



REPUBLIC OF KENYA
IN THE HIGH COURT OF KENYA AT NAIROBI

CIVIL CASE NO. 58 OF 1999

SANITAM SERVICES (EA) LIMITED.....PLAINTIFF

VERSUS

RENTOKIL (K) LIMITED & ANOTHER.....DEFENDANT

RULING

This application is seeking to restrain the respondents from manufacturing, offering for sale, selling, passing of 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 from trading in any way as to infringe the plaintiff's registered patent and/or passing off their business as that of the plaintiff until the hearing and determination of this suit on grounds that the applicant is the exclusively registered as the legitimate owner and possessor of a patent under registration number AP773 which the defendants are infringing without any reasonable excuse; and that the respondents have not furnished any substantial and/or reasonable excuse for manufacturing, supplying and/or passing off to consumers bins similar if not identical to those patented by the plaintiff. There is an affidavit sworn by Samson K Ng'ang'a the Director of the plaintiff company in support of the same application.

The first respondent opposed the application maintaining that the applicant's application is frivolous, misconceived and bad in law in that no *prima facie* case of infringement has been made out by the application taking into account the merits of the first defendant's defence and counterclaim, that the validity of the plaintiff's patent is disputed and as such the applicant's success in his claim for permanent injunction is doubtful and that the applicant has not shown that it is ready to give cross undertaking to make good any damage incurred by the first defendant from the interlocutory injunction orders should the plaintiff's claim fail. Further the first defendant says that it has in its defence furnished substantial reasons for supplying consumers the suit products.

The second respondent/defendant also opposes the application and in its grounds of opposition it states that the applicant has not disclosed all the material facts in this case and thus has come to Court with unclean hands; that the patent in respect of which the plaintiff is making the claim was applied for not by the applicant/plaintiff and was not granted to the applicant/plaintiff; that the product to which the patent refers has been in use and marketed for more than 2 decades, that the applicant has not shown how he will suffer any or any irreparable damage and lastly that the second defendant/respondent has applied for the revocation of the patent on the basis of which the applicant is making its claim.

A brief history of this matter may help in understanding the real matters at issue.

The applicant filed the original plaint on 21st January 1999 seeking permanent injunction against the

respondents on grounds that it designed and invented foot operated litter/sanitary disposal bin and was about to register the same as a patent. It made an application to Kenya Industrial Property Office (KIPO) for its registration on 4th September 1997 which application was accepted and it was advised to make similar application to other countries. The defendants during the period the plaintiff was still following up the question of registration manufactured and used the same bins in marketing their products to consumers and hence the suit. That plaint was accompanied by an application by way of chamber summons seeking temporary injunction which was dated 19th January 1999 and filed on 21st January 1999. That application was heard on 19th March 1999 and was dismissed on 16th April 1999 mainly on grounds that the alleged patent had not been registered and as such was a mere anticipated right which could not in law be protected. I also made reference to *W R Comish's Book on Intellectual Property* at page 171 where it states that in proceedings for infringements, the validity of the patent can be put in issue but that was where a patent exists as is the case now. Be that as it may, I will return to that issue later. Still on the brief history of the matter. After the dismissal of that application on account mainly of lack of registered patent, the matter did not proceed till 1st December 1999 when the applicant filed chamber summons seeking leave to amend the plaint. The chamber summons was dated 30th November 1999 and was filed into the Court on 1st December 1999. I heard that application on 9th December 1999 and on 14th December 1999 I did allow it and amended plaint was filed on 17th December 1999. On 23rd December 1999, the first defendant filed statement of defence and counter-claim and on 7th January 2000, the second defendant also filed an amended defence. This application was then filed on 19th January 2000.

From the brief history I have given above, it will be clear that the foot operated sanitary bins in question were in existence and were apparently in the market for quite sometime before the patent now sought to be protected was granted for the patent was granted according to annexure SKN 2 on 25th October 1999 long after the applicant had itself stated that his invention was being violated and filed an application in January 1999 which was dismissed in April 1999. We are therefore, talking of products already in the market.

The applicant in his grounds of the application states that the respondents are infringing his patent without any reasonable excuse. This in effect means that for the Court to grant the orders sought, infringement of the same patent must be proved. Secondly, the validity of the same patent must be proved. These need only be proved on the standards showing that the applicant's case is a *prima facie* case with a probability of success on those issues. Of course other requirements in *Giella's* case need also be proved.

