

Compounding as an ADR Mechanism in Intellectual Property DisputesThe Kenyan Experience under the Anti- Counterfeit Act

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**anti
counterfeit
authority**

Upholding Authenticity

Introduction



- Intellectual Property (IP) disputes require effective mechanisms for resolution.



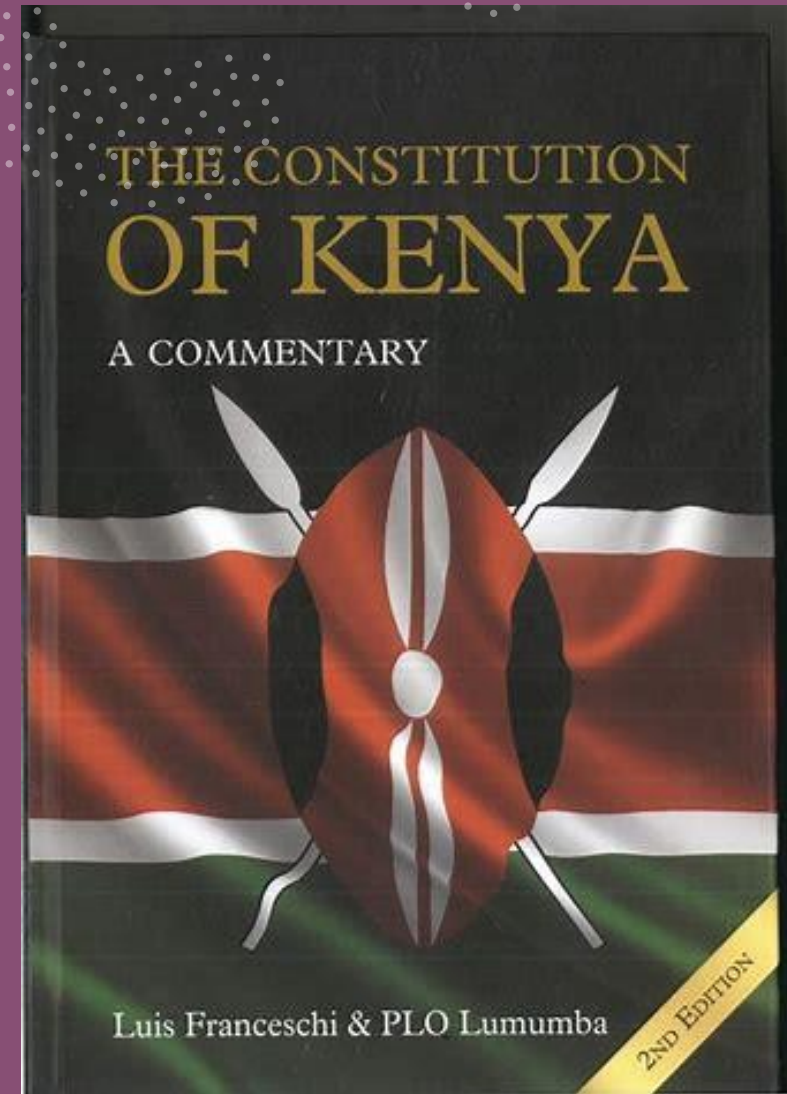
- Alternative Dispute Resolution (ADR) offers efficient and less adversarial approaches.



- Compounding under Kenya's Anti-Counterfeit Act is pivotal in resolving IP disputes.

Legal Framework for IP Protection in Kenya

- Constitution of Kenya 2010 emphasizes ADR under Article 159. Article 40 (5) obligates State to support, promote and protect IP rights of the Kenyan people.
- Anti-Counterfeit Act CaP 510 of Laws of Kenya provides a framework for combating counterfeiting.
- Role of the Anti-Counterfeit Authority (ACA) in enforcing IP rights.



Overview of the Anti-Counterfeit Act, 2008

- Enacted to protect IP rights and combat counterfeit goods.

- Defines offences and penalties related to counterfeiting.

- Establishes the ACA for enforcement and IP protection.

The Role of Anti- Counterfeit Authority

- Public Awareness:** Educate and inform the public on counterfeiting issues.
- Enforcement:** Combat counterfeit goods and related trade in Kenya.
- Capacity Building:** Develop and promote training programs on anti-counterfeiting.
- Collaboration:** Coordinate with national, regional, and international organizations.
- Research & Inquiries:** Conduct research and inquiries into counterfeiting issues.
- Advisory Role:** Advise the Cabinet Secretary on policies to combat counterfeiting.
- Legal Compliance:** Perform additional roles as prescribed by law.
- Incidental Duties:** Execute other necessary or supportive duties.

