



REPUBLIC OF KENYA
HIGH COURT AT NAIROBI (MILIMANI LAW COURTS
MISCELLANEOUS APPLICATION 15 OF 2009

IN THE MATTER OF TRADEMARK ACT CAP 506 LAWS OF KENYA

AND

IN THE MATTER OF AN APPLICATION TO REGISTER TRADEMARK NO.57969

AND

**(BEING AN APPEAL FORM THE RULING AND ORDER OF THE REGISTRAR OF
TRADEMARKS NO.57969)**

INTERCONSUMER PRODUCTS...PLAINTIFF/APPLICANT

VERSUS

L. OREAL.....RESPONDENT

JUDGMENT

Iterconsumer Products Ltd. appealed against the ruling of the Hon. Registrar of Trademarks dated 20th November, 2008. The appellant is dissatisfied with the ruling by the learned Registrar, the following grounds constitute the appeal:-

- (a) The Learned Registrar misdirected himself in that despite finding that it was mandatory to file from TM1; he proceeded to rule that the Respondents Notice of Opposition and all subsequent documents were properly on recorded.
- (b) The Learned Registrar erred in both fact and law in relying entirely on the law of Agency in so far as the recognition of the validity or otherwise of documents file din proceedings before the Registrar.
- (c) The Learned Registrar erred in both fact and law in failing to appreciate the legal effect of the Respondent failing to file form TM1 before the Registrar prior to filling any documents in the matter AND in returning a finding that the effective date of Form TM1 was the date of execution and not the date of filing.

- (d) The learned Registrar failed to appreciate the import of Rules 4, 14 of the Trade mark Rules and section 63 of the trade marks Act in so far as agents are concerned.
- (e) The Learned Registrar erred in both fact and in law in returning a finding that the fact that the Opponents counsel wrote a letter dated 13th January 2006 to the Registrar seeking extension of time, and having acted on such request for extension of time, the Registrar had indeed recognized the principal-agent relationship between the Opponents and their counsel.
- (f) The Learned Registrar erred in fact and in law in returning a finding that it was necessary for the Applicant to prove malades, misrepresentation and/or forgery in the preliminary objection before him.
- (g) The Learned Registrar erred in dismissing the preliminary objection despite the fact that the Respondent failed to give any or any adequate explanation for the inordinate delay in filing form TM1, raising questions about its veracity and authenticity.
- (h) Any other or further grounds to be adduced at the hearing hereof.

In further arguments to support the above grounds, counsel for the appellant relied on the supporting affidavit sworn by Paul Kinuthia on 19th January, 2009 and written submissions filed on 15th June, 2009. Counsel for the appellant submitted that the filing of form TM1 after the objection proceedings or the notice of opposition was fatal; the Registrar should have struck out the objection. According to the provisions of Section 63(1) of the Trademarks Act, a party is allowed to appoint an agent to represent him in proceedings before the Registrar in the prescribed manner.

Section 2 of the Trademarks Act defines an agent to mean:-

“An advocate and any person who before the appointment day was an agent appointed under Rule 14.”

The appointment is done by filing of TM1 with the Registrar of the Trademarks. Before that form is filed, the only party authorized to deal with the matter is the applicant. In this case, the notice of opposition was filed on 15th May, 2006 and form TM1 was filed on 25th June, 2008 after two years since the objection proceedings. The learned Registrar was faulted for failure to find that the objection proceedings which were filed by the agent before the filing of form TM1 was fatal and proceedings were a nullity. The agent was not entitled to have audience before the Registrar of Trademarks. It is clear from the proceedings that the advocate did not have a duly executed form TM1. When the objection proceedings were filed, the form was filed out of time.

Further on the merit of the replying affidavit, counsel argued that it is not supported by any annexure as the annexure thereto offend the provisions of Order 19 of the Civil Procedure Rules because there is no separation from the affidavit. Finally, counsel argued that although the applicant also filed form TM1 out of time, this does not legalize the position of the respondent because it is clearly provided for under Rule 14 of the Trademarks rules that a party wishing to be represented by an agent should file form TM1 which is meant to ensure that the Registrar is dealing with an authorized agent and to prevent a situation where an applicant would disown the actions of their agent.

This appeal was opposed by counsel for the respondent. Mr. Gichachi relied on the replying affidavit by Jose Monteiro sworn on 7th May, 2009 and written submissions on behalf of the respondents filed on 26th June, 2009.

It is not disputed that the agency form TM1 was filed after the objection proceedings were filed. However, the provisions of the Act do not make it mandatory that form TM1 should be filed before any proceedings are filed. Rule 14(2) of the Trademarks Act, prescribes how form TM1 is supposed to be filed with the Registrar. The Act does not provide the time frame within which the form should be filed. Counsel argued that where there is no provision of when an act should be done, the Registrar has the discretion to decide what action to take, thus the Registrar has been exercising his discretion in

determining when the form TM1 should be filed.

