CONSIDERING MUSIC AS PART OF PROTECTABLE SUBJECT MATTER UNDER KENYA'S TRADEMARK LAW

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ABSTRACT

In 2014 and 2018, two Kenyan musical artists took to social media claiming that phrases to their hit songs had been used by a major telecommunication company in a number of their audio visual and print marketing campaigns without their consent. The social media debate that erupted brought to light not only the lack of knowledge of creative's rights, but specifically on the extent of copyright protection for musicians rights in Kenya and whether Kenya's Copyright Act (No. 12 of 2001) is enough to effectively protect the music created by local acts. Although Kenya's copyright law gives provisions for the protection of music, this paper argues that trademark protection would be a supplementary solution for artists to attain overall protection as well as commercial control over their music in its entirety; this includes lyrics and jingles or sounds. Although the use of copyright and trademark law simultaneously would create an overlap of intellectual property rights, the concept is fairly common as many lawyers have explored this loophole in western jurisdictions such as the United States and the United Kingdom. It is from this overlap concept that this paper suggests the expansion of protectable subject matter under Kenya's Trademark Act (Chapter 506 laws of Kenya) to include music in all its forms. It currently does not expressly mention music in any form as part of its protectable subject matter. This paper also explores international laws such as the TRIPs Agreement and common law doctrines that Kenya is privy to that have dealt with the use of trademark and copyright law overlaps over the same subject matter being used and concludes how such inclusion seeks to benefit national economic growth and development.

Keywords; protectable subject matter, trademark law, copyright law, music protection, trademark and copyright overlap

INTRODUCTION

African music and sound has made its way to the international stage within recent years. This is seen with international musicians creating and commercially releasing musical albums using 'fresh' and 'new' African sounds and lyrics, use of African sounds in international blockbuster movies and in international advertising, just to name a few. Although these moves have been celebrated, many misinformed artists have not been able to commercially benefit from this exposure. Western countries have been able to implement and respect musical acts and their art, giving artists the ability to commercially benefit and secure their intellectual property rights through copyright law and trademark law respectively.

Kenya's music scene is fairly different, mainly attributed to the fact that the implementation of intellectual property infrastructure is still in its infancy, misinformation and or the miseducation of local Kenyan artists on how to protect their music and what this paper focuses on, the inadequacy of copyright law since it is the legislation used to safeguard musical rights. Kenya's Copyright laws are modelled after English Laws, the countries colonial masters, and not much has been altered to fit the diverse cultural environment.

In the capitalistic system that operates in Kenya, the expansion of trademark subject matter to include music would have merit. However, it is not lost that such subject matter expansion, as learnt from western jurisdictions, creates another tricky matter of overlapping of intellectual property rights. This article will examine the current copyright and trademark laws and policies in Kenya and where music protection lies. In addition, this article advocates for the inclusion of music, including lyrics and sounds, within trademark law since music has proven to have the ability to influence everyday life through introducing new vocabulary and trends that have a considerable influence on monetary gain.

THE STATE OF MUSIC PROTECTION UNDER COPYRIGHT LAW IN KENYA TODAY

Music logically falls within the Copyright domain. It is categorised as 'works' to mean musical, literary, dramatic and artistic works and 'subject matter other than works'[i] which includes sound recordings, broadcasts, published editions and film (also known as cinematograph works). In Kenya, Article 22 (1) (b) of the current Copyright Law specifically lists 'musical works' as work that is eligible for protection by copyright.

Owners of musical works are granted exclusive moral and economic rights, subject to limitations and exceptions, to control the reproduction, in any material form, of their work, or the translation, adaptation and distribution to the public by way of sale, rental, lease, hire or loan as well to control the importation or communication to the public and broadcasting of their works.[ii] Moreover, a copyright holder in a sound recording has the exclusive right to: reproduce the sound recording in any way; distribute it to the public through sale, hire, rent, lease or any similar arrangements; import it into Kenya; broadcast and communicate the material to the public.[iii]

The moral rights extended to musical works are limited to the right to be named or claim authorship and the right to object to any mutilation or derogatory treatment that affects the honour or reputation of the author or performer. On the other hand economic rights are transmitted through moveable property by assignment, by license, by testamentary disposition or by operation of law.[iv]

These rights therefore allow the author(s) of a musical composition to prohibit any third parties from duplicating their work for the author's lifetime and fifty (50) years after the end of the year in which the author dies.[v] Once such time lapses, the music re-enters the public domain and is free for any person to use and duplicate.

