



**REPUBLIC OF KENYA**  
**IN THE HIGH COURT OF KENYA**  
**AT NAIROBI (MILIMANI COMMERCIAL COURTS)**

**Civil Suit 597 of 2007**

**SANITAM SERVICES LIMITED.....PLAINTIFF**

**VERSUS**

**BINS (NAIROBI) SERVICES LIMITED.....DEFENDANT**

**R U L I N G**

The plaintiff Sanitam Services (EA) Ltd filed suit against the defendant Bins Nairobi Services Ltd seeking orders of permanent injunction to restrain the defendant from infringing its patent in respect of foot operated sanitary bins. Contemporaneous with filing the suit, the plaintiff filed an application for interlocutory injunction under the provisions of **Order XXXIX Rule 1 & 2** of the **Civil Procedure Rules**. The plaintiff sought to restrain the defendant by itself, its agents or servants from providing services using the foot operated sanitary bins, offering for sale, selling, passing off the foot operated sanitary bins as theirs, trading in Kenya howsoever and in any manner likely to cause their business to be confused with that of the plaintiff and or from trading in any way as to infringe the plaintiff's registered patent No. AP 773 and or passing of their business of foot operated sanitary bins as that of the plaintiff pending the hearing and determination of the suit. The plaintiff contends that it is exclusively registered as the legitimate owner and possessor of a patent under registration No. AP 773 which the defendant was infringing without any reasonable excuse. The plaintiff stated that the defendant had failed to furnish any substantial or reasonable excuse for providing services, supplying or passing off to the consumers, bins identical to those patented by the plaintiff. The application is supported by the annexed affidavit of Samson Nganga, a director of the plaintiff.

The application is opposed. The defendant filed grounds in opposition to the application and a replying affidavit sworn by Everlyne Mercy Khabala, an account executive of the defendant company. It is the defendant's case that the foot operated pedal bin is a product that has been in common use in Kenya and the world over prior to the plaintiff's alleged registration and procurement of the patent. The defendant denied that it had infringed any known rights contained in a patent registered by the plaintiff. The defendant stated that if the plaintiff had any rights under a patent then the said rights had lapsed. Further its existence and efficacy was doubtful. In her replying affidavit, Everlyne Khabala deponed that the foot operated sanitary bin used by the defendant was not similar to the foot operated sanitary bin that the plaintiff is alleged to have patented. She deponed that the plaintiff could not claim exclusivity of patent because the plaintiff have not demonstrated that it had invented the foot operated sanitary bin similar to the one sold to the market by the defendant. She deponed that the patent allegedly registered in favour of the plaintiff had lapsed and could not therefore be enforced by the court. She was of the view that the purported patent that was sought to be enforced by the plaintiff was meant to muzzle the legitimate and honest business activities of the defendant. She deponed that the plaintiff had not demonstrated that the said patent was its invention and therefore subject to protection of the law. She urged the court to dismiss the plaintiff's application with cost.

At the hearing of the application, I heard the submission made by Mr. Mutiso on behalf of the plaintiff. He submitted that the plaintiff was the owner of a patent No. AP 773 issued by the African Regional International Property Organization (ARIPO). The patent related to foot operated sanitary bins. He submitted that ARIPO is an organization recognized in law as regard the examination and decision on the patentability of a product. The present case, in his view, was not whether or not a patent had been issued but rather the infringement and the unlawful usage of the products patented to the plaintiff. Mr. Mutiso submitted that the defendants were using exactly the same if not similar sanitary bins to the one that was patented to the plaintiff. He contended that the defendant would suffer irreparable loss which

would be difficult to assess in terms of damages. He was of the view that the goodwill involved could not be adequately compensated by an award of damages.

Mr. Mutiso submitted that the sanitary bin which was patented to the plaintiff was removed from the register but was reinstated by the tribunal after the plaintiff had paid the maintenance fees. He maintained that under **Section 53** of the **Intellectual Property Act, 2001** this court was enjoined to protect the right of a patent owner where infringement is established. He submitted that the plaintiff had established a prima facie case and therefore should be granted the order of injunction sought. He submitted that a similar decision was made in favour of the plaintiff by the Court of Appeal in a case where the plaintiff had sued Rentokil initials. The case referred to was **Sanitam Services (E.A) Ltd –vs- Rentokil K. Ltd & Anor Nairobi CA Civil Appeal No.228 of 2004** (unreported). Mr. Mutiso further submitted that a case relating to patent was similar to that of protection of trade marks. He urged the court to grant temporary injunction to protect the patent of the plaintiff. He was of the view that if the order of injunction was granted, the defendant would not be locked out of business but would be required to pay royalties to the plaintiff.

Mr. Kurgat for the defendant opposed the application. He relied on the grounds of opposition filed together with the replying affidavit filed on behalf of the defendant. He submitted that the defendant was challenging the patent that was issued to the plaintiff. He submitted that the plaintiff had not made any invention capable of being patented. He was of the opinion that the plaintiff had registered the said patent to achieve a technical result – to lock out other users of the said foot operated sanitary bin from the market. He submitted that the foot operated sanitary bin has been in the market and is widely used in many parts of the world including Australia, Malaysia and in the UK. He maintained that the plaintiff had not established that it had a valid patent capable of being enforced by the court. It was further submitted by the defendant that the plaintiff should have taken the dispute over the alleged infringement of involving the patent to the tribunal set up under **Section 106** of the **Industrial Property Act**.

