



**SCHOOL OF LAW  
MASTER OF LAWS  
END OF JANUARY MODULE EXAMINATION  
LLM 8103: ENFORCEMENT OF IP RIGHTS**

DATE: Thursday 11<sup>TH</sup> April 2019

Time: 2 Hours

**Instructions**

1. This examination consists of **THREE** questions.
2. Answer **ALL QUESTIONS**

**Question 1**

A footnote to article 51 of the WTO TRIPS Agreement states as follows:

*“For the purposes of this Agreement:*

*(i) "counterfeit trademark goods" shall mean any goods, including packaging, bearing without authorization a trademark which is identical to the trademark validly registered in respect of such goods, or which cannot be distinguished in its essential aspects from such a trademark, and which thereby infringes the rights of the owner of the trademark in question under the law of the country of importation;*

*(ii) "pirated copyright goods" shall mean any goods which are copies made without the consent of the right holder or person duly authorized by the right holder in the country of production and which are made directly or indirectly from an article where the making of that copy would have constituted an infringement of a copyright or a related right under the law of the country of importation.”*

Section 2 of the Kenyan Anti-Counterfeit Act, 2008 defines counterfeiting as follows:

*“counterfeiting” means taking the following actions without the authority of the owner of intellectual property right subsisting in Kenya in respect of protected goods—*

- i. *the manufacture, production, packaging, re-packaging, labelling or making, whether in Kenya, of any goods whereby those protected goods are imitated in such manner and to such a degree that those other goods are identical or substantially similar copies of the protected goods;*
- ii. *the manufacture, production or making, whether in Kenya or elsewhere, the subject matter of that intellectual property, or a colourable imitation thereof so that the other goods are calculated to be confused with or to be taken as being the protected goods of the said owner or any goods manufactured, produced or made under his licence;*
- iii. *the manufacturing, producing or making of copies, in Kenya or elsewhere, in violation of an author's rights or related rights;*
- iv. *in relation to medicine, the deliberate and fraudulent mislabeling of medicine with respect to identity or source, whether or not such products have correct ingredients, wrong ingredients, have sufficient active ingredients or have fake packaging:*  
*Provided that nothing in this paragraph shall derogate from the existing provisions under the Industrial Property Act, 2001 (No. 3 of 2001).*

Further intellectual property rights are defined in the Anti – Counterfeit Act as follows:

*“intellectual property right” includes—*

- (i) any right protected under the Copyright Act, 2001 (No. 12 of 2001);*
- (ii) any plant breeders' right granted under the Seeds and Plant Varieties Act (Cap. 326);*
- (iii) any right protected under the Trade Marks Act (Cap. 506); and*
- (iv) any right protected under the Industrial Property Act, 2001 (No. 3 of 2001);*

- a) Discuss the differences between the provisions cited from the WTO Agreement and those the Kenya Anti- Counterfeit Act. (10 marks)
- b) Generic product manufacturers, especially in the pharmaceutical sector have on several occasions criticized the above. What in your view are the reasons why this sector is dissatisfied with this definition (Anti- Counterfeit Act)? (10 marks)

## **Question 2**

Netflix Inc. is the registered proprietor of a trademark, “Netflix” in various classes in Kenya. The company is also the proprietor of a domain name, [www.netflix.com](http://www.netflix.com) Kamash, a recent graduate in IT from a university in Kenya and a ‘hustler’ recently attempted to register two trademarks, ‘netflix.co.ke’ and ‘netflixs’ at the Kenya Industrial Property Institute. However, the Trade Marks Examiner has refused to register these two trademarks on account of the subsisting mark in the register, owned by Netflix Inc. Undeterred, Kamash has now gone ahead and succeeded in registering two domain names, (a) [www.netflix.co.ke](http://www.netflix.co.ke) and (b) [www.netflixs.com](http://www.netflixs.com) .

Netflix Inc. considers the successful registration of the domain name to be an infringement of its rights and has come to you for advice on how to protect its rights, including seeking redress concerning the domain names. Advise Netflix Inc. (20 marks).

### **Question 3**

- a) Eric has established a very successful manufacturing plant for a liquor named, 'Kinywaji' in Ruiru, Kenya and has also registered appropriate trademarks for the brand at KIPI, besides also obtaining all the standards and public health certifications necessary. His manufacturing and marketing prowess have seen his product being consumed across all market segments. In recent weeks, he has discovered that illicit products bearing his product's brand, including similarity in packaging are being sold in the market. Further investigations reveal that there are two sources of the illicit counterfeits: (i) another plant in Kariobangi South and (ii) imports from China. Having come to you seeking legal advice, you have informed him that the Anti-Counterfeit Act, 2008 is the most potent legislation in dealing with the problems he is facing. What are the strengths of the Anti – Counterfeit Act and how would its provisions assist Eric? (10 marks)
- b) Explain exhaustion doctrine in intellectual property rights and its relevance in enforcement of rights (5 marks)
- c) A new online market place, [www.nunua-sasa.co.ke](http://www.nunua-sasa.co.ke) is the most popular shopping site in Kenya. The proprietors of this site do not manufacture product sold on the site, but rather make money from advertisements and sales commissions from vendors who place their wares on the site. In recent week, the site has become to 'go to market place' for buying and selling fakes and counterfeit goods. Fearing the wrath of genuine product manufacturers and the government, they come to you for advice.

Briefly advise the proprietors of the website on the most practical step they should take to prevent incurring any liability for offering a market for the sale of counterfeit goods.

(5 marks)