In recent years however, the protection of 'musical works' has seen its fair share of distress. Mainly attributed to the increase of internet activity, the protection of musical works by Copyright Law has raised eyebrows and has been deemed not to be enough primarily due to the fact that Kenya's Copyright Law does not provide protection for musical lyrics and sounds. Across sub-Saharan Africa, the rules of copyright are fairly similar. Many of the legal systems do not allow copyright on single words including short phrases, slogans and titles as they are protected by Trademark Law.

Kenya is no exception and this could be attributed to the fact that intellectual property has not found a footing within African economies and its role in supporting the development of a vibrant innovative ecosystem and ensuring creative industries across the continent.[vi] However, as discussed below western jurisdictions[vii] as well as international laws[viii] have expanded their trademark subject matters to include music and sounds.

KENYA'S CURRENT TRADEMARK LAW AND ITS EXCLUSION OF MUSIC

Creations of the mind have historically been categorized into different types of property. Copyright law, trademark law and patent law have provided the main legal regimes under which property status is granted to intellectual creations. Each of these bodies of law at its most fundamental level is designed to protect different types of products of the mind.

In Kenya, a trademarks main function is to enable consumers to identify a product as whether it is a good or service, belonging to a particular entity and to distinguish it from other identical or similar products in the market. This has been reflected in a number of judicial judgements and legislative provisions. The Trademarks Act, Chapter 506 of the laws of Kenya, is the legislation responsible for the protection of trademarks in Kenya. It provides that the protectable subject matters include a distinguishing guise, slogan, devise, brand, heading, label, ticket, name, signature, word, letter, numeral or any two or three dimensional form.[ix]

A trademark owner therefore goes on to enjoy the protection of their economic interests against third party misappropriation and enabling the trademark owner to move into different markets. The term for the protection of a registered trademark is ten (10) years but the registration may be renewed indefinitely for consecutive periods of ten years provided the renewal fees are paid in time.

From the definition of what a mark is under Kenyan law, it is evident that a more traditional approach is used. Court decisions have reflected the same and the idea that sounds and song lyrics have yet to be considered as a trademark. In contrast, it has been argued that a trademark

seeker may try to argue that musical notations or wording are sufficient to be able to be categorised as two dimensional works. It is important to note that in the Kenyan context, nothing would bar an individual or entity from seeking trade or service mark protection for a song lyric or title as a distinguishing slogan, word or numeral as long as the conditions for registration are met.

Sound marks would be more difficult for registration, but with the rising distinguishing sounds associated by companies offering a specific services or goods it would be interesting to have such registrations attempted. However, a number of jurisdictions have expanded beyond the typical word, phrase or unique design that comprises of most trademarks.[x] Trademark protection has slowly been extended to colours, sounds, shapes, smells, feel and trade dress.

IS THIS OVERLAP OVERDUE? WHY IT MAY BE TIME TO RECONSIDER

Intellectual property overlaps occur when two or more IPRs exist in respect of the same subject matter.[xi] This phenomenon has grown in recent years especially in western jurisdictions for a number of reasons, the most obvious being that some IPRs have been extended to cover new areas, for example, computer software. With software, the law grants both patent and copyright equally if the conditions of laws are fulfilled. Another reason is that lawyers have progressively found new ways of protecting their clients IP interests to be able to maximize their client's endeavours.

This intellectual property overlap concept is relatively new to the Kenyan intellectual property scene partly due to the state of the music scene and the blissful legal ignorance that artists often have. Majority of artists do not create their art with the legal protection of that work in mind especially for artists that release music independent of a record label behind them. The problem tends to occurs when such music becomes a success and open to exploitation by those who are savvier.