Understanding ADR in IP Disputes in Kenya

- **Promotion of ADR:** Article 159(2)(c) emphasizes alternative dispute resolution (ADR), mirrored in ACA's **compounding process** to resolve IP disputes outside court.
- **Efficiency:** ACA's ADR ensures swift and cost-effective dispute resolution, reducing court backlogs.
- **Reconciliation:** Facilitates amicable settlements between IP rights holders and offenders, promoting compliance.
- **Access to Justice:** Offers an accessible, non-litigation pathway for resolving disputes, especially for small-scale traders.
- **Administrative Approach:** ACA's compounding aligns with traditional and administrative resolution mechanisms under Article 159.

Compounding as an ADR Mechanism

- Defined under Section 34A of the Anti-Counterfeit Act.
- Allows offenders to settle disputes by paying fines or fulfilling conditions.
- Avoids lengthy court processes while resolving disputes efficiently.

Legal Basis for Compounding

- • Section 34A empowers the ACA's Executive Director to compound offences.
- • Legal provisions ensure fairness and transparency in the process.
- • Compounded disputes are equivalent to High Court decrees.



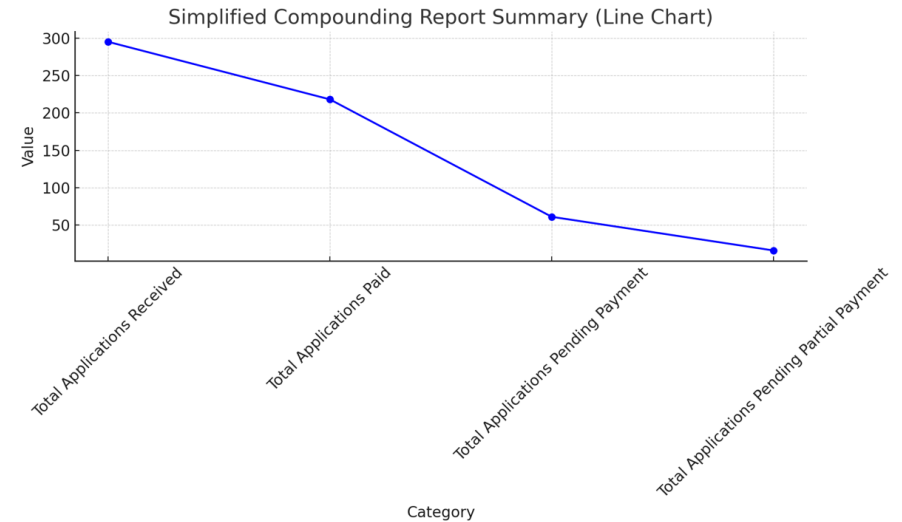


Benefits of Compounding in IP Disputes

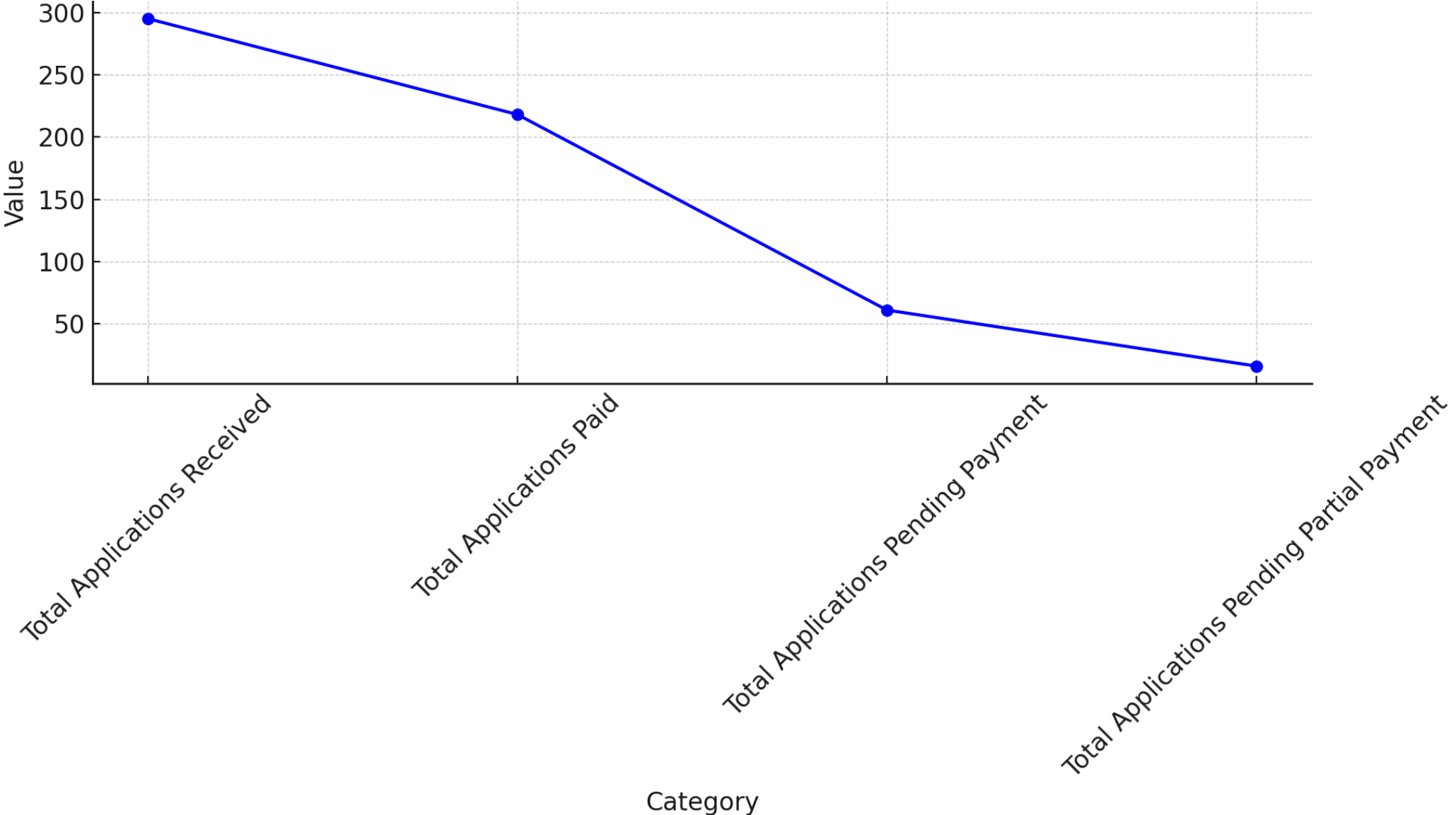
- **Cost-Effective:** Reduces legal and court expenses.
 - **Court Relief:** Eases judicial backlogs.
 - **Flexible:** Allows tailored, amicable settlements.
 - **Compliance:** Encourages corrective actions over prosecution.
 - **Accessible:** Simplifies resolution for small traders.
 - **Fast:** Quick resolution of disputes.
 - **Confidential:** Preserves reputation and relationships.
-

