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ARBITRABILITY OF INTELLECTUAL PROPERTY DISPUTES IN KENYA

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DECLARATION

This thesis is my original work and has not been presented for a degree at the University of Nairobi or any other university or examination body.

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DEDICATION

This dissertation is dedicated to my family and friends for their inspiration, support, prayers and commitment to my education. Special thanks go to my parents for the sacrifices they made to give me the privilege of coming this far.

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ABBREVIATION AND ACRONYMS

AAA: American Arbitration Association

ADR: Alternative Dispute Resolution

AG: Attorney General

AU: African Union

CPR: International Institute for Conflict Prevention and Resolution

FDI: Foreign Direct Investments

GATT: General Agreement on Trade and Tariffs

GI: Geographical Indication

ID: Industrial Design

ICDR: International Centre for Dispute Resolution

IP: Intellectual Property

IPR: Intellectual Property Rights

IPT: Industrial Property Tribunal

JAMS: Judicial Arbitration and Mediation Services

KIPI: Kenya Industrial Property Institute

PBR: Plant Breeder's Rights

TM: Trade Marks

TRIPs: Trade-Related Aspects of Intellectual Property Rights

TS: Trade Secrets

UC: Unfair Competition

UM: Utility Model

UN: United Nations

USA: United States of America

WIPO: World Intellectual Property Organisation

DEFINITION OF TERMS

Ad hoc:	Created or done for a particular/special purpose.
Deposition:	The testimony of a witness taken upon interrogatories, in pursuance of a tribunal reduced in writing and duly authenticated and intended to be used during the hearing.
Discovery:	The disclosure by a party in a proceeding of facts and/or documents which are his exclusive knowledge or in his possession and which are necessary to the party seeking the discovery as part of a cause of action or as evidence of his rights or title in such a proceeding.
Doctrine of Separability:	Allows for an arbitration agreement to be considered entirely separate from the underlying contract.
Erga omnes:	Rights or obligations owned towards all/towards everyone.
Inter partes:	Between Parties.
Neutrals:	An arbitrator who takes no sides in the proceeding and who has no interest in the dispute or proceeding
Prima Facie:	At first sight/ so far as can be judged from the first disclosure.

Pro-arbitration stance:	Action taken before a dispute is set for arbitration determining what makes a policy or practice arbitration friendly.
Res Judicata:	A matter already settled by judgement.
Sui Generis:	Of its own kind or class.

ABSTRACT

Intellectual Property Rights are perceived to have the same status as other personal rights and as such are arbitrable in nature unless statute provides the contrary. The use of arbitration to resolve IP disputes has a number of advantages such as confidentiality and flexibility. These advantages complement the characteristic of IP disputes.

The current legislative frameworks regulating IP disputes is well advanced at the international, regional and national level and have significant influence on whether disputes are resolved in an efficient and effective manner. The main challenges facing these mechanisms are political interference, lack of resources and public ignorance. The challenges faced by these mechanisms have negative ripple effects on right holders whose IPR have been infringed upon as the mechanisms lack the capacity to determine matters in a just, expeditious, proportionate and affordable way.

To create legislative and institutional mechanism that resolve IP disputes in an efficient and effective way, Kenya should enact legislative frameworks governing the resolution of IP disputes based on policy; reform the current laws to provide for the use of ADR as the first step to resolving IP disputes in Kenya; establish one IP organization within the country which will deal with IPRs other than having multiple institutions; and establish many arbitral administrative bodies that emulate those in the USA.

CHAPTER ONE

INTRODUCTION

1.1 Introduction

This chapter gives a background on intellectual property and intellectual property disputes. It also includes the statement of the problem, the research objectives, research questions, theoretical framework, research methodology, literature review, and the hypotheses.

1.2 Background of the Study

One of the values of many companies doing business in Kenya is found in their intellectual property (IP) as most successful companies rely on IP for much of their asset value, from telecommunication companies such as Safaricom Ltd to pharmaceutical and health care companies such as GlaxoSmithKline Kenya. The value and importance of IP to these companies is undisputable and as the commercial value of IP has grown, so has the need to protect IP Rights (IPR) and establish effective ways of resolving IP disputes.[1]

Property is that which belongs to one as a bundle of rights which are unrestricted and exclusive and are guaranteed and protected by the government. It is an exclusive right because the owner (right bearer) has the right to dispose of a thing, to use it and to

[1] Thomas D Halket, David L Evans and Theodore J Folkman, *Arbitration of Intellectual Property Disputes in the United States* (JurisNet, LLC 2019) 6.

exclude everyone else from interfering with it.[2] One may lawfully exercise this right over particular things without any control or diminution unless the laws of the state provide contrary.

The Constitution of Kenya, 2010 defines property as any vested or contingent right to, or interest in or arising from land, goods or intellectual property among others.[3] Sihanya defines IP as a term used to refer to the recognition, protection, and promotion of the work or product of the mind.[4] IP is divided into copyright and related rights; and industrial property (which includes patents, trade secrets (TS), trade marks (TM), utility models (UM), unfair competition (UC), geographical indication (GI), plant breeder's rights (PBR) and industrial designs (ID)).[5] In order to understand how IP is protected and promoted as well as how IP disputes are resolved in Kenya, it is important to first look at the development of IP.

The 1883 Paris Convention of the International Union for the Protection of Industrial Property marks the beginning of the IPR regime. It was the first major step taken to help creators ensure that their intellectual works were protected in other countries.[6] Its

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[2] Henry Campbell Black, *Black's Law Dictionary* (4th edn, St. Paul Minn. West Publishing Co. 1968) 1382.

[3] The Constitution of Kenya, 2010 Article 260.

[4] Ben Sihanya, *Intellectual Property and Innovation Law in Kenya and Africa: Transferring Technology for Sustainable Development* (Sihanya Mentoring & Innovative Lawyering, Nairobi & Siaya 2016) 1.

[5] Donald S Chisum, *Understanding Intellectual Property Law* (3rd edn, Carolina Academic Press, LLC 2015) 1–2.

[6] WIPO, 'Summary of the Paris Convention for the Protection of Industrial Property (1883)<www.wipo.int/treaties/en/ip/paris/summary_paris.html> accessed 19 June 2019.

initial objective was to create a union that would create general principles securing the interests of industrial property within a country as well as abroad, without encroaching on the domestic law of the contracting countries.[7] In 1886, the Berne Convention on the Protection of Literary and Artistic Works came to force as the Paris Convention did not provide for copyrights.

In 1893, the United International Bureaux for the Protection of Intellectual Property was established to administer the Paris Convention of the International Union for the Protection of Industrial Property (1883) and the Berne Convention on the Protection of Literary and Artistic Works (1886). The United International Bureaux for the Protection of Intellectual Property was subsequently replaced by the 1967 Convention establishing the World Intellectual Property Organisation (WIPO).[8] WIPO was created to encourage creative activity and to promote the protection of IP throughout the world.[9]

In the 1970s and 1980s, developing countries sought to have the above IP regime relaxed to enable them access technology at a fair rate while on the other hand international corporations felt that the existing regime was not stringent enough to protect their interests. The General Agreement on Trade and Tariffs (GATT) in 1947 and subsequently the Trade-Related Aspects of Intellectual Property Rights (TRIPs) by the World Trade Organisation (WTO) member states in 1994. The TRIPs

[7] WIPO, Paris Convention for the Protection of Industrial Property (as amended on September 28, 1979) 2019.

[8] Moni Wekesa and Ben Sihanya, *Intellectual Property Rights in Kenya* (Konrad Adenauer Stiftung 2009) 6.

[9] WIPO, 'IP-relevant Bilateral Treaties: Agreement between the United Nations and the World Intellectual Property Organization' 2019 Article 3.

agreement is to date the most comprehensive multilateral agreement on IP and forms the basis of modern IPR in all countries, including Kenya.[10] All WTO member states are signatories to TRIPs which encourages them to implement in their laws the minimum standards for protecting and enforcing IPR.[11] States domesticate provisions of TRIPs due to the importance of trade as a mode of creating wealth.

Kenya is a WTO member state and has ratified various international treaties on IP among them the TRIPs agreement. Article 2(6) of the Constitution of Kenya, 2010 states that any treaty or convention ratified by Kenya shall form part of the laws of Kenya. As such, the TRIPs agreement forms part of Kenyan Law. In the same spirit of the protection and promotion of IPR, article 40 of the Constitution of the Kenya, 2010 mandates the state to protect property with article 40 (5) being specific to the protection of IP. In so doing, Parliament has enacted pieces of legislation that deal with the different forms of IP. Among the pieces of legislation enacted are: The Industrial Property Act, 2001; The Copyrights Act, 2001; The Trademark Act, (Cap.506 of the Laws of Kenya); The Seeds and Plant Varieties Act, Cap. 326 of the Laws of Kenya, 1991; and The Anti-counterfeiting Act No. 13 of 2008.

Despite there being laws that protect IPR, infringement does occur. Infringement of IPR is the violation of a protected IPR, it includes the violation of rights protected by a patent, copyright or trademark among the other forms of IP.[12] The value of many companies in Kenya as earlier stated is increasingly being found in their IP and in

[10] Wekesa and Sihanya (n 8) 5.

[11]World Trade Organisation, Agreement on Trade-Related Aspects of Intellectual Property Rights 1994.

[12] Sihanya (n 4) 226.

addition to this, the growth of incubation hubs in Kenya over recent years has been on a rise. In spite of this increase, the protection of these inventors has been a challenge as the enforcement of the laws protecting IPR in Kenya is weak thus exposing the inventors to exploitation and outright theft of their ideas.[13] IPR enable the right holder to litigate people who have infringed on their rights and seek remedies or any other legal recourse when a dispute involving IPR occurs.[14]

Courts are the main avenues for resolving disputes in Kenya and the overriding objective of the courts is to facilitate just, expeditious, proportionate and affordable resolution of disputes. Courts have however been criticised on their performance in delivering justice. Complaints raised have been about their inability to deliver justice in a manner that is not only fair but is seen to be fair; delay involved in processing and conclusion of cases; and inaccessibility of justice due to the expenses involved in litigation of matters.[15] Kenya was ranked 41 out of the 47 countries in the 2019 study by the U.S Chamber International IP Index with this performance being attributed to the weak judicial system that has case backlogs. The study stated that the judicial system is slow in determining cases before it and inventors rely on the four specialised IP tribunals which are faster than regular courts.[16]

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[13] The U.S. Chamber of Commerce's Global Innovation Policy Centre, 'Inspiring Tomorrow IP Rights and Economic Activities' (February 2019) 21. https://www.theglobalipcenter.com/wp-content/uploads/2019/02/023593_GIPC_IP_Index_2019_Full_03.pdf accessed 10 June 2019.

[14] The Constitution of Kenya, 2010 article 45 and 46

[15] Steve Ouma, *A Commentary on the Civil Procedure Act Cap 21* (2nd edn, LawAfrica Publishing (K) Ltd 2015) 30.

[16] The U.S. Chamber of Commerce's Global Innovation Policy Centre, (n13) 21.

In exercising their judicial authority, courts and tribunals in Kenya are guided by the principles of dispute resolution among them arbitration.[17] As such, arbitration constitutes an alternative to court litigation and specialised tribunals for the resolution of IP disputes. Arbitration is a mechanism for settlement of disputes which usually takes place in private, pursuant to an agreement between two or more parties in which the parties agree to be bound by the decision to be given by the arbitrator according to law, or if so agreed, other considerations after a full hearing, such decision being enforceable in law.[18] As a mode of resolving IP disputes, arbitration has various advantages among them being that the parties to the dispute are ensured of confidentiality of the proceedings, the expertise of the arbitrator as well as time and cost-effectiveness. In addition to this, parties in dispute who opt for the arbitration to be in a different country or who are from different countries will find it easier to enforce foreign arbitral awards as compared to court judgments.[19]

Traditionally, the arbitrability of IP disputes was questionable because IPR such as patents are granted by national authorities. It was argued that disputes arising from such rights should be resolved by a public body within the national system. It is now acceptable that like other disputes relating to other private rights, IP disputes are also

[17] The Constitution of Kenya, 2010 Article 159 (c)

[18] Kariuki Muigua, *Settling Disputes Through Arbitration in Kenya* (edn, Glenwood Publishers Limited 2012) 1.

[19] Dário Moura Vicente, 'Arbitrability of Intellectual Property Disputes: A Comparative Survey' (2015) 31 Arbitration International 163, 152.

arbitrable.[20] This is evident under the TRIPs agreement, 1994 which provides that states which are party to the agreement recognize that IPR are private rights.