This segment highlights instances that would be ideal situations to have protection by both copyright and trademark laws in Kenya. Since the trademark legislation does not include music or sounds as a protectable subject matter, these examples prove that such expansion would be beneficial to both artists and the nation.

i. HAKUNA MATATA, A US TRADEMARK AND KENYAN COPYRIGHT

This has arguably been one of the most famous cases concerning international trademark registration in Africa. Prior to the release of the 2019 remake of the classic Lion King film by Walt Disney Studios, Kenyans received an abrupt lesson on Intellectual Property Rights in the international context. Through a popular local news article, majority of Kenyans learned that Walt Disney Studios had trademarked the Swahili phrase *hakuna matata* in the United States, for use on merchandise. The phrase translates to 'no problems' or 'no worries' and many did not understand how an outside entity could have any sort of control of a phrase that locally forms everyday vocabulary.

The Disney move reinstated the long accepted practice in the trademark world that while selecting or designing your own trademark it is not an offence to pick a term that is in common use, adopt and consistently use it in a trademark sense in conjunction with or in relation to a specific product or service line. The onus of building that connection between the term, the product and the manufacturer is left to the trademark owner to prove whenever challenged. in this case, building that relationship was not the issue as Disney have a global presence therefore the phrase became synonymous with Disney among non-Swahili speaking nations.

On the other hand, in Kenya, a Swahili speaking nation, the term was already an ordinary phrase used in day to day life. It was thrust into international popularity in 1982 by a Kenyan band, *Them Mushrooms*, in their song *Jambo Bwana* as the phrase formed part of the chorus and went on to go platinum. The song is only protected by copyright so when they claimed copyright infringement, it was quickly shut down as the rights accorded to them under copyright did not extend to the phrase.

Even with the *Hakuna Matata* controversy, it was clear that legally speaking, both parties had different subject matters hence the reason that they are protected by two different IPR regimes.

Secondly, since trademark protection is limited to the territory of registration, save for well-known marks, Disney was within its rights to capitalise on the popularity of their animated work within their territory even at the expense of the Swahili speakers who were already trading merchandise with the phrase. The choice to use the phrase as a trademark would seem as an inventive selection in the Western Market since they are not well known in their public domain.[xii] On the other hand, the capitalistic mind-set of the US would deem it intelligent since they are legally able to capitalize of it.

It does however beg the question of whether there would have been a different result if the band had tried to trademark the phrase in the country and continent first, considering the popularity on the African continent mainly because the general consumer connection was present with not only the locals but with tourists as the song evolved to become an anthem in resorts and hotels around the country.

ii. COMMERCIAL USE OF COPYRIGHTED SONG LYRICS

In 2018, the largest telecommunications provider in Kenya ran a national campaign to advertise their newest data bundle. The ads ran on major radio stations, television stations as well as social media. However, the catchy wording that was used to promote it stemmed from a popular song from a prominent local artist. The print ads ran the popular parts of the song while the audio and audiovisual ads used the lyrics but not the sound of the original music. The artists' management then raised an issue of copyright infringement directly against with the company. Consequently, the artist was able to settle with the company and went on to have future sponsorships with the company.

Fast forward to 2020 and the telecommunication company was at the forefront of another alleged IP infringement. The Company ran a different national campaign with another phrase that was popularized by a popular song by a different artist. The phrase itself was made popular by the artist and got incorporated into local vernacular due to the songs popularity. The difference here is that the artist claimed that he had the trademark to the phrase in addition to the copyright to the song. This matter is yet to be addressed by the court, and may not since many smaller artists do not have the funds to take on a large corporation.

MOVING FORWARD AND SUGGESTED 'RULES' FOR SUCH OVERLAP FROM SUBJECT EXPANSION

Laws of Kenya are deeply rooted in the colonial and neo-colonial experience. This means that the applicable laws for trademark and copyright protection are not only found in statutes but in English common law as well. International treaties also form part of Kenyan laws albeit through enactment, domestication or transformation.[xiii] Scholars have argued that the copyright/trademark overlap is considered to be a false overlap, mainly due to the expansion of trademark subject matter.[xiv] Therefore the main criterion is to determine how trademark and copyright would coexist within two different doctrines.