ACA Achievements in Compounding

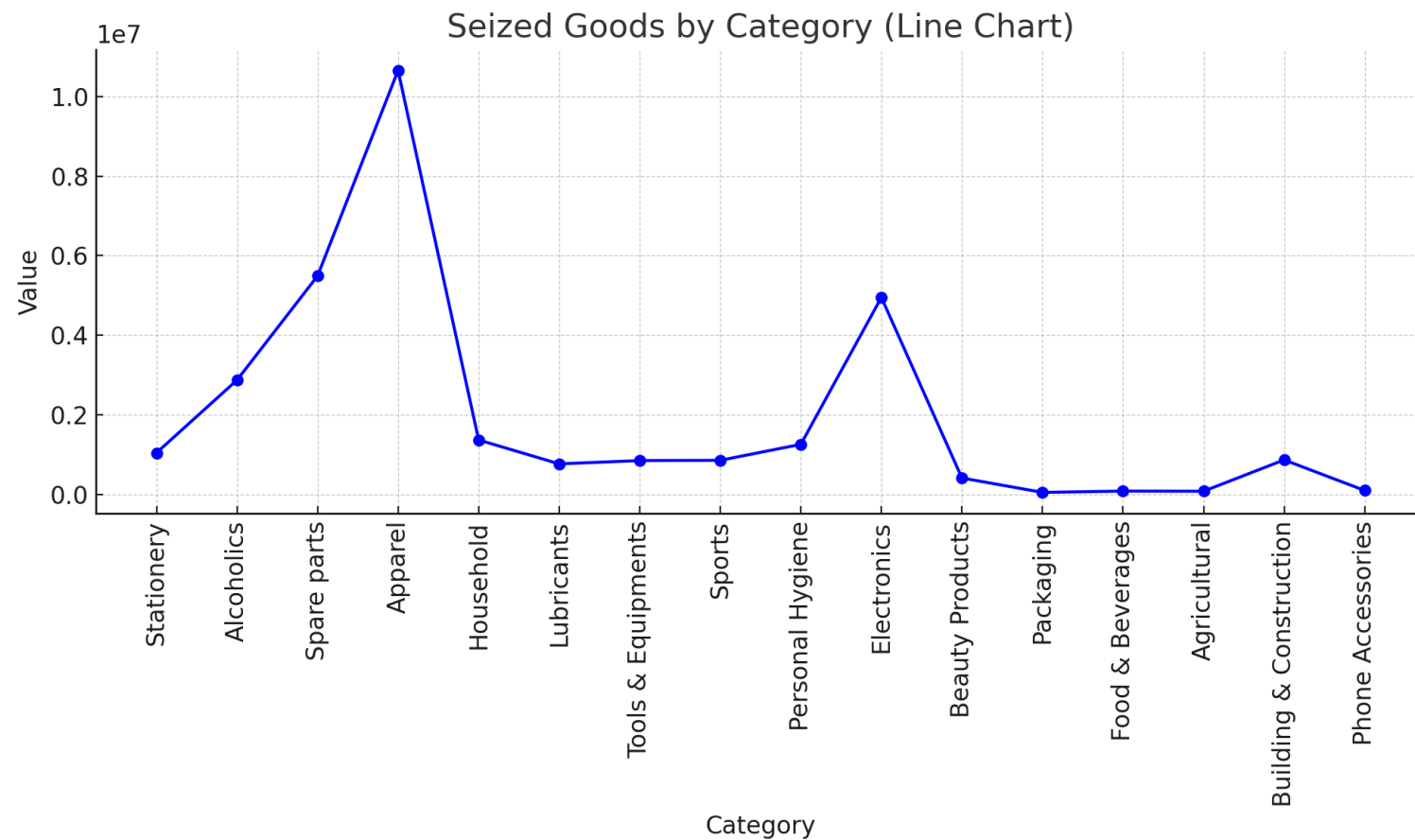
- ❑ •Successful resolution of 300 disputes through compounding since February 2023.
- ❑ The Authority has generated USD 103,164.4 . The funds are being channelled to support enforcement activities.



