



REPUBLIC OF KENYA
IN THE HIGH COURT OF KENYA AT NAIROBI
COMMERCIAL & ADMIRALTY DIVISION - MILIMANI
CIVIL SUIT NO. 588 OF 2014

SAFEPAK LIMITED..... PLAINTIFF

VERSUS

GENERAL PLASTIC LIMITEDDEFENDANT

RULING

1. I have before me an Application brought by the Plaintiff in this matter, Safepack Ltd. It comes before the Court under a Certificate of Urgency dated 15th December 2014 and filed the following day. The Certificate of Urgency is based on the Grounds that:

- (1) The Defendant has infringed on the Plaintiff's registered Design No. 666. It is imperative that this Court issues an injunction to prevent the Defendant from infringing on the Plaintiff's Design.*
- (2) Unless the Defendant is restrained by an injunction from infringement of certain features of the Plaintiff's registered Industrial Design, the Plaintiff will suffer irreparable harm, loss and damage.*
- (3) The Plaintiff has expended significant intellectual and monetary effort in coming up with the unique features of the design that the Defendant is infringing.*

2. The Application by Notice of Motions itself, seeks the following orders on the Grounds set out below:

Orders Sought

3. The Plaintiff seeks Orders that:

- (1) This application be certified urgent*
- (2) An urgent date be set for the inter partes hearing of this application'*
- (3) Pending the hearing and determination of this suit, an injunction be issued restraining the Defendant whether by itself, its directors, officers, employees, servants or agents or otherwise howsoever from infringing the Plaintiff's Industrial Design registered as number 666, in particular:*
 - (i) Infringing on the Plaintiff's protected feature of the honey comb pattern applied on the shoulder of the container.*

(ii) Manufacturing, importing or exporting, selling, offering for sale, distributing, marketing bottles or other similar products manufactured from the reproduction, imitation or infringement of the Industrial Design registered as No. 666.

(iii) Parting with possession, power custody (other than to the Plaintiff or its agents) of or in any way altering, defacing or destroying products or moulds which are used by the Defendant to commit acts of infringement of the Industrial Design registered as number 666.

(iv) Parting with possession, power custody (other than to the Plaintiff or its agents) of all moulds, documents files, invoices, receipts, articles or equipment relating to the importation, purchase, ,manufacture, sale or supply of the infringing bottles, moulds and other products.

(v) The costs of this application be awarded to the Plaintiff.

Grounds

4. The Grounds relied upon in the Application are that:-

(a) The Plaintiff is the registered owner of Industrial Design number 666 and has been the owner of the said design since 2012.

(b) In the Plaintiff's statement of novelty filed under Rule 47 (8) of the Industrial Property Regulations 2002 at KIPI on 20th September 2011 for registration of the Industrial Design, the Plaintiff indicated that the novelty of its design "lies in the honey comb pattern applied on the shoulder of the container in the context of a container having a shape and configuration". The Plaintiff's protection in respect of the design covers all the different aspects of the design.

(c) The Defendant's infringing container embodies substantially similar features of "the honey comb pattern applied on the shoulder of the container". This feature is embodied and specifically protected in the Design No. 666. The fact that the Defendant has applied and used the above feature on the infringing container such that it appears substantially similar to the Plaintiff's design constitutes an infringement of the Plaintiff's registered Design.

(d) The overall shape of the Defendant's infringing container is not substantially different from the Plaintiff's registered design No. 666. However, the claim for infringement is restricted to the specific feature of the honey comb pattern applied on the shoulder of the container which is protected by the Design registration No.666.

(e) The slight variations made by the Defendants to the container do not confer any individual character or personality on the infringing product so as to give it a visual appearance or identity that can be regarded as being substantially different from that of the Plaintiff.

(f) The Defendant is manufacturing and stocking/selling bottles for sale which are a reproduction of the Plaintiff's protected Design.

(g) The Plaintiff has expended significant intellectual and monetary effort in coming up with the unique features of the design.