1.3 Statement of the Problem

IP involves the recognition, protection, and promotion of the work or product of the mind with inventors enjoying their rights with no interference. In recent years, the rise in the importance of intangible assets in Kenya has led to an increase of IP disputes both in value and numbers. Once disputes arise, the aggrieved parties approach the legal and institutional mechanisms established (for example courts and specialised tribunals) for the resolution of the disputes. These legal and institutional mechanisms are then expected to facilitate just, expeditious, proportionate and affordable resolution of the disputes.

The current legal and institutional mechanism governing IP disputes in Kenya are inadequate as they have been found to lack the capacity to determine matters in a just, expeditious, proportionate and affordable way. Fortunately, the Constitution of Kenya offers alternative dispute resolution (ADR) mechanisms to the traditional judicial and tribunal processes. Among these ADR mechanisms is arbitration that comes with various advantages such as confidentiality of the proceedings, the expertise of the arbitrator as well as time and cost-effectiveness. Although traditionally the arbitrability of IPR disputes was questionable, it is now acceptable that like other disputes relating to private rights, disputes involving IPR are also arbitrable.

[20] WIPO, 'Why Arbitration in Intellectual Property?' <https://www.wipo.int/amc/en/arbitration/why-is-arb.html> accessed 24 May 2019.

To this end, this paper focuses on the arbitrability of IP disputes when the arbitration is conducted procedurally under Kenyan arbitral law. It will analyse the existing legal and institutional frameworks governing IP disputes in Kenya with a specific focus on their arbitrability.

1.4 Justification of the Study

Arbitration is an expeditious dispute resolution mechanism that should be extended to the resolution of IP disputes. This study shall contribute to the knowledge of IP in Kenya by analysing the arbitrability of IP disputes and recommending appropriate and effective measures of promoting the arbitrability of the said disputes. The study shall further inform the public and in turn be useful to institutions that resolve IP disputes and to future IP researchers.

1.5 Statement of the Objective

The overall objective of this study is to analyse the arbitrability of IP disputes in Kenya by evaluating the current legal and institutional frameworks governing IP disputes.

1.5.1 Specific Objective

1. To analyse the arbitrability of intellectual property disputes
2. To determine the best practices that allow for the use of arbitration in intellectual property disputes.
3. To recommend appropriate and effective measures of promoting the arbitrability of intellectual property disputes in Kenya.

1.6 Research Questions

In order to meet the objectives stated above, this research seeks to answer the following research questions:

1. What is the arbitrability of intellectual property disputes?
2. What are the best practices that allow for the use of arbitration in intellectual property disputes?
3. What appropriate and effective measures should be taken to promote the arbitrability of intellectual property disputes in Kenya?

1.7 Hypotheses

The following hypotheses will be tested in this study:

1. The existing legal mechanisms in Kenya do efficiently and effectively resolve IP disputes.
2. Arbitration is the most suitable mechanism for resolving IP disputes.

1.8 Theoretical Framework

This study favours the labour theory and the utilitarian theory approaches to IP and the resolution of IP disputes.

The labour law theory developed from the natural law theory which recognizes IP from the principle that, one owns that which one creates, by one's own (intellectual) effort and labour.[21] John Locke's labour theory emulates the natural law theory by

[21] M Du Bois, 'Justificatory Theories for Intellectual Property Viewed through the Constitutional Prism' [2018] University of South Africa 7.

providing that every person has a property in his own person, and where a person mixes his own labour with something which had previously been in the commons, the thing becomes his property.[22] It further postulates that the products of a person's own intelligence, effort, and perseverance should belong to that person and to no one else as the object would not exist but for that person creating it.

IP is centred on art of creating and information resources are taken from the intellectual commons to create intellectual products unlike the use up of the physical property. Labour therefore still serves as the *prima facie* justification for property rights including IP.[23] As stated above, a person who labours upon resources that are either unowned or held in common has natural property rights to the fruits of his labour. The state then has a duty to respect and enforce that natural right. The correct interpretation of this according to Robert Nozick is that the acquisition of property through labour is legitimate if only other persons do not suffer any net harm.[24] This brings about a sense of proportionality and fairness as the property of labour is then put into consideration when determining whether ownership should be assigned to the worker or the community (public).[25] The inventors should only get their just reward for their labour as long as there is enough left for the rest of the public.

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[22] Peter Drahos, *A Philosophy of Intellectual Property* (2016 2nd edn, The Australian National University eText 1995) 64.

[23] ibid 41.

[24] William Fisher and Stephen Munzer, 'Theories of Intellectual Property', *New Essays in the Legal and Political Theory of Property* (Cambridge University Press 2001) 16.

[25] ibid.

The utilitarian school of thought holds that IPR in one's creation is necessary as a means to further development and as an incentive to further technological development.[26] It envisages the maximization of wealth through the establishment of laws that maximize the overall welfare which is measured by the consumers' ability and willingness to pay for goods, services, and conditions (net social welfare).[27] In that the state creates laws that ensure the happiness of the majority. The state should, therefore, create a balance between the IPR holder and the public so as to protect IPR for a limited time. According to William Landes and Richard Posner, most intellectual products are easily replicated and the enjoyment of them by one person does not prevent enjoyment of them by other persons.[28] This means that the creator of the IP will be unable to recover their costs of expression as they will be undercut by imitators who bear the low cost of re-production offering the same products at very low prices. To avoid this economic inefficiency, the inventors are allocated exclusive rights which are to be protected by the state.

The two schools of thoughts form the western philosophy of property ownership and emphasize individual ownership over the property. The individuals who have put in labour in the production of IP are entitled to and accorded exclusive rights to it such as a patent or copyright among the others.

[26] Wekesa and Sihanya (n 8) 3.

[27] Mikhalien Du Bois and M Du Bois, 'Justificatory Theories for Intellectual Property Viewed through the Constitutional Prism' (2018) 21 University of South Africa 1.

[28] Fisher and Munzer, (n24).

1.9 Research Methodology

The study undertakes a qualitative approach in the collection of data, specifically a desktop literature study as there exists an abundance of literature on the resolution of IP disputes. The study also utilises both primary and secondary sources of information. The primary sources are useful to the research as they stated the current laws that inform governance of IPR in Kenya and form the substratum of the study's critique. Secondary sources used included the internet, online libraries, scholarly journal articles, research papers, and textbooks. The secondary sources are useful as they gave insights as to the efficiency, challenges, and opportunities in the arbitration of IP disputes in Kenya. The study also uses case studies that have the required information with respect to the objectives of the research and enabled an in-depth study of the subject area.

1.10 Literature Review

This literature review seeks to clarify the different approaches to resolving IP disputes as much of the literature available on IP disputes document an increase of the disputes without proposing the effective means of resolving them. The lack of focus on the resolution of IP disputes may be attributed to the belief that the mechanisms offered by the national and international regime for managing IP disputes are sufficient. The literature reviewed is thematically clustered into IP disputes and traditional methods of resolving these disputes; and arguments for and against the arbitration of IP disputes.

Two main avenues exist for the resolution of IP disputes, litigation through the judicial court system and specialised IP tribunals. A specialised IP tribunal is an independent

judicial body that can operate at the regional or national level to adjudicate IP disputes.[29] The specialised IP tribunals have expertise on IP and compared to normal courts are better equipped to keep up with the ever-developing IP law. However, these courts have a range of disadvantages such as the costs of establishing and operating them and the fact that they hinder access to justice because they are not easily accessible. In addition to this, the specialised tribunals have a tunnel vision and may neglect the broader legal and policy frameworks with centralization inhibiting the exchange of legal ideas which may, in turn, lead to the perpetuation of errors.[30] Litigation has a range of disadvantages among them the inability of the courts to determine matters in a just, expeditious, proportionate and affordable manner.

Justice Ombija, in a case study of Kenya's Specialised Intellectual Property Court Regime, notes that IPR are important and if not adequately enforced diminish in value.[31] He further states that there has been an increase in foreign direct investment (FDI) in IP industries in Kenya which he attributed to the certainty in the enforcement of IPR. Though tribunals have been more effective than litigation, they too face challenges that hinder transparency while resolving IP disputes. According to Justice Ombija, these challenges include political interference especially in the appointment of the members of the tribunal; lack of facilitation due to underfunding; weak laws that do not grant autonomy to the tribunal; and lack of vigilance attributed to minimal public awareness. An alternative dispute resolution mechanism is, therefore, necessary

[29] Jacques de Werra, 'Specialised Intellectual Property Courts- Issues Adn Challenges' [2016] CEIPI-ICTSD 1.

[30] ibid.

[31] Justice NR Ombija, 'Case Study of Kenya's Specialized Intellectual Property Rights Court Regime: International Intellectual Property Institute' (2011).

to enhance the enforceability of IPR in Kenya and as earlier stated, in exercising their judicial authority, courts and tribunals in Kenya are guided by the principles of dispute resolution among them arbitration.[32]

The arbitration agreement gives jurisdiction to the arbitral tribunal with scholars such as Kariuki Muigua emphasizing on the importance of a properly drafted arbitration clause in an agreement.[33] An arbitration agreement is often in the form of an arbitration clause in a contract and should be carefully and properly drafted as a majority of arbitration clauses refer to arbitration *all matters arising out of or in connection with the contract in question or any breach of it*.[34] If the contract from which the IP dispute arises provides for an arbitration clause, then the parties in dispute should ordinarily be referred to arbitration. This has, however, not been the practice as traditionally, contract disputes arising from rights *in rem* (entitlement to an IPR such as copyright or trademark) were considered non-arbitrable.

A new school of thought has developed with countries like India while carrying out a pro-arbitration stance (determining what makes a policy or practice arbitration-friendly), ensure that purely contractual disputes that would traditionally be rendered non-arbitrable are subjected to arbitration (rights test).[35] The arbitration clause, therefore, plays an important role as such a clause may be over-inclusive or under-

[32] The Constitution of Kenya, 2010 Article 159 (c).

[33] Muigua (n18).

[34] Halket, Evans and Folkman (n 1) 48.

[35] Rahul Donde, Lévy Kaufmann-Kohler and Sharad Bansal, 'Arbitrability of Intellectual Property Disputes : Setting the Scene ?' (2016)< https://lk-k.com/wp-content/uploads/2016/03/Rahul-Donde-Sharad-Bansal-Arbitrability-of-intellectual-property-disputes-Setting-the-scene.pdf. Accessed 20 June 2019.

inclusive for IP disputes.[36] It may be over-inclusive where there is an indemnification provision where a right holder indemnifies the other party of any claim against a third party.[37] This may lead to third-party proceedings as the third party would not be a party to the arbitration. It may be under inclusive in an instance where the agreement allows for the licensee of an IP to use the IP within the grant of the license.[38] Depending on the law applicable, the use of the IP by the licensee outside the scope of the grant of the license may or may not be a breach of the license. In this case, a dispute arising as to the use of the said license may not be within the matters submitted to arbitration under the arbitration clause.[39]

Arbitration has become popular as a dispute settlement mechanism in IP disputes. As Dário Vicente notes, arbitration was mainly used for IP disputes for contracts of licencing or transmission of IPR.[40] Recent developments have seen IPR being considered as valid subject matters for arbitration with various legal systems ensuring that arbitration is a mandatory mechanism for resolving IP disputes as it ensures expeditious disposition of the disputes, unlike litigation. For example, the Portuguese Law no 62/2011 provides for the regulating through mandatory arbitration the pharmaceutical patent disputes between patentees and generic medicine companies.

[36] Halket, Evans and Folkman (n 1) 49.

[37] Vicente (n 19) 153.

[38] ibid.

[39] Donde, Kaufmann-Kohler and Bansal (n35)1.

[40] Vicente (n 19) 163.

Some IP disputes are non-litigable because courts are reluctant to hear them and the same disputes may be efficiently resolved through arbitration. Thomas Halket notes that various forms of IPR exist in almost all countries but tend to vary from country to country.[41] The best example of IPR that are generally non-litigable are domain rights that exist under a regime that is largely part private as opposed to governmental in nature.[42] Some IPR such as patents and trademarks are created by national laws and will vary in different countries, unlike copyright which is uniform in most countries due to the Berne Convention which is a copyright treaty law applicable to majority of countries. A dispute may arise regarding an IPR that does not exist as a right in a country (or a foreign IPR) and the courts maybe unwilling or even unable to resolve the dispute. This makes a case for the arbitrability of such IP disputes as an arbitral tribunal may have jurisdiction to resolve such disputes.

