REPUBLIC OF KENYA

IN THE HIGH COURT OF KENYA AT NAIROBI

MILIMANI LAW COURTS

COMMERCIAL, ADMIRALITY & TAX DIVISION

CIVIL CASE NO. 338 OF 2016

SANITAM SERVICES (EA) LIMITED.....APPELLANT

VERSUS

RENTOKIL (K) LIMITED.....1ST RESPONDENT

KENTAINERS (K) LIMITED.....2ND RESPONDENT

(Being an appeal from the ruling of the Industrial Property Tribunal delivered on 21st January 2014 by J. Weloba (A.G. Chairman),

M. Lewa (Member), D. Kamau (Member)

In Nairobi IPT Case No. 5 of 1999)

JUDGMENT

1. The Judgment herein arises from an Appeal filed against the ruling of the Industrial Property Tribunal delivered on 21st January 2014. The Appellant relies on the grounds in the Memorandum of Appeal dated 5th February 2014 and Amended on 5th June 2017, which states that:-

(a) That the Honourable Tribunal erred in fact and in law in acting without jurisdiction in disregard of the fact that patent number AP773 was in A.R.I.P.O. granted patent subject to the A.R.I.P.O. protocol and consequently not subject to revocation under national law;

(b) That the Honourable Tribunal erred in law in its interpretation of its jurisdiction by failing to consider and uphold the limitations set under Article 59 (10) and (11) of the A.R.I.P.O protocol;

(c) That the Honourable Tribunal erred in law and fact in finding that the patent was granted by mistake;

(d) That the Honourable Tribunal Ruling is afflicted with bias towards the Appellant that renders it untenable;

(e) That the Honourable Tribunal's bias was further exemplified in its award for costs on a higher scale against the Appellant ostensibly as a punishment for the Appellant's pursuit of its constitutional right to seek protection of the patent through judicial proceedings;

(f) That the Tribunal erred in fact and in law in rendering a decision in the matter with full knowledge of a case before the High Court challenging the jurisdiction of the Tribunal;

(g) That the Honourable Tribunal erred in law and fact in failing to consider and determine all the issues raised in the pleadings and evidence;

(h) That the Honourable Tribunal erred in law and fact in basing its decision on extraneous factors and failing to consider material factors;

(i) That the Honourable Tribunal erred in law and fact in un procedurally revoking patent No. Ap773

2. The Appellant avers that, it is the holder of Patent No. AP773 issued by; African Regional Intellectual Property Organization (ARIPO) on 15th October 1999. The patent relates to a unique design of a foot-operated sanitary bin. That, on 16th November 1999, the Respondents filed an application at the Kenya Industrial Property Tribunal (herein "the Tribunal"), for revocation of the grant of that patent. On 7th March 2000, the Appellant filed grounds of opposition to the application and raised the pertinent issue of whether or not the Honourable Tribunal had jurisdiction to determine the matter. The Tribunal heard the matter and rendered its ruling on 21st January 2014, revoking the patent, hence the Appeal herein.

3. The 1st Respondent, in response to the Appeal, joined issue with the Appellant that on or about 15th October 1999, the Appellant was granted Patent Number AP 773 by the Africa Regional Intellectual Property Organization (ARIPO) for an invention concerning a foot operated sanitary bin. On 16th November 1999 and 6th December 1999, the Respondents filed applications for revocation of the said Patent. The Tribunal rendered its decision dated 21st January 2014, provoking present Appeal.

4. The parties agreed to dispose of the Appeal through written submissions. The Appellant filed its submissions dated 13th February 2017, and relied entirely on the same during the highlighting thereof. The Appellant submitted that, the entire Appeal turns on whether or not the Tribunal had jurisdiction to determine the issue of revocation in regard to the subject patent. The Learned Counsel Mr Mutiso representing the Appellant submitted that, the Tribunal did not have the jurisdiction, and indeed erred by failing to consider the issue of whether it could entertain the Respondents application to revoke the patent as a preliminary issue.

