



**REPUBLIC OF KENYA**  
**IN THE HIGH COURT OF KENYA AT NAIROBI**  
**MILIMANI COMMERCIAL & ADMIRALTY DIVISION**  
**CIVIL CASE NO. 207 OF 2013**

**SAFEPAK LIMITED ..... PLAINTIFF**

**VERSUS**

**ASILI PLASTICS LIMITED ..... DEFENDANT**

**R U L I N G**

1. The Plaintiff herein filed a Notice of Motion dated 22nd May 2013 which sought the following substantive Order:

**“3. THAT 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 646, in particular:**

- i. Infringing on the Plaintiff’s protected feature of twisting vertical ribs from the top of the shoulder to the bottom of the waist.**
- 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. 646.**
- 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 646.**
- 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”.**

The Plaintiff’s Application was brought under the provisions of **Order 40 rules 1, 2 and 3** of the *Civil Procedure Rules, 2010* as well as under **section 1A, 3A and 63 (e)** of the *Civil Procedure Act*. More importantly it was brought under the provisions of **section 92 (3)** of the *Industrial Property Act*

No. 3 of 2011 (hereinafter “the Act”).

2. The grounds upon which the Plaintiff’s said Notice of Motion were based are set out as follows:

**“(a) The Plaintiff is the registered owner of Industrial Design number 646 and has been the owner of the said design since 2011.**

**(b) In the Plaintiff’s statement of novelty filed under Rule 47 (8) of the industrial Property Regulations 2002 at KIPI on 18<sup>th</sup> November 2008 for registration of the industrial design, the Plaintiff indicated that the novelty its design “*lies in the pattern of twisting vertical ribs from the top of the shoulder to the bottom of the waist. This feature combined with the overall shape of the container gives the container a unique look*”. The Plaintiff’s protection in respect of the design covers all the different aspects of the design.**

**(c) The Defendant’s infringing bottle embodies substantially similar features of “*twisting vertical ribs from the top of the shoulder to the bottom of the waist and the overall unique shape*”. This feature is embodied and specifically protected in the Design No. 646. The fact that the Defendant has applied and used the feature of “*twisting vertical ribs from the top of the shoulder to the bottom of the twist*” on the infringing bottle 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 bottle is not substantially different from the Plaintiff’s registered design No. 646. However, the claim for infringement is restricted to the specific feature of the twisting vertical ribs from the top of the shoulder to the bottom of the waist which is protected by the Design registration No. 646.**

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

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

**(g) 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 bottle which is represented by the registered design.**

**(h) 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”.**

3. The Plaintiff’s infringement Application is supported by the Affidavit of its Sales & Administration Manager **Catherine Wangari Karanja** who detailed that the Plaintiff was in the business of designing, manufacturing and selling containers and/or bottles in Kenya. It had a reputation for a number of unique designs. She detailed that the Plaintiff is the registered owner of Industrial Design number 646 and attached the Certificate of Registration of an industrial design dated 13<sup>th</sup> December 2011. The Statement of Novelty annexed to the said Certificate reads:

**“The novelty of the container lies in the pattern of twisting vertical ribs from the top of the shoulder to the bottom of the waste. This feature combined with the overall shape of the container gives the container a unique look.”**

The Supporting Affidavit went on to say that it had come to the attention of the Plaintiff, that the Defendant was manufacturing and using a bottle with certain features, pattern and shape which are identical and/or substantially similar to those embodied and protected by the Plaintiff as per owner of a registered design being Industrial Design No. 646 (hereinafter "ID No. 646"). The deponent gave details of the similarities and annexed certain photographs to illustrate to the Court that its product was being breached by the Defendant's product, copies of which were also attached as "CWK 6".

