



**REPUBLIC OF KENYA**

**IN THE HIGH COURT OF KENYA**

**AT NAIROBI**

**MISCELLANEOUS APPLICATION NO. 273 OF 2008**

**IN THE MATTER OF AN APPLICATION TO APPLY FOR JUDICIAL REVIEW ORDERS OF  
CERTIORARI, PROHIBITION AND MANDAMUS**

**AND**

**IN THE MATTER OF THE LAW REFORM ACT**

**AND**

**IN THE MATTER OF THE TRADE MARKS ACT, CAP 506 LAWS OF KENYA**

**AND**

**IN THE MATTER OF PROOF TRADE MARK NO. KE/T/2005/057580**

**REPUBLIC.....APPLICAN**

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**VERSUS**

**THE REGISTRAR KENYA INDUSTRIAL PROPERTY  
INSTITUTE.....RESPONDENT**

**EX-PARTE: PETER WAITE MAGUA**

**JUDGMENT**

The exparte applicant, hereinafter referred to as “**the applicant**”, filed an application by way of Notice of

Motion dated 22<sup>nd</sup> May 2008 seeking the following orders:

- “1. That the Honourable Court be pleased to grant an order of Certiorari to bring before the Honourable court for the purpose of quashing, the expungement proceedings instituted by M/s. David Ball Group PLC in regard to TMA No. 57580 pending determination by the Respondent at the Respondent’s Tribunal.**
- 2. That the Honourable Court be pleased to grant an order of Prohibition to prohibit the Respondent from hearing, considering, determining, ruling on and/or in other manner dealing with the expungement of TMA No. 57580 instituted by David Ball Group PLC.**
- 3. That the Honourable Court be pleased to grant an order of Mandamus to compel the Respondent to register and/or effect the application for change of address made by the applicant on the 2<sup>nd</sup> November, 2007 with regard to TM No. 57580 P.Proof.**
- 4. That all the necessary and consequential orders or direction be given.**
- 5. That the costs of this application to be provided for.”**

The application was supported by the usual statutory statement and a verifying affidavit sworn by **Peter Waite Maigua**, the applicant. He stated that on 28<sup>th</sup> June 2006 he filed an application for TMA No. 57580 in the name of a business partnership known as **P.K Company** and he paid all the attendance fees and charges. The application for the mark was subsequently registered and a certificate thereof issued by the respondent. Prior to the registration of the business name aforesaid, the applicant had been dealing in the manufacture of P.Proof cement and upon entering the partnership with a view to expanding the business, the trademark was registered in the partnership’s name.

Soon after the registration of the partnership, it became apparent to the applicant that the business relationship between the applicant, **Ephantus Mutonyi Macharia** and **Washington Kariuki Macharia** was untenable and therefore the applicant continued to pursue the business as a sole proprietor. In order to protect his interests and the interest in the Trade mark P.Proof which had been registered in the name of a partnership, the applicant lodged a request to alter Trade and Business address in the register and paid the requisite fees on 17<sup>th</sup> November, 2005. The applicant lamented that up to the date of filing the application, the respondent had not effected the alteration and/or change as requested.

On or about the 8<sup>th</sup> day of May 2006, the applicant’s erstwhile partner, Ephantus Mutonyi Macharia, through a company he had registered in the name **Pudlo Kenya Limited**, filed a suit in **HCCC No. 241 of 2006** against the applicant seeking, *inter alia*, an order of injunction to restrain the applicant from passing of concentrated water proof cement by use of the name “**Concentrated Pudlo Cement Water Proofer**”. The plaintiff also sought to have the applicant ordered to deliver and give possession of trademark certificate No. 057580. The applicant opposed the said application and in the long run the suit was withdrawn with costs to the applicant herein.

Sometimes thereafter, the applicant was arrested and charged before the Chief Magistrate’s court at Nairobi in **Criminal Case No. 447 of 2006** with the offence of forging and/or counterfeiting the trademark of David Ball. The applicant believed that the charges against him were instigated by M/S David Ball Group PLC as well as the Weights and Measures Department of the Ministry of Trade. Similar charges were also instituted against the applicant’s erstwhile partners but the charges against the applicant’s former partners were subsequently withdrawn. In the said case, Mr. David Ball of the said David Ball Group PLC testified and in the course of the proceedings it was realized that the company had no registered mark with the respondent, the applicant stated. Upon realizing that there was no right capable of protection, the aforesaid company embarked on the expungement proceedings in respect of TM No. 57580.