Despite there being numerous arguments for the arbitrability of IP disputes, one cannot overlook the arguments that proffer for the non-arbitrability of IP disputes. Cook and Garcia argue that an arbitration agreement may be deemed invalid due to public interest and for this reason, some parties opt not to use arbitration as an alternative to litigation to solve IP disputes.[43] In addition to this, jurisdictions have different opinions on the arbitrability of IP disputes. For example, South Africa explicitly prohibits the arbitration of patent disputes under Article 18(1) of the *Patent Act N0. 57 of 1978* of South Africa.

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[41] Halket, Evans and Folkman (n 1) 26.

[42] ibid.

[43] Trevor Cook and Alejandro I Garcia., *International Intellectual Property Arbitration.* (Kluwer Law International 2010) 23.

Majority of IPR like patents and registered trademarks require government action for them to come into existence. Grantham supports this school of thought as he notes that arbitral awards have an *inter parties'* effect and therefore, cannot affect the validity of a registered IPR with *erga omnes* effects.[44] The state may include criminal sanctions and other punitive actions when legal issues arise that affect the public interest. On the other hand, the power of arbitral tribunals is limited to the specific remedies that it can award and it has no powers to use punitive measures. If a tribunal, therefore, addresses an IP dispute to which a punitive action has been provided for by law, it exceeds its rightful authority. In the US for example, trademark counterfeiting is a criminal offence, therefore, such a dispute can only be determined by the courts and is non-arbitrable.

Another argument against the non-arbitrability of IP disputes is that IPR are granted to the right holder through registration by the State and only the state and not an individual can reverse the rights granted.[45] As stated at the beginning of this paper, IPR are exclusive rights given by the state to individuals within their territory and possess a public nature as the state extracts from the public domain the subject matter (rights) and places it under the control of individuals (right bearers). If the arbitral tribunal is mandated to establish the validity of an IPR, it cannot affect its registration

[44] William Grantham, 'The Arbitrability of International Intellectual Property Disputes' (1996) 14 Berkeley Journal of International Law 173.

[45] M Suzuki, *Patent Infringement and Patent Invalidation. Introduction to Japanese IP Law.* (Nagoya University 2018) 66.

in the national registration system but rather uses that information to decide on the rights that should be protected. [46]

Anh notes that the validity of various IPR has also contributed to the non-arbitrability of IP disputes as an arbitral tribunal can only invalidate or uphold registered IPR through the powers granted by the applicable law. The problem arises where the applicable law to be used for arbitration does not regard an IPR as arbitrable. For instance, Brazil regards patent validity as non-arbitrable while in contrast, the USA have embraced the arbitrability of all disputes pertaining to patents in their legislation.[47] It is, however, important to note that the subject matter before an arbitral tribunal is often not to establish the validity of an IPR but rather the infringement of the said right by a third party.

The literature reviewed above is important to this study as it analyses the pros and cons of using arbitration to resolve IP disputes. However, the authors have focused on the use of arbitration of IP disputes in different jurisdictions other than Kenya such as the USA, India, Brazil and South Africa. This study is specific to the arbitrability of IP disputes in Kenya and seeks to identify the inadequacies of the existing legal and institutional frameworks.

[46] Cook and Garcia. (n 43) 68.

[47] Phan Ngan Anh, 'Arbitrability of Intellectual Property Related Disputes: Necessity and Arguments' (2019) 10.

1.11 Chapter Breakdown

I. Chapter One- Introduction

This chapter gives a background of IP in Kenya. It includes the statement of the problem, the research objectives, research questions, theoretical framework, research methodology, literature review, and the hypotheses.

II. Chapter Two- Arbitration in resolving intellectual property disputes

This chapter is a conceptual study of arbitration and discusses the essence of arbitration in resolving IP disputes. It focusses on the practices and concepts of the process of arbitration that results in the resolution of disputes.

III. Chapter Three- The legislative framework regulating intellectual property disputes in Kenya

This chapter briefly discusses IP disputes in Kenya. It gives an analysis of the international IP regime governing IP disputes; the regional IP regime in Africa governing IP disputes; and the national legislative framework governing IP disputes in Kenya such as the policy framework; the legislation; the institutional and enforcement mechanisms; the judiciary; and specialised courts that have been established to resolve IP disputes in Kenya.

IV. Chapter Four – Arbitrability of IP Disputes in The United States of America and Basic Approaches adopted by Various National Legal Systems on the Arbitrability of IP Disputes

Chapter four constitutes a comparative study of the arbitrability of IP disputes in the United States and basic approaches adopted by various national legal systems on the

arbitrability of IP disputes with a view of identifying the best practices that Kenya may emulate.

V. Chapter Five – Summary of findings Conclusion and recommendations.

This chapter will comprise of a summary of findings, the conclusion based on the findings and recommendations on appropriate and effective measures of promoting the arbitrability of IP disputes in Kenya.

CHAPTER TWO

ARBITRATION IN RESOLVING INTELLECTUAL PROPERTY DISPUTES

2.1 Introduction

This chapter is a conceptual study of arbitration and discusses the essence of arbitration in resolving IP disputes. It focusses on the practices and concepts of the process of arbitration that results in the resolution of disputes.

2.2 Arbitrability of Intellectual Property Disputes

The arbitrability of IP disputes is the question of whether or not the subject matter of an IP dispute may be resolved through arbitration. As briefly discussed in Chapter One, traditionally the arbitrability of IP disputes arose in regards to the arbitration of specific IP disputes. This is because certain IPR are granted by the national authorities and as such disputes arising from these rights should automatically be resolved by a public body within the national system.

Majority of IP disputes arise from a contract and if the contract from which the IP dispute arises provides for an arbitration clause, then the parties in dispute should ordinarily be referred to arbitration.[48] This has, however, not been the practice as contract disputes arising from rights in rem (entitlement to an IP right such as copyright or trademark) were considered non-arbitrable.

[48] WIPO (n 20).

It is now acceptable that disputes relating to IP rights just like other disputes relating to privately owned rights are arbitrable. Any right that a party can dispose by way of settlement should be capable of being the subject of an arbitration as arbitration is largely based on party agreement. [49]

2.3 The Use of Arbitration in Resolving Intellectual Property Disputes

The UN Charter sets out the ADR mechanisms that parties in a dispute may resort to one of which is arbitration among others such as negotiation, mediation, conciliation and judicial settlement.[50] In Kenya, The Arbitration Act, 1995 gives a narrow definition of an arbitration as any arbitration whether or not administered by a permanent arbitral institution.[51] Kariuki Muigua best defines arbitration as a process subject to statutory controls where formal disputes are determined by a private tribunal -often referred to as an arbitral tribunal- chosen by the parties or by an appointing institution such as the Chartered Institute of Arbitrators in Kenya.[52]

2.3.1 The Arbitration Agreement

An Arbitration usually takes place pursuant to an agreement between two or more parties in which the parties agree to be bound by the decision to be given by the arbitrator according to law.[53] Therefore, for arbitration to evolve, there must exist an

[49] WIPO (n 20).

[50] United Nations, 'The Charter of the United Nations and the Statute of the International Court of Justice' article 33.

[51] The Arbitration Act, No 4 of 1995 s 2.

[52] Muigua (n 18) 1.

[53] ibid.

arbitration agreement between the parties who either execute a contract that has an arbitration clause or a stand-alone arbitration agreement.[54] A stand-alone arbitration agreement may be executed before the dispute arises or when parties in a dispute agree to submit an already existing dispute to arbitration where no agreement to arbitrate had previously been executed.

An arbitration agreement has been defined under section 2 of the Arbitration Act of Kenya, 1995 as an agreement by the parties to submit to arbitration ***all or certain*** disputes which have arisen or which may arise between them in respect of a defined legal relationship, whether contractual or not. It provides the legal basis for compelling an unwilling party to arbitrate. Halket avers that an arbitration agreement is important because it lays down the means of settling a possible dispute; it serves as a road map for the dispute resolution process; it gives the arbitrator powers; and sets the jurisdictional basis for resolution of the dispute and enforcement of the tribunal award.[55]

It is therefore important to carefully draft an arbitration agreement to meet the parties desires on how to resolve a dispute. Generally, these agreements are contracts just like any other contract and must meet the basic requirements provided by the law of contract . The arbitration agreement must consist of an offer and an acceptance; must have a consideration; the parties must have the capacity to enter into the contract; the subject matter must be legal; and the agreement must be in writing. The invalidity of

[54] ibid 20.

[55] Thomas D Halket, David L Evans and Theodore J Folkman, *Arbitration of Intellectual Property Disputes in The United States* (JurisNet, LLC 2018) 29 & 30 <http://www.arbitrationlaw.com>.

a contract does not invalidate the arbitration clause as provided for under section 17 (a) of the Arbitration Act. This brings about the ***doctrine of separability*** which requires the arbitration clause to be treated as an agreement independent of the other terms of contract. Justice Kimaru in the case of ***Kenya Airport Parking Services Ltd & Another V Municipal Council of Mombasa [2009] eKLR*** noted that:

> *"…the principle of separability of an arbitration agreement has thus been given judicial stamp of approval and is applicable even where one of the parties is challenging the validity or legality of the agreement itself…"*

If an arbitration agreement is not properly drafted it poses problems to the arbitral proceeding. The following problems may arise from the drafting of an arbitration clause:

i. Multi-Step Procedure

One of the problems that may arise in the drafting of an arbitration clause for an IP transaction relates to the procedures that may be adopted before the arbitration begins such as negotiations or mediation. ADR offers multi-step resolutions and parties to a dispute may opt to first negotiate and where negotiations fail, mediate and if mediation fails, arbitrate. A clause providing for a multi-step procedure may provide for negotiation or mediation or both negotiation and mediation before arbitration as illustrated by **Table 2.1and 2.2 below**:[56]

[56] ibid 37.

Table 2.1 An arbitration clause providing for mandatory negotiation as a first step

The parties shall endeavour to resolve amicably by negotiation all disputes arising out of or in connection with this agreement, including any question regarding its existence, validity or termination. Any such dispute which remains unresolved within thirty (30) days after either party requests in writing negotiation under this clause or within such other period as the parties may agree in writing, shall be finally settled under the… arbitration rules by …arbitrator(s) appointed in accordance with the said Rules. The place of arbitration shall be (city, country). The language of arbitration shall be ...

[*]***Source Thomas D Halket, David L Evans and Theodore J Folkman, Arbitration of Intellectual Property Disputes in The United States (JurisNet, LLC 2018) 37***

Table 2.2 A conflict management clause providing for both negotiation and mediation before arbitration.

All disputes arising out of or in connection with this agreement shall be resolved in accordance with the procedures specified below, which shall be the sole and exclusive procedures for the resolution of any such dispute. **a) Negotiation** The parties shall endeavour to resolve any dispute by negotiation between executives who have authority to settle the dispute and who are at a higher level of management than the persons with direct responsibility for administration or performance of this agreement.

b) Mediation

Any dispute not resolved by negotiation in accordance with paragraph (a) within (30) days after either party requested in writing negotiation under paragraph (a) or within such other period as the parties may agree in writing, shall be settled by mediation under the mediation rules.

c) Arbitration

Any dispute not resolved by mediation in accordance with paragraph (b) within [45] days after appointment of the mediator or within such other period as the parties may agree in writing, shall be finally settled under the arbitration rules. by ….

[*] ***Source Thomas D Halket, David L Evans and Theodore J Folkman, Arbitration of Intellectual Property Disputes in The United States (JurisNet, LLC 2018) 37.***

ii. Scope of Dispute to be Referred to Arbitration

The general practise in arbitrations is that parties agree on the disputes to be referred to arbitration while drafting the arbitration clause. As discussed above, clauses of importance need to be drafted carefully. However, IP transactions may have consideration not present in a normal contract and which can affect the parties consideration of the specific matters they wish to refer to arbitration.[57] Most arbitration clauses provide for *all disputes arising from the contract to be referred to arbitration.*

[57] ibid 48.

The danger with such a provision is that it may be both over-inclusive and under-inclusive for an IP matter.

