



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

CIVIL CASE 359 OF 2007

SAFEPAK LIMITEDPLAINTIFF

VERSUS

DYNAPLAS LIMITEDDEFENDANT

RULING

The application for my decision is the one dated 16th July 2007, where the plaintiff/applicant seeks an injunction to restrain the defendant from infringing on the duly registered industrial design No. 385. The grounds in support of the application are;

- (1) The plaintiff is the registered owner of Industrial design number 385 and has been the owner of the said design since 26th September 2003.
- (2) On or about May 2007 the defendant infringed the plaintiff's design and continues to do so by reproducing the design, to manufacture bottles that are similar and virtually indistinguishable from the plaintiff's bottles in direct competition with the plaintiff.**
- (3) The defendant has deliberately reproduced or copied the plaintiff's design and only altered the pupils of the clown's eyes to an oval shape as opposed to the plaintiff's star shaped pupils. The defendant has also introduced a two arm devices instead of a frill in the area below the waist of the bottle.**
- (4) The changes does not give a new or unique shape to the defendant's bottle.
- (5) **The plaintiff has expended intellectual and money effort in coming up with the unique design.**
- (6) Unless the defendant is restrained by an injunction from infringement of the plaintiff's registered Industrial design, the plaintiff will suffer irreparable harm, loss and damage.**

According to the affidavit in support of the application, the plaintiff carries out the business of designing, manufacturing and selling containers and/or bottles in Kenya. It is the registered owner of Industrial design number 385. The effective date of registration is 26th September 2003. It is contended that the design is for a bottle and that the plaintiff has expended significant effort in designing a unique bottle whose features are distinctive and novel. The novelty of the bottle lies in the impression of a funny clown's face on two sides of the bottle leading to a frill collar.

It is further contended that the general configuration of the bottle is to give the impression of a smiling clown. According to **Miss Malik** Advocate for the plaintiff, the protection given to an Industrial design

pursuant to the Industrial property Act is valid for a period of 5 years. And in May 2007 it was brought to the attention of the plaintiff that the defendant was manufacturing and selling bottles whose features, pattern and shape are substantially similar if not identical to the plaintiff's registered design. It was contended that the defendant's bottles also create an impression of a funny clown, the only difference being that the pupils of the clown's eye have been given an oval shape as opposed to the plaintiff's star shaped pupils. The defendant has also introduced two arm devices instead of a frill in the area below the waist of the bottle.

The plaintiff further contends that other than expending intellectual effort in coming up with the design, it also expended considerable amount of money i.e. Kshs.1,500,000/= to contract mould makers in Singapore to come up with a mould to make the bottles. And that it has established a valuable and extensive reputation and goodwill in the design by virtue of its substantial use.

The application was opposed by the defendant and it filed two affidavits in the form of replying and further affidavits. The reply of the defendant is that it wrote to the plaintiff seeking the specifications of the plaintiff's registered design but did not get details. And the specifications of the registered design are pertinent to determine the distinctions between the designs and as such the plaintiff's claim is incompetent to the extent that it fails to specifically set out the specifications of their registered design. It is also averred that the bottles used by the defendant was specifically designed without any reference whatsoever to the plaintiff's design. The defendant further contends that the slender and longer bottle and the easy grip are some of the distinctive features on its product specifically designed and created for its customers. And in paragraph 8 of the replying affidavit **Mr. Bimal Shah** states;

“That the bottle was designed and created to fit a specific need subsequent to an enquiry and order from our customer M/S Excel Chemicals Ltd who wanted a functional bottle targeting a specific clientele of young children who would purchase or consume products contained therein. As such, our instructions were to develop a bottle which was easy to handle by children. This specific request from our customers was and still is the driving force behind the functionally novel and distinct features and design of a slender bottle providing a better grip to children”.

Mr. Nyaoga learned counsel for the defendant submitted as follows: That the defendant has not in any way infringed, in the registered design of the plaintiff. Each bottle has got its special features, i.e. the waist of the two bottles is completely different. And that is one of the functional differences of the two bottles. The defendants' bottle offers a good grip on the waist as opposed by the one of the plaintiff. Further the nose and mouth of the defendant's clown differ from that of the plaintiff while the neck of the defendant's bottle is longer and distinct from the plaintiff's bottle.

Mr. Nyaoga Advocate also contended that the product in the bottles is not for one specific customers. The plaintiff manufacturers the bottles for one specific customer and there is no evidence from the plaintiff's customer that there has been confusion between the two bottles in the market. And no evidence because of that confusion the sales of the products put in the bottles has gone down, thus there is enough distinction between the two bottles.

In reply **Ms Malik** learned counsel for the plaintiff/applicant submitted that for purposes of a child looking at the two bottles, there is no major difference in the two bottles, in particular the face of the clown in the defendant's bottle. And in order to rely on the question of functionality, the defendant is required to show that the face of the bottle cannot work without its functionality. In her view the face of a clown cannot change the functionality of a bottle.