Mr. Kurgat was of the view that the plaintiff could never have been the inventor of the foot operated bin. This court should therefore not allow the plaintiff to use the fact of its registration by ARIPO to grant an injunction. He submitted that the defendant had sought the revocation of the patent issued to the plaintiff by ARIPO. He maintained that the plaintiff was not a bonafide owner of the patent of the foot operated sanitary bin. It was his view that the said patent was obtained by fraud, mischief and was tainted by non disclosure of material facts. He submitted that the plaintiff had failed to establish a case to warrant this court to grant it the order of interlocutory injunction sought. He maintained that the patent that was issued to the plaintiff by ARIPO had expired because the plaintiff failed to pay the required patent fees. He urged the court not to grant an injunction on the basis of an expired patent. He submitted that the plaintiff had failed to establish that it had a patent capable of being enforced in accordance with the provisions of the **Industrial Property Act**. He therefore urged the court to dismiss the application with costs.

I have carefully considered the rival submission made before this court by the counsel for the plaintiff and the counsel for the respondent. I have also read the pleadings filed by the parties in support of their respective opposing positions. The issue for determination by this court is whether the plaintiff established a case to entitle this court grant the order of interlocutory injunction sought. The principles to be considered by this court in determining whether or not to grant an order of interlocutory injunction are well settled. In **Michael Gitau –vs- Pamela Salvage & 4 others CA Civil Appeal No. 244 of 1999 (Nairobi)** (unreported), the Court of Appeal held at page 7 of its judgment as hereunder:

*“The principles which guide the court in dealing with such an application are well settled and are clearly spelt out in the often cited case of **Giella –vs- Cassman Brown & Co. Ltd [1973] E.A. 358**. The applicant must first show he has a prima facie case with the probability of success upon trial. Secondly, he must show that in the event that he is refused an injunction and he were eventually to succeed that damages would not adequately compensate him for any loss which he would have suffered. Thirdly, that if the court is in doubt on either of the two principles above then it should consider the application on the balance of convenience.”*

In the present application, the issue in dispute relates to whether or not the plaintiff has a patent which is capable of being protected by this court. According to the plaintiff, it is the owner of patent No. AP 773 issued by the African Regional Industrial Property Organization (ARIPO). The plaintiff annexed a certificate of grant of patent issued to it by the said organization in respect of a foot operated sanitary/litter bin (annexture SKN2). The said certificate was issued on 25<sup>th</sup> October, 1999. The plaintiff further annexed a sketch of the foot operated sanitary bin which was registered by ARIPO. The defendant does not dispute that the plaintiff was registered by ARIPO as an owner of the patent in respect of a foot operated sanitary bin. It was however the defendant's submission that the foot operated sanitary bin that it is offering in the market was not similar to the one which was patented by the plaintiff. This was due to the fact that similar foot operated sanitary bins were in use in many parts of the world. The defendant contended that it had imported the foot operated sanitary bins which it currently is issuing to its customers. The defendant is of the view that the patent which the plaintiff registered with ARIPO was not in respect of an invention but was rather meant to achieve a technical result of locking out other users of the said foot operated sanitary bins from the market. The defendant told the court that it was in the process of challenging the registration of the said patent by the plaintiff.

I have considered the arguments made on this point by the plaintiff and the defendant. **Section 59** of the **Industrial Property Act, 2001** provides that a patent issued by ARIPO will be recognized in Kenya. This court therefore is required in law to recognize the patent registered in favour of the plaintiff. As stated earlier in this ruling, the defendant does not dispute that the plaintiff is a registered owner in respect of a foot operated sanitary bin. What the defendant is questioning is the wisdom ARIPO of registering a patent which in its opinion is not an invention capable of being patented. This court observes that if the defendant is of the opinion that the said patent was wrongly registered, then it can apply under **Section 103** of the **Industrial Property Act, 2001** for its invalidation or revocation. **Section 59** of the **Industrial Property Act**, provides an avenue where the defendant can seek the exclusion of the application of a patent in Kenya where such a patent is registered by ARIPO. If the defendant is of the strong opinion that the said patent ought not to have registered in favour of the plaintiff, then it has legal avenues to seek redress.

As it were, the plaintiff established that it has a valid patent which must be protected by this court in accordance with **Section 53** and **54** of the **Industrial Property Act**. Under **Section 55 (a)** of the **Industrial Property Act, 2001** an owner of a patent has a right to obtain an injunction to restrain the performance or the likely performance by any person without his authorization of any acts infringing his patent. In the present case, the plaintiff established the defendant has infringed its patent by offering for sale or hire foot operated sanitary bins without the authorization of the plaintiff. The plaintiff has therefore established a prima facie case with a likelihood of success. The argument advanced by the defendant in support of its contention that it was not bound to respect the patent issue to the plaintiff is attractive but does not have the backing of the law. This court is fortified in its decision by the ruling of Court of Appeal in a similar case to the present one where the Court of Appeal upheld the rights of the present plaintiff to benefit from its registered patent (see **Sanitam Services (E.A) Ltd -vs- Rentokil K. Ltd & Anor Nairobi CA Civil Appeal No.228 of 2004 (unreported)**).

I therefore hold that the plaintiff has established its entitlement to orders of interlocutory injunction sought. The defendant by itself, its servants or agents is hereby restrained from providing services using the foot operated sanitary bins, offering for sale, selling, passing off the foot operated bins as theirs or trading in Kenya in any manner likely to cause their business to be confused with that of the plaintiff and or from trading in any manner as to infringe the plaintiff registered patent No. AP 773 and or passing of their business of foot operated sanitary bins as that of the plaintiff pending the hearing and determination of the suit.

The plaintiff shall have the costs of the application.

**DATED** at **NAIROBI** this **20<sup>th</sup>** day of **FEBRUARY, 2008**.

**L. KIMARU**

**JUDGE**