(h) The Defendant by infringing on the Plaintiff's registered design is seeking to benefit from the origination of the novel feature which the plaintiff has created and the goodwill associated with the plaintiff's unique container which is represented by the registered design.

(i) Unless the Defendant is restrained from infringing on the features of the Plaintiff's registered Industrial Design, the Defendant will continue with the infringement and the Plaintiff will suffer irreparable loss and damage.

5. In summary, it is the Plaintiff/Applicant's case that it is and has been the owner of Registered Industrial Design No. 666 since pursuant to the Certificate of Registration dated 6th June 2012. A copy appears as Exhibit **CWK 1**. The attached statement of Novelty states that "*The novelty of this design has in the honey comb pattern applied on the shoulder of the container in the context of a container having such a shape and configuration and drawings of the container are set out*".

6. The Plaintiff's claim is that the Defendant's bottles are infringing that Design right and Registered Industrial Design.

Submissions/Legal Argument

Plaintiff/Applicant's case

7. I have read the Affidavits and Written Submissions filed together with the copies of authorities so helpfully provided by both Parties.

8. The Written Submissions on behalf of the Plaintiff were not filed until 11th September 2015 despite the Order of the Court made on 24th December 2014 which directed that filing and service should be within 14 days after the Exchange of Affidavits.

9. In the submissions filed on behalf of the Plaintiff/Applicant it is said, by way of background, that the Plaintiff is the registered owner of Industrial Design No. 666 and has been the protected owner since 2007. It is said the claim for infringement is restricted to the specific feature, of the honey comb pattern applied on the shoulder of the container that is what is protected by Design No. 666. The Defendant has applied and used that feature in particular the honey comb pattern applied on the shoulder of the infringing bottle and as such it is substantially similar in appearance to the Plaintiff's design and as such constitutes an infringement of the Plaintiff's registered design.

10. The Plaintiff asserts that the Defendant is manufacturing and stocking and selling bottles for sale which are a reproduction of the Plaintiff's protected design. The Plaintiff states in its Grounds that the slight alterations made by the Defendant do not confer any individual character or personality on the infringing product so as to give it a visual appearance or identity that can be regarded as substantially different from that of the Plaintiff. It is also stated that the Plaintiff has expended significant intellectual and monetary effort in coming up with the unique features of the design.

11. The Defendant opposes the Application on the grounds that the Design Right should not have been registered or certified due to the absence of originality.

12. The Plaintiffs Application is straightforward in that it claims that it is the Registered Owner of Registered Design 666 registered under Part XIII - **Sections 85 et seq** of the **Industrial Property Act 2001**. The Plaintiff has exhibited to the Application a copy of the appropriate certificate. The fact that such registration and certificate exists is indisputable. The Plaintiff alleges that the Defendant has breached the rights conferred by copying the design the production of containers. The main features complained of are the use of two rows of the honeycomb design upon the shoulder of the container- which in this case is a bottle.

13. The Plaintiff states that it has expended time and expense in coming up with an original design. There is no evidence of that expenditure before the Court and it is not a factor that needs to be decided finally at the interlocutory stage given that a certificate of Registration exists. That certificate contains a statement of novelty.

14. The Defendant has not denied that it has produced bottles applying the honey comb design to the shoulder of the bottle. It seems to be common ground that the Defendant manufactures bottles and sells them as a commercial enterprise and in the course of that enterprise produced what the Plaintiff calls the "*infringing bottles*".

15. The Defendant has filed a Replying Affidavit sworn on its behalf by a Victor Fernandes. In his Replying Affidavit he states that the Defendant/Respondent Company, is involved in manufacturing and selling containers and/or bottles both in Kenya and outside and it has been in business since 1980.

16. The Deponent then goes on to accept that the Plaintiff is the owner of Industrial Design No. 666, but then says he has been advised that the registration is null and void. He then goes on to explain that the honeycomb design on bottles containing honey is a common feature in other jurisdictions. He does not deny that the Respondent Company has produced what the Plaintiff refers to as “*the infringing bottles*”. He does not say that the infringing bottles were imported lawfully from such a jurisdiction and therefore fall within Section 92(2) of the Industrial Property Act.