4. The Defendant filed a Replying Affidavit to the Plaintiff's said Application sworn by one of its directors, **Mohamed Abdi Yare**, but also opted to file a Notice of Preliminary Objection dated 19th July 2013 in which it maintained that this Court lacked the requisite jurisdiction to entertain the suit in light of **sections 106, 113 (1) and 115 (1)** of the Act. Paragraph 3 of the Replying Affidavit was very forthright. It maintained that without doubt the Plaintiff/Applicant is the registered owner of ID No. 646. However the deponent went on to say that the Defendant/Respondent denied any alleged infringement upon ID No. 646. He noted that the Defendant requested for a search at the Kenya Industrial Property Institute (hereinafter "KIPI") on 30th January 2013. He maintained that KIPI in its response dated 1st February 2013 granted the Defendant/Respondent leave to proceed to file an application to have its design duly registered. He annexed a copy of the search results from KIPI to the Replying Affidavit.
5. Thereafter, Mr. Yare related details as to how the Defendant/ Respondent had gone about seeking registration of its product including attaching to the Replying Affidavit, a copy of the Industrial Design application and the formality examination report. The said application by the Defendant/Respondent has to date passed the KIPI formality check and would now seem to be awaiting publication in either the Kenya Gazette or the Industrial Property Journal pursuant to Regulation 48 of the Industrial Property Regulations (hereinafter "the Regulations"). The deponent went on to say that the publication in either of the two periodicals would lead to a period of 60 days in which parties who may have reservations as to the Defendant/Respondent's Industrial Design can file their objections thereto. The salient paragraphs of the Replying Affidavit, so far as the Preliminary Objection of the Defendant/Respondent is concerned, were paragraphs 16, 17, 18 and 19 which detailed that, in Mr. Yare's opinion as advised by his advocates on record, the Plaintiff/Applicant has failed and/or has elected not to adhere to the express provisions of the Act specifically in regard to the alleged infringement. It has instead instituted the instant suit which is not only premature but an abuse of the Court's process. Further, it was Mr. Yare's belief that the Plaintiff/Applicant has made its application in the wrong forum, as the proper forum, in the first instance, lies with the Industrial Property Tribunal (hereinafter "the Tribunal"). It was his advocates' advice that the jurisdiction of this Court can only be invoked by the Plaintiff/Applicant on appeal from the Tribunal as provided for under section 115 of the Act and not in the first instance.
6. The said **Catherine Wangari Karanja** responded to the Replying Affidavit of the Defendant/Respondent by swearing a Further Affidavit on 15th July 2013. She noted that in the second paragraph thereof, that the Defendant/Respondent had applied for the registration of its Industrial Design after receiving the demand notice sent by the Plaintiff/Applicant's advocates dated 29th January 2013 (annexed to her Further Affidavit). She maintained that this demonstrated that the Defendant/Respondent was keen on unlawfully copying and utilising the Plaintiff/Applicant's ID No. 646. She further maintained that the Defendant/Respondent's application for registration of its Industrial Design was immaterial and irrelevant to the present suit as the Defendant/Respondent continues to infringe the Plaintiff/Applicant's ID No. 646. She noted that the Defendant/Respondent had not, as yet, obtained registration for its Industrial Design and consequently, she had been advised by her advocates on record, that the Defendant/Respondent has no legal rights in respect thereof. She maintained that the Defendant/Respondent had merely carried out preliminary steps which did not confer any legal rights upon it. Finally, Ms Karanja informed the Court that she had been further advised by her advocates on record that this Court does have jurisdiction to deal with an industrial design infringement under **section 92 (3)** of the Act. The Plaintiff/Applicant's advocates had enquired of KIPI as to the position with regard to the Defendant/Respondent's Industrial Design and had been informed that the same had a distinguishing feature from that of the Plaintiff/Applicant's ID No. 646. KIPI, in its response to the said advocates, stated that it did not have the mandate to make any comment in respect of

issues of infringement.

