



RSA Limited v Managing Director, Kenya Industrial Property Institute (KIPI); Total Kenya Limited & another (Interested Parties) (Commercial Appeal 007 of 2022) [2022] KEHC 14456 (KLR) (Commercial and Tax) (28 October 2022) (Ruling)

Neutral citation: [2022] KEHC 14456 (KLR)

**REPUBLIC OF KENYA
IN THE HIGH COURT AT NAIROBI (MILIMANI COMMERCIAL COURTS)
COMMERCIAL AND TAX
COMMERCIAL APPEAL 007 OF 2022**

**DAS MAJANJA, J
OCTOBER 28, 2022**

BETWEEN

RSA LIMITED APPELLANT

AND

**THE MANAGING DIRECTOR, KENYA INDUSTRIAL PROPERTY
INSTITUTE (KIPI) RESPONDENT**

AND

TOTAL KENYA LIMITED INTERESTED PARTY

CRUISE EAST AFRICA INTERESTED PARTY

(Being an appeal against the Ruling of the Industrial Property Tribunal at Nairobi dated 31st October 2019 in Nairobi IPT Reference No. 2 of 2018)

RULING

1. By the notice of motion dated June 2, 2022, the appellant seeks leave to amend the memorandum of appeal dated November 28, 2019 in terms of the draft annexed to the application and to adduce further and/or additional evidence in the appeal. The application is supported by the affidavit of the appellant's Managing Director, Manmohan Singh Bhamra, sworn on June 2, 2022. It opposed by the 1st interested party through the affidavit of its General Manager, Simon Mwititi, sworn on July 13, 2022. The 2nd interested party filed grounds of opposition dated July 14, 2022.
2. Before I deal with the substance of the application, a brief background of the appeal will suffice. At the material time, in 2007, the appellant registered 15 industrial designs with Africa Regional Intellectual Property Organisation ("ARIPO"). The 10-year term for protection lapsed in August 2017. Its



advocates through a letter dated August 4, 2018 applied to the respondent to renew registration of the industrial designs for two further consecutive terms of five years as set out in section 88 of the Industrial Property Act, 2012 ("the IPA") upon payment of the prescribed fee. The respondent replied to the appellant by a letter dated September 14, 2018 noting that the period of the protection of the appellant's industrial designs had expired and pointed out that the period of protection under the section 4(6) of the Harare Protocol on Patents and Industrial Designs (1982) and section 88 of the IPA were out of sync and this being a complex matter, it sought direction of the Industrial Property Tribunal ("the tribunal") under section 118 of the IPA.

3. The respondent filed a reference to the tribunal which deliberated on the matter and by a ruling dated October 31, 2019, concluded as follows:
 - a. There is no power/jurisdiction to renew or restore an ARIPO Industrial Design under the Industrial Property Act 2001 and the ARIPO Protocol beyond the 10-year period granted under section 4(6) of the ARIPO Protocol.
 - b. The provisions of the law relating to renewal and restoration of industrial designs are specific to Kenya National Industrial Designs and must be complied with. Failure to comply with the renewal and restoration in the Act would disentitle an applicant to renewal and restoration of industrial designs under sections 88(2) and 89 of the Industrial Property Act.
4. The finding of the tribunal precipitated the appeal contained in the memorandum of appeal dated November 28, 2019 containing 11 grounds of appeal. In support of the application for amendment, the appellant states that it now seeks to include material particulars and grounds of appeal which were not pleaded at the time of filing the appeal. That for purposes of determining the real issues in controversy, it is proper that the court grant leave to amend the memorandum of appeal.
5. As regards the admission of new evidence, the appellant seeks to admit a decision of the Court of Appeal in Tanzania at Dar-es-Salaam; Civil Appeal No 179 of 2016, *RSA Limited v Hanspaul Automechs Limited and another* which nullified the decision of the High Court of Tanzania in Commercial Case No 160 of 2014, *RSA v Hanspaul Automechs and another*. It also seeks to admit a letter dated January 16, 2018 from its advocates addressed to the respondent seeking renewal of the appellant's industrial designs.
6. The appellant contends that the evidence it now seeks to rely on was not available before the tribunal and could not be included in its list of documents due to an oversight. Further, that it could not have been obtained with reasonable diligence for use at the tribunal. It prays that it is in the interest of justice that the new evidence be allowed.
7. The interested parties take the same objections to the application. They contend that the application has been filed after a delay of over two and half years after the appeal was filed without any plausible or valid explanation for the delay hence the court should not exercise discretion in the appellant's favour.
8. As regards the decision of the Court of Appeal in Tanzania, the interested parties assert that it is not relevant as it was not relied on by the tribunal and that at the hearing of the matter before the tribunal, counsel for the appellant took the position that the High Court of Tanzania decision was not relevant. They further aver that the Court of Appeal decision is not relevant as it dealt with the issue of jurisdiction. At any rate, they contend that the decision need not be produced as evidence but can be referred to in its submissions as an authority.
9. The interested parties point out that the appellant's advocates' letter sought to be introduced in evidence was always in possession of the advocates and could have been produced had they exercised even minimal diligence. They submit that the letter does not add anything to the case as it merely sets