17. The Replying Affidavit goes into great length presenting arguments challenging the Registration verify whether or not the design was original or novel in particular the statement of novelty and the failure of the Kenya Industrial Property Institute. (KIPI) to carry out a due diligence to Paragraph 15 of the Replying Affidavit states that the Respondent is “*making arrangements*” “to commence Revocation proceedings under Section 103 (3)(i) of the Act. There is no evidence before the Court whether those proceedings have (a) been commenced and (b) had the outcome the Respondent desires. In the circumstances the Certificate of Registration of Design No. 666 stands.

18. I find the absence of a denial to be a tacit admission that the Respondent carried out the acts complained of by producing the infringing bottles”. In paragraph 19 of the Replying Affidavit, it is said that: Due to the temporary Order for injunction issued 16th December 2014 the Respondent have stopped manufacturing and selling the disputed bottles/containers. The way in which that statement phrased in way that suggests that had it not been for the injunction the Respondent would have continued to manufacture, produce, store sell and possible import the items complained of.

19. In its Written Submissions the Defendant puts forward the Defence of prior Art. It also challenges the validity of the Design on the basis that the design is not original should not have been registered under **Section 86** of the **Industrial Property Act**. The Plaintiff has rebutted that argument by saying that those issues are for deliberation by the Tribunal.

20. In paragraph 5 of its written submissions the Defendant/Respondent has not denied the use of a container having a honey comb pattern applied on the shoulder of the container. It then states that the only issues for determination are:-

(1) As at the time of filing this case and indeed prior to that did the plaintiff have any design capable of being protected under the provisions of the Industrial Act 2011, and

(2) Does the court have jurisdiction to consider the Defence of prior art in infringement proceedings?

21. In fact what the Defendant’s Submissions argue upon is the additional issue of a validly registered design rights. That is whether a certificate of Design can be challenged as invalid as a defence and then became unenforceable under Section 105 of the Act. Alternatively, was the registration validly done?

22. The Defendant’s opposition to the making of the Orders sought rests squarely on the issue of the validity of the certificate. It is the Defendant’s position that at the time the Certificate of Registration was granted (2012) the Design, namely a bottle with a honey comb design was not original and was in common use. It is also argued that there was no creativity or ingenuity involved because the Plaintiff simply copied the design from elsewhere and, “*reverse-engineered*” to produce the design submitted for registration.

23. The Defendant goes on to argue that the Certificate of Registration of the Design is therefore void and in consequence a nullity. The Defendant has referred to three authorities in support of that proposition.

24. The Plaintiff has responded to these arguments in a document entitled “***Applicant’s Rejoinder***” it is argued that there is a process provided for Registration of a Design. That process was followed by the Plaintiff. That process also provides for an interested person to apply to the Tribunal to revoke or invalidate a Registration of Design.

25. The Plaintiff also urges upon the Court consistency with previous decisions of the High Court in keeping with the principle of stare decisis, “*The principle of stare decisis requires that, although not bound to do so, the court should follow the decision of a judge of equal jurisdiction unless the decision appears to be clearly wrong. It is vertical application, a court is bound by the decisions of a court superior to it. Horizontally, while it may be desired for the sake of certainty and consistency that the court does not deviate from decisions of the courts of the same rank, decisions of courts of concurrent jurisdiction are only persuasive and cannot bind the court.*” (***Civil Appeal No 158 of 2007***)

26. The Defendant relies on the authority of ***London Distillers Limited vs. Ponu Manu Suppliers, Industrial Property Tribunal Case No IT No 47 of 2006*** where the defence of prior art was raised, alleging the design lacks novelty. One of the issues to be determined was whether the Industrial Design was duly and properly registered raising issues of novelty. That dispute was before the Tribunal not the High Court. The Tribunal also considered the question of jurisdiction. On the final page of the authority the decision is set out. It recognises the Tribunal has jurisdiction to revoke the certificate.