5. The Appellant further argued that, courts have often-time restated the legal dicta of the necessity to examine whether or not it has jurisdiction to hear a matter before it, as a preliminary step, especially where the issue of jurisdiction has been taken up by either party. The Appellant relied on the case; *Esther Gachambi Mwangi vs Samuel Mwangi Mbiri (2013) eKLR*, which quoted the case of; *Owners of the Motor Vessel "Lillian S" vs Caltex Oil (Kenya) Ltd 1989 KLR*, and held that, Jurisdiction is everything and without it, a court has no power to take one more step.

6. It was submitted that, in view of the aforesaid, a court of Law or Tribunal must down its tools once it finds it has no jurisdiction, as jurisdiction cannot be self-conferred or even conferred by the parties. That the Tribunal being a creature of a Statute Act, could only exercise such jurisdiction as is conferred by it by the said legislation, in particular section 59 of the Act- Industrial Property Act (herein "the Act").

7. The Appellant argued that, the Act does not provide for the revocation of powers. The omission was not accidental, but stands to reason: First, the ARIPO protocol has established a Board of Appeal that deals with such issues under section 4 of the protocol. Secondly, the process of registration of patent under ARIPO protocol is so elaborate. The file, the technical details, the search, the equipment and decision to register are the repository of ARIPO. The Appellant argued that, in that regard, the Tribunal cannot practically deal with the issue of revocation, when it does not have the said materials in its hands. Thirdly, there is the question of enforcement. If the Tribunal revokes an internationally granted patent, how is the local Tribunal supposed to enforce its orders against ARIPO, yet no such jurisdiction is granted by the Act?

8. In conclusion the Appellant submitted that, the Tribunal acted without jurisdiction and its findings are a nullity and therefore the Appeal should be allowed with costs and the Tribunal's decision of 21st January 2014, be quashed for want of jurisdiction.

9. However, the 1st Respondent invited the court to consider the following issues in determining the Appeal:-

(a) whether the Industrial Property Tribunal had jurisdiction to revoke a Patent issued by ARIPO;

(b) whether this Appeal is frivolous, misconceived, and bad in law; and

(c) who should bear the costs.

10. The Respondent submitted that, ARIPO does not have revocation nor enforcement mechanisms. It entirely relies on contracting party mechanisms not only to enforce but revoke patents. Therefore under sections 59 and 103 of the Act, the Tribunal has jurisdiction to deal with the revocation application.

11. The Respondent further submitted that, even then, this issue of jurisdiction of the Tribunal has been dealt with before in the following cases:-

a) HCCC No. *57 of 2008; Chemserve Cleaning Services Ltd vs Sanitam Services (EA) Ltd*, where the Tribunal indicated that it has no jurisdiction to revoke ARIPO Patent

b) However, in the case of; *Sanitam Services Limited vs Bins (Nairobi) Services Limited (2008) eKLR*, the court dealing with the challenge on a patent issued by ARIPO, held that, "if the defendant is of the opinion that the said patent was wrongly registered, then it can apply under Section 103 of the Industrial Property Act, 2001 for its invalidation or revocation"

c) High Court Misc. No. 28 of 2011, Republic vs Industrial Property Tribunal & Another Ex Parte Sanitam Services (EA) Limited, where the Appellant herein was asserting that the Tribunal as constituted did not have jurisdiction. In affirming the tribunal's jurisdiction once more, the court observed that a purposive interpretation of the law has to be considered to guide the court for expeditious disposal of disputes.

d) In the case of,*Steel Structures Limited vs David Engineering Limited (2007) eKLR*, the court held that, the Tribunal is empowered to address all the issues in dispute between the parties as they relate to patents.

e) Similarly in the case of; *Apex Creative Ltd & Another vs Kartasi Industries Ltd (2011) eKLR*, the Court referred the dispute between the parties to the Tribunal, "so as not to allow litigants to flood the High Court and congest its diary with matters whose determination and disposal thereof have been provided in a well thought out forum."