On the question of confusion, it is not one of the tests that is required to determine an industrial design infringement. According to **Ms Malik** Advocate, the plaintiff is relying on its statutory rights conferred upon by virtue of registration. The fact that you registered a design but you have not produced a product does not confer a right. And that confusion is relevant to passing off action.

Now, the basis of an injunction as sought by the plaintiff must be in conformity with the principles set out in **Giella vs Cassman Brown**. The test is whether an applicant has a prima facie case with a probability

of success and secondly that he stands to suffer irreparable loss and damages, which cannot be compensated by an award in damages. The last consideration is that if the court is in doubt the application be considered on the balance of convenience.

The basis of the plaintiff's case is that it has a registered design and obtained a certificate of registration from the Industrial Property Institute, design Number 385 which was exhibited. The duration of protection of the design is for five years (5) with effect from 26.9.03 and can be renewed for two further terms of five years each upon payment of the requisite renewal fee.

It is clear that sometimes in May 2007 the plaintiff discovered that the defendant company was manufacturing and selling bottles or container whose features, pattern and shape were substantially similar if not identical to the features patterns and shape like that of the plaintiff.

Section 92(1) of the Industrial Property Act states:

“Registration of an Industrial design shall confer upon its registered owner the right to preclude third parties from performing any of the following acts in Kenya.

- (a) reproducing the Industrial design in the manufacturer of a product**
- (b) importing, offering for sale and selling a product, reproducing the protected Industrial design or**
- (c) stocking of such a product for purposes of offering it for sale or selling it.**

It is clear in my mind that the rights conferred by registration of an Industrial design extends only to acts done for industrial or commercial purposes. And in law the creator of an Industrial design or his successors in title shall have exclusive rights to sell or cause to be sold for commercial or industrial purposes the goods in which the design is incorporated. It is therefore clear that a party whose design rights have been infringed is obligated to seek judicial remedy for the said infringement. In my understanding an infringement of a design is tantamount to gross trespass into the proprietary rights of an individual or institution. The statutory protection for trespass to property entitles the aggrieved party an immediate remedy of an injunction.

The object of injunction is to prevent the defendant, his servants or agents from infringing the registered design at any time in the future where infringement is proved. There is a prima facie right to an injunction as it is presumed from the fact of the infringement that there is a likelihood of its recurrence, so that practically all cases where the plaintiff succeeds, it will obtain an order of injunction. However it must be understood that injunction is an equitable discretionary remedy and it would not be granted to a party whose conduct does not meet the test of equity and justice.

The purpose of the industrial property Act is to protect novel and original designs devised to be applied to govern the shape and construction of particular articles to be manufactured and marketed commercially. In my understanding if good design is to be encouraged those responsible for producing designs must be protected against promiscuous taking by others of the fruits of their labour. The whole question of originality depends on the amount of labour, skill and judgement which went into the drawings and moulding in respect of which copy right was claimed. In essence the design must be originated by the party claiming ownership and not copied from another work. It is also essential to understand that under copy right ideas are not protected but only the skill and labour needed to give any idea some particular material form, is what is protected. To secure copy right for product, it necessary to show that labour, skill and capital was expended sufficiently to impart to the product some quality or character, which a subsequent product does not possess. It is the product of the application of one's skill, judgement, labour and learning to certain materials, which though may not be novel or ingenious but nevertheless is the claimant's original work, in that it is originated by him, emanates from him and is not copied, that is protected.

In order to ascertain what the registered design is, so that it may be compared with the alleged infringement, it is necessary to examine the clown images or pictures on the two bottles. If only small differences separate the registered design from what has gone before, then equally small differences between the alleged infringement and the registered design will be held to be sufficient to avoid infringement.

In my view nothing is to qualify as a design capable of protection at all, unless it has features which appeal to and are judged solely by the eye appeal. However the eye is not that of an expert at all times. Indeed the whole purpose of a design is that it shall not stand on its own as an artistic work but shall be copied by embodiment in a commercial produced artifact. I do not mean to say that a party is entitled to reproduce by way of small alterations and/or differences a particular design instigated and registered by a party. The subsequent design must possess some features to enable a person that it is completely and substantially different from the earlier design. The design and the rights conferred by registration is to prevent the manufacture and sales of the same bottles or similar bottles from the registered design. The emphasis therefore is on the visual image conveyed by the manufactured article. In essence what is registered and protected is the shape, configuration and/or pattern to be applied to a particular and specific article or object. And it is the shape or configuration of the whole bottle in respect of which there is to be a commercial monopoly. It is important to note and understand that the prospective customer is the customer that buys the bottles from the parties herein. It would be wrong to address to one's mind to the customer purchasing the product in the bottle at the supermarket or the shops. It is also important to understand that the intellectual property to be protected is in the bottle and not in the product to be put in the bottle. The customer who eventually buys the product in the bottle has no relevance to the issues for determination in this application.