27. That decision goes onto say that upon becoming aware of a registered design the Respondent was statute bound to file revocation proceedings under Section 103 (2). Section 103 (2) provides:

“103(2) 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 registration. (emphasis added).

The grounds on which this challenge can be mounted are listed in **Section 103(3)** including (i) that the invention is not new in terms of section 23 of the Act.

28. The Respondent’s latest submissions are entitled “***Respondent’s Rejoinder to Applicant’s submissions....***”. It is not clear why the parties have reverted the use of terminology more appropriate for pleadings before the advent of the Civil Procedure Rules 2010. It adds nothing.

29. In addition to the Defendant’s argument is that the High Court has Jurisdiction to revoke the certificate of Registration and it is said it was an erroneous act by the Managing Director to issue the Certificate of Registration. The un numbered argument on page 2 of the “*rejoinder*” then states that:

“*The Respondents is not asking this court to revoke design NO. 666 but declare does not belong to the Applicant and the Applicant did not qualify to apply for its registration because it was already in the public domain...*”.

That sounds like the Respondent’s Advocate has resiled from his primary argument as to revocation and is now asking for a declaration of sorts.

30. Although it is correct that both of the last 2 authorities relied upon by the Respondent of ***London Distillers Limited vs. Ponu Manu Suppliers, Industrial Property Tribunal Case No IT No 47 of 2006*** and ***Glenmark Pharmaceuticals vs Las Laboratories T Case No 58 of 2009*** do assist the court it should be borne in mind that, the first was an infringement cases brought before the Tribunal, the outcome was the same in that the Tribunal decided that revocation was the necessary next step. In ***London Distillers*** the Tribunal states clearly that the Respondent was statute bound to bring revocation proceedings. That case cites a later case of ***Glenmark Pharmaceuticals*** (decided earlier 16th June 2011) where the Tribunal revoked a patent where the latter patent had been registered in breach of an earlier patent. The Applicant specifically sought revocation of the later infringing patent and that prayer was granted.

31. In each case the remedy of revocation was provided by the Tribunal not the High Court.

32. On the last page of the Respondent's "rebuttal" submissions, again changes stance and says "all" what the court is being asked to do is find out whether the design was validly obtained and because the Applicant has failed to prove that it obtained its design validly as per the provisions of the Act then its case for infringement cannot stand and interlocutory injunction can be made at this stage. Declarations of validity are within the preserve of the Tribunal and the High Court cannot usurp that jurisdiction.

33. The Defendant has also argued that the High Court by dint of Article 165 of the Constitution of Kenya 2010 has jurisdiction to revoke the Certificate of Registered Design. That is changed to say the court should find that Design NO. 666 was not properly registered and finally that the court should conduct an inquiry into whether or not the Registration was validly obtained.

List of Issues

34. The Issues that arise for determination at this interim stage are:

- (1) Does the Plaintiff have a Registered Industrial Design NO. 666.
- (2) Does that incorporate the feature alleged to have been copied/infringed.
- (3) Is there or has there been infringement of Registered Design NO. 666 by the Respondent.
- (4) Was the infringement, as alleged, permitted or licenced.
- (5) Did the Plaintiff ask the Respondent to cease infringement?
- (6) Did the Respondent comply before the injunction was granted. In the event is it likely that the alleged infringement would continue in the absence of an injunction.
- (7) Is there or has there been infringement of Registered Design No. 666 by the Respondent.
- (8) Which is the correct tribunal to deal with the Respondents challenge under section 103(3)?
- (9) What is the Statutory Remedy available to the holder of the Registered Design in cases of infringement?
- (10) What is the test for deciding interlocutory applications and its application?
- (11) Is the Plaintiffs case made out on a prima facie basis.

In addition,

(12) The Plaintiff considers the following issues require determination:

"Whether the Plaintiff has established a prima facie case and damages are not an adequate remedy.

(13) The submissions on behalf of the Defendant also raise the question of whether the High Court has jurisdiction to overrule and impose its own decision in circumstances where the statute, in this case the Industrial Property Act No. 3 of 2001 provides for a different body to make that decision.