12. The Respondent therefore, submitted that, it is trite law that what has been conclusively determined by court should not be returned to the same court, more so by a party who has litigated the same point over and over again. It was reiterated that, even if the Patent was issued by ARIPO, the Tribunal still has jurisdiction by virtue of Section 59 of the Act and so the decision of the Tribunal is not in vain as the same section provides that the Managing Director can write to ARIPO and notify them that a patent shall have no effect in Kenya.

13. On the issue of bias, the Respondent submitted that, the Appellant has not proved demonstrable bias in the Tribunal's finding or mentioned the form of the alleged bias and how it manifested itself. That the proceedings and the ruling of the Tribunal are consistent with the law and that it is worth noting that the three-member Tribunal consisted of; a lawyer and engineers, persons with both legal and technical competency to determine whether or not the Appellant's alleged invention was indeed novel.

14. It was further submitted that, the Appellant deliberately avoided proceedings and/or has for the last 18 years delayed the proceedings so as to continue to exclusively exploit the benefits of the patent at the Respondents expense. Further, the Appellant continues to harass and intimidate the Respondents through a multiplicity of respective suits thereby entitling the Respondents to costs on a higher scale. As such, it is not accurate to allege that there was bias if the said allegation is founded only on the fact that the Tribunal did not want any further delays and/or adjournments.

15. Finally, the Respondent submitted that, the costs of the Appeal were to be borne by the Appellant, in that the Appellant brought it up once more, having known that, that issue of jurisdiction had been exhaustively dealt.

16. However, the Appellant in brief reply argued that, their submissions are limited to the issue of jurisdiction to revoke the patent and not jurisdiction over other matters and that the decision referred to herein were on other different matters and/or issues.

17. I have considered the grounds of Appeal, the respective submissions filed by the parties and the oral address in highlighting the same. The grounds of Appeal as stated in the memorandum of Appeal, can be summarised as follows; that the Tribunal acted without jurisdiction, misinterpreted section 59(10) of the Act, was bias towards the Appellant, and in the award of costs on the higher scale, failed to consider and determine all the issues and/or material facts and/or considered extraneous factors.

18. However, the Appellant decided and actively chose to abandon all these grounds cited above, save for the ground on jurisdiction as clearly stated in its submissions at page 2 (though the submissions are un-paginated) paragraph 1, that the "the Appeal turns on whether or not the Tribunal had jurisdiction to determine the issue of revocation of the patent issued by ARIPO". The same sentiments were repeated by the learned counsel Mr Mutiso; for the Appellant while highlighting the submissions orally in court. Therefore the findings herein will be restricted to that ground on jurisdiction alone.

19. In that regard, I find that, the law on jurisdiction is settled that, jurisdiction is everything. In the celebrated case of; *Owners of the Motor Vessel "Lillian S" vs Caltex Oil (Kenya) Ltd 1989 (supra)* the court held that-

> *"Jurisdiction is everything. Without it, a court has no power to take one more step. In the matter of Advisory Opinions of the Supreme Court under Article 163(3) of the Constitution, Constitutional Application No. 2 of 2011; the Supreme Court noted that the Lillian 'S' case (1989) KLR 1) establishes that "jurisdiction flows from the law, and the recipient-Court is to apply the same, with any limitations embodied therein. Such a Court may not arrogate to itself jurisdiction through the craft interpretation or by way of endeavours to discern or interpret the intentions of Parliament, where the wording of legislation is clear and there is no ambiguity……"*

20. The Appellant relied on the same authority and referred the court to the sentiments of Nyarangi JA (as he then was) therein, where he stated that:-

> *"By jurisdiction is meant the authority by which a court has to decide matters that are before it or take cognizance of matters presented in a formal way for its decision. The limits of this authority are imposed by the statute charter or commission under which the court is constituted and may be extended or restricted by the like means. If no restriction or limit is imposed the jurisdiction is said to be unlimited. A limitation may be either as to the kind and nature of the actions and matters of which the particular court has cognizance or as to the area over which the jurisdiction shall extend, or if it may partake both of these characteristics. If the jurisdiction of an inferior court or tribunal (including an arbitrator) depends on the existence of a particular state of facts, the court or tribunal must inquire into the existence of the facts in order to decide whether it has jurisdiction, but except where the court or Tribunal has been given power to determine conclusively whether the facts exists, where the court takes it upon itself to exercise a jurisdiction which it does not possess, its decision amounts to nothing Jurisdiction must be acquired before judgment is given.*

