Change in
ownership

11.(1) All contracts assigning applications or registered geographic indications shall be in writing and shall be signed by the parties thereto.

(2) Any change in the ownership of an application or registered geographical indications shall be recorded in the Register on payment of the prescribed fee in the manner prescribed in 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 registered geographical indication, unless the Tribunal otherwise directs.

Right of Use

12. Only producers carrying on their activity in the geographical area specified in the Register shall have the right to use a registered geographical indication, in the course of trade, with respect to the products specified in the Register, provided that such products possess the quality, reputation or other characteristic specified in the Register.

Cancellation and
Rectification of
Register

13.(1) Any interested person or any competent authority may request the Tribunal to order:

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(a) the cancellation of a registration of a geographical indication on the ground that it does not qualify for protection as such having regard to Section 6;

(b) the rectification of a registration of geographical indication on the ground that the geographical area specified in the registration does not correspond to the geographical indication, or that the indication of the products for which the geographical indication is used or the indication of the quality, reputation or other characteristic of such products is missing or unsatisfactory.

(2) In any proceedings under this section, notice of the request for cancellation or rectification:

(a) shall be served on the person who filed the application for registration of the geographical indication or his agent or successor in title; and

(b) shall, by a publication in the Industrial Property Journal be given to all persons having the right to use the geographical indication under Section 12,

(3) The persons referred to in subsection (2) and any other interested person may, within a period which shall be specified by the Tribunal in the said notice and publication, apply to join in the proceedings.

Register, Search
and
Applications
for copies of
documents:
Publications

14.(1)(a) The Registrar shall maintain a Register in which he shall record all matters required by this Act to be recorded.

(b) Any person may search, inspect or apply for copies of the records maintained by the Registrar of Geographical Indications upon fulfillment of the conditions and payment of the fees prescribed in the Regulations.

(2) The Registrar shall publish in the Journal all the publications provided for in this Act,

Corrections of
Errors
And Extension
of Time

15.(1) The Registrar, subject to the Regulations, shall correct any error of translation or transcription, clerical error or mistake in application or document filed with the Office or in any recording effected pursuant to this Act.

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(2) If the-Registrar is satisfied that the circumstances justify it, he may, upon, receiving a written request, extend the time for doing any act or taking any proceeding under tills Act or the Regulations, upon notice to parties concerned and upon such terms as.he.1Jlay direct. The extension maybe granted, though the time for doing the act or taking the proceeding has expired.

Exercise of
Discretionary
Powers

16. The Registrar shall give any party to a proceeding before him an opportunity of being heard before exercising adversely to that party any discretionary power vested in him by this Act or the Regulations.

Competence of
Tribunal and
Appeals

17.(1) The Tribunal shall have jurisdiction in cases of dispute relating to the application of this Act and the Regulations and in matters which under this Act and the Regulations are to be referred to the Tribunal.

(2) Any decision taken by the Registrar under this Act may be the subject of an appeal by any interested party before the Tribunal and such appeal shall be filed within two months of the date of the decision.

(3) Any party to the proceedings before the Tribunal may appeal against the decision of the Tribunal to the Court.

Regulations and
Administrative
Instructions

18(1). The Minister may issue Regulations prescribing details for the implementation of this Act. The Regulations may, in particular provide for the payment of fees in connection with applications for the registration of geographical indications and matters related thereto.

(2) The Registrar may issue Administrative Instructions relating to the procedures under this Act and the Regulations as well as to the functions of the Office.

PART V: CIVIL PROCEEDINGS AND OFFENCES.

Civil Proceedings

19. Any interested person and any interested group of producers or consumers may institute proceedings in the Tribunal to prevent, in respect of geographical indications,

(a) the use of any means in the designation or presentation of goods that indicate or suggest that the goods in question originate in a geographical area other than the true place of origin in a

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manner which misleads the public as to the geographical origin of the goods;

(b) any use which constitutes an act of unfair competition within the meaning of Article 1 Obis of the Paris Convention; or

(c) use of a geographical indication identifying wines, spirits or other goods not originating in the place indicated by the geographical indication in question, even where the true origin of the goods is indicated or the geographical indication is used in translation or accompanied by expressions such as "kind", "type", "style", "imitation" or the like;

and in proceedings under this section, the Tribunal may, in addition to issuing an injunction, award damages and grant any other civil remedy or relief as it shall deem fit.

Offences

20. Any person who intentionally performs any of the acts referred to in Section 19 shall be guilty of an offence punishable by a fine not exceeding Kenya shillings two hundred thousand (K.shs.200,000/=) or by imprisonment for a term not exceeding five years, or by both.

PART VI: SPECIAL PROVISIONS CONCERNING MARKS; EXCEPTIONS.

Misleading
Marks

21. The Registrar of Trade Marks may, on his own motion or at the request of an interested party, after hearing all the parties concerned, refuse or invalidate the registration of a trade mark which contains or consists of a geographical indication with respect to goods not originating in the territory indicated, if use of the indication in the trade mark for such goods in Kenya is of such a nature as to mislead the public as to the true place of origin.

Marks
conflicting with
a Geographical
Indication for
Wines, Spirits
or other goods

22. The registration of a trade mark for wines which contains or consists of a geographical indication identifying wines or of a trade mark for spirits or for other goods which contains or consists of a geographical indication identifying spirits shall be refused or invalidated by the Registrar, ex officio or at the request of an interested party, with respect to such wines or spirits not having this origin.

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Exception
Regarding Prior
Users

3.(1) Nothing in this Act shall prevent continued and similar use in Kenya of a particular geographical indication of another country identifying wines, spirits or other goods or in connection with goods or services by any national or domiciliary of Kenya who has used that geographical indications in a continuous manner with regard to the same or related goods or services in the territory of Kenya either:

(a) for at least 10 years preceding 15 April 1994; or

(b) in good faith preceding that date.

(2) Where a trade mark has been applied for or registered in good faith, or where rights to a trade mark have been acquired through use in good faith either:

(a) before the date of entry into force of this Act; or

(b) before the geographical indication is protected in its country of origin, this Act shall not prejudice the registrability of or the validity of the registration of a trade mark, or the right to use a trade mark, on the basis that such a trade mark is identical with, or similar to, a geographical indication.

(3) Nothing in this Act shall apply in respect of a geographical indication of any country with respect to goods or services for which the relevant indication is identical with the term customary in common language as the common name for such goods or services in Kenya or in respect of a geographical indication of any other country with respect to products of the wine for which the relevant indication with the customary name of a grape variety existing in Kenya as of January 1, 1995.

(4) Any request for relief made under Part **III** of this Act in connection with the use or registration of a trade mark must be presented within five years after the adverse use of the protected indication has become generally known in Kenya or after the date of registration of the trade mark in Kenya, provided that the trade mark has been published by that date, if such date is earlier than the date on which the adverse use became generally known in Kenya and provided that the geographical indication is not used or registered in bad faith.

(5) This Act shall in no way prejudice the right of any person to use, in the course of trade, that person's name or the name of that person's predecessor in business, except where such name is used in such a manner as to mislead the public.