7. In his submissions before Court on 22nd July 2013 in relation to the said Preliminary Objection, Mr. Muchoki for the Defendant/ Respondent noted that there was no dispute that the Defendant/ Respondent had filed an application for its design to be registered with KIPI. He stated that upon publication (without stating that publication had in fact occurred) there was a window of 60 days in which objections to the Defendant/Respondent's Industrial Design could be made. He understood that such period of 60 days would take up to the end of August 2013. He noted the provisions of the Act as to the composition of the Tribunal and **section 114** of the Act detailed the powers of the Tribunal. **Section 115** of the Act specified the jurisdiction of the High Court which is appellate in nature. He maintained that the Defendant/Respondent's Application for registration was not contested and was pending before the Tribunal. While it was still pending before the Tribunal, counsel determined that the Plaintiff/Applicant could not bring this Application before Court. He submitted that the Plaintiff/Applicant's failure to follow the procedure as set out in the Act made the proceedings before Court fatal, premature and an abuse of the Court's process.
8. With regard to the law, Mr. Muchoki referred this Court, so far as the Preliminary Objection is concerned, to the well-known case of **Mukisa Biscuit Manufacturing Co. Ltd. v West In Distributors Ltd (1969) EA 696** as well as the case of **Oraro v Mbaja (2005) 1KLR 141**. As to the question of the Court's jurisdiction, counsel referred the Court to the well-known case of **The Owners of Motor Vessel "Lillian S" v Caltex Oil Kenya Ltd (1989) KLR 1**. In terms of the submission that where the law prescribes a procedure, that procedure has to be followed, the Court was referred to the case of **Jimmy Mutinda v Independent Electoral and Boundaries Commission & 2 Ors ex parte Patel & 2 Ors (2013) eKLR** as well as **Mayers & Anor. v Akira Branch Ltd (No. 2) (1972) EA 347**. On this particular point, counsel also referred the Court to the cases of **Cecil Miller v Parin Shariff & 2 Ors (2012) eKLR** and **Narok County Council v Trans Mara County Council & Anor (2000) eKLR**. The cases that Mr. Muchoki wish to refer the Court to so far as the abuse of its process is concerned were **Kirigiti Thathi-Ini Mugumo Water Company Ltd v Kiambu Water and the Sewerage Company Ltd (2013) eKLR** as well as two English cases being **Pasmore v Oswaldtwistle Urban District Council (1895-9) All ER 191 (HL)** and **London Borough of Southwark v Williams & Anor (1971) 2 All ER 175**. Finally, as regards the importance of this Court having jurisdiction, Counsel referred to the cases of **George & 15 others v Limuru Pyrethrum Growers Cooperative Ltd & 9 others (1990) KLR 214** and **Kibunja v Atty Gen & 12 others (2002) 2 KLR 1**. In concluding his submissions, Mr. Muchoki detailed that the proceedings before this Court were premature and that the clear procedure laid down, including the forum, is set out in the Act. Counsel anticipated that the Plaintiff/Applicant would be saying that **section 92** of the Act applied and consequently this Court had jurisdiction. It was the Defendant/Respondent's simple position as regards that section, that where there is an application for Industrial Design registration pending, then the procedure under the Act should be followed.
9. Mrs. Opiyo for the Plaintiff/Applicant went straight to the **Mukisa Biscuit** case which, of course, lays down that with Preliminary Objections, the Court should only consider matters of law not matters of fact. In her opinion, there were disputed facts in relation to the Application before this Court and not points of law. What is before the Court are infringement proceedings brought pursuant to **section 92 (3)** of the Act. As regards the Defendant/Respondent's pending application for registration of its Industrial Design at KIPI, after publication, such would involve the objection proceedings as per Regulation 49 of the Regulations. Infringement proceedings and objection proceedings are two distinct and separate matters. Mrs. Opiyo noted that, at the time that the Applicant was registering ID No. 646, there had been no objection thereto by any person let alone the Defendant/Respondent. **Section 92** of the Act does not provide for any defence that a pending application before KIPI and the Tribunal amounts to such. The fact that the Defendant/Respondent had made such an application was irrelevant and immaterial. Further, the fact that the Plaintiff/Applicant may take an objection thereto will also be immaterial to the Application before Court. Counsel maintained that nowhere under the Act was there a requirement that upon an Application for infringement such might be stayed pending objection proceedings. She noted that a demand notice was issued to the Defendant on 29th January 2013. The application for registration by the Defendant/Respondent of its Industrial Design came thereafter. That showed that the Defendant/Respondent was aware of the Plaintiff's ID No. 646. Counsel emphasised that

the fact that there is a pending application for registration, did not confer any legal right on the Defendant/Respondent. Opposition proceedings that may follow the Defendant/Respondent's application did not prevent the infringement proceedings. Indeed the letter from KIPI, dated 20th July 2013 annexed to the Further Affidavit of the Plaintiff/Applicant, quite clearly stated that KIPI had no mandate as regards infringement proceedings.