Article 15 (1) of the TRIPs Agreement covers slogans and titles; two dimensional artistic works (figurative marks such as colour combinations, logos, graphical user interfaces, or computer visual displays); musical works (sound marks); and three dimensional artistic works (shape marks). Kenya is party to the TRIPs agreement

As a rule of thumb, it is considered that as long as the requirements or originality and distinctiveness are met such overlap although subjective, will exist. A trademark exists as such as long as it is used and renewed .Therefore if a trademark expires, copyright will still subsist until it expires. However, in majority jurisdictions, there are no statutory solutions offered and courts have been divided. The recourse left is to ensure that a balance is struck between the exceptions and limitations of both trademark and copyright laws.

With the TRIPs agreement as a guiding light, ensuring the freedom of movement for goods and services while making sure criss-crossing of ownership, dealings, rights, infringement and exceptions are taken into account. The general consensus of jurisdictions that have dealt with this overlap is that there are no actual rules to regulate. Matters are handled on a per case basis.

Ensuring free trade of goods and services can be best summarised tackled in the United States and Canada and the European Union. In *Dior V. Evora*[xv] the Court of Justice of the European Union (CJEU) that held;

"When copyright forbids the reproduction of a work 'attached' to a trademark good or service (ie, commercialised as such by the trademark owner) but there is no trademark infringement, copyright law cannot surpass the free movement of goods or services which would have prevailed would trademark law have been exclusively applicable."

In some of cases, matters of ownership, rights, infringement and or exceptions of both copyright and trademark converge making it easier for the stricter regime to prevail. For example, copyright will outweigh the limitations of trademark law while trademark law will outweigh the limitations of copyright law mainly since the basic requirements are the same in most jurisdictions.

The rules to be implemented for copyright law and trademark law to be used simultaneously for music protection should therefore reflect the current policies of each law respectively. The rights of the copyright owner however surpass since the purpose of copyright is to protect original work while trademark is purely for commercial protection of the owner.

CONCLUSION

The musical culture in Kenya is extremely diverse and there is no specific identifiable genre that could be used to identify it. The genres borrow and cross-fertilize each other's languages and musical instruments, just to name a few. These distinct sounds are what have fallen prey to loopholes when protecting their work and have made it difficult for the copyright owners to commercially exploit their work. The argument that music and sounds should be included by trademark law does not diminish copyright law protection since commercially it limits how owners of the work can be able to exploit their work to different domains.

Expanding Kenya's trademark law subject matter to include music ought to be considered as an advantageous move for both the owners and the country. It shows that the countries laws are reflective of the current environment, especially since intellectual property rights are constantly changing and evolving. Africa's distinct sounds should be accorded as much protection that is legally available to avoid cases of cultural appropriation or even lack of enough legal protection. The potential of economic gain of such subject matter expansion can

simply not be ignored since opportunity to boost both local and foreign direct investment is undeniable.

ENDNOTES

[i] Sihanya B. (2012) *Empowering Authors in Kenya: Copyright and Alternative publishing*
[ii] Copyright Act, Section 26 (1) 2018
[iii] Copyright Act, Section 28, 2018
[iv] Copyright Act Section 33, 2018
[v] Copyright Act, Section 23 (2), 2018
[vi] Gurry F. (2015), *Intellectual Property for an emerging Africa*, WIPO Magazine
[vii] US Trademark Office website lists some sounds, including music, that are registered trademarks e.g. the loonie toons theme sound for entertainment provided by Time Warner. Available at https://www.uspto.gov/trademarks/soundmarks/trademark-sound-mark-examples (last visited December 2, 2020
[viii] The Agreement on Trade Related Aspects of Intellectual Property Rights Agreement (TRIPS), Article 15 (1)
[ix] Trademarks Act , Cap 506, 2007
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