(14) Is a Certificate of Registration of Design granted in circumstances where it should not have been made it void or voidable? In other words is it an irregularity or nullity.

LEGAL PRINCIPLES

35. The Industrial Property Act No 3 of 2001 sets out a codified statutory framework in relation to patents, utility models and industrial designs. The act describes each, provides for its protection by registration and defines what is to be considered infringement and the remedies available. The Act meets the perceived need to protect the ingenuity and industry that goes into developing the patents, designs etc.

36. The current application is brought to protect a design right. The definition of an Industrial Design is provided by **Section 84 (1) of the Act** which states:

“84. (1) for the purposes of this part, “an industrial design” means any composition of lines or colours or any three dimensional form, whether or not associated with lines or colours:

Provided that such composition or form gives a special appearance to a product of industry or handicraft and can serve as a pattern for a product of industry handicraft.

(3) The protection under this Act shall not extend to anything in an industrial design which serves solely to obtain a technical result.”

37. The rights of the owners of an industrial design are set out in **Section 85**. It states: *“85. (1) subject to the provisions of any other written law, the creator of an industrial design or his successors in title shall have the exclusive right to sell or cause to be sold for commercial or industrial purposes the goods in which the design is incorporated, subject to the conditions of this Act.*

(2) Section 30, 32 and 33 shall apply mutatis Mutandis to the rights of the creator of an industrial design.

38. **Sections 86 and 87** set out the process and documents required for of registration *“(1) An industrial design is registrable when it is new and (2) Industrial design shall be deemed to be new if it has not been disclosed to the public, anywhere in the world, by publication in tangible form or, in Kenya by use or in any other way, prior to the filing date or, where applicable, the priority date of the application for registration” (Section 86).*

39. The Rights and to some extent the powers acquired on registration are set out in **Section 92**. Section 92(1) of the Act is clear and categorical. It provides that Registration of the Design confers the right to preclude third parties from the following acts in Kenya *“(1) Reproducing the design in the manufacture of a product, (2) importing, offering for sale and selling a product reproducing the registered design, (3) stocking such a product for the purposes of offering for sale or selling it. (2) The rights conferred by the registration of an Industrial design shall extend only to acts done for industrial or commercial purposes and shall not extend to acts in respect of a product embodying the protected industrial design after the roduct has been lawfully imported or sold in Kenya”*

40. The Applicant complains that the Respondent’s acts fall within these additional right to bring court proceedings to prevent infringement in particular **Section 92(1)**: *“Registration of an industrial design shall confer upon its registered owner the right to preclude third parties from performing any of the following acts in Kenya:-*

(a) reproducing the industrial design in the manufacture of a product,

*(b) importing, offering for sale and selling a product reproducing the protected industrial design,
or*

(c) stocking of such a product for the purposes of offering it for sale or selling it.”

41. If a person feels that a certificate should not have been registered, **Section 103** provides the procedure for challenge.

42. **Section 105 of the Act** defines infringement as: *“Subject ot section 58,61(6), 72, 73 and 86, any act*

specified in section 54 or 92 and enforced by a person other than the owner of the patent or.....industrial design without the owner's authorization, in relation to a product or process falling within the scope of a validly granted ... or certificate or registration shall constitute the infringement."

43. Therefore the question to be dealt with first, at this interlocutory stage is has the Plaintiff established a prima facie case whether or not there has been infringement. The test was defined in the celebrated case of ***Giella vs. Cassman Brown 1973 EALR CA 385 at P.***

44. In the Plaintiff's written submissions the two separate steps, namely whether there is a prima case of the harm or risk of the harm complained of and whether damages are adequate. The two are separate steps within the analysis.