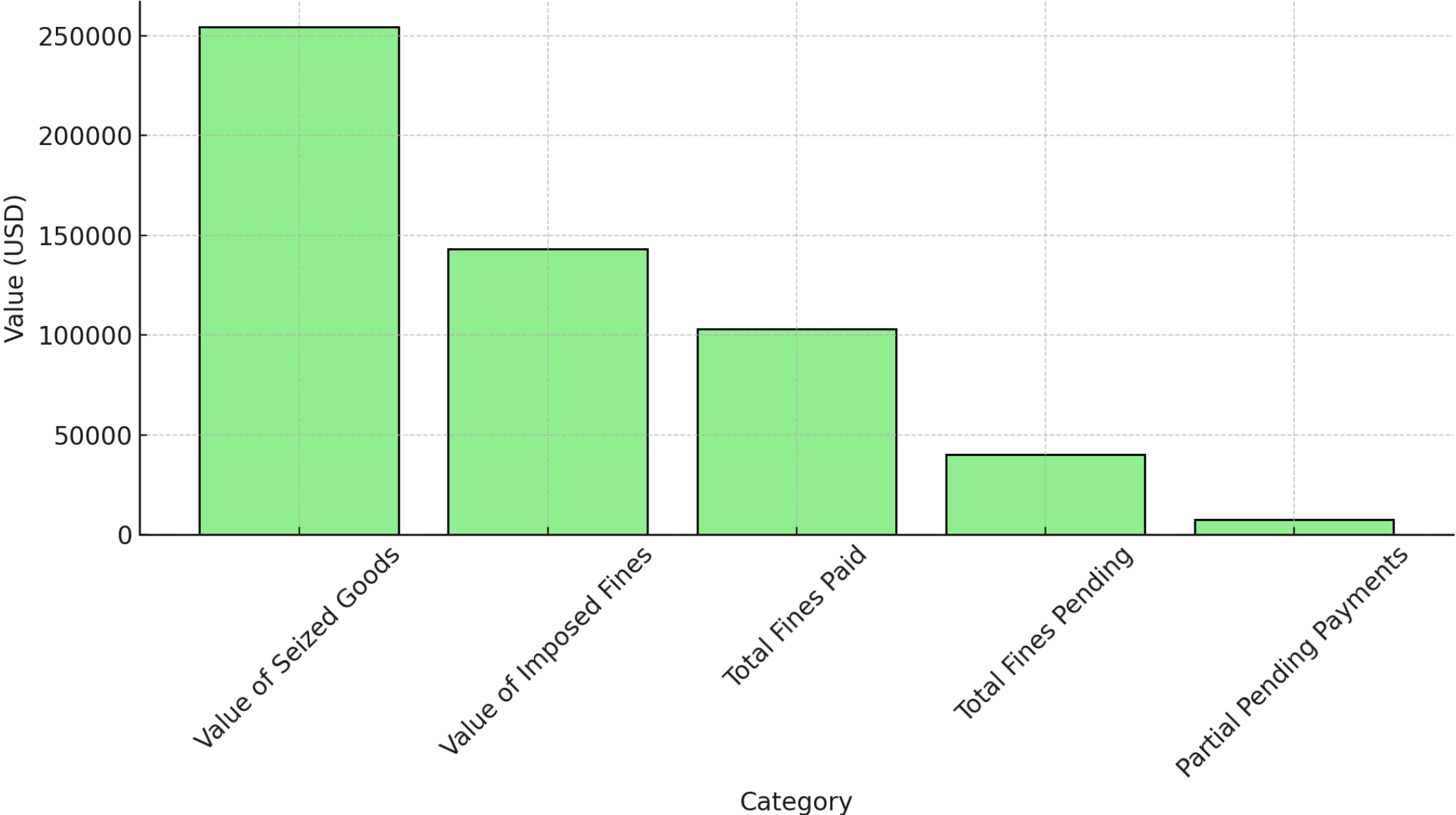
Simplified Compounding Report Summary (Line Chart)