On 20<sup>th</sup> December 2006, the applicant instructed his advocates on record to write to the respondent and appraise them on the court matters herein before stated and particularly request that:

***“Any attempts to change the TM No. 57580 or deregister the same should be notified to us and/or to our client so that we may take appropriate action to defend.”***

Subsequently, the applicant instructed his advocates to file form TMA 1 with the respondent so that the said advocate had full authority in terms of the respondent’s rules to act for the applicant. However, the respondent never notified the applicant or its advocates/agent of the expungement proceedings by David Ball Group, the applicant stated.

On 10<sup>th</sup> April 2008, on the advice of its advocates, the applicant paid the respondent a visit and requested to peruse the file on TM No. 57580 so as to determine why the application for alteration of address had not elicited any response from the respondent. That is when the applicant realized that the expungement proceedings were pending determination by the respondent and he immediately instructed his advocates to make proper inquiry.

The applicant stated that his advocate, **Mr. Omulele**, informed him that he visited the respondent and held discussions on the matter with one **Miss Apiyo**, the respondent’s legal counsel. His advocate further informed him that the respondent’s file for TM 57580 on which the expungement proceedings were being considered did not have his application for change of address, the letters by the applicant and his advocates, appointment of agent and receipts in payment of the various fees paid on the trademarks.

It came to the fore that the expungement proceedings were apparently served upon the applicant’s erstwhile partner, Mr. Ephantus Mutonyi Macharia, who had purported to defend TM 57580 P.Proof when the proceedings in HCCC 241 of 2006 had clearly showed that he had no such right, the applicant stated. The applicant added that Ephantus Mutonyi Macharia, David Ball Group as well as the respondent knew of his interest in the trademark.

In view of the foregoing, the applicant stated, it was fallacious and overreaching on the part of the respondent to purport to conduct expungement proceedings in respect of TM 57580 as between David Ball PLC and Ephantus Mutonyi Macharia. When the applicant’s advocates wrote to the respondent regarding the applicant’s complaints, the respondent replied vide a letter dated 8<sup>th</sup> April 2008 and rubbished the applicant’s complaint and dared him to institute any proceedings he deemed appropriate.

The applicant believes that he is unlikely to get justice in the respondent’s court seeing that the respondent had shown open disdain and bias against him. For these reasons the applicant now urges the court to grant the orders of certiorari, prohibition and mandamus as aforesaid.

The respondent, through its Managing Director, **Prof. James Otieno-Odek**, filed a replying affidavit. He stated that on 28<sup>th</sup> June 2005, P.K Company Manufacturers of P.O. Box 74259 Nairobi (**P.K**) filed an application (form TM2) for registration of a mark “**P**” with device (**the Mark**). The said application was made in respect of goods in class1, and specifically, cement preparations and preservatives. The application was approved and accordingly, a certificate of registration reference No. TMA No. 57850 was issued to P.K. On or about 17<sup>th</sup> November 2005, the applicant filed form TM17 seeking firstly, to change the Trade and Business address from P.O. Box 74259 Nairobi to P.O. Box 7126 Nairobi. The second, TM17 sought to change the name in the register from P.K Company to P.C Company.

While the aforesaid applications were being considered, the respondent received a letter dated 17<sup>th</sup> January 2006 from Mr. Ephantus M. Macharia. By the said letter Mr. Macharia indicated that he was a director of P.K Company Limited and that the said company had not authorized the alterations sought by the applicant. Mr. Macharia further alleged that the applicant, Mr. Washington Kariuki and himself had registered Pudlo Kenya Company as a business name but a disagreement between the three proprietors emerged. As a consequence, Pudlo Kenya Company Limited was incorporated by Mr. Washington Kariuki and Mr. Macharia. The applicant was excluded from the new company.

On or about 18<sup>th</sup> January 2006, David Ball Group PLC, “**the objector**”, wrote to the respondent alleging that the mark registered as TMA 57850 (hereinafter the Mark) was infringing on its registered mark and that it was being used to counterfeit its products. On 23<sup>rd</sup> January 2006, Mr. Macharia filed an application on behalf of P.K Company seeking to alter the mark so as to include a black rectangle to surround the device and the word “**Proof**” as the base and orange as the background colour. On 16<sup>th</sup> February 2006 while all the aforementioned applications were pending, David Ball Group PLC lodged an application for expungement and the removal of the Mark on ground that they were the owners of the Mark “P” (with device) and which according to them, was virtually identical to the Mark.

Prof. Odek further deposed that the applicant herein instructed the firm of Omulele & Co. Advocates to represent him in the expungement proceedings and that all the parties duly filed their pleadings in the expungement proceedings. The parties actively participated in the proceedings from the determination of the preliminary issues up to the point when the matter was ready for the hearing of the substantive application. However, on 22<sup>nd</sup> April 2008, the applicant through its advocates, requested the respondent to discontinue the expungement proceedings and instead approve and allow its application for change of address. The respondent declined to allow the aforementioned application on the basis of the existence of the expungement proceedings. The respondent was of the view that the applicant was engaged in a tussle with his partners over the ownership of the Mark. The deponent further stated that the respondent had no jurisdiction to discontinue the expungement proceedings as that would have amounted to requesting the respondent to disregard its statutory duty of giving all parties, including the objector, a fair hearing.