It may be over-inclusive where, for instance, there is an indemnification provision where a right holder indemnifies the other party of any claim against a third party. It may be under inclusive in an instance where the agreement allows for the licensee of an IP to use the IP within the grant of the license therefore a dispute arising as to the use of the said license may not be within the matters submitted to arbitration under the arbitration clause.[58]

iii. Place or Seat of the Arbitration and the Location of the Hearing

The seat of the arbitration is of importance because its arbitral procedural laws govern the procedural aspects of the arbitration. For example, if the choice of the seat of arbitration is Kenya, it means that Kenyan arbitral law will govern the arbitral proceedings. The location of the hearings is the place where the arbitral tribunal will physically sit during the hearing. The location of the hearing does not affect the procedural aspect of the arbitration if the arbitration clause provides for the seat of arbitration. However, the location of the arbitration has the advantage of home court proceedings and a party that may be concerned about the application of adverse local law at the location of the hearing is advised to consider specifying a hearing location that is neutral to all parties to the dispute while drafting the arbitration clause.[59]

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[58] ibid.

[59] ibid 55.

2.3.2 Arbitration as an Alternative to Litigation

According to the Black's Law Dictionary, litigation is a contest in a court of justice for the purpose of enforcing a right.[60] Bello states that one of the greatest shortcomings of litigation is the delay in the dispensation of justice.[61] The opportunity to choose how a dispute would be resolved is said to be the greatest advantage of arbitration over litigation.[62] This advantage is pegged on the practice of the parties driving the arbitration process by referring the dispute to arbitration and giving the arbitral tribunal powers.[63] On the other hand, litigation, though the main avenue for resolving disputes, has been deemed not effective or efficient mainly because it is a time-consuming procedure. As discussed in chapter one, courts have been criticised on their performance in delivering justice. Below are the main differences between litigation and arbitration:

[60] Henry Campbell Black, *Black's Law Dictionary* (4th, ST Paul, MINN West Publishing Co 1968) 1082.

[61] Adesina Temitayo Bello, 'Arbitration as an Alternative to Litigation Malady : The Frontiers of How Arbitrators Saves Time' (2014) 62 Nigerian Chapter of Arabian Journal of Business and Management Review 1, 1.

[62] Thomas Stipanowich, 'Arbitration and Choice: Taking Charge of the "New Litigation"' 7 DePaul Business & Commercial Law JournalL <https://papers.ssrn.com/sol3/papers.cfm?abstract_id=1372291> accessed 21 August 2019.

[63] Bello (n 61) 2.

Table 2.3Differences between Litigation and Arbitration

	Litigation	**Arbitration**
1.	Open to the public as proceedings are held in open court.	Confidential as proceedings are held privately.
2.	Parties cannot choose Judges/ Magistrates.	Parties directly choose the arbitral tribunal.
3.	Not flexible as rules are set beforehand.	Flexible as it is a private and consensual matter where parties and the tribunal agree or set the rules to be followed.
4.	A formal setting with rules that are compulsory set in place.	Minimum emphasis on formality thus encouraging expeditious disposal of matters.

[*]***Source: The Author***

IP disputes have characteristics that are better addressed by arbitration than by litigation. Some of the main characteristics of IP disputes and the results offered by both domestic litigation and arbitration as outlined by the WIPO are summarized below:[64]

[64] WIPO (n 20).

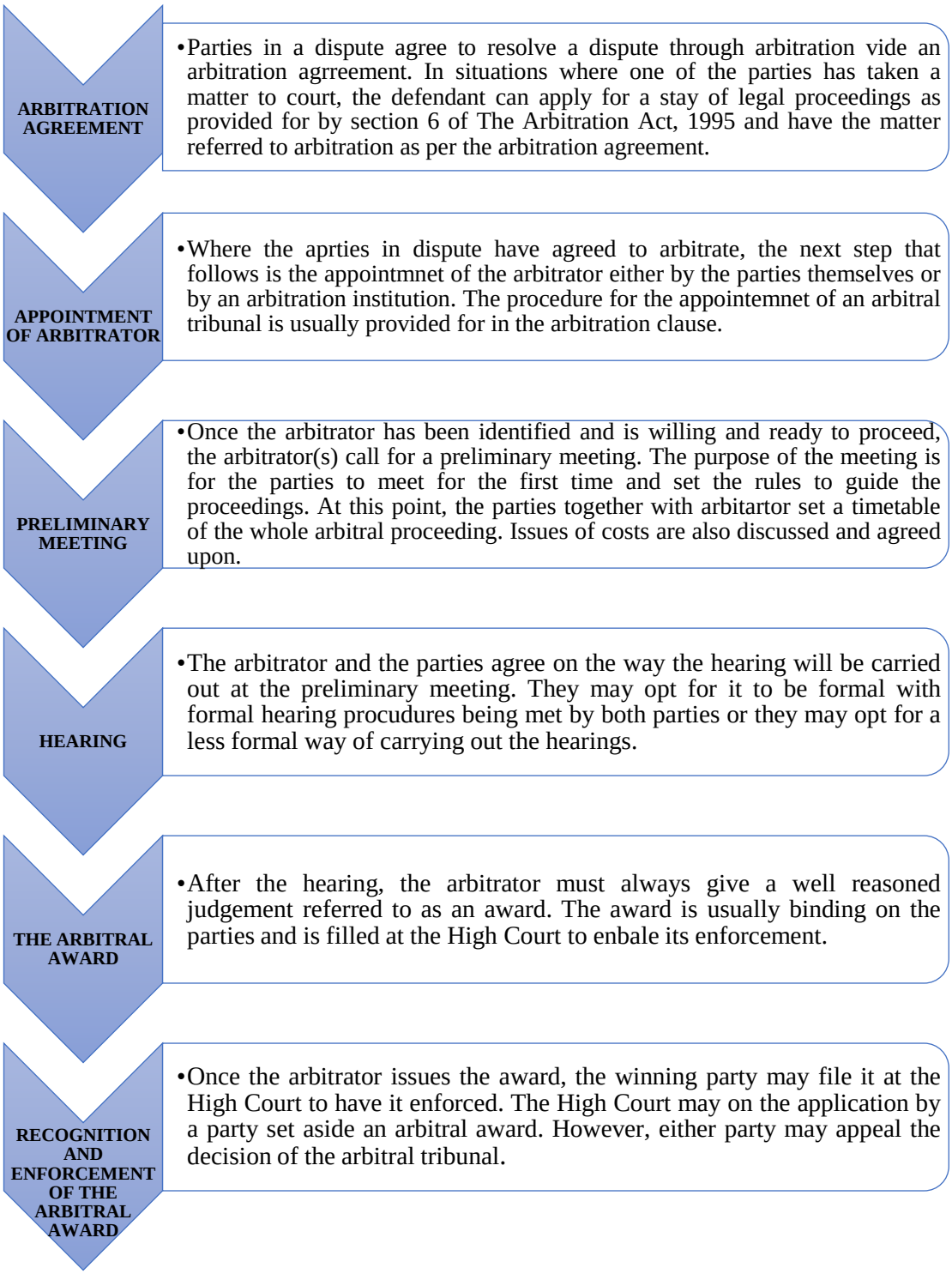
Table 2.4 The Main characteristics of IP disputes and the results offered by domestic litigation and arbitration

CHARACTERISTICS	LITIGATION	ARBITRATION
1. International	Multiple Proceedings under different laws that increase the risk of conflicting results. Possibility of home court advantage for the party that litigates in its own country	A single proceeding under the law agreed upon by parties. Arbitral procedure and nationality of arbitrator can be neutral, so is the language and institutional culture of parties.
2. Expertise	The judge/decision maker may not have relevant expertise to determine the matter.	Parties can select an arbitrator(s) with IP expertise.
3. Urgent	Procedures are often drawn-out delaying the process of resolving the disputes. In certain jurisdictions, injunctive relief is available.	Arbitrator(s) and parties can agree to shorten the procedure to be used. Arbitration may include provisional measures and does not preclude seeking court-ordered injunction.
4. Require Finality	Possibility of appeal.	Limited appeal option.
5. Confidential	Public proceedings.	Proceedings and awards are confidential.

****Source WIPO Website on https://www.wIPo.int/amc/en/arbitration/why-is-arb.html*.

2.3.3 The Arbitration Process in Kenya

The flow chart below provides an overview of the standard Arbitration Process:



Source: The Author

2.4 A Critique of the use of Arbitration to Resolve IP Disputes

Cook and Garcia argue that an arbitration agreement may be deemed invalid due to public interest and for this reason, some parties opt not to use arbitration as an alternative to litigation to solve IP disputes.[65] As mentioned above, majority of IPR like patents and registered trademarks require government action for them to come into existence. The state may include criminal sanctions and punitive actions when legal issues arise that affect the public interest. The power of arbitral tribunals is limited to specific remedies that it can award and it has no powers to use punitive measures.

IPR are granted to the right holder through registration by the State and only the state and not an individual can reverse the rights granted.[66] As stated at the beginning of this paper, IPR are exclusive rights given by the state to individuals within their territory and possess a public nature. If the arbitral tribunal is mandated to establish the validity of an IPR, it cannot affect its registration in the national registration system but rather uses that information to decide on rights that should be protected. [67]

[65] Cook and Garcia. (n 43) 23.

[66] Suzuki (n 45) 66.

[67] Cook and Garcia. (n 43) 68.

CHAPTER THREE

THE LEGISLATIVE FRAMEWORK REGULATING INTELLECTUAL PROPERTY DISPUTES IN KENYA AND THEIR SHORTCOMINGS

3.1 Introduction

This chapter briefly discusses IP disputes in Kenya. It gives an analysis of the international IP regime governing IP disputes; the regional IP regime in Africa governing IP disputes; and the national legislative framework governing IP disputes in Kenya such as the policy framework; the legislation; the institutional and enforcement mechanisms; the judiciary; and specialised courts that have been established to resolve IP disputes in Kenya.

3.2 Intellectual Property Disputes in Kenya

Kenya is intellectually rich in different aspects of IP from publications by Kenyan academics to technological innovations and pharmaceuticals. As discussed in chapter one, the value of many companies in Kenya is increasingly found in their IP with the growth of incubation hubs in Kenya over recent years having been on a rise. Generally, Kenya has seen a significant growth in IP. The greatest problem that exists for the innovators and other IPR holders is translating the know-how and incentives into commercially viable assets.

Majority of IP disputes in Kenya arise from the infringement of IPR, to address this, right holders use the available avenues of dispute resolution such as courts and tribunals to seek redress in the form of injunctions (stopping the infringement) and/or

damages. If these IP rights are protected using the existing IP system, IPR holders can begin to generate income from their intellectual labour. Identifying and protecting valuable IP assets helps boost business growth, improves market competition in both local and international markets, promotes employment and supports national economic growth.[68]

Kenya is guided by various international, regional and national legal frameworks that protect and promote IPR. These legal frameworks establish various platforms for the resolution of IP disputes. However, despite there being laws that protect IPR, infringement does occur and the protection of IPR holders has been a challenge as the enforcement of the laws protecting IPR in Kenya is weak thus exposing the IPR holders to exploitation and outright theft of their ideas.[69]

3.3 International Intellectual Property Legal Regimes Regulating IP Disputes

3.3.1 The World Intellectual Property Organization (WIPO)

The WIPO Convention of 1967 established the WIPO which was mandated to assist member states in the enactment and enforcement of substantive law within the regime of WIPO; to enhance international co-operation in the development of international and regional IP law; and to help countries with the transfer and development of skills and the enforcement of IP.[70] Kenya is a signatory to the WIPO convention and has

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[68] WIPO, 'Strengthening Kenya's IP Landscape' <https://www.wIPo.int/wipo_magazine/en/2016/04/article_0007.html> accessed 18 September 2019.

[69] The U.S. Chamber of Commerce's Global Innovation Policy Centre, (n 13) 17.

[70] United Nations, 'Convention Establishing the World Intellectual Property Organization' 11.

been a member state of the WIPO since 1971 and is therefore a beneficiary of the structures put in place by WIPO among them, the WIPO arbitration and mediation centre.