21. Be that as it were, it suffices to note that, a party to any legal proceedings who wishes to raise an issue of jurisdiction must raise it at the earliest stage in the proceedings. This position was affirmed in the case referred to above and the case of; *Owners and Masters of the Motor Vessel "Soey" vs Owners of the Motor Tugs (2008) EA 367*, where the court held that:

> *"The question of jurisdiction is a threshold issue and must be determined by a judge at the threshold stage, using such evidence as may be placed before him by the parties. It is reasonably plain that a question of jurisdiction ought to be raised at the earliest opportunity and the court seized of the matter is then obliged to decide the issue right away on the material before it……"*

22. In that regard, the questions that arise herein are: At what stage in the proceeding before the Tribunal did the Appellant raise the issue of

jurisdiction?. How was it raised? Was it raised orally or through a formal Application? If it was raised at all, did the Tribunal hear and determine the same?

23. I have gone through the proceedings of the Tribunal and the resultant ruling and I note that the history and/or the chronology of events is as follows; the Application for revocation dated 12th November 1999 (herein the "Application"), was filed in court on 16th November 1999 and upon service, the Appellant filed grounds of opposition dated 7th March 2000, in opposition thereto.

24. The matter was set down for hearing on 13th January 2005, at 11.00am with orders that the firm of; Mutiso & Co. Advocates for the Appellant be served. However, on that date the matter did not proceed as the Appellant's counsel was said to be held up in another matter in the High Court. The Application was stood over to 20th January 2005.

25. On that date, the matter did not proceed as the Appellant filed a series of applications seeking for orders of prohibition against the Honourable Tribunal proceeding with the hearing of the Application. The first was an Application for Judicial Review on 28th January 2005, but it was later withdrawn on 15th May, 2009.

26. In the meantime, the Appellant had filed another Application dated 5th August 2008, in the matter HC Misc. Application No. 468 0f 2008, seeking for orders inter alia, that the proceeding before the Tribunal be stayed and leave be granted to apply for orders of certiorari. The Appellant was granted leave that operated as an automatic stay of proceedings. The order for stay was lifted on 5th August 2009. Therefore generally; the matter remained dormant from 20th January 2005 to 18th June 2009, when it was fixed for mention by Respondents law firms.

27. In fact the matter was revived when the 1st Respondent's learned counsel Mr Katiku, on 16th July, 2009, informed the Honourable Tribunal that, the order issued in H.C No. 468 of 2008 and extracted by the Appellant, allegeding that the proceedings before the Honourable Tribunal had been stayed, was misleading and invalid. He clarified that the court gave the Appellant leave to file proceedings, but there was no order staying the proceedings. The Appellant conceded to that fact.

28. Be that as it were, the revival of the proceedings was short lived as the Appellant filed yet again another application; HC Misc. Application No. 170 of 2011, seeking for similar orders as sought for in the previous application. By this time, the application for revocation, had been fixed for hearing on 24th January, 2011 and the Tribunal had directed the parties to file written submissions and authorities to shorten the hearing, slotted for 26th July, 2011. On that date, the matter did not proceed as the Appellant had obtained leave in the Misc. Application No. 170 0f 2011, that operated as a stay of proceedings.

29. This background information clearly reveals that the Appellant elected to pursue the issue of jurisdiction in the High court and not before the Honourable Tribunal. In deed from the 7th March 2000, when the Appellant filed the grounds of opposition, it had not raised the issue of jurisdiction with the Honourable Tribunal.