45. Similarly in the list of issues injunctive relief arises as a consideration when it is decided that damages are not adequate, not automatically if there is a prima facie case. Therefore the Court simply needs to be satisfied that there is a prima facie case, that the applicant will suffer irreparable harm which cannot be compensated for in damages and where the balance of convenience lies, as explained in the case of ***Giella v Cassman Brown (1973) EA LR 359, 360 D-F.*** These well accepted principles were set out by the Court of Appeal in ***Giella v. Cassman Brown***, and established that the court has to consider the following questions before granting injunctive relief: (i) *is there a prima facie case with a probability of success?* (ii) *does the applicant stand to suffer irreparable harm, if relief is denied?* (iii) *on which side does the balance of convenience lie?* The Court also said "***The conditions for the grant of an interlocutory injunction are now, I think, well settled in East Africa. First, an applicant must show a prima facie case with a probability of success. Secondly, an interlocutory injunction will not normally be granted unless the applicant might otherwise suffer irreparable injury, which would not adequately be compensated by an award of damages. Thirdly, if the court is in doubt, it will decide an application on the balance of convenience (E.A. Industries v. Trufoods, [1972] E.A. 420)***".

46. The next step is to decide whether or not the Plaintiff has demonstrated a prima facie case, "*a prima facie case is more than an arguable case, it is not sufficient to raise issues. The evidence must show an infringement of a right, and the probability of the applicant's case upon trial. That is clearly a standard which is higher than an arguable case.*" ***Per Bosire JA in the Mrao v First American Bank and 2 Others Civ App 39 or 2002***

DELAY

47. Consideration of delay is relevant because the Application was brought under Certificate and prayer 2 asks for early hearing date.T

48. This Application was brought under a Certificate of Urgency on 16th December 2014. An interim Order was made in the terms of prayer 3 of the namely that pending the hearing and determination of the Application.

49. Application interpartes an injunction do issue restraining the Defendant whether by itself, its directors agents, servants or otherwise howsoever from infringing the plaintiffs designs rights registered as Registered Design No. 666 etc. The Applicant was also ordered to provide a cross-undertaking for damages in the event the injunction should not have been granted. That was filed on 23rd December 2014.

50. The Application and order was to be served. The Affidavit of Service of Dominic Mwendwa Muinde deposes that was done on 19th December 2014. The Defendants Notice of Appointment of advocates was filed on 23rd December 2014.

51. The matter was listed for mention on 24th December 2014. Both parties were represented and directions were given for the filing of a Replying Affidavit and written submissions. Further the matter was listed for mention to decide whether highlighting was necessary on that day neither party bothered to

attend and the matter was stood over generally by a different Judge.

52. The Defendant did not file its Replying Affidavit until 2nd April 2015. The matter was then re-listed at the instigation of the Defendants by a letter of 25th May 2015. The mention for directions was fixed for 1st October 2015. On 1st October 2015 the Defendant raised the issue of the Plaintiff's dilatory actions and asked for the injunction to be discharged. On each occasion the matter was listed it was the Plaintiffs instructed counsel who was not present. However, the court decided not to punish the client for that conduct and the injunction was not lifted by the court and no application was made to extend it so it seems to have been in a state of limbo.

53. The Parties were to highlight their written submissions on 26th October 2015. Highlighting did not go ahead because the plaintiff's counsel was not present. The court made an order granting each party leave to file further submissions provided it was done within 7 days, that is on or before 2nd November 2015. Neither did the Applicants further submissions were filed on 9th November 2015 and the Defendants were purportedly filed on 17th November 2015 but not placed on the court file until after 3 p.m. on 15th December 2015, that is a day after the ruling was first to be delivered.

54. Both Parties appear to have taken a surprisingly lax attitude to these proceedings and the court's directions. Since each is as bad as the other, I have decided, on this occasion to consider all the submissions and arguments filed.

55. The submissions seem to take on more and more emotive language as time goes on. The issues are clear and repetition does not necessarily add value to the arguments.

Decision and Reasons

56. Both Parties have raised the question of jurisdiction in the Written Submissions. The Plaintiff argues that the Court does not have jurisdiction to revoke the Certificate of Registration of Design No 666. The Defendant first argued vehemently that the Court does have the jurisdiction to do so. In fact it went so far as to argue that under Article 165 (3) of the Constitution of Kenya 2010 which provides that "***Subject to clause (5), the High Court shall have (a) unlimited original jurisdiction in criminal and civil matters; ...***". The Plaintiff argues that the Court does not have jurisdiction. However, the Plaintiff has begun these proceedings in the High Court, therefore it is clear that it has not only submitted to the jurisdiction of the High Court but also that is asking the Court to use its powers to protect its Design Right. Unfortunately, the Parties have put their arguments in too simplistic a way, leading to a confusion as to the real issue.