10. Turning to the authorities as cited by the Defendant/Respondent, Mrs. Opiyo submitted that the **Lillian S** Case (supra) in fact reinforced the Plaintiff/Applicant's position in that the High Court had jurisdiction under **section 92 (3)** of the Act as such specifically provided for proceedings to be taken to Court. This would be so as far as the **Jimmy Mutinda** (supra) authority as well. Counsel then went on to submit that both the **Mayers** and the **Cecil Miller** cases as well as the **Narok County Council** case (all supra) did not apply as the Court's jurisdiction had not been ousted under **section 92 (3)** of the Act. Further, the reference to the English authorities by counsel for the Defendant/Respondent, was also inapplicable for the Plaintiff/Applicant had followed the correct procedure as under **section 92 (3)** of the Act. Similarly, this Court's jurisdiction had not been ousted and consequently the **George** and **Kibunja** cases (again supra) were not applicable as there was no ouster clause. Mrs. Opiyo submitted that Article 165 (1) of the Constitution detailed that this Court had unlimited civil jurisdiction except for Industrial Court and Land Court matters which were inapplicable in this case. **Sections 112 and 113** of the Act, to which the Court had been referred, involved an appeal is firstly from the KIPI's Managing Director's decisions to the Tribunal and thereafter, appeals from the Tribunal to the High Court. In her opinion, all these sections were inapplicable to infringement proceedings and only applied to objection or opposition proceedings in relation to industrial design registration. Finally, counsel referred me to the case of **Safepak Ltd v Dynaplast Ltd HCCC No. 359 of 2007** as per the finding of **Warsame J.** that:

**“I am inclined to hold that the plaintiff has established the presence or existence of a right infringed by the defendant. The right infringed has the protection of the law. In my understanding the existence of a right allegedly infringed by the opposite party gives the court the duty or obligation to accord it the necessary protection given by the law.”**

In counsel's view, this Court assumes jurisdiction and it is in the duty of the Court to afford protection as against infringement. Opposition proceedings are not a defence to infringement proceedings.

11. In a short rejoinder, Mr. Muchoki stated that it was an undisputed fact that there was the Defendant/Respondent's application for registration of its Industrial Design pending before KIPI. What counsel for the Plaintiff/Applicant had not told the Court was the purpose of objection proceedings. In the view of the Defendant/ Respondent opposition/objection proceedings are meant to highlight any such objections and consequently, infringement objections should be taken into account. Counsel pointed to **section 106** of the Act as regards the Relief that could be granted by the Tribunal in infringement proceedings. **Section 92** would, in counsel's opinion, only apply where the Defendant had nothing before KIPI. Part 11 of the Act (which included **section 106**) dealt with issues of infringement and **section 92** cannot be looked at in isolation. Counsel insisted that the Plaintiff/Applicant's proper procedure would be to file opposition proceedings. If the Tribunal's decision was not acceptable, then the Plaintiff/Applicant could appeal to this Court. As per the **Jimmy Mutinda** case (supra) the jurisdiction given to an industrial tribunal is to complement the jurisdiction of the High Court. The distinguishing feature as regards the **Safepak** case was that the applicant therein did not have an application for registration before KIPI. Counsel urged the Court to look at the intention of the Act and what is entailed in opposition proceedings.
12. Both counsel who appeared before the Court, spent time dwelling upon facts that it wanted the Court to take cognizance of. Whether the Defendant/Respondent has an application for registration of an Industrial Design pending with KIPI or whether KIPI does or does not deal with infringement proceedings is, in my opinion, of little relevance to the determination of the Preliminary Objection of the Defendant/Respondent dated 19th July 2013. The only facts that are relevant to the Preliminary Objection are whether the Defendant/ Respondent was aware of the Plaintiff/Applicant's ID No. 646 or not. In my opinion, it was given 2 instances. Firstly, it was