30. The Appellant only raised the issue before the Honourable Tribunal, on 9th November 2011, by filing a Notice of objection on ground of jurisdiction. The notice of preliminary objection was thus filed eleven (11) years after the Appellant responded to the Application for revocation. The question that arises is; why didn't the Appellant raise the issue of jurisdiction before the Honourable Tribunal at the outset? Whatever the reasons, the notice was premised on the grounds that:-

> *a) the Honourable Tribunal as constituted lacks jurisdiction to hear and determine the Requestors application; and*
>
> *b) the Honourable Tribunal is bound by the decision of the High Court in H.C No. 170 of 2011, staying further proceedings regarding patent No AP773.*

31. However, it is not clear from the record of the proceedings of the Honourable Tribunal whether the Notice of objection filed by the Appellant was ever heard. The last record of the proceeding was on 10th August 2011, when the court was informed by the learned counsel, Mr Mulandi holding brief for the learned counsel Mr Mutiso for the Appellant that, the matter in the High Court was due for hearing on the 25th October 2011 and sought that the Application before the Honourable Tribunal be heard thereafter. The Application was then stood over to 26th October, 2011 for mention, with orders that notice to issue. There is no record or evidence that the notice of objection was heard and/or determined. It can only be concluded that it was abandoned.

32. This position is evidenced by the sentiments in the ruling of the Honourable Tribunal (at pages 45 and 46 of the Record of Appeal) that, the Appellant did not fully participate in the hearing of the Application by the Respondents. The Honourable Tribunal states as follows:-

> *" The Respondents instead focused their energies and arguments on challenging the jurisdiction of the Tribunal to hear the matter by filing up to five (5) applications in the High Court under Miscellaneous Application Numbers 661 of 2001, 26 of 2005, 468 of 2008, 170 of 2011 and 208 of 2011 all of which were duplications of the same prayers and suffered the similar fate of failure. It was in this diversionary trend that the Respondents probably failed to even file affidavit evidence or submissions in the very matter that mattered most to its patent namely these proceedings. Indeed apart from filing the grounds of opposition which in themselves were general in nature, the Respondent in our view did nothing to defend the challenge of its patent and the matter stood unopposed literally. Further still and in sync with the Respondents cursory regard to the matter we note from the record that on the following dates namely; 2.12.2004, 10.12.2004, 13.1.2005, 20.1.2005, 18.6.2005, 26.7.2011 when the matter came up for hearing or fixing a hearing date the Respondents did not attend or give any reasons for his absence. It got worse and regrettably so, when on 16th July 2009 it was established that the Respondent served the Tribunal with an order that was established that the Respondents served the Tribunal with an order that was at variance with the actual position in the High Court file leading to the verification through*

secondary means. These actions or omissions by the Respondents in our view led to the conclusion that there was never any intention to proceed with the defence in this matter"

33. It is therefore clear that the Honourable Tribunal did not have a chance to pronounce itself on the issue of jurisdiction and more so on the challenge filed before it. The questions that arise are: Did the Honourable Tribunal assume jurisdiction that it did not have? Was there any order from the High Court that declared that the Honourable Tribunal did not have jurisdiction to hear the matter before it and/or barred it from hearing the matter?

34. Before I deal with these issues, it suffices to note what the Honourable Tribunal had this to say on this issue in its ruling. It sated as follows:-

"With regard to the grounds of opposition to the effect that the Tribunal lacks jurisdiction to revoke ARIPO patents we are of the view that, that is a well settled issue both in the fate of the series of applications filed by the Respondent in the High Court and our own decision in Glenmark Pharmaceuticals Limited vs Les Laboratories Services & Another and in Misc. Civil Application No. 661 of 2009 Republic vs Industrial Property Tribunal Ex parte Chemserve Cleaning Services Limited as correctly cited by Mr Simiyu for the Applicant"

35. Be that as it were, at the risk of repeating what is already stated, I shall now consider the submissions tendered on this issue of jurisdiction. The Appellant basically relied on three grounds; firstly ARIPO protocol has established a Board of Appeal that deals with such issues under Section 4 of the protocol. Secondly, the process of registration of patent under ARIPO protocol is so elaborate that a Kenyan Tribunal cannot practically deal with the issue of revocation, without the materials required for the registration. Thirdly, if the National Tribunal revokes an internationally granted patent, how is it going to enforce its orders against ARIPO, yet no such jurisdiction is granted by the Act.

