

PRACTICE NOTE EIGHT (8)

Amendments to the Industrial Property Act, No. 3 of 2001

1. **It is hereby notified for general information of the public** that various provisions of the Industrial Property Act, No. 3 of 2001, Laws of Kenya (the Act) were amended through the Statute Law (Miscellaneous Amendments) Act, No. 11 of 2017 (see here). Page 195 of the Miscellaneous Amendments Act indicates the effective date of the amendments as 4th May 2017.
2. The Act has already been revised by the National Council for Law Reporting and the amendments to the Act have already been duly incorporated (see here).
3. The following table clarifies how the amendments affect practice at the of Patent Registry:

| No. | Amended Section | Amendment Achieved | Effect of Amendment |
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| 1. | Section 22 | Section 22 was amended by inserting the word "and" immediately after the words "inventive step" and deleting the words "or is a new use". | The phrase “new use” was not necessary considering the fact that “new use” is not one of the criteria for patentability as provided for under the Act. |
| 2. | Section 28 | Section 28 was amended by deleting subsection (4). | This provision was superfluous since the Act defines an application in section 2. |
| 3. | Section 36 | Section 36 was amended by: (i) deleting the words “one or more” and substituting thereof the words “two or more” in subsection (2); and (ii) adding the following new subsection immediately after subsection (2): (3) The Cabinet Secretary may make regulations for the carrying out of the provisions of this section. | To correct a typographical error. |
| 4. | Section 41 | Section 41 was amended by: (i) inserting the words “and address” immediately after the word “name” in subsection (1) (a); | To obligate applicants to provide both their name and address. |
| | | (ii) deleting sub section (6); and | This provision has never been implemented and the requirement only places an unnecessary burden on the Institute. |

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| | | (iii) deleting sub section (7) (d). | The provisions of this subsection was difficult to enforce since it was not possible for the applicant to furnish copies of search and examination report at the time of carrying out formality examination. The provisions of section 38 are sufficient. |
| 5. | Section 42 | <p>Section 42 was amended by:</p> <p>(i) inserting the following proviso below subsection (1):</p> <p>“Provided that the Managing Director may at the request of the applicant, publish the application before the expiry of eighteen months.”</p> <p>(ii) Inserting the following new subsection immediately after subsection (3)-</p> <p>(4) The Cabinet Secretary may make regulations for the carrying out of the provisions of this section.</p> | To allow patent applications to be published before 18 months at the request of the applicant. |
| 6. | Section 44 | <p>Section 44 was amended by:</p> <p>(i) deleting sub section (1);</p> | This provision was not necessary and has never been implemented. In practice all patent applications are subjected to substantive examination. |
| | | <p>(ii) deleting subsection (2) and substituting thereof the following:</p> <p>(2) Where an application for a patent satisfies the requirements specified in section 41(7), the Managing Director shall notify the applicant who shall within five years from the filing date of the application, submit a request as prescribed for examination of the application pursuant to the provisions of subsection (3):</p> <p>Provided that where no request is made within the prescribed period, the application shall be deemed to be abandoned.</p> | The amendment increases the period for requesting substantive examination from three years to five years. This is to address a problem with PCT applications which enter national phase in the 30 th month (21/2 years) from international filing date, which means that such applicants have only about six months to apply for substantive examination. This is usually a short time considering that most of the PCT applications are by persons who are non-Kenyan residents. |

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| | | (iii) Adding the following new paragraph- 3(c) the application complies with the requirements of unity of invention prescribed in section 35. | To allow examination for compliance with unity of invention during substantive examination rather than as a separate examination. |
| | | (iv) deleting sub section (4); | This provision was not necessary since examination of applications is already provided under sub section (3). |
| | | (v) deleting sub section (5); | The provisions under this subsection have been incorporated in the amendment effected to section (44) (3) (c) above. |
| | | (vi) deleting sub section (6); | The deleted provisions are part of procedure and they will be transferred to the Regulations. |
| | | (vii) deleting subsection(7) and substituting thereof the following: (7) Where the Managing Director is of the opinion that any of the conditions referred to in subsection (3) are not fulfilled, he shall notify the applicant accordingly and invite him to make his observations, and where applicable, to amend his application. | This amendment follows from the amendment effected to section 44 (3) above and provide for the correct cross-reference. |
| | | (viii) deleting (2) and substituting thereof (3) in subsection (8). | To provide for appropriate cross-reference. |
| 7. | Section 45 | Section 45 was amended by inserting the expression "41 or" immediately before the expression "44" in subsection (1). | To insert a missing reference and to prescribe other granting procedures in the Regulations. |
| 8. | Section 54 | Section 54(2) was amended by deleting the words "the Institute" and substituting thereof the words "a relevant authority". | According to the Act, Institute means the Kenya Industrial Property Institute (KIPI). However, KIPI does not give marketing approval. This is done by other authorities such as the Pharmacy and Poisons Board, in the case of pharmaceutical products, or the Pest Control Products Board in the case of |

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| | | | pesticides. The effected amendment clarifies this position. |
| 9. | Section 82 | Section 82 (2) was amended by: (i) Inserting the expression "42" immediately after the expression "24". (ii) Inserting the following new subsection immediately after subsection (2)— (2A) An application for a utility model certificate shall be published in the Industrial Property Journal upon compliance with the requirements of section 41. | To provide for publication of utility model applications upon compliance with formal requirements rather than after 18 months. |
| 10. | Section 103 | Section 103 was amended by deleting subsection (2). | The deleted subsection was a repetition of and contradicted subsection (1). |

Dated this 30th day of June 2017

**Mr. Sylvance A. Sange
Managing Director**