- out the arguments that were made before the tribunal and could be incorporated in the submissions before this court.
10. Order 42 rule 3 of the [Civil Procedure Rules](#) upon which the application is premised provides:
[Order 42, rule 3] Amendment of memorandum of appeal.
 - (1) The appellant may amend his memorandum of appeal without leave at any time before the court gives directions under rule 13.
 - (2) After the time limited by subrule (1) the court may, on application, permit the appellant to amend his memorandum of appeal.
 11. It has been held by our superior court that a memorandum of appeal is a pleading like any other and the rules that apply to amendment of pleadings also apply to a memorandum of appeal hence in [Uburu Highway Development Ltd v Central Bank of Kenya](#) [2002] 1 EA 314 the Court of Appeal held that, “a memorandum of appeal, subject to the interests of justice, is always amenable to amendment”. The Court of Appeal in [Central Kenya Limited v Trust Bank limited](#) [2000] 2 EA 365 in determining an application to amend a memorandum of appeal held as follows:

"A party is allowed to make such amendments as may be necessary for determining the real question in controversy or to avoid a multiplicity of suits, provided there has been no undue delay, that no new or inconsistent cause of action is introduced, that no vested interest or accrued legal right is affected and that the amendment can be allowed without injustice to the other side."
 12. While I agree that the proposed amendment has been brought late in the day, the grounds set out in the draft are generally matters of law which the appellant wishes to raise. I have not heard the interested parties complain that the proposed grounds raise new issues or matter that were outside the purview of matters before the tribunal. I take the view they will clarify the issues in the appeal. Further, I do not think any party will suffer prejudice by allowing the amendments that would not be salvaged by an award of costs.
 13. It is not in doubt that this court exercising appellant jurisdiction, has the power to admit fresh evidence. Section 78(1) of the [Civil Procedure Act](#) empowers the court, “to take additional evidence or to require the evidence to be taken”. The power is given practical effect in order 42 rules 27, 28 and 29 of the [Civil Procedure Rules](#). I need not go into the details and principles governing admission of new evidence because the issues the tribunal was called upon to resolve were purely legal issues involving interpretation of international treaties and domestic legislation. Nothing turned on disputed factual issues.
 14. While the memorandum of appeal refers to the tribunal erring in law and in fact, the reference to facts is unfounded as the reference by the respondent did not call upon the tribunal to resolve any factual or evidential issues. I therefore agree with the interested parties that the two documents sought to be introduced are not necessary or relevant for determination of the appeal. The decision of the Court of Appeal in Tanzania can be referred to in submissions and without pre-empting what the appellant seeks to submit, the ratio of the decision relates to the issue of jurisdiction. The letter dated January 16, 2018 merely set out the appellant’s arguments before the tribunal, is not necessary and does not add anything which cannot stated in the submissions.
 15. For the reasons I have set out above I allow the notice of motion dated June 2, 2022 on the following terms:



- a. The appellant be and is hereby granted leave to amend its memorandum of appeal in terms of the draft memorandum of appeal annexed to its application and the same shall be filed and served within 14 days.
- b. The appellant shall bear the costs of the interested parties which are assessed at Kshs 10,000.00 for each party to be paid within 14 days.

DATED AND DELIVERED AT NAIROBI THIS 28TH DAY OF OCTOBER 2022.

D. S. MAJANJA

JUDGE

Court Assistant: Mr M. Onyango.

Mr Kamwendwa with Ms Righa instructed by N. M. Kamwendwa and Company Advocates for the Appellant.

Mr Mbaluto instructed by Oraro and Company Advocates for the 1st Interested Party.

Ms Dave instructed by LJA Associates Advocates for the 2nd Interested Party.