I will start with the question of the validity of the patent. The applicant has produced a copy of the same patent and on its face value it was duly registered by a recognised body. The first respondent says the patent was registered by mistake because first defendant had obtained a patent for the foot operated litter sanitary disposal bin on 20th February 1995 under certificate of registration No 2042739. The second respondent says it was not properly registered because the objection to its registration had been lodged with Kenya Industrial Properties Office (KIPO) who were expected to inform ARIPO before it could be registered. In my humble opinion, and with respect, these are not for me to consider as these are matters between the registering bodies and the respondents. I cannot sit on judgment upon the actions of KIPO and ARIPO as that aspect is not before me. Neither can I legally stop the applicant in its application on grounds that there are objections lodged against the registration of its patent as these objections are not before me for decision. I find that as far as I am concerned, what is before me as a duly registered patent is valid and will remain so valid till the same validity is revoked by the right bodies.

That then leaves the question of whether or not there is proof of infringement of the patent.

The plaintiff says at paragraph 7 of the affidavit sworn by Samson K Ng'ang'a as follows:-

"That the defendants during the pendency of this registration and perpetually after the grant of the said patent, by themselves, their servants and/or agents have and are wrongfully and without any reasonable excuse continued to manufacture, supply, offer for sale and pass off to consumers bins similar if not identical to those patented by the plaintiff. (annexed and marked SKN/3 are photographs of the said bins offered for sale, a replica of those of the plaintiff)."

The applicant has annexed photographs of the respondents bins but no photographs of its bins for ease of comparison. The dictionary meaning of the word infringement (*Oxford Dictionary*) is to 'transgress'. It means in my mind that the respondent's products were so close to the applicant's that they would pass off as the applicants' products. To show that this is so, it was necessary as a matter of evidence to have the respondent's products and the applicant's products (if photographed) produced to enable the Court see for itself the infringement. This has not been done. Further, apart from the drawings, I have not seen the applicant's manufactured bin (in photograph) to lead me into a conclusion that its patent is indeed being infringed. I will refer to what I had stated earlier when I was giving a short history of this case and that is that the patent had been registered when there were already foot operated bins in the market. It is, therefore, not altogether inaccurate when the first respondent says that their products were in the market in 1995 when what it calls patent (but which I do agree with Mr Mutiso can be referred to as Design Registration Only) was registered.

Under these circumstances, it is clearly upon the applicant to show that the respondents have copied their product and are manufacturing their product as if the same were theirs. This would require more than Mr Nganga's affidavit. It would require an affidavit to the effect that the respondents who had their bins before registration of the applicant's patent changed the design of their products to that of the patented products or were taking action to so change their design. That in my opinion is what would qualify the application of the word infringement in this aspect. Further, although this is not a matter of trade mark, it would have helped a great deal if any members of the public had sworn an affidavit stating that after the patent was registered a similar bin was manufactured by the respondents for public consumption as alleged by the applicant. I feel that where a similar product has been in the market for sometimes before one person patented his that person will have to show clearly that he has not himself pulled a fast one over the others who had been manufacturing theirs earlier on before his came into the market. The second respondent says at paragraphs 3 & 4 of the affidavit of Madhu Gudha sworn on 18th March 1999 and adopted in this application as annexure MGI that pedal operated bins have been available in the Kenyan market for over 10 years and he bought one for his house several years ago and he bought others from Nakumatt recently. This was not challenged. I do find that I am not satisfied that a *prima facie* case with a probability of success has been shown on the question of whether or not the respondents have infringed the applicant's registered patent.

Further, there is the question of loss. The applicant has stated that it will suffer loss. It has not stated how the loss will occur. It has not stated that it is now manufacturing these bins or that it is right now using the patent to earn any income in any way. It says at paragraph 10 that the actions of the respondents have deceived and misled the trade and general public into belief that the said bins are the plaintiffs and not buying defendants said bins, but it does not say whether its own products are in the market for sale. I am not satisfied on the question of loss either.

On the question of balance of convenience, as I have stated above, similar bins were in the market even by January 1999 when the first application for injunction against the respondents was filed. The applicant has not shown that its products are in the market as I have stated. To stop the sale of the same bins may very well mean that the public will be deprived of what may in the first place not have been an infringement of the recently obtained patent. That would put the public into unnecessary hardship at a time when there may very well be no alternative in the market. Balance of convenience favours status quo.

The sum total of all these is that I decline to grant this application. It is dismissed with costs to the respondents.

Dated and Delivered at Nairobi this 14th day of March 2000.

J.W.ONYANGO OTIENO

JUDGE