36. However, the Respondents responded that ARIPO does not have revocation nor enforcement mechanisms. It relies entirely on contracting State mechanisms to enforce and revoke patents issued by it, as provided for under Sections 59 and 103 of the Act.

37. I have considered these submissions and I note at the onset that, Kenya became a contracting state to the Harare Protocol on; Patents and Industrial Designs within the Framework of the African Regional Intellectual Property Organization (1982) (herein "the Protocol"), on October 24, 1984. It is therefore subject to the provisions thereof.

38. Pursuant to the provisions of Harare Protocol, the ARIPO Office receives and processes patent applications and administers patent grants on behalf of contracting Parties. Once a patent is granted by ARIPO, the patent offices of the designated states are notified of the grant of the patent. The patent granted has, in each designated state, the same effect as a patent registered, granted or otherwise having effect under the applicable national law.

39. In that regard the provisions of Section 3(12) of the Protocol states that:-

" A patent granted by the Office shall in each designated State be subject to provisions of the applicable national law on compulsory licences, forfeiture or the use of patented inventions in the public interest". (emphasis added)

40. This provisions mirror the provisions under Section 59 of the Industrial Property Act No. 3 of 2001 which states as follows:-

"A patent, in respect of which Kenya is a designated state, granted by ARIPO by virtue of the ARIPO Protocol shall have the same effect in Kenya as a patent granted under this Act except where the Managing Director communicates to ARIPO, in respect of the application thereof, a decision in accordance with the provisions of the Protocol that if a patent is granted by ARIPO, that patent shall have no effect in Kenya."

41. The question that arises is what the word(s) "shall have the same effect" or "effect" meaning or connote? The Legal Dictionary states that the meaning or definition of the word "effect" is:-

" ....(As a verb) to do; to produce; to make; to bring to pass; to execute; enforce; accomplish. (As a noun); that which is produced by an agent or cause; result; outcome; consequence. The result that an instrument between parties will produce in their relative rights, or which a statute will produce upon the existing law, as discovered from the language used, the forms employed, or other materials for construing it. The operation of a law, of an agreement, or an act. The phrases take effect, be in force, and go into operation, are used interchangeably. (emphasis added)

42. According to Black Law Dictionary, the term "effect" means:-

"The result which an instrument between parties will produce, In their relative rights, or which a statute will produce upon the existing law, as discovered from the language used, the forms employed, or other materials for construing it. The phrases "take effect," "be in force," "go into operation," etc., have been used interchangeably ever since the organization of the state. Maize v. State, 4 Ind. 312".

43. In my considered opinion, the words "shall have the same effect" mean that the patent granted by ARIPO, shall be subject to the law of the contracting state in same way, as the patent granted by that state. Thus the ARIPO patent shall be so subjected to the national legislation in terms of inter alia; enforcement, administration, compliance, infringement and/or recognition and protection of the rights of the patent holder(s). It will be subjected to the domestic environment in which it operates and to the public interest of the contacting state, so long as

that contracting state did not object to its registration.

44. In that regard, the provisions of Section 3(14) of the Protocol states that:-

> *" (b) An ARIPO patent shall confer on its proprietor from the date on which the mention of its grant is published in the ARIPO Journal, in each Contracting State in respect of which it is granted, the same rights as would be conferred by a national patent granted in that State.*
>
> *(c) An ARIPO patent application shall on the date of its publication provisionally confer upon the applicant the protection provided for in Section 3(14)(b) in the contracting states designated in the application*. Any contracting state may prescribe that an ARIPO patent shall not confer such protection as specified in Section 3(14)(b).
>
> *(d)* ***An infringement of any ARIPO patent shall be dealt with by the national law of the Contracting State" (emphasis added)***

45. From these provisions, it is evident that the contacting states has wide powers to deal with the enforcement of the ARIPO granted patents. It is also noteworthy that, under Section 3(7) of the Protocol before expiration of six months from the date of the notification of application of ARIPO patent, the contacting states may under Section 3(6)(a) of the Protocol, make a written communication to the ARIPO office that, if a patent is granted by the office, that patent shall have no effect in its territory for the reasons–

> *(i) that the invention is not patentable in accordance with the provisions of this Protocol, or*
>
> *(ii) that, because of the nature of the invention, a patent cannot be registered or granted or has no effect under the national law of that State.*

46. In that regard, the contracting state is deemed to be an agent of the contracting state in assessing the application for registration and grant of a patent. Once granted it becomes subject to and is regulated by the contracting state's laws.

