



# INTELLECTUAL PROPERTY





## INTRODUCTION

The disruptive potential of innovation and the economic value of the intellectual property (IP) assets that it yields cannot be disputed in today's world. A hallmark of progressive businesses is the ability to generate, identify, harness and leverage IP assets to gain significant competitive advantages. Our firm has unique IP law capabilities that make us a key partner for our clients in their efforts to achieve this in Kenya and other parts of Africa. We understand the IP law frameworks that exist on the continent and work together with a network of local counsel in various African jurisdictions to deliver cutting edge legal IP solutions to our clients.

### Why partner with Cliffe Dekker Hofmeyr (CDH)?

With a track record spanning more than 167 years, CDH distinguishes itself from its competition within the African legal market by forging powerful and longstanding partnerships with clients. As trusted advisor and partner, we develop an in-depth understanding of our clients' businesses, enabling us to tailor legal solutions that are both commercial and practical for our clients' transactional and advisory needs.

## About Cliffe Dekker Hofmeyr Incorporating Kieti Law LLP



### Who we are

Cliffe Dekker Hofmeyr (incorporating Kieti Law LLP) is a leading law firm in Nairobi, Kenya, anchored on the tenets of personal service, integrity and excellence. It was formed following the merger of Cliffe Dekker Hofmeyr, a top-tier full service South African law firm and Kieti Law LLP, a leading boutique Kenyan law firm.



### What we do

We are active in intellectual property law, technology media and telecommunications, corporate law, finance, energy, natural resources and climate change, projects and real estate, and dispute resolution. We provide the specialised and personalised legal services of a lean and agile team, at the highest quality.



### What sets us apart

Our team comprises well regarded lawyers with exceptional credentials, who embrace the opportunity to push the law forward in creative and ingenious ways. Our lawyers have been ranked in global legal directories such as the World Trade Mark Review's WTR1000, Managing IP's IP Stars, Chambers Global, IFLR and Legal 500 and have been involved in market leading transactions over the past few years in Kenya's telecommunications, health, education, retail, real estate, energy and natural resources sectors.



### Our pro bono work

We support NGOs and social enterprises actively involved in social change with free legal advice, and are members of Trustlaw, the Thomson Reuters Foundation pro bono referral organisation.



## EXPERIENCE STATEMENT



### Transactional/advisory intellectual property 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 fourth amendment to it.
- Advising a South African online subscription video-on-demand service provider on its copyright related regulatory and royalty fee related obligations 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 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, along with 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 securing the university's IP rights.
- Advising a leading American pest control company on a proposed franchising arrangement, including the licensing of its marks 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.
- 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.
- Advising a clean ethanol fuel distribution group of companies regarding the transfer and licensing back of its intellectual property assets between its Kenyan operating company and the offshore holding company based in Mauritius including drafting and perfecting all the necessary transactional documents.

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### 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 application for the registration of its new trade mark 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 applications for the registration of its marks 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.

## EXPERIENCE STATEMENT..continued



### 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 university's trade mark.
- Acting as assisting counsel in successful trade mark opposition proceedings filed on behalf of a Dubai-based soft drinks manufacturer against Trade Mark Application Numbers 62286, 62287 and 67859 (Words And Device) in Class 32 (2010–2012).
- Representing one of the world's leading beer manufacturers in opposition proceedings against two trade mark registration applications filed by an international competitor and defending the client in expunction proceedings filed by the competitor against the client's existing trade mark registrations.
- Successfully representing a Kenyan paper bag manufacturing company on the recovery of its domain names from a cybersquatter.

## LEAD PARTNER CONTACT

If you have any questions or require any additional information, please do not hesitate to contact us.



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**BBBEE STATUS: LEVEL ONE CONTRIBUTOR**

Our BBBEE verification is one of several components of our transformation strategy and we continue to seek ways of improving it in a meaningful manner.

**PLEASE NOTE**

This information is published for general information purposes and is not intended to constitute legal advice. Specialist legal advice should always be sought in relation to any particular situation. Cliffe Dekker Hofmeyr will accept no responsibility for any actions taken or not taken on the basis of this publication.

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