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Utility Models in Kenya

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15.1 CONTEXTUALIZING THE KENYAN UMC

From independence in 1963 until 1990, patents in Kenya were extensions of patents filed and granted in the United Kingdom. From 1990 until 2001, patent and UMC (utility model certificate) applications in Kenya were filed under The Industrial Property Act, Cap. 509, which commenced on February 2, 1990. The same law created the Kenya Industrial Property Office (KIPO, now known as the Kenya Industrial Property Institute, KIPI), which, unusually for African patent offices, includes an examiner corps for carrying out substantive patent examination. Applications are currently filed under the Industrial Property Act of 2001 ("IPA2001"), which repealed Cap. 509 and was passed in response to the requirement for modernization under TRIPS. In practical terms, however, the Industrial Property Act of 2001 is similar in most respects to Cap. 509, and changed little for the procedures applied to applications for patents and UMCs.

To obtain exclusionary rights in Kenya for inventions, applicants have numerous options. The legal framework includes the option to file national applications directly at KIPI, and the applicant may file the application as either a patent or UMC. In both cases, the applicant may also elect to file the application as a "provisional" or "final" specification – in the case of the former, a final specification must be filed within 12 months from the filing of the provisional application, and must claim priority to the provisional application, which automatically expires at the end of that period.

Alternatively, applicants can enter the national phase in Kenya after filing an application through the Patent Cooperation Treaty (PCT). Applications can enter the national phase either as patent or UMC applications. Local applicants can access the PCT either through KIPI, as a Receiving Office, or by filing directly through the International Bureau. PCT applications can claim priority to Kenyan national applications, whether such applications are for patents or UMCs.

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As a third option, protection can be obtained through the regional system, the African Regional Intellectual Property Organization (ARIPO), for which Kenya is a founding member and a signatory of the Harare Protocol on Patents and Industrial Designs. ARIPO receives, processes, and grants or rejects applications independently of the national patent offices for its various member states. Both patent and UMC applications are possible through the ARIPO route. After ARIPO receives, examines, and decides to grant a patent or UMC, it notifies the member state national offices that have been designated by the applicant, and gives such offices a period of time to object to the grant of the patent or UMC.[1] If no objection is raised, the application proceeds to grant, and the granted patent or UMC has the effect of a patent or UMC granted by the national office.

The IPA2001 takes a very favourable position toward encouraging innovation, in particular by allowing UMCs that grant patent-like protection for inventions that do not meet the threshold of inventive step. The law goes even further, providing a form of intellectual property referred to as "technovations", which are designed specifically to reward innovation and innovative thinking by employees of companies. A "technovation" is defined as

> a solution to a specific problem in the field of technology, proposed by an employee of an enterprise in Kenya for use by that enterprise, and which relates to the activities of the enterprise but which, on the date of the proposal, has not been used or actively considered for use by that enterprise.

This definition means that, in contrast to patents and UMCs, technovations require neither global nor national-level novelty, but rather merely require company-level novelty (i.e., the technology is novel within the company in which the employee works). An employee may suggest to their employer a technology that they developed or that was found from another source. If the company had not yet used or considered using the technology, and certain other requirements are met,[2] the employee is then entitled to receive a Technovation Certificate from the company. The employee may, then, also be entitled to receive remuneration from the company. The origin of technovations is a model law developed by WIPO in 1980, and that model law was adopted almost verbatim by Kenya.[3] Technovations appear to exist, however, only in the laws of Kenya and Uganda.[4]

[1] Objections can be raised, for example, if the application violates national law in terms of subject matter eligibility, or on grounds that the patent or UMC would go against "public order".

[2] For example, Section 95 of the IPA2001 also requires that the duties of the employee should not be making and proposing technovations – i.e., the employee should not be regularly tasked with innovating for the company.

[3] WIPO 1980.

[4] WIPO LEX database.