The plaintiff contends that its bottle is used to bottle a ready to drink juice called *Starpop* which is aimed at children. And that its design of the said bottle is novel but infringed by the defendant. The plaintiff contends that the novelty of its design lies in the impression of a funny clown's face. And that it is not aware of any container design with a funny clown face having been registered prior to the registration of its design.

The defendant in its replying affidavit at paragraph 8 states;

“that the bottle was designed and created to fit a specific need subsequent to an enquiry and order from our customer M/S Excel Chemicals Ltd, who wanted a functional bottle targeting a specific clientele of young children who would purchase or consume products contained therein. As such, our instructions were to develop a bottle which was easy to handle by children. This specific request from our customer was and is still the driving force behind the functionally, novel and distinct features and design of a slender bottle providing a better grip to children”.

The defendant also contends that the slender and longer bottle and the easy grip are some of the distinctive features on this product specifically designed and created for one particular customer. I think the incorporation into the shape of some or even a majority of features dictated by functional requirements will not deprive the design of the plaintiff the necessary statutory protection. One may say that the two bottles compared together from a distance displayed various and obvious differences on casual inspection. However they would appear to the non-exparte to be reproductions of the applicant's design. Without making conclusive findings one cannot escape the verdict that some element of material alteration or embellishment which suffices to make the totality of the work of the defendant is substantially missing, whether the same plan, arrangements and combination of materials have been used for both bottles is a matter which must await a full consideration and determination of the dispute. In my understanding the moulding of the defendant's bottle appears to be a superficial creation from the design of the plaintiff. The plaintiff says that it had expended significant effort in designing a unique bottle whose features are distinctive and novel. The novelty of the plaintiff's bottle lies in the impression of funny clown's face on two sides of the bottle leading to a frill collar. The general configuration of the plaintiff's bottle is to give the impression of a smiling clown.

It is also clear that the defendant's bottle creates an impression of a funny clown, the only difference

being that the pupils of the clown's eyes have been given an oval shape as opposed to the plaintiff's star shaped pupils. The defendant also introduced two arm devices instead of a frill in the area below the waist of the bottle. I think there is such a limitation in the two images or impressions as to make it impossible to distinguish the plaintiff's bottle from that of the defendant. In doing so, the eye of an expert is not the consideration.

In my mind it appears the defendant incorporated some small differences which is difficult to separate the design of the plaintiff from that of the defendant. It is essential to understand that the defendant has not registered its moulding to restrict the statutory protection, the plaintiff enjoys. I tend to believe that the differences in the two bottles are not substantial enough to distinguish the overall features and shape present in the defendant's bottle from the configurations and features embodied in the plaintiff's design. Generally speaking the differences are minimal and it is difficult to notice any striking or substantial differences in the two bottles. If one undertakes a close scrutiny, it would be clear that the defendant reproduced the moulding in the plaintiff's bottle with all the salient and essential features but with visually insignificant alterations. I think the incorporation into the shape, configuration and/or features of the plaintiff's moulding into its moulding, the defendant displayed the fears or concerns the plaintiff says it would suffer. And because of those little or insignificant differences or alteration created by the defendant, the plaintiff is entitled the statutory protection afforded to it by the law.

In conclusion and having addressed my mind to the issues raised by the plaintiff and the defendant, 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. The establishment or demonstration of a right infringed is a prima facie evidence that the case of the plaintiff has a probability of success at the trial. In short I am persuaded that the plaintiff has established a prima facie case which must be heard and determined at the trial.

On damages I am minded to hold that, a party entitled to a statutory protection cannot be made to suffer loss and damages because the opposite party is able to compensate him for any eventual loss or damages. I do not think the protection of a right through the grant of an injunctive orders can be a substitute for damages. In my view damages cannot be in lieu of a protection of a right through injunction. In short my take is that the plaintiff's case is not one where damages is appropriate due to the protection given under section 92(1) and (2) of the Industrial property Act.

The plaintiff having satisfied the first two limbs of the grant of an injunction is entitled to the orders sought, I therefore grant the orders sought by the plaintiff in the application dated 16th July 2007. The order is hereby granted for a period of 60 days within which the plaintiff must list down the suit for hearing. Parties are required to resolve all pre-trials within the next 45 days. Costs shall be in the cause.

Dated and delivered at Nairobi this 11th day of December, 2007.

M. A. WARSAME

JUDGE

Court: Ruling delivered in the presence of Mr. Wanyama for the defendant and no appearance for the applicant in open court.

M. A. WARSAME

JUDGE