notified by Kaplan & Stratton, the Advocates for the Plaintiff/Applicant by its warning letter of 29 January 2013 as regards infringement of ID No. 646. Secondly and more importantly, the letter from KIPI to the Defendant/Respondent dated 1st February 2013 is even more explicit in the last paragraph thereof which detailed:

**“There is a registered design ID 646 with a closely similar appearance. However the design under search has a distinguishing feature on the part between the shoulder and the cap. The feature comprises of a recessed part almost square in shape when viewed from above.”**

Obviously undeterred by the two warnings, the Defendant/ Respondent has pressed on to seek registration of its Industrial Design although it is not clear to this Court as to just how far its application in this regard has progressed. As at the time of coming to Court, it does not appear that the Industrial Design has been advertised in either the Kenya Gazette or the Industrial Property Journal.

13. There is little doubt that the Legislature has intended that the Act be all encompassing as regards the promotion of inventive and innovative activities. Part VII thereof covers the rights and obligations of the Applicant or the Owner of an invention. The Rights of the owner of patent are set out at **section 54** of the Act as follows:

**“54. (1) The owner of the patent shall have the right to preclude any person from exploiting the protected invention by any of the following acts –**

- a. **when the patent has been granted in respect of a product –**
  - i. **making, importing, offering for sale, selling and using the product; or**
  - ii. **stocking such product for the purposes of offering it for sale, selling or using the product;**
- b. **when the patent has been granted in respect of a process –**
  - i. **using the process; or**
  - ii. **doing any of the acts referred to in subsection (a), in respect of a product obtained directly by means of the process.**

**(2) The rights conferred on the owner of the patent under this section shall not apply to acts by third parties necessary to obtain approval or registration of a product from the Institute, for the purpose of commercializing the product after expiry of the patent”.**

As regards the enforcement of such rights, **section 55** of the Act is again self-explanatory. It reads:

**“55. The owner of a patent shall have the right –**

- a. **to obtain an injunction to restrain the performance or the likely performance, by any person without his authorization, or any of the acts referred to in section 54; and**
- b. **to claim damages from any person who, having knowledge of the patent, performed any of the acts referred to in section 54, without the owner’s authorization.**
- c. **to claim compensation from any person who, without his authorization, performed any of the inventions, claimed in the public application, as if a patent had been granted for that invention:**

**Provided that the said person, at the time of the performance of the act, had –**

- i. **actual knowledge that the invention that he was using was the subject matter of published application; or**
- ii. **received written notice that the invention that he was using was the subject matter of published application, such application being identified in the said notice by its serial number”.**

As I understand it, the Plaintiff/Applicant has now moved this Court for injunction as envisaged under **section 55 (a)** of the Act as above. In my opinion the Act gives the Plaintiff/Applicant two options in this respect. Firstly (and which it has done), an Application can be made under **section 92 (3)** of the Act which reads:

**“92. (3) The registered owner of an industrial design shall, in addition to any other rights, remedies or actions available to him, have the right to institute court proceedings against any person who infringes the industrial design by performing, without his consent, any of the acts referred to in subsection (1) or who performs acts which make it likely that infringement will occur”.**

The second option open to the Plaintiff/Applicant under the Act is under Part XVI thereof – Infringement. **Section 105** under that Part details the acts constituting infringement and specifically refers to **section 92**. However, where a party seeks relief from infringement, **section 106** details that such party can go before the Tribunal in that regard. The section reads as follows:

**“106. On the request of the owner of the patent or the registered utility model or industrial design, the Tribunal shall grant the following relief –**