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15.2 NOTABLE ASPECTS OF THE LEGAL FRAMEWORK FOR UMCS IN KENYA

The legal framework for UMCs in Kenya consists of a mere three sections in the IPA2001; more detail was not necessary, as the legislative drafters applied many of the provisions of patents mutatis mutandis. The UMC therefore resembles patents, with the same bundle of rights and mechanisms of enforcement, but with key distinctions. The three sections, then, specify the differences between UMCs and patents, and are described below.

The substantive requirements for a UMC are novelty and industrial applicability; inventive step is not required, as it is in patents. Substantive examination by KIPI is a requirement for patents, and was originally also carried out for UMC applications. A major change occurred in 2014 when KIPI ceased to perform substantive examination of UMC applications after an applicant claimed that the IPA2001 did not authorize that procedure.[5] The validity of this claim has been reviewed and refuted, although KIPI did not resume examination, and all applications since 2014 remain unexamined. Without a substantive examination process, UMCs are now granted roughly 18 months after the filing date (assuming all fees are paid). This also means there is not (or should not be) a presumption of validity in any litigation involving a UMC granted after 2014.

The term of a UMC was, under the original IPA2001, 10 years as measured from the date of grant of the UMC. Considering that patent terms were 20 years measured from the filing date, and that substantive examination and grant procedures for patents could take numerous years, the effective term of UMCs could be relatively similar to that of patents. This was changed in a 2007 amendment to the IPA2001, and UMC term is now 10 years from the filing date.

In another key distinction, potentially inconsistent language in the IPA2001 raises questions about eligible subject matter. Section 82 of the IPA2001 lists sections of the patent law that "shall not apply" to UMCs, but does not include Sections 21 and 26, which collectively address subject matter eligibility. Section 21 provides that "inventions" are patentable, including both products and processes, while a subsequent subsection as well as Section 26 list non-patentable subject matter (discoveries, scientific theories, etc.). This framework seems to imply that the subject matter available for UMCs is the same as the subject matter available for patents. This interpretation is either conflicting with, or perhaps modified by, the express definition of "utility model", which is provided in Section 2 of the IPA2001:

> "utility model" means any form, configuration or disposition of element of some appliance, utensil, tool, electrical and electronic circuitry, instrument, handicraft mechanism or other object or any part of the same allowing a better or different functioning, use, or manufacture of the subject matter or that gives some utility,

[5] Author's personal communication with KIPI.

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> advantage, environmental benefit, saving or technical effect not available in Kenya before and includes micro-organisms or other selfreplicable [*sic*] material, products of genetic resources, herbal as well as nutritional formulations which give new effects.

This express definition seems to exclude processes (among other things allowed for patents) from eligibility for protection by UMCs. Nevertheless, as noted above, Section 21(2), relating to patent subject matter, applies to UMCs, mutatis mutandis, and specifies that inventions can be either products or processes. No judicial decisions and no guidance from the Office of the Registrar at KIPI have clarified this apparent contradiction.[6]

Under the IPA2001, infringement and legal proceedings pertaining to revocation or invalidation are the same for UMCs and for patents. Notably, for both patents and UMCs, Section 103 of the IPA2001 provides that revocation and invalidation may be litigated on grounds of lack of novelty,[7] lack of sufficient written description, subject matter ineligibility, lack of disclosure of the best mode, or material misrepresentation in the filing documents, but may not be based on the grounds that there is a lack of inventive step.

15.3 TRENDS IN THE ACQUISITION AND USE OF KENYAN UMCS

As a fully fledged form of intellectual property right, a variety of tactics are possible for users of UMC systems. As discussed throughout this volume, in some countries, the utility model and patent systems are integrated, or are intended to operate in a complementary fashion. One or more of a variety of factors may lead to this situation: applications may be easily converted from UMCs to patents (and vice versa), or it may be possible to hive off a UMC from a patent application; there is no prohibition against obtaining a patent and UMC for the same invention; one system covers classes of inventions that are not eligible for protection in the other system, etc. In Germany, for example, UMCs are used primarily by patent applicants in a strategic manner, particularly since the (unexamined) UMC can be filed based on an existing patent application, and will proceed to grant substantially more quickly than the (examined) patent application (see Chapter 6). An applicant might obtain a UMC in order to signal to the market their claim of ownership to a particular technology, and to quickly initiate legal proceedings without waiting for the examination process.