Types of Goods By Category



Financial Data in USD (Bar Chart)

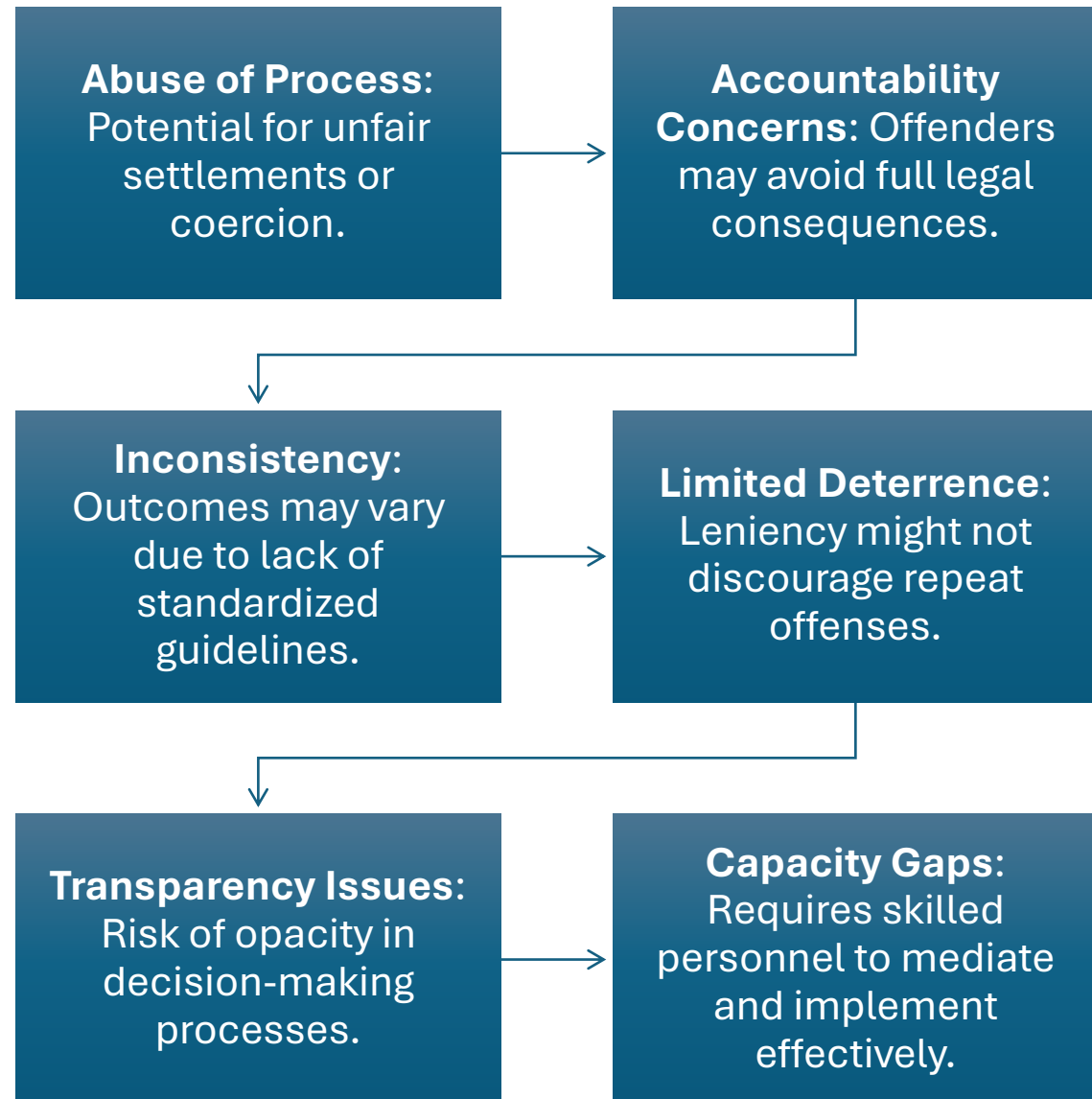


Case Studies: Successful Compounding Examples

- Examples of notable IP disputes resolved through compounding.
- *City General Stores case (2023)* : Goods were seized in Nairobi. They admitted to dealing with SKF bearings, for which a USD 10,000 fine was imposed. *The* seized goods were forfeited to the State for destruction.
- *Greenlink Cargo Limited Case (2023)*: The company was found dealing in counterfeit stationery for Hewlett Packard (HP). A fine of USD 5,000 was imposed, and the counterfeit goods were forfeited to the State.
- *Bille Abdi Case (2024)*: The individual was caught with counterfeit Nike apparel. A fine of USD 7,000 was imposed, and the goods were seized by the State.