57. In fact there are two issues on jurisdiction. The first is does the Court have jurisdiction to grant the relief that the Plaintiff/Applicant seeks and the second is does this Court have jurisdiction to provide the relief (in its various formats) that the Defendant/Respondent seeks. The Prayers sought by the Plaintiff are appropriately brought in this Court and this Division. In relation to the relief sought by the Respondent, firstly the Defendant was seeking revocation of the Registered Design. The Industrial Property Act No 3 of 2001 puts the power to grant a Certificate of Registered Design in the hands of the Kenya Industrial Property Institute ("***the Institute***"). Section 5 of the Act sets out the functions of the Institute which shall be (inter alia) to (a) consider applications for and grant industrial property rights". Revocation and Invalidation of a grant is dealt with in Section 103 of the Act. Section 103(1) provides "Any interested person may in proceedings instituted by him against the owner of a patent, or 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. Section 103(3) sets out the grounds upon which "***the Tribunal shall revoke or invalidate the industrial design***" (emphasis added). Therefore it is clear from the scheme of the Act that the jurisdiction to grant and revoke or invalidate a registered industrial design rests solely with the Tribunal set up for that purpose. That is its function and although there may be circumstances when the High Court could intervene, the scenario placed before the Court in this Application does not give rise to such circumstances.

58. If there was still any lingering doubt as to whether the High Court had original jurisdiction in these issues, Section 103(11) should put that firmly to rest. It provides that **“(11) An aggrieved party may appeal; against the decision of the Tribunal to the High Court.”**. Therefore the High Court has appellate jurisdiction. As there is no evidence that either Party has referred the matter to the Tribunal, the jurisdiction of the High Court is not engaged on the question of revocation.

59. The Defendant’s **“Rebuttal”** Submissions ask the Court to inquire into whether the Registration was properly and appropriately obtained, alternatively to declare the registration invalid. Again those are matters that are within the preserve of the Tribunal as set out in Section 103 of the Act. To my mind the jurisdiction is akin to the jurisdiction of an Arbitrator or a Deputy Registrar on Taxation. The High Court cannot become involved until after the matter has been referred to the Tribunal and adjudicated upon.

60. That means, there is before the Court a certificate of registration of industrial design No 666. It is on the face of it valid. There is no challenge before the appropriate Tribunal set up to deal with those matters. Under Section 85 the creator of the industrial design and his successors have the exclusive right to commercially exploit the design. If that exclusive right is infringed, there is a right to preclude third parties from performing any of the acts set out in Section 92(1) including reproducing the industrial design in the manufacture of a product.

61. The Defendant argues that the Plaintiffs registration was not properly obtained within the meaning of Section 105 of the Act. The Defendant has produced evidence to show that the honey comb design applied to the shoulder of a container was in the public domain long before the Plaintiffs design was registered. It is a fundamental tenant of litigation that he who asserts must prove. For the Defendant to prove its case there must be an inquiry as to the information before the Institute at the time of registration. The proper forum for such inquiry is the Tribunal. The Defendant knows this and says so. This matter is at the interlocutory stage. The evidence placed before the court is partly circumstantial as to what was or was not available on the inherent and partly conjecture as to what was or was not done at KIPI.

62. At this stage the Court does not hear oral evidence, nor are the statements in Affidavits tested by Cross-examination. Against the Defendant’s claims is the Certificate of registration of Industrial Design is void. The Defendants only allegations do not render it void. Firstly allegations have to be proved. Secondly, even if they are proved, they may or may not invalidate the registration. The Tribunal has the power to revoke or invalidate the registration (Section 103). It will then decide on the consequences that follow. Thirdly, even if the court did have the jurisdiction to decide that question, it could not be done without hearing evidence from both Parties.