In contrast, the UMC and patent systems exist in Kenya largely as substitutes for one another. Although conversion between patent and UMC applications is possible under Section 83 of the IPA2001, rather than a strategy for using the systems in

[6] But see note 15, and associated text for a discussion of a case that addresses invalidity of a UMC.

[7] See note 15. The cited case involved a claim of invalidity over a lack of novelty, among other defects.

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a complementary manner, it typically is the result of a substantive rejection during examination of a patent application. It may also occur where the applicant decides not to wait through the process of substantive examination, or would prefer to forgo examination fees and to pay the lower annual fees of a granted UMC as compared with the granted patent.[8] Although there is no prohibition under the IPA2001 against simultaneously holding a patent and UMC for the same invention, it is not common in practice.

The first application for a UMC in Kenya was filed in 1993 by the International Centre for Insect Physiology and Ecology (ICIPE), an international research institution with strong ties to the region. Growth in the number of applications remained slow for some time, and by 2011, only about 240 applications were on file, with 60 of those having been granted as UMCs.[9] As noted above, KIPI ceased substantive examination of UMC applications in 2014. Without the gate-keeping function of examination, the number of granted UMCs increased after 2014.

The applicants for UMCs in Kenya are predominantly local (i.e., the applicant has a Kenyan address).[10] In UMCs granted through 2016, applicant identity was reported as follows: 87% local filers, 1% foreign filers, and 12% unknown.[11] This trend remains consistent: for the 210 UMCs granted in the period 2020–2023, 200 (95%) have local applicants and 10 (5%) have foreign applicants.[12] Interestingly, comparing the same periods for patents, the proportion of local applicants has dramatically increased. Whereas 168 of the 725 patents (23%) granted through 2016 had local applicants, local applicants accounted for 65 of the 162 patents (40%) granted in the period 2020–2023. This may represent an increase in the level of innovation, and/or an increase in the use of the patent system by local innovators.

The identities of UMC applicants have evolved over time. Out of the 210 UMCs granted within the period 2020–2023, 84 (40%) list a company as the applicant, 22 (10%) list a university, and one (<1%) lists a government entity.[13] The remaining 103 UMCs (49%) list an individual (or several individuals) as the applicant. These

[8] Fees are provided in the Industrial Property Regulations 2002, Second Schedule. For example, an application fee for a patent is 3,000 KES, but for a UMC is only 1,000 KES. Annual fees for patents range from 2,000 KES in the first year to 50,000 KES in the 20th year. Annual fees for UMCs range from 1,000 KES in the first year to 5,500 KES in the final (10th) year. An examination fee of 5,000 KES applies only to patent applications.

[9] A small number of the remaining 180 applications were granted after 2011, but most were abandoned at the application stage.

[10] The data in this paragraph are reported for national-route applications filed directly at KIPI or national phase applications filed through the PCT. ARIPO-route applications are not considered.

[11] See Rutenberg 2017, 212. For the 12 "unknown" applicants, no data was present in the dataset received from KIPI, but presumably all 12 applications have local applicants. A "local" applicant is one in which the official KIPI record lists a Kenyan address.

[12] Data obtained directly from KIPI.

[13] In the data provided by KIPI, "companies" are assumed for any applicant name that includes "Limited", "LTD", "store", "trust", "pharmaceuticals," or other obviously commercial terms.

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percentages indicate strong growth in filings in the corporate sector – for all granted UMCs until 2016, only 20% listed a corporate applicant.[14] This suggests that the innovation ecosystem in Kenya is increasingly favouring innovation in the private sector (or, at least, that the private sector is increasingly using the UMC system).