Challenges in Compounding



Policy Recommendations

-
- Address challenges in compounding and ADR implementation.
-
- Enhance capacity-building for Enforcement Agencies and other stakeholders.
-
- Reforms to strengthen ADR mechanisms.
-
- Vision for IP dispute resolution in Kenya.
-

IP Enforcement agencies initiatives to educate the public on counterfeiting.

- Importance of awareness in reducing IP infringements.
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- Enforcement Agencies' partnerships with local and international organizations.
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- Role of collaboration in enhancing IP enforcement.
-
- Views of IP rights holders, legal practitioners, and policymakers to be taken into account.
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Conclusion

- Compounding represents a significant step in Kenya's IP enforcement.

- Emphasizes cost-effective and timely dispute resolution.

- Strengthens IP protection while fostering business growth.

Thank
You!

Thank You!

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**GOBIERNO DEL
PARAGUAY**

**DIRECCIÓN NACIONAL
DE PROPIEDAD
INTELECTUAL**



**Mediation as an alternative dispute resolution
mechanism in enforcement matters in Paraguay and
the collaboration between DINAPI and the WIPO
Arbitration and Mediation Center (AMC)**

**Atty. Diego Pérez Bernal, MPPII
Director General of Enforcement
National Directorate of Intellectual Property (DINAPI)**

Collaboration between the WIPO AMC and DINAPI

- Training of 15 DINAPI officials as mediators (WIPO Academy course DL-317 and other training)
- Advice on the drafting of internal mediation regulations.
- Provision of a regularly updated computer platform to monitor and manage cases, with an electronic filing option.
- Provision of software for conducting online hearings and allowing for their recording.

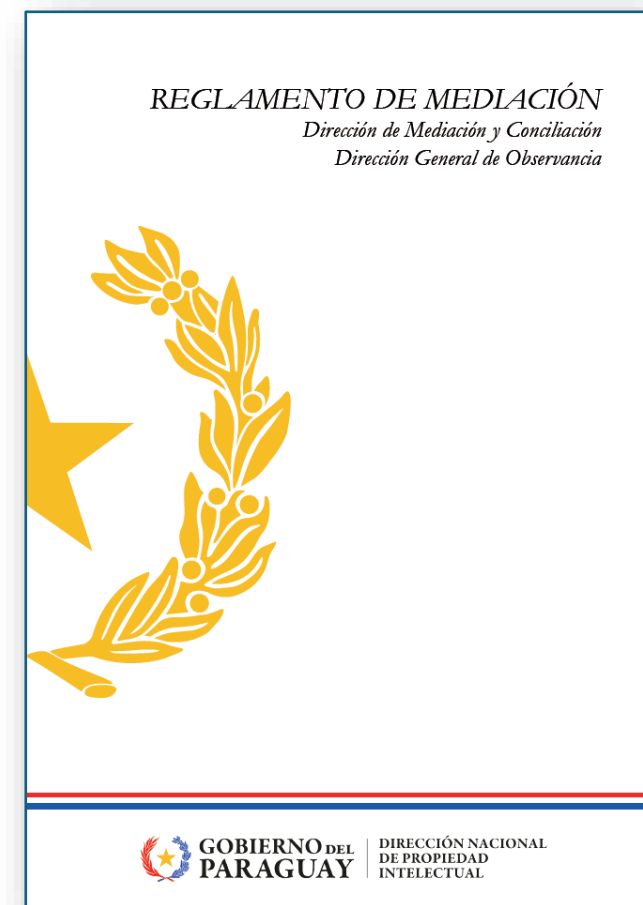


Mediation regulations of DINAPI

Decision No. 113/2023 “APPROVING THE REGULATIONS GOVERNING THE MEDIATION SERVICE OFFERED BY THE MEDIATION AND CONCILIATION DIRECTORATE UNDER THE AEGIS OF THE GENERAL DIRECTORATE OF ENFORCEMENT”

It has 28 articles, divided into three chapters:

- Preliminary provisions
- The mediation process
- The mediator



Pre-implementation stage

After the issuance of regulations and the training of mediators, the Directorate of Mediation and Conciliation prepared the necessary documentation for the service (orders, notifications, confidentiality agreements, minutes, agreements, etc.), the integration of WIPO's IT platforms with DINAPI's internal systems and conducted the necessary tests to achieve stable operation.