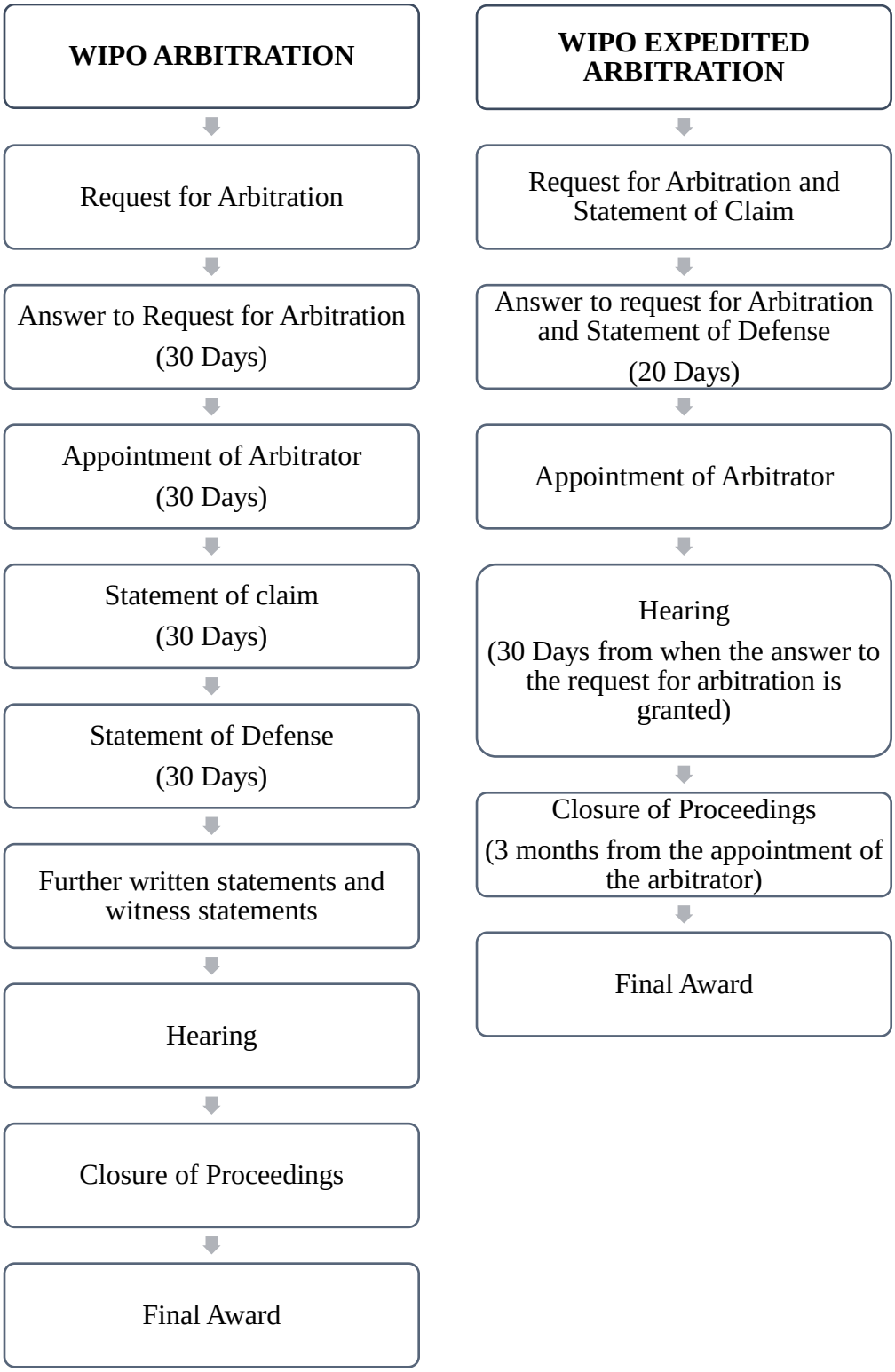
The WIPO arbitration and mediation centre was established to provide time and cost-efficient ADR options by enabling private parties to efficiently settle IP disputes out of court. The role of the centre is to facilitate the resolution of IP disputes by: helping parties submit existing disputes to WIPO procedures in cases where they had not previously agreed on a WIPO arbitration clause; assisting in the selection of arbitrators; administering the financial aspect of the proceedings; and ensuring optimal communication and procedural efficiency.[71]

WIPO also offers expedited arbitration where the centre shortens the time frame and reduces the costs of arbitration through the WIPO expedited arbitration rules that ensure an expeditious resolution of the IP dispute in question. It also sets time limits and advocates for the hearing before the arbitrator to be condensed and be heard within three days.[72] **Table 3.1** below lists the principle steps in the WIPO arbitration and the WIPO expedited arbitration.

[71] WIPO, 'Role of the Center' <https://www.wipo.int/amc/en/center/role.html> accessed 16 September 2019.

[72] WIPO, 'What Is WIPO Expedited Arbitration?' <https://www.wipo.int/amc/en/arbitration/what-is-exp-arb.html> accessed 16 September 2019.

Table 3.1 Principle Steps in the WIPO Arbitration and Expedited Arbitration



Source: https://www.wIPo.int/amc/en/arbitration/expedited-rules/princIPal-steps.html

The WIPO has also developed the WIPO eADR which is an online case administration tool that aims to offer time efficient administration options at no extra cost including an online docket and video conferencing facilities.[73] It allows parties to an arbitration, including the arbitrator, to securely submit communications electronically into the online docket, which communication is protected and encrypted to ensure confidentiality.[74] Although the WIPO eADR is only available to parties to a WIPO procedure, the centre does under certain circumstances make this facility available (by creating custom versions) in non- WIPO procedures.

3.3.2 The TRIPs Agreement,1994

The historical development of the international IP legal regime has been discussed in chapter one. As noted earlier, the TRIPs agreement is the most comprehensive multilateral agreement on IP and forms the basis of modern IPR in all countries, including Kenya.[75] TRIPs mainly deals with IP and addresses several IP doctrines such as copyrights and related rights, trade mark, geographical indication, industrial design and patents and sets the minimum standards for the protection and promotion of IP doctrines.[76]

The TRIPs agreement provides for the enforcement of IPR under part III which mandates member states to ensure that enforcement procedures under the agreement

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[73] WIPO, 'WIPO Online Case Administration Tools' <https://www.wipo.int/amc/en/eadr/index.html> accessed 16 September 2019.

[74] ibid.

[75] Wekesa and Sihanya (n 8) 5.

[76] World Trade Organisation (n 11) article 1(2)

are available under their laws. Article 41 of the TRIPs agreement states that these enforcement procedures are meant to permit effective action against any act of infringement of IPR covered by the agreement. It further provides that the member states should ensure that the enforcement procedures: include expeditious remedies to prevent infringement; include remedies which constitute a deterrent to further infringements; are fair and equitable without being unnecessarily complicated or costly; and do not entail unreasonable time-limits or unwarranted delays.

Civil and administrative procedures and remedies are the enforcement procedures outlined in the agreement. These procedures should be made available to right holders by member states as provided under article 42 of the TRIPs agreement. Injunctions and damages are among the remedies discussed in the agreement: Injunctions order a party to desist from an infringement[77]while damages compensate a right holder for the injuries they have suffered because of an infringement of their IPR. [78]

The TRIPs agreement also states that member states desire to establish a mutually supportive relationship between the WTO and the WIPO as well as other relevant international organizations thus ensuring effective protection and promotion of IP. In order to establish a supportive relationship that facilitates the implementation of the TRIPS agreement, the council for TRIPs concluded with the WIPO an agreement on cooperation between the WIPO and the WTO.[79]

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[77] World Trade Organisation (n 11) article 44

[78] ibid article 45

[79] World Trade Organisation, Intellectual Property (TRIPS) - WTO-WIPO Cooperation' <https://www.wto.org/english/tratop_e/trips_e/intel3_e.htm> accessed 18 September 2019.

3.3.3 Challenges faced by International Intellectual Property Legal Regimes Regulating IP Disputes

The main challenge that the International IP Regime regulating IP disputes face is that African countries are of the opinion that they ought not to be bound by them because they did not participate actively in the negotiations. These regimes are said to have been conceived and promulgated without the involvement and participation of African countries with arguments that most of the provisions or clauses were enacted to benefit western transnational corporations.[80] Ben Sihanya notes that many African countries, including Kenya, want standards at the international level but have not enacted the same standards under their national policies and laws.[81]

3.4 Regional IP Regimes in Africa that Regulate IP Disputes

There are a number of regional IP regimes in Africa that regulate IP disputes among them:

i. African Regional Intellectual Property Organization (ARIPO)

The ARIPO, established by the Lusaka Agreement in 1976 caters to English speaking countries on industrial property. Its objectives are: to foster establishment of close relationships among member states; to facilitate the harmonisation and co-ordination of industrial property matters; to promote effective and continuous exchange of information and harmonisation of co-ordination of member states' laws and activities in industrial property matters; and the creation of an African regional IP

[80] Sihanya (n 4) 69.

[81] ibid 70.

organization.[82] The Lusaka Agreement provides for the resolution of IP disputes under article XIII with disputes being directed to the administrative council and the council of ministers.[83] ARIPO also has an appeal tribunal that hears and determines disputes related to IPR registered under ARIPO.

ii. The Harare Protocol on Patent and Industrial Design

The protocol came into force in 1982 and it empowers the ARIPO patent office to revive and process patent and industrial design applications on behalf of member states. Kenya is a member state to the protocol which is useful as many national patent or industrial property offices do not have sufficient information or resources to conduct official searches on the state of the art before granting patents.[84]

iii. The Banjul Protocol on Marks

The Banjul Protocol introduced trademarks into ARIPO in 1993 though Kenya is among the African states that are yet to ratify the Protocol. The protocol under section 4*bis* establishes the board of appeal which is empowered to consider and decide on any appeal lodged by an applicant who had registered a utility model in regards to the grant or refusal of grant of registration.[85]

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[82] WIPO, 'Agreement on the Creation of the African Regional Industrial Property Organization (ARIPO)' (1976) <https://www.wipo.int/edocs/lexdocs/treaties/en/ap001/trt_ap001_002en.pdf> accessed 25 September 2019.

[83] ibid.

[84] Sihanya (n4) 74.

[85]ARIPO, Harare Protocol on Patents and Industrial Design (2019) <https://www.aripo.org/wp-content/uploads/2018/11/Harare-Protocol-2019.pdf> accessed 25 September 2019.

iv. Pan African Intellectual Property Organization (PAIPO)

PAIPO is established by the Statute of the Pan African Intellectual Property Organization which was adopted in January 2016 by the African Union (AU) though Kenya is among the countries that are yet to ratify this agreement, and is yet to come into force[86] Through PAIPO, the African Union seeks to establish a development-oriented intellectual property system that will promote economic growth and development. Article 14 of the statute establishes the Board of Appeal which is empowered to hear disputes and litigations arising from the activities of the PAIPO. Article 19(1) further provides for the use ADR to resolve disputes that may arise between state parties. In the event ADR fails, article 19(2) states that the parties in disputes may upon mutual consent refer the dispute to the African Court of Justice and Human Rights or to an Arbitration Panel of three Arbitrators.[87] This is by far the only agreement in Africa that directly provides for the arbitration of IP disputes.

3.4.1 Challenges faced by the Regional Legal Regimes Regulating IP Disputes Africa

The main challenge that faces the regional legal regimes in Africa is that some African states are yet to ratify the conventions and treaties and/or have not domesticated the said agreements. Scholars like Ben Sihanya have argued that the region is yet to fully appreciate the importance of IP. Some African countries have expressed reservations when it comes to domesticating some these regional agreements. Kenya for example

[86] African Union, Statute of the Pan African Intellectual Property Organization (2016).

[87] ibid.

is yet to ratify the Statute establishing PAIPO. It therefore becomes difficult to enforce the law if it is yet to be ratified.

3.5 National Legislative Framework Regulating IP disputes in Kenya

3.5.1 Policy Frameworks

A sound policy framework determines the quality of the legislative and regulatory framework in a country. According to *A Guide to the Legislative Process in Kenya,* it is recommended for policy to precede law because it allows the executors to: determine a clear road map; assess the problem and possible solutions; and define the opportunity to be embraced and the modalities or approach to realise the benefit prior to proposing the necessary legal framework. [88]

Kenya does not have a sound IPR policy which can be used as a framework on which other laws would be passed. The current IPR laws in Kenya are not developed from policy but meet the basic requirements set out by the TRIPs agreement. IPR in Kenya are contained in policies such as the innovation, science and technology policy which looks into technology development and transfer with a focus on the Kenya National Innovation system.[89] The problem with this policy is that its main focus is on innovation of science and technology and not all IPRs, for instance copyrights and trademarks, fall under science and technology. There is therefore no *sui generis* policy

[88] KLRC, *A Guide to the Legislative Process in Kenya* (1st edn, Kenya Law Reform Commission 2015) 26 <http://www.klrc.go.ke/images/images/downloads/klrc-a-guide-to-the-legislative-process-in-kenya.pdf> accessed 16 September 2019.

