

Shem Otanga

Partner



Shem Otanga is a Partner in our Technology, Media & Telecommunications sector. Shem specialises in Intellectual Property and data protection.

About Shem

Shem started his legal career as Trainee Lawyer at a firm in Kenya and was appointed as an Associate in 2010. He then joined another firm as Principal Associate in 2016 and was appointed as a Senior Associate in 2017. Shem also worked as a seconded lawyer at Mayer Brown International LLP(UK) and Brick Court Chambers in 2018 (as part of the International Lawyers for Africa (ILFA) Flagship Program). In 2020 Shem joined Kieti Advocates LLP as a Partner.

Credentials

Education

- Advanced Certification in Patents, World Intellectual Property Organisation (WIPO) Academy, Geneva
- Advanced Certification in Intellectual Property Law, WIPO Academy, Geneva
- Postgraduate Diploma in Law, Kenya School of Law & Kenyan Bar Admission
- LL.B, Bachelor of Laws (2nd Class Honours, Upper), University of Nairobi, Kenya

Memberships

- Co-chair of the International Trademark Association's Global Advisory Council for Africa (AGAC)
- International Trademark Association's Data Protection Committee
- International Association of Privacy Practitioners (IAPP)
- Law Society of Kenya
- Member, Famous and Well Known Marks Committee, International Trade Marks Association, (INTA), (January 2018 to – present).
- Council Member, Africa Global Advisory Council (GAC), International Trade Marks Association, (INTA), (February 2020 to – present).
- Member, IP & ICT Law Committee, Law Society of Kenya (LSK – Nairobi Chapter) (May 2017 to 2019).
- Member, IP & ICT Law Committee, Law Society of Kenya, Law Society of Kenya (LSK) (May 2012 – January 2014).

Contact Shem

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Expertise

Corporate & Commercial Law

Consumer Goods, Services & Retail

Gambling & Regulatory Compliance

Technology & Communications

Industrials, Manufacturing & Trade

Location

Nairobi

Language

English

Swahili

Experience

- **Kenyan listed bank**

Advising a leading Kenyan listed bank on the review and re-negotiation of the material terms of its key banking software licence granted by Oracle Inc. including a review of the historical series of amendments to the licence and redrafting the 4th amendment thereto.

- **Video on demand service provider**

Advising a South African online subscription video on demand service provider on its regulatory and copyright related royalty fee obligations in Kenya.

- **Data protection**

Advising a leading international parcel delivery service provider on data protection in relation to collection and use of its customers' personal data in Kenya.

- **International fertiliser manufacturer**

Advising a leading international fertiliser manufacturer on the data protection implications under the European Union's General Data Protection Regulation (EU GDPR) as well as Kenyan and Tanzanian data protection law in relation to the collection of personal data for its COVID 19 related aid program for farmers in Africa as well as the drafting and review of its software platform's terms of use and various privacy policies to ensure compliance with data protection law under the said regimes.

- **Tech start-up**

Advising the tech start-up arm of a Kenyan listed marketing and communication company in relation to the drafting and review of its privacy policies for use in Kenya, Tanzania, South Africa, Uganda, Zambia and Ghana.

- **Non-Contentious IP experience**

Acting for one of the world's largest security companies in connection with filing and prosecuting various trade mark applications in a number of African countries, including Kenya and Tanzania.

- **Non-Contentious IP experience**

Advising a leading Kenyan bank with regional presence on its rebranding process and filing and prosecuting the registration of its new trademark in Kenya as well as co-ordinating the filing and prosecution process through local counsels in various sub-Saharan African countries including DRC, Mozambique, Rwanda and Ethiopia.

- **Non-Contentious IP experience**

Advising a pan African bank on its rebranding process including filing and prosecuting the registration of its trademarks through both national and international registration systems (Madrid) as well as co-ordinating the filing and prosecution process through various local counsels in sub-Saharan Africa for non Madrid member states.

- **Non-Contentious IP experience**

Acting for a pan African university, in connection with filing and prosecuting various trade mark applications in a number of African countries, including Kenya, Nigeria, Zambia, Ethiopia, Ghana, South Africa, Tanzania and Uganda.

- **Contentious IP experience**

Representing a Fortune 500 computer technology company in successful trade mark opposition proceedings against a local Kenyan company that wrongfully sought to register the computer technology company's trade mark.

- **Contentious IP experience**

Representing a leading international motor vehicle manufacturer in 3D trade mark opposition proceedings against an international SUV manufacturer.

- **Contentious IP experience**

Representing an Ivy League university in successful trade mark opposition proceedings against a local Kenyan company that had wrongfully sought to register the said university's trade mark.

- **Contentious Intellectual Property experience**

Acting as assisting counsel in successful trademark opposition proceedings filed on behalf of a Dubai based soft drinks manufacturer against Trademark Application Numbers 62286, 62287 and 67859 (Words And Device) in Class 32 (2010 - 2012).

- **Contentious IP experience**

Representing one of the world's leading beer manufacturer in opposition proceedings against two trade mark registration applications filed by an international competitor and defending the said client in expunction proceedings filed by the said competitor against the client's existing trade mark registrations.

- **Contentious IP experience**

Successfully representing a Kenyan paper bag manufacturing company on the recovery of its domains names from a cybersquatter.

