



REPUBLIC OF KENYA

High Court at Nairobi (Nairobi Law Courts)

Miscellaneous Civil Application 165 of 2012

IN THE MATTER OF AN APPLICATION FOR JUDICIAL REVIEW ORDERS OF CERTIORARI AND ORDERS OF MANDAMUS BY SONY HOLDINGS LIMITED AGAINST THE REGISTRAR OF TRADEMARKS

IN THE MATTER OF THE REFUSAL BY THE REGISTER TRADEMARKS NUMBER TMA NO 65981 AND 65982

IN THE MATTER OF ILLEGAL/ULTRA VIRES WRONGFUL AND/OR IRREGULAR EXERCISE OF DISCRETION BY THE REGISTRAR OF TRADEMARKS

IN THE MATTER OF ARTICLE 47 OF THE CONSTITUTION OF KENYA, SECTION 21, 22, 30, 44 AND THE LAW REFORM ACT CAP 26, THE TRADEMARKS ACT, CAP 506 AND RULE 102 OF THE TRADEMARKS RULES

IN THE MATTER OF THE LAW REFORM ACT CAP 26 AND ORDER 53 OF THE CIVIL PROCEDURE RULES OF 2010

REPUBLIC

VERSUS

THE REGISTRAR OF TRADEMARKS.....RESPONDENT

AND

SONY HOLDINGS LIMITED.....EX PARTE APPLICANT

SONY CORPORATION.....INTERESTED PARTY

JUDGMENT

The Applicant is Sony Holdings Limited. The Respondent is the Registrar of Trade Marks, an office established under the Trade Marks Act, Chapter 506 of the Laws of Kenya (hereinafter called the Act). The Respondent is mandated to consider applications for the registration of trade marks.

The application for my determination is the Notice of Motion dated 2nd May 2012 which seeks orders;

- a) Of certiorari to call and quash the decision of the Registrar of Trademarks to extend time for filing

notice of opposition;

- b) Of certiorari to call and quash the proceedings pending before the Registrar of Trademarks in respect to trademarks numbers TMA 65981 and 65982;
- c) Of mandamus compelling the Registrar of Trademarks to register the Applicant's trademarks TMA No 65981 and TMA 65982;
- d) That costs of the application be provided for.

The application is based on the grounds that:

- a) The violation of the legitimate expectation where the Applicant has waited for close to one year since the trademark application was accepted, approved and duly paid for registration;
- b) The Registrar has exercised jurisdiction he did not have and or exercised the said discretion arbitrarily which amounts to an illegality;
- c) The Applicant herein was deprived the right to be heard prior to the exercise of the purported discretion by failing to serve the notice of intention to exercise discretion;
- d) The Registrar of Trademarks considered irrelevant matters and ignored the relevant matters embodied in the mandatory constitutional and statutory provisions
- e) It is only fair and just to grant the orders sought.

The Application is supported by the Supporting Affidavit, Statutory statement and further affidavit of Vaishali Madan.

The facts leading up to these proceedings are provided in the statutory statement.

Sometime in 2009, the Applicant instructed its advocates to pursue the registration of two trademarks (a word mark, and a word device) herein after called the trademarks. The Applicant's advocate submitted the proposed trademarks for registration by way of two letters dated 18th May 2009. The Registrar of Trademarks wrote back to the Applicant's advocate on 8th September 2009, giving notice of refusal to register the trademarks. The Advocate's wrote back to the Respondent asking that he reconsider his refusal. The Respondent then gave approvals for the marks to be advertised in the Industrial Property Journal.

The advertisement was done on 31st May 2011. On 26th January 2012, the Respondent wrote to the Applicant, informing it an extension of time had been granted to the Interested Party to lodge a notice of opposition. The Applicant wrote back to the Respondent on 29th February 2012 indicating its objection to the extension of time. The Respondent did not respond to the content of this last letter and instead wrote to the Applicant informing it that a notice of opposition had been filed on behalf of Sony Corporation (who is the Interested Party herein), and asked it to file a counter statement within 42 days.

The Applicant's case is that the Respondent's discretion in extending time to file the notice of opposition was illegal, irregular and wrongful.

