



Customs protection in Kenya

Background

A French company was selling its products in South Sudan. Although it had no market in Kenya, it had protected its trade mark in Kenya under the Madrid Protocol and had established its office for South Sudan in Kenya. Out of the blue, their Kenyan office was informed of the seizure of goods suspected of infringing their trade marks rights by the Anti Counterfeit Authority at a seaport. As the company did not sell its products in Kenya, it suspected that the goods had been brought by sea into Kenya and would later have been transported by trucks into South Sudan.

Action undertaken

The French company filed a complaint with the ACA through a signed complaint form. In addition, the company provided an affidavit stipulating the reasons as to why the goods were counterfeit, the registration certificate and the signed indemnity form relieving the Agency from any claim for wrongful seizure.

The company did not want to reach a settlement and the ACA launched criminal proceedings against the importer.

The French company has now filed an application for the recordal of its IP rights with the ACA.

Lessons learned

- The importance of considering trade routes for your registration strategy. Although the firm was not selling its products in Kenya, it knew that Kenya is a shipping and transport hub for East Africa. Counterfeits were likely to pass through Kenya.
- The importance of filing for recordal. The counterfeit goods were found by the ACA. IPR owners should not rely on always being so lucky and should take advantage of the possibility of applying for a recordal, either with the ACA or the Commissioner of the Kenya Revenue Authority (KRA) to protect their rights.
- In Kenya, criminal matters may only be prosecuted by an officer from the Office of the Director of Public Prosecution or designated officers in other government institutions. However, a rights holder may hire a lawyer to oversee the process, liaise with the designated prosecutor to ensure that the IPR owner interests are protected during the entire process and be up-to-date on the progress of the matter.
- Whether goods are considered counterfeit is a matter of evidence in court. The rights holder must therefore provide a clear and detailed analysis as to why the goods are counterfeit. The analysis affidavit must preferably be written by an expert involved in the production of the relevant goods who possess current special knowledge/skills in the relevant features of the products.

Contacts us:

africaiphelpdesk.eu

E-mail: africa.iphelpdesk@euipo.europa.eu

Phone Number: Europe (Spain): +34 96 513 9810

Opening hours: Monday to Friday
8:30 to 18:30 (CET/CEST)

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