[89] Republic of Kenya Ministry of Science and Technology, *Science, Technology and Innovation Policy and Strategy* (2008) 23.

on IP in Kenya. The lack of a clear policy makes the IP sector disjoined leading to the duplication of roles by state corporations.[90]

3.5.2 Legislative and Regulatory frameworks

As a WTO member state, Kenya has ratified the TRIPs agreement thus enacting laws that meet the minimum standards for protecting and enforcing IPR. Despite the lack of IPR policies, Kenya has a number of laws enacted by parliament that seek to protect and promote IP by creating an enabling environment for the development of IP in the country. The legislative framework regulating IP in Kenya can be found in: The Constitution of Kenya, 2010; The Industrial Property Act,, Cap 509 of the Laws of Kenya, 2001; The Copyrights Act Chapter 130 of the Laws of Kenya, 2001; The Trademark Act, Cap.506 of the Laws of Kenya, 2009; The Seeds and Plant Varieties Act, Cap. 326 of the Laws of Kenya, 199; and The Anti-counterfeiting Act No. 13 of 2008.

Article 2(6) of the Constitution of Kenya, 2010 states that any treaty or convention ratified by Kenya shall form part of the laws of Kenya. As such, international IP treaties and conventions ratified by Kenya such as the TRIPs agreement form part of Kenyan Law. Article 2(6) of the Constitution of Kenya, 2010 gains effect from the Treaty Making and Ratification Act, 2012 which lays down the procedure on how Kenya ratifies treaties. The legal provisions herein are relevant in IP because Kenya is a signatory to various IP treaties and conventions. In the same spirit of protecting and promoting IPR, article 40 of the Constitution of the Kenya, 2010 mandates the state to protect property with article 40 (5) being specific to the protection of IP. In so

[90] KLRC (n 87).

doing, Parliament has enacted pieces of legislation that deal with the different forms of IP. Among the pieces of legislation enacted are:

i. The Industrial Property Act, Cap 509 of the Laws of Kenya, 2001 which provides 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; and to provide for the establishment, powers and functions of the Kenya Industrial Property Institute;

ii. The Copyrights Act Chapter 130 of the Laws of Kenya, 2001 makes provision for copyright in literary, musical and artistic works, audio-visual works, sound recordings and broadcasts;

iii. The Trademark Act, Cap.506 of the Laws of Kenya, 2009 provides for the registration of trademarks;

iv. The Seeds and Plant Varieties Act, Cap. 326 of the Laws of Kenya, 1991, an act of Parliament that confers the power to regulate transactions in seeds, including provision for the testing and certification of seeds; to provide for the grant of proprietary rights to persons breeding or discovering and developing new varieties; to establish a national centre for plant genetic resources; and to establish a Tribunal to hear appeals and other proceedings among other powers; and

v. The Anti-counterfeiting Act No. 13 of 2008 which is an Act of parliament that prohibits trade in counterfeit goods.

The different legislation enacted by parliament establish various tribunals that act as avenues for resolving IP disputes. These tribunals are discussed under **3.5.5.** below.

3.5.2.1 Challenges faced by the Legislative Framework Regulating IP Disputes in Kenya

Kenya has great laws in writing, the problem with these laws may be said to be two-fold. First, majority of Kenyan IP laws were not developed from policy and do not therefore have the advantages of laws developing from polices. One of the best advantages of developing law from a policy is the assessment carried out while developing the policy that identifies the problem and possible solutions. This assessment also defines the opportunity to be embraced and the modalities or approach to realise the benefit prior to proposing the necessary legal framework. Not carrying out these necessary steps among others in the development of IP laws in Kenya has led to the enacted of laws that were drafted to meet certain international standard and some that were duplicated from other regions. We therefore find that the IP laws in Kenya do not address the IP problems that the country faces and neither do they put into consideration the rapid growth of IP in the region and the unique features that IP in Kenya has developed.

Second, the enforcement of the IP legislative framework in place is wanting. Once again we find that we have very good laws in writing but the enforcement mechanisms put in place are limited and inefficient. Champe S. Andrews questioned the essence of having good laws in statute books unless some means are adopted of bringing to book

those who are guilty of violating the provisions of a statute.[91] If the enforcement of IP laws in Kenya is weak, then the laws may be deemed to serve no purpose. IP laws are enacted to protect IPR, if right holders cannot adequately have their rights at the list protected leave alone promoted, the law then may be said to have failed.

3.5.3 Institutional and Enforcement Mechanisms

Article 42 of the TRIPs agreement on the enforcement of IPR provides that member states are to ensure enforcement procedures specified under the agreement are available under their law so as to permit effective action against any act of infringement of IPR. These procedures are to be fair and equitable without being complicated, costly, with unreasonable time limits or unwarranted delays.[92] Member states are required to ensure that there are expeditious remedies to prevent infringement and remedies which constitute a deterrent to further infringement. The Kenyan legislative frameworks regulating IP discussed above established institutional and enforcement mechanisms that ensure effective and efficient implementation of IPR. These institutional and enforcement mechanisms are discussed hereunder.

3.5.4 The Judiciary

Civil and criminal judicial procedures are provided for under article 43 of the TRIPs agreement with member states mandated to make available civil and criminal judicial procedures concerning the enforcement of any IPR to right holders. IPR as stated above are private rights and are deemed to be constitutional rights by virtue of article

[91] Andrew Champe S, 'The Importance of the Enforcement of Law' (1909) 34 The Annals of the American Academy of Political and Social Science 85, 86.

[92] World Trade Organisation (n 11) article 2.

40 of the Constitution of Kenya, 2010 which provides for the protection of right to property. As mentioned in chapter one, property is defined under article 260 of the Constitution of Kenya, 2010 to include IP. The High Court in Kenya has unlimited original jurisdiction on any question touching on a person's constitutional right to IP.[93] Therefore, superior courts in Kenya exercise general civil and criminal jurisdiction over IP related disputes depending on the subject matter of IP under review and the stage of the legal proceeding.[94]

In addition to having the original jurisdiction within the court structure to hear IP disputes, the High Court also has appellate jurisdiction to hear appeals from specialised IP tribunals established by legislation. This power is conferred on it by different statutes such as the Trademark Act, Cap.506 of the Laws of Kenya, 2009 which confers power upon the High Court to exercise appellant jurisdiction over the decisions of the Registrar of Trademarks; the Industrial Property Act Cap 509 of the Laws of Kenya, 2001 for the decision made by the Industrial Property Tribunal; and the Seeds and Plant Varieties Act, Cap 326 of the Laws of Kenya, 1991 for the decisions of the Seed and Plants Varieties Tribunal.

3.5.4.1 Challenges faced by the Judiciary in Kenya

Kenyan courts have been criticised on their poor performance in delivering justice which is mainly attributed to the weak judicial system that has case backlogs. Complaints raised have been about their inability to deliver justice in a manner that is not only fair but is seen to be fair; delay involved in processing and conclusion of

[93] Ombija (n 31).

[94] ibid.

cases; and inaccessibility of justice due to the expenses involved in litigation of matters.[95] The judicial system is slow in determining cases before it and inventors rely on the four specialised IP tribunals which are faster than regular courts.[96]

3.5.5 Specialised Tribunals

Under Article 41 para 5 of the TRIPs Agreement, states are given the option to create specialised IP tribunals. States are therefore free to decide what type of judicial bodies have the jurisdiction to hear IP disputes. Specialised IP tribunals are established by legislation enacted by parliament to deal with IP disputes that arise in the course of the registration and administration of specific IP matters.[97] There are five main specialised IP tribunals in Kenya. The Managing Director of KIPI; The Industrial Property Tribunal; The Registrar of Trademarks; The Seeds and Plant Varieties Tribunal; and the Competent Authority.

3.5.5.1 The Managing Director of KIPI

The Kenya Industrial Property Institute (KIPI) is established by the Industrial Property Act No.3 of 2001 and is currently under the Ministry of Industry, Investment and Trade. Its mandate is to promote inventive and innovative activities and to facilitate technology transfer through regulation and protection of the industrial property in Kenya. It has a board of directors whose function under section 11(1) of the Industrial Property Act is to appoint a Managing Director whose role is the administration of the

[95] Ouma (n 15) 30.

[96] The U.S. Chamber of Commerce's Global Innovation Policy Centre, (n13) 21.

[97] Ombija (n 31).

KIPI with regard to making the decision to grant or refuse the grant of IPR such as patents, industrial designs and utility models**.** In addition to this, the Managing Director of KIPI makes the decision to register or refuse to register technology transfer agreements and licenses. Justice Ombija states that the Managing Director of KIPI can be said to implement the functions of the institute.[98]

3.5.5.2 The Industrial Property Tribunal

Section 113 of the Industrial Property Act no.3 of 2001, establishes the Industrial Property Tribunal (IPT) which hears and determines appeals from the decisions of the Managing Director of KIPI where provision has been made for appeals. The IPTs jurisdiction extends to IP disputes relating to Patents, Industrial Designs, Utility Models and Technovations arising from appeals against the decision of the Managing Director to register a patent or contractual license; application for or to transfer compulsory license; appeals from the decision of the arbitration board regarding disputes between an employer and employee on technovations; applications for declaration of non-infringement; and applications for injunctions to prohibit the threat of infringement proceedings and damages.

3.5.5.3 The Registrar of Trademarks

The Managing Director of KIPI doubles as the registrar of trademarks who also forms part of the IP tribunal. The main role of the registrar is to preside over both contentious and non-contentious matters involving specific aspects of trademarks in Kenya as

[98]ibid.

prescribed by the Trademark Act.[99] In regards to non-contentious matters, the registrar has jurisdiction over administrative matters regarding registration of trademarks, trademark searches, screening of trademarks and advisory opinions on the registration of trademarks.[100] For contentious matters, the registrar's jurisdiction over matters relating to trademarks is wider than that of the Managing Director and extends to:

i. Under Section 20(2) of the Trademarks Act, the powers to hear submissions against citations or conditions raised by the registry;
ii. Under section 29 of the Trademarks Act, to hear an application to remove from the register of trademarks, a registered trademark in respect of any of the goods or services registered without any bona fide intention on the apart of the applicant; and
iii. Under section 35 of the Trademark Act to cancel the registration of a person as a licensee on the application in writing in the prescribed manner of any person on various grounds listed under this section.

The decisions of the registrar of trademarks can be appealed to the High Court as of right in certain circumstances. The registrar of trademarks has no jurisdiction to hear disputes relating to passing off or infringement of unregistered and registered trademarks as such disputes can only be instituted before the High Court. [101]

[99] Trademark Act CAP 506, Laws of Kenya, 2009

[100] ibid.

[101] Ombija (n 31).

3.5.5.4 The Seeds and Plant Varieties Tribunal

The Seeds and Plant Varieties Tribunal is established by the Seeds and Plant Varieties Act Cap 326, Laws of Kenya under section 28(1). Section 29 of the act specifies the jurisdiction of the tribunal as to:

i. Hear appeals from persons aggrieved by any decision to allow or refuse the grant of plant breeders rights; to cancel the grant of plant breeders rights; to allow or refuse an application for extension of the period of plant breeders rights; or to allow or refuse any application made for compulsory or voluntary licences against plant breeder's rights; and

ii. To hear and determine any matters agreed to be referred to the tribunal by an arbitration agreement relating to the infringement of plant breeder's right, or to matters which include such infringement. No right of appeal lies from a decision of the Seeds and Plant Varieties Tribunal.

Justice Ombija notes that the tribunal faces procedural technicalities regarding the tribunal rules of procedure which hinders it from making decisions from the cases submitted before it.[102]

3.5.5.5 The Competent Authority

The Copyright Act No. 12 of 2001 under section 48(1) empowers the AG to appoint a Competent Authority with the jurisdiction to hear appeals from decisions of the Kenya Copyright Board in relation to: unreasonable refusal to grant a certificate of registration in respect of a collecting society; it imposing unreasonable terms or

[102] ibid.

conditions on the granting of such a certificate; a collecting society that unreasonably refuses to grant a license in respect of a copyright work; and a collecting society imposing unreasonable terms or conditions on the granting of such a license.[103] The Competent Authority forms part of the subordinate courts under the judiciary by virtue of article 169(1) of the Constitution of Kenya, 2010.