During this pre-implementation stage, 16 applications for mediation were exceptionally processed with the authorization of the National Directorate, with agreements being reached in five cases.



Mediation Service pilot plan

Decision No. 412/2024 “IMPLEMENTING THE PILOT PLAN OF THE MEDIATION SERVICE OFFERED BY THE MEDIATION AND CONCILIATION DIRECTORATE OF THE DIRECTORATE GENERAL OF ENFORCEMENT OF THE NATIONAL INTELLECTUAL PROPERTY DIRECTORATE (DINAPI)”

The decision provides as follows:

- The use of the WIPO platform and tools integrated with the systems of the institution, as well as the application form in its two formats is approved;
- The mediation service is free of charge for the duration of the pilot plan;
- The pilot plan shall be in effect until January 31, 2025.

Ceremony to launch the Mediation Pilot Plan





PORTAL DE ESTADÍSTICAS

SOLICITUDES Y CONCESIONES DE MARCAS, PATENTES Y DIBUJOS Y MODELOS INDUSTRIALES

Estimado/a usuario/a: Ahora te damos la bienvenida al sitio web de la DINAPI. Verifica en el menú de navegación la opción de inicio de sesión y crea tu cuenta si eres nuevo/a usuario/a.

Propiedad Industrial

Marcas

Patentes

Dibujos y Modelos Industriales

IG/DO

Gestiones Administrativas

Derecho de Autor y Derechos Conexos

Registro de Derechos de Autor y Derechos Conexos

Industrias Creativas y Promoción del Folklore

Sociedades de Gestión Colectiva

Observancia

Lucha contra la Piratería y Falsificación

Promoción y Prevención

Mediación y Conciliación

Unidad de Registro de Importadores

Dirección de Conocimientos Tradicionales y Recursos Genéticos

Solicitud de Mediación ante la Dirección Nacional de Propiedad Intelectual de Paraguay (DINAPI)

1. Partes

Sírvase completar la siguiente información de contacto:

Parte Solicitante	Parte Solicitada
Nombre: Nombre. País de residencia: País de residencia. Tel: Tel. E-mail: E-mail. Domicilio: Domicilio.	Nombre: Nombre. País de residencia: País de residencia. Tel: Tel. E-mail: E-mail. Domicilio: Domicilio.
Representada por (si procede): Presentada por. Tel: Tel. E-mail: E-mail. Domicilio: Domicilio.	Representada por (si procede): Presentada por. Tel: Tel. E-mail: E-mail. Domicilio: Domicilio.

2. Controversia

Sírvase describir brevemente la controversia:
Escribir texto.

Sírvase indicar la cuantía o estimación del monto objeto de la controversia:
Escribir texto.

3. Sometimiento a Mediación

a) La Parte Solicitante acuerda someter la controversia arriba detallada a mediación de conformidad con el Reglamento de Mediación de la Dirección General de Observancia de la DINAPI.

Sírvase suscribir el formulario y enviarlo a mediacion@dinapi.gov.py y a arbitr@mail@wipo.int.

Lugar y fecha: Lugar y fecha. Firma: _____

b) La Parte Solicitada acuerda someter la controversia arriba detallada a mediación de conformidad con el Reglamento de Mediación de la Dirección General de Observancia de la DINAPI.

Sírvase suscribir el formulario y enviarlo a mediacion@dinapi.gov.py y a arbitr@mail@wipo.int.

Lugar y fecha: Lugar y fecha. Firma: _____

OMPI

Inicio

Solución alternativa de controversias en materia de PI

ayuda

Solicitud de mediación ante la Dirección Nacional de Propiedad Intelectual de Paraguay (DINAPI)

Este formulario de presentación electrónica le permite completar y presentar una Solicitud de mediación en virtud del Reglamento de Mediación de la Dirección Nacional de Propiedad Intelectual de Paraguay (DINAPI), en colaboración con el [Centro de Arbitraje y Mediación de la OMPI](#). Una vez presentada, se enviará una copia de esta Solicitud a la parte solicitada.
La información sobre el servicio de mediación de la DINAPI está [aquí](#).
La información sobre el tratamiento de datos personales por el Centro de la OMPI está [aquí](#).
Los campos obligatorios están marcados con (*).

Nombre (parte solicitante) *	Nombre (parte solicitada) *
País *	País *
Teléfono	Teléfono
Email *	Email *
Representado por	Representado por
Dirección	Dirección
País	País
Teléfono	Teléfono
Email	Email

Partes adicionales

Agregar parte solicitante

Agregar parte solicitada

Proporcione una breve descripción de la controversia *


Otros documentos, si los hay

Adjunte (en caso de múltiples archivos adjuntos, por favor cargue todos en un archivo .zip) *

Agregar documento

Persona que solicita *

☐ No soy un robot



Presentar solicitud

In person

Remotely

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Highlight in publication “WIPO ADR Stories”.