47. This position is fortified by the fact that, the Protocol does not make provision for revocation of the patents it grants. In my considered opinion, the draftsman did not, make a mistake and neither was it an omission but it was intended that, once the patent becomes subject to the national laws, then all the issues that appertain to it including enforcement or infringement would be subjected to the national law as aforesaid

48. In deed the provisions of Article 2 (5) and (6) of the Constitution of Kenya provides that:-

> *"2(5) The general rule of international law shall form part of the law of Kenya.*
>
> *2(6) Any treaty or convention ratified by Kenya shall form part of the law of Kenya under this Constitution."*

49. To revert back to the submissions the Appellant argued that, the Board of Appeal under the protocol has the mandate to deal with the issue of revocation of the patent issued by ARIPO. However, I note that the functions of the Board are detailed as follows:-

> *(a) to consider and decide on any appeal lodged by the applicant in terms of Section 3(5) of this Protocol;*
>
> *(b) to review any final administrative decision of the Office in relation to the implementation of the provisions of this Protocol, the Banjul Protocol on Marks or any other protocol within the framework of ARIPO;*
>
> (c) *to decide on any other matter related to or incidental to the exercise of the Board's powers*.

50. It is evident, that the Board has no power to entertain an application for revocation of a patent issued by ARIPO. This is understandable in the sense that, the Board has appellate jurisdiction and issue of infringement are dealt with in accordance with the laws of and by the contracting state. Therefore recourse falls in the provisions of the national laws, and in that, case the provisions of Section 103 of the Industrial Property Act No. 3 of 2001, come into play. The said provisions provides as follows:-

> *"Revocation of Invalidation*
>
> *(1) Any interested person may in proceedings instituted by him against the owner of a patent, or a registered utility model or industrial design or in proceedings instituted against him by the owner, request the Tribunal to revoke or invalidate the patent, utility model or industrial design registration.*
>
> *(2) Deleted by Act No. 11 of 2017, Sch.*
>
> *(3) The Tribunal shall revoke or invalidate the registration of the patent or the utility model or industrial design on any of the following grounds:-*
>
> > *(a) That the owner of the Patent is not entitled under section 30, 31 or 32 of the Act to apply for the grant of a patent;*

(b) That the owner of the patent is in infringement of the rights of the person filing an application for revocation of the patent or of any persons under or through whom he claims;

(c) That the invention does not relate to an art (whether producing a physical effect or not), process, use, machine, manufacture or composition of matter which is capable of being applied in trade or industry

(d) That the intention is obvious in that it involves no inventive step having regard to what was common knowledge in the art at the effective date of the application;

(e) That the invention, in so far as it is claimed in any claim of the application is not useful;

(f) That the patent does not fully describe and ascertain the invention and the manner in which it is to be performed;

(g) That the patent does not disclose the best method of performing the invention known to the owner of the patent at the time when the specification was lodged at the Institute;

(h) That at the time the application for the grant of the Patent was filed, the application form or any other documents filed in pursuance of the application contained a material misrepresentation; or

(i) That the invention is not new in terms of section 23 of the Act.