3.5.5.6 The Challenges faced by Specialised IP Tribunals in Kenya

Specialised tribunals offer various advantages the main one being the specialization and technical expertise unlike the technicalities of litigation. However, specialised IP tribunal do have disadvantages hinged in their operations which in turn hinder the expectations of IPR holders.[104] A case study carried out by the International Intellectual Property Institute on specialised courts[105] found that these challenges are common among all the specialised IPR tribunals and include: Methods and procedures of appointment and removal of tribunal members; Organization and qualifications of tribunal members; Terms and period of service of tribunal members; Resource allocation to the tribunals; Law reporting system of the tribunals; and Public ignorance.

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[103] The Judiciary, 'Know Your Tribunals' <http://www.kenyalaw.org/kl/fileadmin/pdfdownloads/RevisedKnowYourTribunalsAdvert.pdf>.

[104] Assoc Rohazar and Wati Zuallcobley, 'Study on Specialized Intellectual Property Courts' 145, 81.

[105] ibid.

3.6 Conclusion

Kenya has put in place legislative, institutional and enforcement mechanisms that have not only greatly contributed to the protection and promotion of IPR but also led to its development. However, we must note that there are various challenges across the board with all the mechanisms that have been established to resolve IP disputes. These mechanisms seem to be inadequate as they face various challenges that make it difficult for the (effective and efficient) resolution of IP disputes in Kenya. There is therefore the need to develop an alternative dispute resolution mechanism that ensures adequate and efficient resolution of IP disputes in Kenya.

CHAPTER FOUR

ARBITRABILITY OF IP DISPUTES IN THE UNITED STATES OF AMERICA AND BASIC APPROACHES ADOPTED BY VARIOUS NATIONAL LEGAL SYSTEMS ON THE ARBITRABILITY OF IP DISPUTES

4.1 Introduction

This chapter constitutes a comparative study of the arbitrability of IP disputes in the United States of America and basic approaches adopted by various national legal systems on the arbitrability of IP disputes with a view of identifying the best practices that Kenya may emulate.

4.2 Arbitrability of IP Disputes in the United States of America

4.2.1 The Arbitral Tribunal

The arbitral tribunal is important in an arbitration as it maximizes the likelihood of arbitration to be conducted fairly and expeditiously while at the same time minimizes the likelihood of the award being set aside.[106] In the US federal and state law on arbitration gives the parties in an IP dispute powers to agree on the constitution of the tribunal. Parties to an IP dispute are however expected to consider the expertise of the tribunal, the size of the tribunal and the applicable method through which the arbitrators are to be chosen. A special criterion of selection is considered in regards to

[106] Halket, Evans and Folkman (n 1) 95.

IP disputes because IP disputes tend to be more complicated than similarly sized commercial disputes.[107] Thomas Halket is of the opinion that a three-member tribunal in an IP arbitration is most suitable.

There are no meaningful constraints under USA law on the ability of parties in an IP dispute to impose specific qualification on who may be their arbitrator(s). The general requirement of the neutrality of the arbitrator in the US can be waived by the affected party. Section 11(b) of the Revised Uniform Arbitration Act (RUAA), 2000 provides that an arbitrator should be neutral, its comment thereafter waives this requirement as it states as follows:

> *"Because Section 11 is a waivable provision under Section 4(a), parties may choose their own method of selecting an arbitrator under Section 11(a)…. …Section 11(b) does not apply to non-neutral arbitrators but only to neutral arbitrators. Moreover, because Section 11(b) is subject to the agreement of the parties, they may choose to have a person with the type of interest or relationship described in this subsection serve as a neutral arbitrator*."

Professional background and experience of arbitrators in IP matters in the USA is not a major area of concern as there are growing bodies of arbitrators with expertise in IP and technological disputes. Several administrative bodies such as the American Arbitration Association (AAA) have panels of 'neutrals' who specialize in IP (mainly as IP attorneys) and membership to such panels is restricted to arbitrators with

[107] ibid.

expertise in IP or the panels subject matter and in the resolution of disputes relating to it. [108]

4.2.2 Arbitral Rules and Administrative Bodies

In the USA, an arbitration may proceed under the federal and/or state arbitration laws with the parties in the IP dispute having agreed on whether the arbitration should be administered by a specific arbitral tribunal or be *ad hoc.* However, there are several sets of rules that pertain to specific types of IP disputes with some of the features in these rules being of significant importance to parties in IP disputes.[109] These features are emergency relief, expedited procedures, discovery and confidentiality. The most common arbitral bodies in the USA for IP matters are the American Arbitration Association (AAA) and its international division the International Centre for Dispute Resolution (ICDR), Judicial Arbitration and Mediation Services (JAMS), the International Institute for Conflict Prevention and Resolution (CPR) and WIPO as they each have rules that can be used for IP disputes.

4.2.3 Features in USA AAA and ICDR Arbitral Rules Applicable in IP Disputes

The American Arbitration Association (AAA) is the largest arbitral institution in the USA and has vetted panels of neutrals[110] with majority of IP arbitrators being drawn from its national roster and the ICDR's international panel. The AAA has rules that

[108] ibid 99.

[109] ibid 121.

[110] ibid 134.

are applicable to IP disputes such as patent disputes[111] and domain name disputes.[112] The two tribunals have rules that offer features such as emergency relief and expedited procedures that are applicable in IP disputes.

i. Interim or Emergency Relief

The AAA Rules[113] and ICDR Rules [114]give an arbitral tribunal powers to order interim measures of protection which can include injunctive relief and measures for the protection and/or conservation of property.[115] Emergency reliefs under the rules are only offered prior to the constitution of the arbitral tribunal that decides the case. The rules also provide for the appointment of an emergency arbitrator to be appointed within one day of the receipt by the AAA or ICDR of the application for emergency relief.[116] The said emergency arbitrator has the power to enter interim/emergency relief orders or award and their power ceases on the appointment of the tribunal who have the ability to reconsider the emergency relief granted prior to its constitution.[117]

[111] USA, National Patent Board Rules (2014).

[112] AAA Domain Name Disputes Supplementary Rules.

[113] AAA Rules and Procedure R-37.

[114] International Centre for Dispute Resolution Article 34.

[115] International Centre for Dispute Resolution.

[116] AAA Rules and Procedure R-38(c).

[117] ibid R-38(f).

ii. Expedited Procedures

The AAA and ICDR rules provide for streamlined arbitration with the option of having a document only proceeding for smaller claim matters ($75,000 and $250,000 respectively).[118] Under the ICDR rules, the parties can agree to the expedited procedures regardless of the claims and counterclaims unlike the AAA rules where the arbitrator as well has to agree. Expedited Procedures are of importance to IP disputes because some of these IP disputes, such as the Fair, Reasonable and Non-Discriminatory (FRAND) disputes, request reliefs that are primarily or exclusively injunctive or declaratory.[119]

4.2.4 Judicial Arbitration and Mediation Services (JAMS)

JAMS is a privately-owned administrative body with majority of the neutrals on its panel being retired judges.[120] Among its list of roasters it has an IP Practice Group which includes retired federal judges with notable IP expertise as well as retired state and appellate court judges and attorney-neutrals who specialize in IP litigation.[121] JAMS states that their arbitrators increase their deep subject matter expertise with

[118] ibid R-E6.

[119] Halket, Evans and Folkman (n1) 141.

[120] JAMS, 'JAMS Mediation, Arbitration and ADR Services' <https://www.jamsadr.com/about/> accessed 26 September 2019.

[121] 'JAMS Intellectual Property Practice Group' <https://www.jamsadr.com/intellectual-property> accessed 26 September 2019.

ongoing training on the latest developments in IP law and ADR therefore making sound judgements.[122]

JAMS Rules give the arbitral tribunal power to issue interim measures, conservatory measures and injunctive reliefs. The rules also enable a party to an IP dispute to apply for emergency relief from an emergency arbitrator.[123] In addition to interim/emergency relief, JAMS offers expedited procedures which are different from those of AAA and ICDR discussed above as they are available if either party opts into them.[124] The expedited procedures limit available discovery and some depositions thus expediting the arbitral proceedings.[125]

4.2.5 The International Institute for Conflict Prevention and Resolution (CPR)

The CPR is an independent no-profit organization that helps global businesses and their counsel prevent and resolve commercial disputes more effectively by improving ADR capacity worldwide. The institute has a vetted panel of neutrals who are grouped by location and background.[126] It has a set of rules specifically for patent and trade secret disputes.[127] CPR Rules give the arbitral tribunal powers to issue interim

[122] ibid.

[123] 'JAMS Intellectual Property Practice Group' (n 121) Rule 2(c).

[124] ibid Rule 16.1(b) and (c).

[125] ibid Rule 16.2.

[126] 'The International Institute for Conflict Prevention and Resolution (CPR)' <https://www.cpradr.org/resource-center/protocols-guidelines> accessed 26 September 2019.

[127] Patent & Trade Secret Arbitration Rules 2015.

measures that it deems necessary with the appointment of a special arbitrator who is appointed just to issue the interim measure.[128] In addition to this feature, CPR has a set of rules of procedure which provide for 'fast track' arbitration which expressly modifies the CPR rules for any arbitration.[129] The provisions in the fast track procedures are significant in an IP matter in that discovery for example is limited to an exchange of documents[130] and the initial pre-hearing conference must be held within 5 days of the arbitrator's appointment.

4.2.6 Remedies and Enforcement

Damages are the most usual form of relief in arbitration and litigation with the damages being sufficient in amount to indemnify the injured person for the loss incurred. Generally, punitive or other non-compensatory damages are not available in for IP disputes. In the USA however, there are various grounds under which non-compensatory 'punitive' damages can be awarded in an IP dispute by the courts.[131] The common law in the USA provides for punitive damages where the defendant's conduct that harmed the plaintiff's rights was ***malicious, oppressive or in reckless disregard of the plaintiff's rights***.[132] The USA Supreme court in the case of

[128] CPR Rules for Administered Arbitration of International Disputes 2019.Rule 14.2 and Rule13

[129] CPRADR, Fast Track Arbitration Rules.<https://www.cpradr.org/resource-center/rules/arbitration/fast-track-rules-of-procedure> accessed 26 September 2019

[130] ibid 6(a)

[131] Halket, Evans and Folkman (n 1) 274.

[132] Ninth Circuit Jury Instructions Committee, 'Manual Of Model Civil Jury Instructions For District Courts In The Ninth Circuit 81' (2018) <https://bit.ly/2GQ2uiX.>.

Mastrobuono v. Shearson Lehman Hutton, Inc., 514 U.S. 52 (1995) held that punitive damages are not by federal law prohibited in arbitrations. Even under arbitrations covered by the Federal Arbitration Act, the parties remain free to limit or shape available remedies. States such as New York have rules that make punitive damages unavailable in arbitration because they vindicate the interests of the public rather than private interests of the disputing parties.[133]

Other types of damages that maybe available in the USA are treble or statutory damages which are reliefs sought for intentional infringement of a US patent, certain types of copyright infringement and/or violations of the antitrust laws. Treble damages is a term used in the USA to refer to compensatory damages offered by the court that are three times the actual damages. These damages are given by statute in certain cases, consisting of the single damages found by the jury, being tripled in amount.[134] The usual practice has been for the jury to find the single amount of the damages, and for the court, on motion, to order that amount to be trebled. Whether these types of damages are available to a claimant in an IP arbitration in the United States depends on the nature of the enhanced damages, the applicable arbitral law and the rules chosen by the parties.[135]

[133] Halket, Evans and Folkman (n 1) 276.

[134] Black (n 2) 1674.

[135] Halket, Evans and Folkman (n 1) 274.

4.3 Basic Approaches Adopted by Various National Legal Systems on the Arbitrability of Registered IP Rights

National Legal Systems have different approaches to the arbitrability of IP disputes. Some systems advocate for no arbitrability while others opt for arbitrability with limitations, full arbitrability or mandatory arbitrability.

4.3.1 No arbitrability

IP disputes that are not arbitrable often arise from disputes relating to IP rights that are subject to mandatory public registration such as patents.[136] South Africa is one of the countries that has a national legal system that provides for no arbitrability of IP rights with the law being specific to patent rights. Article 18(1) of the Patents Act No. 57 of 1978 of South Africa states that no tribunal other than the commissioner shall have jurisdiction in the first instance to hear and decide any proceedings, relating to any matter under the act.