This proposition is also founded under the Practice Notes issued on 31st July, 2007 especially Rule 4(3) which provides as follows:-

“Where upon examination the trade mark is filed without a Form TM1, the Registry will accept and examine the trade mark application but it will not proceed to advertise that application until it has received the advertisement fees and a properly signed and stamped Form TM1 in favour of the agent who filed the application. The Registry examination reports will contain a check box, which will indicate that the agent must file a signed form of authorization in addition to meeting the other conditions that are normally indicated in the relevant boxes in the Registry’s cyclostyled examination report.”

Counsel further submitted that the form TM1 is always filed after the proceedings and this was also the case with the appellant. The appellant filed their form TM1 seven months after they had lodged the counterclaim. Moreover, the respondent’s counsel admitted before the Registrar on 13th January, 2006 and informed him that they were appointed to oppose the trademark and they sought leave and time within which file the objection. The Registrar gave the respondent’s counsel audience and extended the period within which they could file form TM1.

The Registrar has the discretion to accept the documents. Counsel therefore submitted the appeal has no merits and defended the decision by the Registrar and findings that the rules do not provide the period within which to file form TM1. That discretion of the Registrar cannot be questioned because it was exercised judiciously and in the interest of substantive justice. On the replying affidavit, counsel argued that every exhibit is annexed and commissioned by the commissioner for oaths. Finally the appellant has not suffered any prejudice because of the filing of form TM1 out of time.

This being an appeal under the trademarks Act, especially Section 52 of the Act provides that:-

“In any appeal from a decision of the registrar to the court under this Act, the court shall have and exercise the same discretionary powers as under this Act are conferred upon the Registrar.”

By dint of the above provisions of the law, this court is given the same powers as the Learned Trial Registrar. The issue for determination is whether the learned registrar erred by dismissing the preliminary objection and for failing to find that when the respondent filed a notice of motion on 15th May, 2006, the agency form TM1 had not been filed, thus the proceedings; whether the Registrar erred by failing to declare the notice of objection incompetent and thereby dismiss it.

I have read the ruling by the learned registrar of trademarks and the reasons given for dismissing the preliminary objection. I have particularly read the provisions of Section 63(1) of the trademarks Act which is couched in a directory and not mandatory terms. Rules 14 of the trademarks rules make provisions on how an agent should be appointed. However the rules do not stipulate the period within which the notice of appointment of an agent by way form TM1 should be filed. This therefore gives the Registrar the discretion to decide when to accept the appointment of an agent.

The Registrar in this case in exercise of his discretion found that there is a form TM1 on record, executed by the respondent on 12th January, 2006 and filed on 25th June, 2008. That form showed that there was a principle - agent relationship between the respondent and the advocate. The Registrar proceeded to find that the respondent’s form TM1 filed on 25th June, 2008 was properly on record and agent had a right of audience. The Registrar was of the view that the respondent should be given an opportunity to be heard so that the Tribunal can determine the case on merit rather than on technicalities.

I find myself in agreement with the findings of the Learned Registrar of Trademarks. The usage of the word may in the trademark rules granted the Registrar the discretion on when to admit the agency form TM1. Going by the evidence on record, I do not see any prejudice that was occasioned on the appellant by the filing of the respondent's form TM1 when the appellant also admitted that they filed their form TM1 seven months after filing the counterclaim. The ruling by the registrar accords with the broad principles in the administration of justice as provided for under Section 3 of the Judicature Act which provides as follows...;

“Shall decide all such cases according to substantial justice without undue regard to technicalities of procedure and without undue delay.”

Also borrowing from the decision in the case of **Microsoft Corporation –Vs- Mitsumu Computer Garage Ltd and Mitsuminet (K) Ltd Milimani HCCC Case No.810 of 2001**

“Rules of procedure are the hand maidens and not the mistresses of justice. They should not be elevated to a fetish. There is to facilitate the administration of justice in a fair orderly and predictable manner, not to fetter or choke it.”

Taking the totality of the matters raised to this appeal, I am in agreement with the ruling by the learned trial registrar that the filing of the form TM1 out of time did not prejudice the appellant in any fundamental respect. The Registrar exercised his discretion and in my view the ruling underscored the need for the court or tribunal to rise to its higher calling to do justice by saving the proceedings and by administering substantive justice. In the circumstances the decision by the Registrar is hereby upheld. The appeal lacks merit and it is hereby dismissed with costs to the respondent.

Judgment read and signed on 18th September, 2009.

M. K. KOOME

JUDGE