In view of the foregoing the respondent urged court to dismiss the application.

The interested party filed an affidavit that was sworn by **David Martin James Ball**, a director of the company. He stated that David Ball Group PLC (“**DBG**”) is the owner of trade mark “**P**” device (the “**P**” device Mark). The “**P**” device is virtually identical to the trade mark which has been registered in Kenya in the name of PKC as Trade Mark No. T/2005/57580 “**P**” device in class 1 (the disputed mark). The “**P**” Device mark has been used by DBG extensively and is known in numerous countries of the world including Kenya and has acquired a worldwide reputation for chemical preparations for addition to cement or plaster to improve their water impermeability, cement water proofing powders, etc. All of DBG goods fall within class 1 of the World Intellectual Property Organization international classification of goods which is followed by the Kenya Trade Marks registry for classification of goods in relation to registration of trade marks. DBG goods have been sold in packets bearing the “**P**” Device Mark in Kenya by DBG’s sole appointed distributor in Kenya, Jayantilal Jivraj and Company Limited, from 1997 to late 2006 and by Nabico Enterprises Limited from 2006 onwards. The sale of DBG goods in such packets had taken pace in Kenya well before the trade mark application No. T/2005/57580 for the disputed Mark in class 1 was filed by P.K Company at the Kenya Trade Marks registry and the “**P**” Device Mark was known to the Kenya public and associated by users of such goods in Kenya with the DBG goods manufactured and sold by DBG before the said application for the trade mark was filed by P.K Company.

Mr. Ball further stated that the disputed mark is so similar to the “**P**” Device Mark visually that confusion and deception is likely to arise in Kenya from the use of the disputed mark by P.K Company on similar goods to the DBG goods. Following the discovery by DBG that the disputed mark had been registered in Kenya by P.K Company and was being used on packaging for similar goods to the DBG goods an expungement application under **section 35** of the **Kenya Trade Marks Act** was filed on 16<sup>th</sup> February 2006 at the Kenya Trade Marks registry. Mr. Ball supported the depositions by Prof. Odek regarding the documents that were filed in respect of the expungement application and the proceedings thereafter. He further explained that according to advice given to him by his advocates, **Messrs Kaplan & Stratton**, although DBG had not registered the “**P**” Device mark in Kenya by the time DBG filed the expungement application, it was still entitled to file the same under **section 35** of the **Trade Mark Act**, having regard to rights acquired and established in Kenya in that mark by DBG from 1997 to 2007 as a result of sales of the DBG goods in Kenya over that period.

The deponent denied that there was any collusion between DBG and the Kenya Registrar of Trade Marks

or any other party to the expungement proceedings as alleged by the applicant. A statement of defence was filed by **Maina Makome & Co. Advocates** as the authorized agent of P.K Company. DBG and its advocates had no reason to believe that the said firm of advocates were not the agents of P.K Company. Mr. Ball added that under form TM1, the applicant did not appoint Omulele & Co. Advocates to act for him or P.K Company in connection with the expungement application. The wording of that form merely shows that the above firm was appointed to act in connection with the application and registration of TMA No. 57580 **PROOF** (word) and **“P”** (logo), that is the disputed mark. The disputed mark has been registered with effect from 28<sup>th</sup> June 2005 and the registration certificate issued on 12<sup>th</sup> November 2005 and therefore the appointment under form TM1 dated 26<sup>th</sup> July 2007 was ineffective and irrelevant to the expungement application and expungement proceedings, the interested party added. Mr. Ball urged the court not to grant the orders sought so that the expungement application can be heard and finalized.

I have considered affidavits filed by the parties herein and the submissions in support thereof by their respective advocates. It is trite law that judicial review proceedings are not concerned with the merits of a decision but with the decision making process. See **REPUBLIC vs. JUDICIAL SERVICE COMMISSION exparte PARENO [2004] 1KLR 203**. Where a party is challenging the manner in which an inferior body has proceeded or is intending to proceed in the process of making a decision the party may seek an order of prohibition to prohibit that body from adopting an improper process. In this matter, the applicant is seeking an order of certiorari to quash the expungement proceedings as well as an order of prohibition to prohibit the respondent from hearing and determining the expungement application. The applicant is further praying for an order of mandamus to compel the respondent to register the application for change of Trade and Business address as stated hereinabove. It is not for this court to consider the merits of the expungement application. Suffice to say that on the basis of the exhibits annexed to the interested party’s affidavit it is evident that the interested party has a *prima facie* case with a likelihood of success.