4.3.2 Arbitrability with limitations

The arbitration of IP disputes concerning contracts of licensing and transmission of registered IPRs is allowed in majority of national legal systems because no public interests are affected in such cases and the right to compensation can be waived by the right holder.[137] Some national legal systems allow the arbitration of IP disputes on the

[136] Vicente (n 19) 153.

[137] Francois Dessemontet, *Arbitration of Intellectual Property Rights and Licensing Contracts' in Emmanuel Gaillard and Domenico Di Pietro (Eds), Enforcement of Arbitration Agreements and International Arbitral Awards. The New York Convention 1958 in Practice* (Cameron May 2008) 554.

registration of IPR, in Spain for example, Article 28 of the *Ley de Marcas* provides that parties in an IP dispute may submit to arbitration contentious issues that have arisen in the context of proceedings aimed at the registration of a TM. In Portugal, a decision by an administrative body concerning the grant or refusal of grant of IPR may be appealed to an arbitral tribunal as stated under Article 48 of the Portuguese Code of Industrial Property. The arbitrability of IP disputes in such national legal systems is limited to the fact that the arbitration should not affect public interest.

4.3.3 Full arbitrability

Belgian and Swiss national legal systems allow for full arbitrability of IP disputes. Belgian allows for the full arbitrability of Patent disputes under article 51(2) of the Patent Law of 1984 which gives the award of an arbitral tribunal the force of *res judicata* and such awards are to be registered. Article 73(6) further gives jurisdiction to arbitral tribunal on disputes related to the ownership of a request for a patent, the validity or the infringement of a patent or to disputes relating to patent licenses other than compulsory licenses. Swiss law allows for the arbitrability of disputes on registered IPR and does not impose restrictions as to the effects of arbitral awards. The Swiss federal institute of intellectual property recognises such arbitral awards provided they have been declared enforceable by a Swiss court. [138]

4.3.4 Mandatory arbitrability

Portugal has since 2011, under the Portuguese Law no 62/2011 which provides for the regulation of pharmaceutical patent disputes between patentees and generic medicine

[138] Vicente (n 19) 157.

companies through mandatory arbitration of IP disputes. [139] This has however been amended by the new Portuguese Industrial Property Code which came into force in June 2019.[140] Disputes are no longer subject to mandatory arbitration and disputes between patentees and pharma generic medicines shall be decided either by the IP Court or by voluntary arbitration.

4.4 Conclusion

Arbitration proceedings worldwide have a fixed set of characteristics such as neutrality of the tribunal and confidentially of the proceedings. The USA arbitration rules have greatly advanced the arbitrability of IP disputes with differences among the various tribunals influencing the outcome of IP disputes being resolved through arbitration. In situations where parties opt to have their arbitration administered the differences in the tribunals available in the USA would be of great consideration to the parties in dispute. Kenya should consider and implement the different approaches by the different tribunal in the USA in order to improve on the arbitrability of IP disputes in the country.

[139] ibid 158.

[140] European Union, 'The Portuguese IP Code Revision - Designs and Models | Trademarks and Logotypes' <https://www.lexology.com/library/detail.aspx?g=ec21d0f8-d1f2-466e-a9ce-ad8ba0b6e7be> accessed 30 June 2019.

CHAPTER FIVE

SUMMARY OF THE STUDY, FINDINGS, CONCLUSION AND RECOMMENDATIONS

5.1 Introduction

This chapter comprises of a summary of findings, the conclusion based on the findings and recommendations on appropriate and effective measures of promoting the arbitrability of IP disputes in Kenya.

5.2 Summary of the Study

The study sought to analyse the arbitrability of intellectual property disputes in Kenya. A number of research objectives were set to guide the collection of the required information. The objectives of the study were to analyse the arbitrability of intellectual property disputes; to determine the best practices that allow for the use of arbitration in intellectual property disputes; and to recommend appropriate and effective measures of promoting the arbitrability of intellectual property disputes in Kenya.

5.2.1 Hypotheses Tested

The first hypothesis that was tested was that the existing legal mechanisms in Kenya do not efficiently and effectively resolve IP disputes. This hypothesis was proven as the study found that the existing legal mechanisms in Kenya have provided for various avenues to resolve IP disputes among them the courts and specialised IP tribunals. The aforementioned avenues face various challenges such as case backlogs, political

interference, lack of expertise in IP by the judges or tribunal members and lack of sufficient resources. As a result, IP disputes brought before these legal institutions are not effectively and efficiently heard and determined.

The second hypothesis tested was that arbitration is the most suitable mechanism for resolving IP disputes. This hypothesis was proven as the study found that the characteristics of IP disputes make arbitration the most suitable mechanism to resolve IP disputes. The main characteristic that supports this hypothesis is that majority of IP disputes are international in nature therefore a conflict of laws and jurisdiction would arise while on the other hand arbitrations allows for the parties to determine the law that will govern the arbitral proceeding. In addition to this, the study also highlighted that parties to an arbitration can select an arbitral tribunal with expertise in IP unlike litigation where the decisionmaker may not have the relevant expertise in IP. The advantages of arbitration such as flexibility, confidentiality and finality have proven that arbitration is indeed the most suitable mechanism for resolving IP disputes.

5.3 Summary of Research Findings

This section presents a summary of the findings according to the objectives of the study.

5.3.1 The Arbitrability of IP Disputes

The IPR are perceived to have the same status as other personal rights and as such are arbitrable in nature unless statute provides the contrary. The use of arbitration to resolve IP disputes has a number of advantages as compared to litigation among them confidentiality because proceedings are held privately; parties directly choose the arbitral tribunal; flexibility of the proceeding as it is a private and consensual matter

between the parties; and minimum emphasis on formality thus allowing for expeditious disposal of matters.

These advantages are beneficial to IP disputes because they complement the characteristic of IP disputes. For instance, some IP disputes are international and in such disputes arbitration is the most suitable mode of resolving international disputes because the parties agree on the law to govern the proceeding other than litigation which would involve multiple proceedings under different laws. The main critique on the use of arbitration that was identified from this study is that an arbitration agreement may be deemed invalid due to public interest and that majority of IPR are granted through registration therefore only the state can reverse the rights granted.

5.3.2 Current Legal Provisions that govern the Resolution of IP Disputes in Kenya

This study also found that the legislative frameworks regulating IP disputes is well advanced at the international, regional and national level. At the international level we find that various agreements have provided for the resolution of IP dispute. The WIPO for instance has gone a step further and developed an arbitration and mediation centre that provides time and cost-efficient ADR options that enable private parties to efficiently settle IP disputes. The main challenge facing the international legal regime governing IP disputes is that majority of African countries are of the opinion that they ought not to be bound by them because they did not participate actively in their negotiations. Therefore, although these agreements are ratified and domesticated by majority of African countries including Kenya, their enforcement lacks full commitment.

At the regional level in Africa, the study found that there are a number of agreements established to promote and protect IP within Africa for example the Lusaka Agreement establishing ARIPO and the Statute establishing the Pan African Intellectual Property Organization. Some of these agreements such as PAIPO provide different options of resolving IP disputes such as ADR and special tribunals. The main challenge facing the regional agreements is that some African states, are yet to ratify and domesticate these agreements. The study found that Kenya has not yet ratified the statute establishing PAIPO. It is therefore not possible to enforce agreements that are not yet laws.

The study found that at the national level, despite there being no policy on IP in Kenya, the country has a number of legislative and institutional mechanisms put in place to resolve IP disputes. Parliament has enacted laws that provide for the resolution of IP disputes thus empowering the judiciary and specialised tribunals to hear and determine IP disputes. The national regime faces most of the challenges when resolving IP disputes. Courts in Kenya for instance have case back logs that delay the determination of IP disputes making litigation costly and time consuming. The special tribunals on the other hand although offering a better avenue for the resolution of IP disputes compared to the courts have disadvantages hinged in their operations. These challenges include the methods and procedures of appointment and removal of tribunal members; organization and qualification of tribunal members; resources allocation to tribunals; and public ignorance.

5.3.3 The Best Practice that allows for the Use of Arbitration in IP Disputes and various approaches by national legal system on the arbitrability of IP disputes

The study found that the USA has established various arbitral administrative bodies that enable effective and efficient resolution of IP disputes. The administrative bodies have features that are of importance to parties in IP disputes. These features are emergency relief, expedited procedures and the expertise of neutrals. The arbitral administrative parties have panels from which neutrals with expertise are selected to hear and determine IP disputes. The arbitrators have a vast experience in the IP as some are retired judges with notable IP experience or attorney-neutrals who specialise in IP litigation.

Emergency relief is another feature that the study found to be dominant among these arbitral administrative bodies. It entails the appointment of an emergency arbitrator who has powers to give interim/emergency reliefs prior to the established of the arbitral tribunal that will hear and determine the whole dispute. This is an advantage for an IPR holder whose rights are being infringed upon and there is need to cease the infringement immediately as the parties to the dispute await the establishment of the arbitral tribunal.

The other feature that the study found to be common among the arbitral administrative bodies is that of expedited arbitral tribunals/fast track arbitration. The administrative bodies give parties the option of having expedited arbitrations either by offering streamlined arbitration with the option of a document only proceeding for smaller claim matters or having separate arbitral rules that provide for fast track arbitration.

The study also found that there are various approaches used by national legal systems for the arbitrability of IP disputes. Some legal systems provide for non-arbitrability while other provide for mandatory arbitrability or arbitration with limitations or full arbitrability. This guides parties in an IP dispute to determine what mode of resolving IP disputes is available in the country.

5.4 Conclusion

From the findings, the study concluded that legal and institutional mechanism in a country have significant influence on whether disputes are resolved in an efficient and effective manner. The main challenges facing these mechanisms are political interference, lack of resources and public ignorance. The challenges faced by these mechanisms have negative ripple effects on right holders whose IPR have been infringed upon as the mechanisms lack the capacity to determine matters in a just, expeditious, proportionate and affordable way.

5.5 Recommendations of the Study

It has become apparent throughout the study that there are legal and institutional mechanism that govern the IP disputes already established in Kenya. Based on the findings and conclusion of this study, the following recommendations are made:

Firstly, the Ministry of Industry, Trade and Cooperatives should develop an IP policy for Kenya in cooperation with IP experts and stakeholders. This study found that it is recommended for policy to precede law mainly because the research carried out before developing policies identifies problems and also provides possible solutions. This step should be taken as soon as possible as it creates a clear road map to addressing

challenges that may exist within the IP industry in Kenya and assist in reforming IP laws in Kenya.

Secondly, while developing the IP policy, the government, IP experts and stakeholders should benchmark the USA arbitral administrative bodies and established arbitral administrative bodies within Kenya that have features such as emergency relief, expedited/fast track arbitrations and panels of expert neutrals who are trained continuously on IP matters so as to write sound awards. The lessons learnt from this benchmark that would be beneficial to Kenya should be included in the IP policy.

Thirdly, once an IP Policy has been developed, the Cabinet Secretary under the Ministry of Industry, Trade and Cooperatives and IP experts should lobby for the current IP laws to be reformed to provide for the solutions identified in the policy and also for the use of ADR as the first step to resolving IP disputes in Kenya. This would not only ensure fast and cost-effective resolution of IP disputes but also ease the burden on the judiciary which has a back log of cases to hear and determine. The law reforms should also provide for treble damages which should be added to the damages available to IPR holders in Kenya. In addition to this, these laws should clearly provide for IP matters that are arbitrable, non-arbitrable, arbitrable with limitations or fully arbitrable in the country.

Fourthly, the government after consultations with IP experts and stakeholders should establish an IP Organization within the country that deals with IPRs. This should be done concurrently with the law reforms as the organisation would be established by law and the same law would repeal other laws that have established the current IP institutions. The organisation would merge all IP institutions in Kenya and provide procedures to be used to quickly and efficiently resolve IP disputes. In addition to this,

the organization would establish an ADR centre, just like the WIPO arbitration and mediation centre, with ADR rules of procedures.

5.6 Further Area of Research

In the course of writing this thesis, the researcher came across other areas that need to be researched on. The first area that requires further research on is that of the specialised IP tribunals. Research on the rationale behind the provisions that establish these tribunals, their structure and operations as well as their output will be essential to have a better understanding of why these tribunals are not efficient. Such a research will most probably identify ways through which these specialised tribunals can be reformed to ensure that they are fully operational and result oriented. The second area that calls for further research is that of establishing one IP organisation in Kenya that would consolidate all the IP institutions. This would create information on the advantages and disadvantages of having one IP organization; the best way to structure the organization; and its role in resolving IP disputes.

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