- a. **An injunction to prevent infringement where infringement is imminent or to prohibit the continuation of the infringement, once infringement has started;**
- b. **Damages; or**
- c. **Any other remedy provided for in law”.**

14. As pointed out by Mrs. Opiyo for the Plaintiff/Applicant, the **Mukisa Biscuit** case (supra) clearly indicates that a preliminary objection must be confined to a pure point of law which may be argued before Court based on the assumption that all the facts pleaded are correct. Mr. Muchoki for the Defendant/Respondent has laid before this Court the decision in the **Oraro v Mbaja** case (again supra) the findings of which I completely adopt so far as this Ruling is concerned. **Ojwang J.**(as he then was) held as follows:

**“1. A preliminary objection correctly understood, is a point of law which must not be blurred with factual details liable to be contested and in any event, to be proved through the process of evidence.**

**2. Any assertion which claims to be a preliminary objection, and yet it bears factual aspects calling for proof, or seeks to adduce evidence for its authentication, is not, as a matter of legal principle, a true preliminary objection which the Court should allow to proceed.**

**3. If a matter comes before the Court dressed as a “preliminary objection”, it will not come to co-exist with such factual scenerious as may lead the Court**

to exercise its discretion by virtue of section 3A of the Civil Procedure Act.

4. The court's discretion is never exercised just on the basis of propositions of law; there must be a factual situation of which the Court takes cognizance, and in relation to which its equitable conscience is exercised.

5. It has to be appreciated that the court's discretion exercised by virtue of section 3A of the Civil Procedure Act is always for the purpose of upholding the law as far as is possible; and this would require preserving the claims of parties so that they may be heard and determined according to law.

6. The applicants plea is that the respondents pleadings be terminated in *limine*. There is no consistency between such a prayer, which belongs to the normal practice attending preliminary objections (matters of law), on the one hand, and the case for ensuring fair trial which the applicant has also urged, on the other hand".

Similarly, and as regards the question of this Court's jurisdiction the observations of Nyarangi JA in the MV Lillian case at page 14 are relevant in this situation:

**"I think that 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. Jurisdiction is everything. Without it, a court has no power to make one more step. Where a court has no jurisdiction, there would be no basis for a continuation of proceedings pending other evidence. A court of law downs tools in respect of the matter before it the moment it holds the opinion that it is without jurisdiction."**

15. Again as pointed out by Mrs. Opiyo these proceedings before this Court are for the enforcement of rights, in this case, of the Plaintiff/Applicant. They are not proceedings of objection in relation to the Defendant/Respondent's application to KIPi for registration of its Industrial Design. Those proceedings are yet to come subject to advertisement and are not in any way dependent upon the outcome of these proceedings as regards infringement of the Plaintiff's/ Applicant's ID No. 646. As a result, I agree with counsel for the Plaintiff/Applicant that the other authorities to which I have been referred to by Mr. Muchoki are irrelevant to the Application before me. What I am required to decide upon is the point of law raised in the Preliminary Objection of the Defendant/Respondent dated 19th July 2013 as to whether this Court has jurisdiction to entertain the instant suit. As I have indicated above, so far as enforcement proceedings are concerned, the Plaintiff/Applicant had two options. Either it could go before the Tribunal under the provisions of **section 106** of the Act or it could institute court proceedings under **section 92 (3)** of the Act against any person, in this case the Defendant/ Respondent, who infringes its industrial design being ID No. 646. Under **section 2** of the Act, court is interpreted as meaning the High Court of Kenya. In all the circumstances therefore, I find that this Court does have jurisdiction to entertain this suit as well as the Plaintiff/Applicant's Notice of Motion dated 22 May 2013.

16. As a result, I dismiss the Defendant/Respondent's Preliminary Objection dated 19th July 2013 with costs to the Plaintiff/Applicant. The Plaintiff/Applicant may now set down its Notice of Motion dated 22nd May 2013 for hearing by taking a date at the Registry in that regard.

**DATED and delivered at Nairobi this 1<sup>st</sup> day of August, 2013.**

**J. B. HAVELOCK**

**JUDGE**