WIPOEnglish ▾🔍

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Home > Alternative Dispute Resolution > Specific Sectors > IP Offices > Paraguay

WIPO ADR Stories: Paraguay - Mediation as a Tool to Combat Piracy and Counterfeiting of Products

Counterfeiting and piracy are global threats that affect intellectual property (IP) rights holders, consumers and economies alike. In Paraguay, these illicit activities have posed a significant challenge, particularly for markets like luxury goods and pharmaceuticals. To address this problem, Paraguay's National Intellectual Property Office, (DINAPI) has adopted an innovative approach: mediation.

A photograph showing three individuals in a professional setting. On the left, a woman in a black jacket and grey scarf holds a white folder. In the center, a man in a blue polo shirt and jeans holds a white folder. On the right, a woman in a dark blue blazer and white top is shaking hands with the man in the center. Behind them is a white banner with the text "DIRECCIÓN NACIONAL DE PROPIEDAD INTELECTUAL PARAGUAY" and "DINAPI" with a logo.

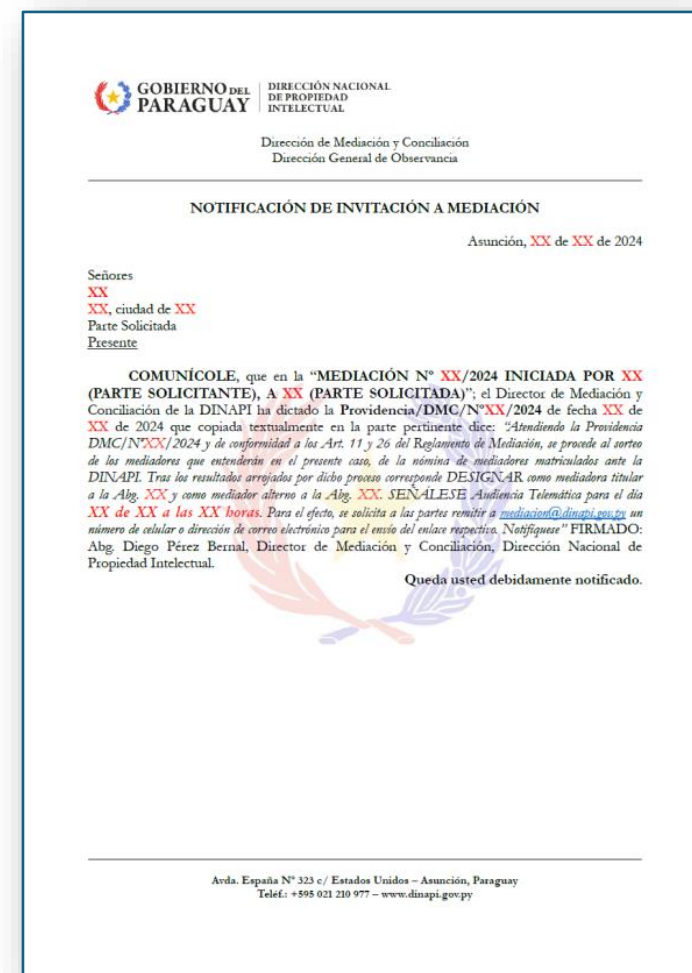
www.wipo.int/amc/en/center/specificoffices/paraguay/dinapi.html

Processing

After the submission, the Mediation and Conciliation Directorate performs an admissibility analysis to determine whether the dispute can be mediated and verifies compliance with the formal requirements of the Regulations.

If the case can be mediated and the formal requirements are met, the process is triggered by the appointment of mediators and alternate mediators from the list of mediators registered with DINAPI.

The initial hearing is then scheduled and the parties notified and consulted as to their preferred method of attendance (in person or remotely).



Hearings

In-person hearings are held at DINAPI headquarters, in the offices of the Directorate General of Enforcement.

Online hearings are conducted on the WEBEX platform, which is one of the IT tools provided by WIPO for the provision of the service.

Online hearings are recorded unless otherwise requested by the parties.

In both formats, minutes are taken to record the appearance, the particulars of the parties, their statements and, if agreement is reached, the terms of the agreement.







2024 statistics

Total figures

Cases: **37**

Hearings: **49**

Agreements **12**

Success rate: 32.4%

Type of case

Administrative/industrial property: **1**

Administrative/copyright: **1**

Extrajudicial/others: **2**

Extrajudicial/infringements: **33**

Type of applicant

National: **9**

Foreign **28**

Application type

In person: **23**

Electronic: **14**

Hearing type

In-person: **19**

Remote **30**



**THANK YOU VERY MUCH.
AGUYJE (THANK YOU IN GUARANÍ)**