54. It is unfortunate that the Appellant did challenge the reasons advanced by the Honourable Tribunal in revoking the subject patent and choose to deal with the issue of jurisdiction only. However, to put this matter in perspective, the grounds the Respondent relied on in opposition application for revocation are that:-

a) That the patent was registered by mistake because:-

(i) As at the date of grant of the patent, there were pending opposition proceedings filed by the Respondent in a similar application for registration made before KIPI the then KIPO which had not been determined;

(ii) The Respondents (herein) and other suppliers had been manufacturing and/or marketing in Kenya and elsewhere in the world bins similar or identical to the patented bin well before the patent in this case.

b) That the patent is in respect of a matter which is not an invention at all as the same is a mere adaptation or replica of products which were at the time of grant already in the market in Kenya and elsewhere in the world for a considerable number of years.

c) That the subject matter of the invention was anticipated by prior art and available for public use;

d) That the patent lacked an inventive step;

e) That the registration of the patent is an attempt by the Appellant to close out competition;

f) That the registration of the patent is contrary to public policy for reserving to the Appellant exclusive use of a product which for many years had been available for public use;

55. In my opinion these grounds fall under section 103 of the Act. However, the question that remains to be answered is, the jurisdiction to revoke the subject patent. In that regard, it suffices to note that, the Appellant filed and/or have been involved in quite a number of applications in the High Court challenging the jurisdiction of the Tribunal to hear and determine the application to revoke the subject patent No.AP 773 as herein detailed. Apparently they were not successful. In the Misc Application *ITP No. 57 of 2008, Chemserve Cleaning Services Limited vs Sanitam Services (EA) Limited*, the Honourable Tribunal on 1st October 2009, ruled upon hearing the application to revoke the subject ARIPO patent, that it did not have jurisdiction and the application should be canvassed at the ARIPO, in whose custody all the registration documents are and where the avenue to appeal to the Board of Appeal, has been laid down in the protocol.

56. However, that decision was set aside by the High Court, through a ruling delivered on 1st December 2010 in *Misc. Application No. 661 of 2009; The Republic vs Industrial Property Tribunal Exparte Chemserve Cleaning Services Limited*, on Appeal by the Ex-parte/Applicant, whereby the quashed the said ruling of the Honourable Tribunal and issued an order for mandamus directed to the Tribunal compelling it to reinstate, hear and determine the application for revocation of the subject patent No. AP773 filed by the Applicant on 12th April 2008. The court also issued an order of certiorari to remove the matter from the court.

57. This finding was based mainly on a letter written by C.J. Kiige, Senior Director Technical & Infrastructural Development at ARIPO office in which he expressed stated inter alia as follows;

"I therefore wish to confirm that the Harare Protocol does not provide for a revocation procedure after grant of a patent. Such revocation procedures fall within the jurisdiction of the applicable national law of each designated state.

Revocation of AP773 with respect to Kenya as a designated state is subject to procedure under the relevant Kenyan Law."

58. The content of this letter supports the finding herein that, the provisions of Section 3(11) of the Harare protocol and Section 59 of the Industrial Property Act 2001,of Kenya, confer power on the Tribunal herein to hear and determine an Application for revocation of a patent issued by ARIPO. This finding is also supported by the decision in; *Glenamrk Pharmaceuticals vs Les Laboratories (16-06-2011).*

59. The Appellant further submitted that, the Honourable Tribunal does not have jurisdiction to entertain the subject application herein in view of the fact that, the documents of registration are not available for consideration. However, under Section (3) of the Protocol, upon grant, an ARIPO patent becomes a bundle of patents that are subject to the national law of each designated stated and each national patent derived from the same ARIPO independent of other national patents derived from the same ARIPO patent. This principle is referred to "as" independence of patents and is contained in Article 4bis of the Paris Convention, a convention that is a cornerstone of Industrial Property Laws worldwide.

60. From the foregoing, it is clear that, the Tribunal has the jurisdiction to hear an application of revocation of an ARIPO patent and the Tribunal herein had jurisdiction to hear and determine the application for revocation of the subject patent. Therefore, the Appeal herein cannot succeed on the ground of lack of jurisdiction. Taking into account the fact that, the Appellant chose to rely entirely on the ground of jurisdiction and abandoned all other grounds, I find that the Appeal has no merit. I uphold the decision of the Honorourable Tribunal and dismiss the Appeal with costs to the Respondent.

61. Those are the orders of the Court.

Dated, delivered and signed in an open court this 25th day of April 2019.

G.L. NZIOKA

JUDGE

In the presence of;

Mr. Mutiso for the Appellant

Mr. Simiyu for the Respondents

Dennis .....Court Assistant