The Interested Party filed a replying affidavit sworn by John Syekei on 6th June 2012. The Interested Party states in this affidavit that the present application is not properly before this court because there are proceedings pending before the Registrar of Trade Marks.

The Interested party's case is that that the Respondent invited the Applicant to respond to the Notice of Opposition, but it failed to do so. The Interested Party is of the view that the application before this court

is pre-mature and ill - founded, and that the orders sought cannot lie.

The Interested Party states that the deadline within which to file the Notice of Opposition was 29th July 2011. So as not to be time barred, the Interested Party filed applications for extension of time, which were all granted by the Registrar in the exercise of his lawful discretion. The Applications for the grant of extension of time were all made under Rule 102 of the Trade Marks Rules. The Registrar informed the Applicant of all the extensions by way of a letter dated 26th January 2012, and at no time did it request the Registrar for a hearing under Rule 103 of the Trade Mark Rules.

The Respondent filed a Replying Affidavit sworn by Dr. Henry Kibet Mutai on 27th June 2012. The Respondent has also given a chronology of the events leading up to these proceedings

After consideration of the pleadings filed by the parties, the main question for my determination is whether the Respondent followed the procedure laid down in the Trademarks Act in extending the time to file the notice of opposition.

All the parties filed submissions to advance their positions. The Respondent and the Interested Party are of the view that the orders sought ought not to be granted because the Applicant is guilty of material non-disclosure, that there are other remedies available to the Applicant, that there was no legitimate expectation owed to the Applicant and the Respondent has jurisdiction to extend the time to file a notice of opposition.

The Interested Party has asked this court to dismiss the present application because the Applicant has not exhausted all the avenues available to him. It has submitted that the Applicant had indicated that it would appear at the hearing of the counterclaim to object to the extension of time. The Interested Party is of the view that the Applicant ought to have appeared before the Respondent and argued out its objection, rather than bringing these proceedings. The Court of Appeal has pronounced the guidelines on the availability of an alternative remedy in ***R –Vs- National Environment Management Authority [2011] eKLR (Civil Appeal No.84 of 2010)***. In this case, the Court of Appeal considered various authorities that the superior court (Wendoh J) had cited with regard to the existence of an alternative (statutory or appeal) remedy. The court of appeal then stated thus:

“The principle running through these cases is that where there was an alternative remedy and especially where Parliament had provided a statutory appeal procedure, it is only in exceptional circumstances that an order for judicial review would be granted, and that in determining whether an exception should be made and judicial review granted, it was necessary for the court to look carefully at the suitability of the statutory appeal in the context of the particular case and ask itself what, in the context of the statutory powers, was the real issue to determine and whether the statutory appeal procedure was suitable to determine it”.

The Court then affirmed the decision of the High Court. The principle that emanates from this case is that where there is an alternative existing remedy, then it is upon the Applicant to disclose that remedy and also to show the court that there are some exceptional circumstances that would warrant the court to invoke its judicial review jurisdiction.

Applying this principle to the present proceedings, I find that there is a remedy available to the Applicant by dint of section 21 (6) – (10) of the Act. However, I am of the view that the present application is properly before the court because the Applicant has alleged that the Respondent acted in excess of his jurisdiction. An action taken in excess of jurisdiction can only be quashed by way of judicial review orders.

The Applicants contend that their legitimate expectation has been violated by the Respondent because they reasonably expected that the trade marks would be registered after advertisement in the journal.

The principle of legitimate expectation seeks to enforce a promise or a benefit from a public authority.

Pollard, Papworth & Hughes in *Constitutional and Administrative Law 4th Edition (2007)* define the legitimate expectation as follows:

“It is a principle of good administration or of administrative fairness that, if a public authority leads a person or body to expect that the public authority will, in future, continue to act in a way either in which it has regularly acted in the past, or on the basis of a past promise or statement which represents how it proposes to act, then, prima facie, the public authority should not, without an overriding reason in the public interest, resile from that representation and unilaterally cancel the expectation of the person or body that the state of affairs will continue.”