The applicant explained how TM No. 57580 was registered in 2005. Following registration and issuance of the certificate of registration, the applicant sought a change of the Trade and Business address as well as change of the name in the register from P.K Company to P.C Company. There is no dispute that the application for the said changes was necessitated by the disagreement of the partners in Pudlo Kenya Company. When the interested party learnt that there had been infringement of its trade mark, **“P”** Device it filed an expungement application on 16<sup>th</sup> February 2006. The application was made pursuant to the provisions of **section 35** of the **Trade Marks Act Cap 506** which states as hereunder:

***“35(1) Any person aggrieved by the non-insertion in or omission from the register of an entry, or by any entry made in the register without sufficient cause, or by any entry wrongly remaining on the register, or by any error or defect in any entry in the register, may apply in the prescribed manner to the court or, at the option of the applicant and subject to the provisions of section 53, to the Registrar, and the court or the Registrar may make such order for making, expunging or varying the entry as the court or the Registrar may think fit.***

***(2) The court or the Registrar may in any proceeding under this section decide any question that it may be necessary or expedient to decide in connection with the rectification of the register.”***

On 16<sup>th</sup> May 2008, Dulu, J. granted leave to the applicant to seek the orders of certiorari, prohibition and mandamus. The court further ordered that the grant of leave was to operate as a stay of the expungement proceedings. The respondent was therefore unable to proceed and determine any of the issues raised by the parties in the expungement proceedings.

Prof. Odek stated that vide a letter dated 28<sup>th</sup> April 2008, the respondent declined to allow the applicant’s application for termination of the expungement proceedings as well as his request for application for change of address. The respondent stated, *inter alia*:

***“A party to a suit cannot under any circumstances direct or order proceedings to be terminated or ceased. Be advised that the jurisdiction to order cessation of any proceedings is not vested on any party***

***but on the Registrar of Trade Marks or the High Court as appropriate. Consequently, be informed that your “demand” is hereby summarily rejected.”***

The respondent further explained that it was not vested with the jurisdiction to hear and determine partnership disputes. The respondent further gave reasons as to why the change of Trade and Business address could not be granted. The applicant was not satisfied with the respondent’s response to his request and moved to court shortly thereafter.

The respondent is vested with jurisdiction to hear and determine expungement applications. A statutory body cannot be stopped from undertaking its statutory duties simply because one of the parties to a dispute believes that the body may not proceed in a fair manner or may be biased against him. Where such an allegation is made, cogent evidence must be adduced. In this matter, the applicant believes that he will not be given a fair hearing by the respondent for reasons disclosed in his affidavit which have been summarized hereinabove. I must state that I did not find the applicant’s arguments to be satisfactory to warrant grant of an order of prohibition to restrain the respondent from considering and determining the expungement proceedings. In **H.T.V. LIMITED VS. PRICE COMMISSION [1976] (ICR 170)** Lord Denning stated:

**“...a public body which is entrusted by parliament with the exercise of powers for the public good, cannot fetter itself in the exercise of them. It cannot be estopped from doing its public duty. But that is subject to the qualification that it must not misuse its powers; and it is a misuse of powers for it to act unfairly or unjustly towards a private citizen where there is no overriding public interest to warrant it.”**

In this case, I am not satisfied that an order of prohibition can issue to correct or alter the course, practice and procedure of the respondent. Ordinarily, an order of prohibition is granted to forbid a body or tribunal from acting or continuing with proceedings in excess of its jurisdiction or in contravention of the law or in disregard of the rules of natural justice. See **HALSBURY’S LAWS OF ENGLAND, 4<sup>th</sup> Ed. Vol. 1 page 83 para 128.** It was not demonstrated by the applicant that the respondent is acting outside its jurisdiction or has in any way acted outside the law or in disregard of the rules of natural justice. It would be prejudicial to the interests of the Interested Party if the respondent does not proceed with the expungement proceedings.

As regards the prayer for an order of certiorari, all I wish to say is that certiorari is a discretionary remedy which the court may refuse to grant even when the requisite grounds for its grant have been shown to exist. Having considered the nature of this matter, I am of the considered view that the interests of justice require that the expungement proceedings be expeditiously undertaken by the respondent. Consequently, I dismiss the applicant’s application with costs to the respondent and interested party.

**DATED, SIGNED AND DELIVERED AT NAIROBI ON THIS 5<sup>TH</sup> DAY OF OCTOBER, 2011.**

**D. MUSINGA**  
**JUDGE**

**In the presence of:**

**Margaret & Nazi – Court Clerks**

**Mr. Omulele for the Applicant**

**Miss Malik for Interested Party**

**Mr. Nyabori for Mr. Mate for the Respondent**