



REPUBLIC OF KENYA

IN THE HIGH COURT OF KENYA

CIVIL APPEAL NO. 338 OF 2013

THE AGRICULTURAL AND PROCESSED FOOD PRODUCTS

EXPORT DEVELOPMENT AUTHORITY (APEDA)..APPELLANT

VERSUS

KRISH COMMODITIES LIMITED.....RESPONDENT

(Being an Appeal from the Ruling and Decision of the Learned Registrar of Trade Marks Dr. Henry Kibet Mutai delivered on 17th May, 2013)

JUDGMENT

This appeal arises from the ruling of the Registrar of Trademarks delivered on 17th May, 2013. The facts presented before the Registrar of Trade Marks were fairly straight forward. In October, 2009 the respondent herein filed six applications for registration of trade marks. They all related to different names but included the words “BASMATI RICE”. The applications however, stated that the words ‘WALI’, ‘BASMATI’ and ‘RICE’ each separately and apart from the mark as a whole were disclaimed.

Subsequent thereto, a notice of opposition was filed by the appellant objecting to the issuance of the trade marks. The grounds set out by the appellant in opposing the registration included the fact that ‘BASMATI’ was a geographical indication grown and produced in a specific region of the Indian Sub-continent at the foothills of the Himalayas and falling in India and Pakistan. It was contended that the respondent sought to benefit from the substantial reputation and goodwill built up in connection with the name ‘BASMATI’ which the appellant had been promoting and securing protection worldwide.

The appellant also submitted that the respondent had no claim in law or equity to own or use the contested mark, and that the proposed registration was meant to deceive the public into believing the respondent had proprietary right over the word ‘BASMATI’.

It was also the appellant’s position that it had successfully opposed applications for registration by third parties of the name ‘BASMAT’I in various jurisdictions including Kenya. To counter this opposition the respondent filed documents secured from Kenya and Pakistan to show that no exclusivity could be claimed by the appellant relating to the contested mark. The appellant however, doubted the veracity and authenticity of those documents and sought their rejection.

Parties filed their submissions but in a considered ruling, the Registrar gave the following decision,

“1. The opponent has the locus standi to bring these oppositions;

2. That whereas the applicant does not claim exclusive rights to the use of the word *BASMATI*, the opponent has not established any proprietary rights to the word such as would enable it to prevent its registration as a mark by any other party;

3. That the opponent has not established that under Kenyan Law the word *BASMATI* is a mark whose registration is prohibited by reason of its being a geographical indication;

4. The opponent has not been guilty of laches;

5. The specification of goods in the respective applications is irregular and should be amended in all six applications to “*BASMATI RICE*”; and

6. Costs are awarded to the applicant”.

The appellant was given 60 days to lodge an appeal which was done. The summary of the grounds of appeal is that the Registrar erred in fact and in law in finding that the duties and responsibilities under the APEDA Act, of 1985 do not vest ownership of the name *BASMATI* in the appellant in the Kenya jurisdiction. The Registrar was also faulted for holding that the appellant had not established that under the Kenyan Law, the word ‘*BASMATI*’ was a geographical indication and that the appellant had not established the respondent’s intention to deceive the general public about the ownership of the word ‘*BASMATI*’. Further, the appellant alleged the Registrar misdirected himself in concluding that the appellant should have filed an application for registration under Section 40A of the Trade Marks Act (Cap 406 Laws of Kenya) for the word ‘*BASMATI*’ to enjoy protection as a geographical indication in Kenya, as he had correctly held elsewhere in his finding that an application for registration under the said section was not mandatory for purposes of enforcement of geographical indication rights.

The appellant also complained that in allowing the registration of the six trademarks which incorporated the word *BASMATI*, the Registrar proprietary rights not belonging to the respondent. The award of costs was also contested.

Under the Kenyan Law and in particular Section 21 (2) of the Trade Marks Act, the appellant had all the rights to raise the objection. The said section reads as follows,

“Any person may, within the prescribed time from the date of the advertisement of an application, give notice to the Registrar of opposition to the registration”.

I have considered the proceedings before the Registrar and the cited provisions of law and decided cases. The appellant is not the owner of the contested mark and has not shown any proximity relating to proprietorship of the said mark. In fact, the thrust of the appellant’s opposition is that being a statutory body established in India for purposes of representing the interests of various stakeholders involved in farming, this processing and exporting of various agricultural products gave it the authority to raise the issues.

That status regrettably falls short of establishing ownership of the trade mark. The appellant had filed a statutory declaration dated 1st November, 2010 whereat paragraph 12 stated that it had lodged an application to register *BASMATI* as a geographical indication in India. Going by the dates of the objection and the said statutory declaration, it would appear that as at the date of filing the objection herein, *BASMATI* was not formally and legally registered as a geographical indication in India.

For purposes of clarity, “**geographical indication**” is a term designated under the laws of its country of origin to identify goods from which “**a given quality, reputation or other characteristics.... Is essentially attributable to its geographic origin.** – See The Trade Related Aspects of Intellectual Agreement (TRIPS). There is not a single indication that *BASMATI* can be assigned any geographical indication either in India or Pakistan. In any case no opposition has been raised from Pakistan. I have observed elsewhere in this judgment that the respondent exhibited a document issued by Mwea Co-operative Society Limited showing a liberal use of the word and name *BASMATI*. It would appear that

under the Kenyan Law that mark is not protected by any geographical indication giving the impression that it is registerable.

When all factors and submissions are taken into consideration, the respondent cannot be faulted or prohibited from the registration of the disputed mark.

The submission by the appellant and which attracted the attention of the Registrar that the respondent intends to deceive the public into believing it has proprietary rights over the word and name BASMATI has not been backed by any evidence on record.

No economic prejudice or loss has been established or has been alleged to have visited upon the appellant by the application lodged by the respondent.

I am persuaded on the Kenyan Law on registration of trademarks and related cases that the Registrar of Trade Marks could not have come to a different decision and therefore uphold his findings. The end result is that the appeal is hereby dismissed with costs to the respondent.

Dated and delivered at Nairobi this 26th Day of April, 2017

A. MBOGHOLI MSAGHA

JUDGE