For a legitimate expectation to arise, there must be a promise or representation that arises from the public body, that would be reasonably expected to continue. In *Council of Civil Service Unions Vs Minister for Civil Service [1984] 3 All ER 935* the principles that are taken into consideration for the existence of legitimate expectation to be said to have occurred: Lord Diplock stated that the decision:

“.....must affect the other person by depriving him of some benefit or advantage which either -

(i) he had in the past been permitted by the decision maker to enjoy and which he can legitimately expect to be permitted to continue doing until there has been communicated to him some rational grounds for withdrawing it in which he has been given an opportunity to comment, or

(ii) He has received assurance from the decision maker that it will not be withdrawn without giving him first an opportunity to advance reasons for contending that they should not be withdrawn.”

Having considered the submissions of counsel on this ground of the Applicant’s motion, it is my finding that the claim of legitimate expectation by the Applicant cannot stand. The fact that the trademarks had been advertised did not necessarily mean that the trademarks would as of right be registered. In fact, there was no representation to the Applicant that these marks would definitely be registered once the advertisement in the journal had been done.

Even if the advertisement was a step towards the registration of the marks, I find that there was no legitimate expectation that the marks would be registered because the Applicant had been previously informed that there was a similar mark that had been undergoing registration.

The Applicant has relied on Section 21 of the Trade Marks Act to further its claim that no proceedings of opposition were filed in the time prescribed by the Act. The Applicant submits that section 21 provides the time within which a party intending to oppose an application for registration must lodge an application, and that Rule 102 does not give the Registrar any authority to extend the time for filing of proceedings.

The relevant parts of section 21 of the Trade Marks Act provides as follows:

21.(1) When an application for registration of a trade mark has been accepted, whether absolutely or subject to conditions or limitations, the Registrar shall, as soon as may be after acceptance, cause the application as accepted to be advertised in the prescribed manner, and the advertisement shall set forth all conditions and limitations subject to which the application has been accepted:

...

(2) 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.

Rule 102 provides for extension of time. It states that:

102. (1) The Registrar may extend, on such conditions as he may specify, the time for doing any act or taking any proceedings under these Rules.

(2) The Registrar may not extend a time expressly provided in the Act, other than the period prescribed under subsection (6) or (7) of section 25 of the Act.

(3) A time limit may not be extended for a period exceeding ninety days, except for a time period prescribed by rule 76 which may be extended for a period not exceeding six months.

...

(6) An application for an extension of time may be made even though the time has already expired.

(emphasis mine)

This rule appears to give the Registrar wide discretion in matters of extension of time. My understanding of this rule is that the Registrar may extend any period for doing any Act where time is not expressly provided in the statute. Where such an extension is granted, then each of those extensions should not be for a period of not exceeding ninety days.

In *Republic V Kenya Ports Authority & 2 Others Ex-Parte Kaburu & Sons Ship Contractors & Another* [2006] eKLR (Misc Civ Appli 606 of 2005) Justice Serگون adopted the statements of the court *Regina vs Vestry of Pancras* [1890] 24 Q.B.D. 371 at pages 375-376 in which the court stated that a body that is entrusted with discretion: ***“must fairly consider the application and exercise their discretion on it fairly and not take into account any reason for their decision which is not a legal one. If people who have to exercise a public duty by exercising their discretion take into account matters which the courts consider not to be proper for the guidance of their discretion, then in the eye of the law they have not exercised their discretion.”***

In *Associated Provincial Picture Houses, Ltd. v. Wednesbury Corporation* [1947] 2 All E.R. 680, Lord Greene M.R. stated as follows regarding discretion:

“The law recognizes certain principles on which the discretion must be exercised, but within the four corners of those principles the discretion [of the decision-making public body] is an absolute one and cannot be questioned in any court of law. “What, then, are those principles? They are perfectly well understood. The exercise of such a discretion must be a real exercise of the discretion. If, in the statute conferring the discretion, there is to be found, expressly or by implication, matters to which the authority exercising the discretion ought to have regard, then, in exercising the discretion, they must have regard to those matters. Conversely, if the nature of the subject-matter and the general interpretation of the Act make it clear that certain matters would not be germane to the matter in question, they must disregard those matters. Expressions have been used in cases where the powers of local authorities came to be considered relating to the sort of thing that may give rise to interference by the Court. Bad faith, dishonesty, unreasonableness, attention given to extraneous circumstances, disregard of public policy have all been referred to as matters which are relevant for consideration. In the present case we have heard a great deal about the meaning of the word ‘unreasonable’. It is true the discretion must be exercised reasonably. What does that mean?.....It [the word ‘unreasonable’] is frequently used as a general description of the things that must not be done. For instance, a person entrusted with discretion must direct himself properly in law. He must call his own attention to the matters which he is bound to consider. He must exclude from his consideration matters which are irrelevant to the matter that he has to consider. If he does not obey those rules, he may truly be said.....to be acting ‘unreasonably’. Similarly you may have something so absurd that no sensible person could ever dream that it lay within the powers of the authority.”

The court will therefore only interfere with discretion exercised by an inferior body such discretion is exercised unreasonably, in bad faith or in disregard to the law. In my view, the Registrar exercised his discretion within the bounds of the law in extending the time at the application of the Interested Party. It is also my view that the Registrar took into consideration all the material facts in giving the Interested Party time to put in the notice of opposition.

The Applicant has set out various reasons why the notice of opposition that was eventually filed by the Interested Party were irregular. It has directed me to various sections in the Act to which he states the notice of opposition does not conform to. The Interested Party on its part have also advanced reasons why the Notice of opposition ought to be allowed by the Respondent.

It is my considered view that these claims cannot be determined by this court as they do not fall under the jurisdiction of the court. For the court to make a determination on these issues, it would be descending into the arena of the merits or demerits of the proceedings before the Respondent. It is of course well settled that the supervisory jurisdiction carried out by the High Court in judicial review does not deal with the merits of any decision but rather with the process through which an inferior body was reached.

The Applicant has prayed for orders of certiorari to quash the decision to extend time and the objection proceedings now before the Respondent. The situations in which an order of certiorari will issue are stated in Halsbury's Laws of England, 4th Edition Vol. 1:

“Certiorari will issue to quash a determination for excess or lack of jurisdiction, error of law on the face of the record, breach of the rules of natural justice or where the determination was procured by fraud, collusion or perjury”.

In this case, I find that the grounds upon which an order of certiorari will issue have not been proved. This prayer therefore fails.

The Applicant also seeks an order of mandamus to compel the Respondent to register its trademarks. An order of mandamus is described as follows in Halsbury's Laws of England, 4th Edition:

“[it] is of a most extensive remedial nature, [it] is directed to any person, corporation or inferior tribunal requiring him or them to do some particular thing thereon specified which appertains to his or their office and is in the nature of a public duty. Its purpose is to remedy the defects of justice and accordingly it will issue, to the end that justice may be done, in all cases where there is a specific legal right and no specific legal remedy for enforcing that right and it may issue in cases, where although there is an alternative legal remedy yet that mode of redress is less convenient, beneficial and effectual.”

...

The order must command no more than the party against whom the application is made is legally bound to perform. Where a general duty is imposed, a mandamus cannot require it to be done at once. Where a statute, which imposes a duty leaves discretion as to the mode of performing the duty in the hands of the party on whom the obligation is laid, a mandamus cannot command the duty in question to be carried out in a specific way.”

It is my decision that the Applicant has also not demonstrated that it is deserving of the order of mandamus. Mandamus is issued to compel the performance of a public duty. It is also issued to a person who holds some right from a public authority so as to compel that public authority to fulfil that right. In this case, the Applicant is not of right entitled to the registration of its trademarks until such time as the opposition proceedings are concluded in its favour. Having found that the opposition proceedings are properly before the Respondent, it follows that the Applicant has the opportunity to raise his objections before the Respondent.

It is therefore my decision that the Respondent did not exceed its authority in extending the time for filing the notice of opposition. The Applicants motion therefore fails. It is hereby dismissed with costs to the Respondent and the Interested Party.

DATED, SIGNED and DELIVERED this 20TH day of NOVEMBER 2012

M. WARSAME
JUDGE