



## Shem Otanga

### Partner

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

#### Practice areas

Technology, Media & Telecommunications

#### Sectors

Consumer Goods, Services & Retail  
Gambling & Regulatory Compliance  
Technology & Communications  
Industrials, Manufacturing & Trade

#### Contact Details

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#### Career

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.

#### Experience

##### Transactional/Advisory IP/ICT/TMT & Data Protection Experience

- 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 4<sup>th</sup> amendment thereto.
- Advising a South African online subscription video on demand service provider on its regulatory and copyright related royalty fee obligations in Kenya.
- Advising a leading international parcel delivery service provider on data protection in relation to collection and use of its customers' personal data in Kenya.
- 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 famers 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.



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- 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.
- Advising the Sydney based office of Baker McKenzie on behalf of its client, a leading multinational financial and payment service provider, on the data protection implications of a new/intended payment services program at the pre-launch stage.
- Advising one of the world's largest social media and technology companies in relation to the data protection framework in Kenya including advising on the content of the Constitution, 2010 and the 2018 and 2019 Data Protection Bills.
- Advising a US based cyber security technology company in relation to the data protection review of its end user licence agreements, data subject consent forms and data protection agreements.
- Advising an American multinational technology company that specialises in internet related services and products on the Kenyan data protection compliance concerns relating to the collection and processing of personal data for purposes of its identity verification program for customers of its services.
- Advising an arm of the Japanese Government on the various aspects of the Kenyan Data Protection Act including the adequate and appropriate personal data safeguards required under the law, the extra-territorial application on the Kenyan Data Protection Act, obligations of data processors etc.
- Advising a leading global bank on the Kenyan data protection law implications arising in the context of a legal due diligence in relation to an arrangement for facilitating local payables and receivables (onshore and mobile payments) in partnership with a local bank.
- Advising a leading global money remittance company on the legal and regulatory framework for telecommunication-based advertising in Kenya.
- Advising a Kenyan electronic home appliances retailer in relation to software development agreements for its new line of customer service applications including drafting the said agreements.
- Advising a Kenyan betting, gaming and lotteries operator on its internal restructuring including the offshoring of its IP assets and licensing back of the same to its subsidiaries/joint ventures in various African jurisdictions including the preparation of IP assignment and licensing agreements.
- Advising a Kenyan container freight station operator on the setting up of its state of the art, software operated, command centre including preparing the software development agreement and the permitted use and service level agreements.
- Advising an American university on its IP policy in relation to innovations developed by its students and staff including drafting of template agreements and policy documents for purposes of securing the university's IP rights.
- Advising a leading American pest control company on a proposed franchising arrangement including the licensing of its trademarks to a Kenyan company and advising on arising anti-trust issues.
- Advising a Kenyan based manufacturer of fast-moving consumer products in relation to a distribution and co-branding agreement with a Tunisian company.



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- Advising a Kenyan betting, gaming and lotteries operator in relation to a brand endorsement arrangement with a Kenya national soccer team player including advising on the IP and image rights as well as the anti-trust implications of the proposed brand endorsement model.

### **Non-Contentious Intellectual Property 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.
- 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.
- 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.
- 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.
- Advising a leading Kenyan commercial bank with regional presence on the protection of its domain names against cyber squatters.
- Advising a Kenyan trade union in the banking sector on copyright protection for software.
- Advising a Kenyan inventor on possible patent protection for his software gaming invention and facilitating the prosecution of a Kenyan as well as an international patent application covering 27 jurisdictions under the Patent Co-operation Treaty (PCT).
- Advising a leading US based multinational corporation in the field of agrochemical and agricultural biotechnology on intellectual property and confidentiality in relation to the submission of its research data to the National Biosafety Authority.

### **Contentious Intellectual Property 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.
- Representing a leading international motor vehicle manufacturer in 3D trade mark opposition proceedings against an international SUV manufacturer.
- 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.
- 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).



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

## Market Recognition

- Chambers Global 2022-2023 ranked Shem as "Up & Coming" for Intellectual Property. From 2019-2021 he was ranked as "Lawyer to watch" for Intellectual Property.
- World Trademark Review 1000 2018-2020 (Kenya) ranked Shem as a recommended Individual.

## 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 (2<sup>nd</sup> 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).

## Languages

English, Swahili



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