

INTA Comments on the Protection of Traditional Knowledge and Cultural Expressions (Registration) Regulations. 2022. Kenya

The International Trademark Association (INTA) is a global association of brand owners and professionals dedicated to supporting trademarks and complementary IP to foster consumer trust, economic growth, and innovation, and committed to building a better society through brands. Members include nearly 6,000 organizations, representing more than 33,500 individuals (trademark owners, professionals, and academics) from 181 countries, who benefit from the Association's global trademark resources, policy development, education and training, and international network. Founded in 1878, INTA is headquartered in New York City, with offices in Beijing, Brussels, Santiago, Singapore, and the Washington, D.C. Metro Area, and representatives in Nairobi, Amman and New Delhi.

In Kenya, our membership comprises of 13 firms representing 50 individuals, majority of whom serve in our various committees. It is through these committees that we assess and address a wide range of issues related to trademarks and IP. We are also privileged to have one of our members in Kenya sitting on our Board of Directors owing to her longstanding commitment and dedication to INTA's activities and objectives.

We've been working in close collaboration with the Kenya Industrial Property Institute (KIPI) where we successfully conducted Phase 1 of the training of trademark examiners for KIPI staff in June and are discussing various topics for Phase 2 of this training. We are also currently exploring potential areas of cooperation with the Anti Counterfeit Authority of Kenya (ACA) including revamping the Memorandum of Understanding that we signed with the ACA in 2019. Additionally, we are looking to collaborate with the Ministry of Investment Trade and Industry, the Kenya Association of Manufacturers (KAM), the Kenya Copyright Board (KECOBO) as well as other educational institutions in Kenya to promote the awareness and importance of IP rights protection. Finally, we are working with the Kenya National Assembly to relaunch the Trademark/IP Caucus whose main objective is to mitigate threats of trademark counterfeiting and related matters, a first of its kind in Africa.

Notably, INTA is one of the first IP organizations to recognize the significance of indigenous IP rights by establishing a separate dedicated committee to, inter alia, consider and advise the organization of their value and impact of traditional IP rights.

INTA is highly supportive of the recognition of traditional knowledge and cultural expressions of indigenous communities, but we believe that any protection should not minimize vested trademark rights and should provide a degree of certainty for indigenous communities and trademark owners alike. Creation of a system safeguarding against the misappropriation and exploitation of traditional knowledge and cultural expressions of indigenous communities must be balanced holistically with existing IP rights.

Specific Comments

Scope of Protection: According to article 4 of the Protection of Traditional Knowledge and Cultural Expressions (Registration) Regulations, these Regulations apply to owners and holders of traditional knowledge and cultural expressions associated with communities in Kenya. However, the term ‘community’ is not clarified. The only reference is in the Protection of Traditional Knowledge and Cultural Expressions Act, 2016 (hereinafter as the “Act”). The Act defines ‘community’ very broadly as a group with any of the following attributes: shared ancestry, language, culture, community of interest, ecological or geographical space.

Such a broad definition leads to the potential abuse of traditional rights and difficulties in determining a legitimate holder or owner of a specific traditional knowledge or cultural expression, hindering further decision making about consent and benefit sharing.

Compulsory Licensing: Based on Section 12(1) of the Act and Section 20 of the Protection of Traditional Knowledge and Cultural Expressions (Licensing and Access of Traditional Knowledge and Cultural Expressions) Regulations, the Cabinet Secretary may grant a compulsory license for exploitation of traditional knowledge or cultural expressions: -

- a) that is not being sufficiently exploited; or
- b) where the exploitation is necessary to achieve public good;
- c) to facilitate response to an emergency;
- d) where the owners or holders of the traditional knowledge or cultural expressions refuse to grant an applicant consent to exploit the traditional knowledge or cultural expressions, without justifiable cause.

Such provisions may pose a danger of unreasonable violation of traditional rights. The criteria are highly subjective and thus cannot effectively regulate a potential conflict between the interests of a community and the country. The ‘compulsory licensing’ provisions give the government unlimited rights to bypass the community.

Further, in case of community failure to defend their rights, according to Section 20 (5) (e) of the said Regulations, the Cabinet Secretary shall make a determination “to grant the compulsory license, upon establishment of fair and reasonable compensation to the providers of the traditional knowledge or cultural expression”. However, it is complicated to determine fair and reasonable compensation for traditional knowledge and cultural expressions as intangible cultural heritage passed down from generation to generation usually does not have readily ascertainable market value. We should recognize the seriousness of the interference into traditional rights and that compensation should be calculated using clearly stated principles.

Concurrent Claims: Pursuant to Section 7(6) of the Act, where concurrent claims arise from different communities, the Kenya Copyright Board or County Government shall, while determining the claim, consider customary law and protocol of the communities in question, local information sources and any other means that may be applicable.

According to Section 14 of the Protection of Traditional Knowledge and Cultural Expressions (Registration) Regulations, 2022, concurrent claims arising from different communities residing

in different counties are determined by the Kenya Copyright Board, whereas concurrent claims from different communities residing within a county are determined by the County Executive Committee Member and the council of elders.

In making a determination on concurrent claims they may constitute a panel of persons knowledgeable on matters related to customary law or traditional knowledge and cultural expressions to facilitate in making the determination. In other words, involving specialists is not an obligation. However, a lot of claims require specific knowledge of the parties' history or specificity of their traditional knowledge and cultural expressions which will most likely require the input of a knowledgeable specialist.

Second, the fact that traditional knowledge and cultural expressions are now potentially wealth generators provides an incentive for communities to seek exclusive control, and some disputes over ownership may be difficult to settle using only customary law.

Enforcement and Cross-Border Cooperation: Traditional knowledge and cultural expressions are often a source of revenues for communities and hence vulnerable to counterfeiting and illicit trade that requires an effective enforcement policy. It is very challenging to protect indigenous IP rights of transboundary communities. Securing a framework for cross-border cooperation on the legislative level could be a solution. However, neither the Act nor the Regulations make sufficient provision for cross-border cooperation mechanisms to assist in enforcement of rights in transboundary traditional knowledge and cultural expressions.

INTA looks forward to supporting the Government of Kenya in this process and is ready to assist in the improvement of the situation of indigenous communities through development of capacity-building initiatives and awareness raising.

We welcome the opportunity to provide further comments to support this important topic as it develops. We remain at your disposal for any clarifications or further requests for information. You can reach our INTA Africa Consultant, Hazel Okoth on hokoth.consultant@inta.org.