63. On whether the Plaintiff has demonstrated on a prima facie basis that it is the registered owner of the industrial design I find It has.

64. On the question of whether the Defendant has demonstrated on a prima facie basis that the registration is void ab initio. I find it has not. The Defendant has not bothered to have gone to the trouble of referring the question to the Tribunal. Had it done so it may have raised a question as to voidability thus far it has not shown the courage of its convictions.

65. The Plaintiff relies upon previous authorities of the High Court and urges upon this court the argument of consistency under the doctrine of stare decisions. Although the Plaintiff is correct in that consistency of approach leads to certainty and that in itself leads to a stronger decision making process and junction. However, each case must be decided on its own facts and the discretion of the High court is unfettered and cannot be fettered so that a particular party can obtain the decision it wants each time. Every case must be decided on its own merits.

66. The ownership of the Industrial Design incorporated in Design NO. 666 arise from Registration. That arises from the framework of the Industrial Property Act 2001 and the International agreements leading to that Act. It is Notice the world at large. Previous Decisions of the High Court simply recognize the rights endowed by the Act. The owner of those rights is entitled to protection. That includes preventing

exploitation by Third Parties. The owner is entitled under the Act to seek such relief from the Courts. In the circumstances as long as the Plaintiff remains such owner it is entitled to that protection. Damages is not sufficient remedy for loss of the statutory protection.

67. I am satisfied on the evidence before me which I accept is limited to two dimensional photos and drawings, that the bottles/containers produced by the Defendant do infringe the Plaintiffs Registered Industrial Design. Although there are differences the two articles are substantially the same with a starting point of a honey comb design of at least 2 rows applied to shoulder (Plaintiff's design) on a bottle of almost identical shape.

68. As to whether there is a risk that the Defendant will infringe the Design right if no injunction is granted, given the strength of opposition and the Defendants own affidavit that infringement after the ex parte injunction was granted, I am satisfied that there is a risk that it will continue.

69. As to the question of where the balance of convenience lies, I am satisfied that the balance of convenience lies in favour of maintaining the status quo. Bearing in mind that I have not decided the matter on its merits, I hold that maintaining the status quo also requires the Plaintiff to renew its Cross-undertaking in damages in the event that it is found at trial that the interlocutory injunction should not have been granted.

70. I have read all the authorities provided and referred to by the parties including both sets of submissions. I do not set them out line by line in the interests of speed and clarity but I have taken into account the factual allegations and legal principles put forward.

71. I therefore allow the Plaintiffs application to a limited extent to prevent infringement until trial.

72. The Defendant has complained that it has not been served with a summons to enter appearance. There are undated copies on the Summons on the court file. These can be extracted and served to enable the Defendant to file a Memorandum of Appearance and Defence.

73. I do not make order in terms of prayer 3(III) and 3(IV) as that may impinge on the Defendants ability to refer the matter to the Tribunal for consideration of the issues raised here if it decides to do so.

74. Although the Plaintiff has also raised arguments more appropriate for a passing-off claim I make no decision in relation to ingenuity and expense as there is no evidence before me on those issues at this stage.

ORDER

76. The Defendant whether by itself through its servants, agents, directors, employees or howsoever is forbidden from infringing the Plaintiffs Registered Industrial Design in particular the following:

- (a) reproducing the industrial design in the manufacture of a product,
- (b) importing, offering for sale and selling a product reproducing the protected industrial design, or
- (c) stocking of such a product for the purposes of offering it for sale or selling it."

77. Plaintiff to provide Cross-undertaking in damages to trial.

78. Costs in the Cause.

Order accordingly.

Dated Signed and Delivered on 16th day of December 2015.

FARAH S. AMIN

JUDGE

Coram

Hon. Lady Justice F. Amin

CC Kabugi

In the Presence of:

Mr Mr Ahmed Jelle holding Brief for Mrs Opiyo

Clerk from the Respondent's Advocates

(who explained that he was unable to find an Advocate to attend).