Litigation involving UMCs is rare, and most of it proceeds in the Intellectual Property Tribunal (IPT). In one case before the IPT,[15] the UMC at issue was directed to "a computer implemented banking system" consisting of components that are enumerated and described, and the system "is utilized for payment processing between conventional and business banking channels."[16] In response to the accusation of infringement of the UMC, one of the defendants argued that "the invention does not relate to an art, process, use, machine, manufacture, or composition of matter", as well as arguing that the protected invention lacked industrial utility, lacked a complete written description, and lacked novelty, among other arguments. Interestingly, in view of the discussion above regarding allowable subject matter for UMC protection, the defendant did not argue that the UMC was invalid for claiming unprotectable subject matter (i.e., a process). The IPT also did not address whether UMCs may claim processes, but instead held the UMC invalid for being directed to a "mere method of doing business" which is "not capable of protection as provided under section 23(3)(b) of the industrial property Act." The IPT also held that the invention lacked a "technical effect," and on this point cited, as informative, precedent in the Supreme Court of the United States.[17]

In a second case before the IPT,[18] the defendant was accused of infringing seven separate UMCs (all owned by the plaintiff) drawn to various household fixtures. The case was dismissed as the IPT concluded that there was insufficient objective evidence on record to support the accusation of infringement. The case is therefore notable for setting a minimum evidentiary standard in cases of UMC infringement.

15.4 TRENDS IN THE ACQUISITION OF UMCS AT ARIPO

The Harare Protocol, which implements the patent system at ARIPO, entered into force in 1984, and the first patent applications were filed at ARIPO that same year.[19] Although the Harare Protocol also provides for utility models, the first UMC application serial numbers date from 2001. It is unclear whether there were no

[14] Rutenberg 2017, 212.
[15] In re Request for Relief by Alex Muigai Muchiri and Itesyl Technologies (IPT 2021).
[16] Quoted material is from the abstract of UMC 315, as restated in the IPT judgment. The text of the claims of the UMC are not recited in the judgment.
[17] *Mayo Collaborative Services* v. *Prometheus Laboratories, Inc.*, 566 U.S. 66 (2021).
[18] *Zaidat Limited* v. *Fenesi Management Limited and Fenesi Limited* (IPT 2020).
[19] See Section 15.1 for a description of the process and territorial effects applicable to ARIPO patents and UMCs.

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utility model applications before 2001, or whether ARIPO was not at that time assigning serial numbers that identify them as such.

Although ARIPO receives and processes a large number of patents compared with the national patent offices of member states, it receives a relatively low number of utility models. Data were obtained for filings between 2001 until the beginning of 2023.[20] During that period, 224 utility model applications were received and assigned filing numbers. In contrast, by the end of 2021, over 13,000 patent application serial numbers had been assigned at ARIPO. The pool of patent and UMC applicants at ARIPO is diverse inasmuch as it represents a large number of countries – both within and external to the regional membership. This includes applications originating from countries without Utility Models, such as the United States. It is not surprising, then, that the more popular filing option is the patent route.

15.5 CONCLUSION

The Kenyan legal framework for UMCs provides a cheaper, faster alternative to patents. The UMC is also attractive as it is available to inventions that are merely novel, and would not necessarily satisfy the inventive step requirement for patents. These advantages are balanced by the shorter term and unexamined nature of the UMC, which may make a granted UMC less valuable to applicants seeking longer, more certain protection. In general, UMCs are primarily used by local applicants, and are a valuable legal instrument for delivering patent-style rights to local innovators.

[20] Data obtained from Patentscope, a service of the World Intellectual Property Organization. In a Patentscope search of all patents filed in ARIPO, 52 records have serial numbers that begin with "AP/U" (as opposed to "AP/P", indicating a patent application). The most recent entry has a filing date in February 2023, and a serial number of 224. Assuming that serial numbers are sequential for all filed applications, this indicates that at least 172 UMC applications are not included in the records of Patentscope.

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