News

[Cracking the whip: Implications of the recent imposition of penalties by the Office of the Data Protection Commissioner in Kenya](#)

On 26 September 2023, the Office of the Kenyan Data Protection Commissioner (ODPC) issued a press release (2023 ODPC press release) indicating that it had imposed penalties on a number of data controllers for the infringement of the privacy rights of data subjects and non-compliance with the requirements of the Data Protection Act (DPA).

[Developments and changes in the Kenyan tax landscape: Tax outlook for 2023](#)

[Renewed efforts by the taxman to collect rental income tax](#)

The Kenya Revenue Authority (KRA) will soon be knocking on your tenant's door to find out how much the tenant pays as rent and who is the owner of the property. On 18 October 2022, the KRA issued a notice to the public of its intent to undertake a data collection exercise on rental properties within Nairobi City County and the Nairobi Metropolis as part of its tax base expansion programme. The taxman's move to get information about landlords from tenants represents a change in approach on the KRA's part as it has previously collected similar information through the Kenya Power and Lighting Company (KPLC) and other agencies.

[Cracking the whip: The supervisory power of the Office of the Data Protection Commissioner in Kenya](#)

On 5 October 2022, the Office of the Data Protection Commissioner (ODPC) issued a press release stating that it would be conducting a preliminary documentary assessment and audit on 40 digital lenders that have been subject to complaints raised by various members of the public. In the press release, the ODPC stated that it had received a total of 1,030 complaints by the end of September 2022, out of which, 555 complaints had been admitted for investigation.

[Extension of implementation date for recordation of intellectual property rights](#)

Kenya established the legal framework for the recordation of trademarks and other intellectual property rights (IPRs) through the amendment of the Anti-Counterfeit Act (Act) in 2019, and the adoption of the Anti-Counterfeit (Recordation) Regulations, 2021 (Regulations). The mandate of implementing this legal framework is bestowed upon the Anti-Counterfeit Authority (ACA), which is the regulatory body that is established under the Act to combat counterfeiting, trade of, and other dealings in counterfeit goods in Kenya.

Videos

[Trademarks and rebranding](#)

Trademarks represent a form of intellectual property that is rooted in the heart of every business. It provides businesses with a unique identity for the brand, its products and/or services, which is how the enterprise connects with their stakeholders. A brand's identity is often refreshed, through corporate and commercial rebranding exercises which, by their nature, can affect its entire conceptual framework or structures such as its manifesto, mission and vision statement, core product line, etc. In this video, Shem Otanga, a Partner in CDH Kenya's IP, Technology, Media and Telecommunications practice, unpacks some of the legal and practical considerations that business owners should bear in mind while carrying out corporate and commercial rebranding exercises.

Re-thinking industrialization in Kenya and the East Africa Community. What does the future hold?

CDH in partnership with the French Chamber of Commerce Kenya hosted an informal breakfast event to discuss matters that affect the future of business in an everchanging market.

CDH's Industrials, Manufacturing & Trade Sector

CDH's Industrials, Manufacturing & Trade Sector is strategically positioned to provide clients with support to navigate international, regional, and domestic policy, domestic regulatory and legal nuances to tap into the African market.

LGC Pulse with Kieti Law LLP

LGC Pulse with Kieti Law LLP

Kenya's Data Protection Act, 2019

Partner Shem Otanga discusses Kenya's Data Protection Act, 2019.

Podcasts

Njeri Wagacha provides a summary of the year's recordings

Every month CDH Kenya Partner Njeri Wagacha publishes a podcast 'Njeri Talks Law'. In this final podcast for 2022, Njeri extends her gratitude to her listeners for accompanying her on your journey and provides a summary of her 2022 podcasts.

Renewed efforts by the taxman to collect rental income tax

On 18 October 2022, the Kenya Revenue Authority (KRA) issued a notice to the public of its intent to undertake a data collection exercise on rental properties within Nairobi City County and the Nairobi Metropolis. This exercise, which entails moving from house to house to collect information from tenants on their landlords, has elicited reactions from the public. Accordingly, the taxman's move raises a lot of questions, for tenants, landlords, and the public at large. Some of the key questions that need to be addressed include: what Rental Income Tax (RIT) is, how it is paid, how KRA can enforce payment of RIT under the law, the parts of the country where KRA's data collection exercise be conducted, whether KRA has conducted similar data collection exercises before and what the key data protection issues are. Click here to listen as Alex Kanyo, Shem Otanga, and Joseph Macharia provide some clarity on the taxman's data collection exercise, its legal founding under current law, and the implications to taxpayers and KRA.

Njeri Wagacha talks to Shem Otanga

On this month's podcast, Njeri talks to fellow Partner Shem Otanga on the Data Protection Registration Regulations, the requirements for registration in Kenya, what it means to be a Data Controller or Data Processor. He further discusses the need for Data Protection Regulation across Africa and case law regarding this.

NjeriTalksLaw - Episode 1 | Formation and Beyond

In this episode, Njeri talks to Partners, Sammy Ndolo and Shem Otanga, about starting and growing a law firm.

[All news by Shem Otanga →](#)

Recognition

- Chambers Global
 - Chambers Global 2024 ranked Shem Otanga in Band 2 for intellectual property.
 - Chambers Global 2021–2023 ranked Shem as "Up & Coming" intellectual property lawyer. From 2019–2021 he was ranked as "Lawyer to watch" for intellectual property.
- World Trademark Review 1000 2024 (Kenya) ranked Shem in the bronze category.
- World Trademark Review 1000 2018–2020 (Kenya) ranked Shem as a recommended Individual.