



**Republic v Kenya Industrial Property Institute; Newline Trading Company Ltd (Exparte) (Judicial Review Miscellaneous Application E156 of 2024) [2025] KEHC 1890 (KLR) (Judicial Review) (6 February 2025) (Ruling)**

Neutral citation: [2025] KEHC 1890 (KLR)

**REPUBLIC OF KENYA  
IN THE HIGH COURT AT NAIROBI (MILIMANI LAW COURTS)  
JUDICIAL REVIEW  
JUDICIAL REVIEW MISCELLANEOUS APPLICATION E156 OF 2024  
JM CHIGITI, J  
FEBRUARY 6, 2025**

**BETWEEN**

**REPUBLIC ..... APPLICANT**

**AND**

**KENYA INDUSTRIAL PROPERTY INSTITUTE ..... RESPONDENT**

**AND**

**NEWLINE TRADING COMPANY LTD ..... EXPARTE**

**RULING**

1. The Application that is before this court for determination is the one dated Chamber Summons 11<sup>th</sup> July 2024 wherein the Applicant seeks the following orders that:
  1. The matter be certified as urgent and be heard Exparte in the first instance:
  2. The Honourable Court be pleased to grant leave to apply for Judicial Review of an order for Certiorari to quash the Ruling dated 31<sup>st</sup> October, 2022 by the Respondent expunging trademark name QAMAR of trademark number 96287 from the register having registered on 7<sup>th</sup> March, 2017 with an expiration date of 7<sup>th</sup> March, 2027 in the name of the Applicant
  3. The Honourable Court be pleased to grant leave to apply for Judicial Review for an order for Prohibition to the Respondent to prohibit the registration of the trademark name QAMAR to any entity other than in the name of the Applicant
  4. That the leave so granted does operate as a stay of the registration of the trademark name QAMAR of trademark number 96287 registered by the Respondent on 7<sup>th</sup> March, 2017 with



an expiration date of 7<sup>th</sup> March, 2027 until determination of the application herein or until the court orders otherwise.

5. The costs of this Application be met by the Respondent.
2. The Application is opposed.

**Exparte Applicant's Case;**

3. It is the applicant's case that Order 53 Rule 1 of the Civil Procedure Rules 2010 mandates that an Applicant in such an application must seek leave before he can file the substantive application and the Applicant humbly submits that it has complied with the said provision.

4. Order 53 Rule 1(4) of the Civil Procedure Rules provides,

“The grant of leave under this rule to apply for an order of prohibition or an order of certiorari shall, if the judge so directs, operate as a stay of the proceedings in question until the determination of the application, or until the judge orders otherwise.”

5. Reliance is placed in the case of Republic v National Transport & Safety Authority & 10 others [2014] eKLR the Court stated,

“In judicial review, the threshold for obtaining leave to commence is low and obtaining leave is not in itself evidence of a strong case for issuance of stay orders. In order to obtain leave to commence judicial review proceedings, an applicant only needs to show that he has an arguable case. The standard for the grant of an order of stay is however a high one. In a situation where an Applicant seeks to stop the implementation of a law, he must demonstrate that the implementation of the law will cause irreparable harm. Otherwise, the Court will be reluctant to suspend the operation of a law.”

6. The applicant invokes Section 9(2) of the *Law Reform Act* Cap 26 Laws of Kenya which provides the time limit for filing for judicial review orders and states,

“Subject to the provisions of subsection (3) rules made under subsection (1) may prescribe the applications for an order of mandamus, prohibition or certiorari shall. In specified proceedings be made within six months or such shorter period as may be prescribed, after the act or omission for which the application for leave relates.”

7. The Applicant argues that it came to learn of the expungement on 27<sup>th</sup> May, 2024 when the Applicant received a demand letter from the and that the Applicant is using the same trademark and intends to import products with the same brand name as their client Bahati Home Foodstuff Ltd.

8. The search on 29<sup>th</sup> May, 2024 returned a finding that its trademark status is expunged vide a ruling in favour of Applicant for expungement.

9. This prompted the Applicant via a letter dated 10<sup>th</sup> June, 2024 to lodge complaint and/or inquiry to the Respondent regarding the said double registration and expungement and this prompted to these proceedings as the Respondent was served formally by the Applicant's advocate on record and the Respondent's adamantly, refused and/ or neglected to disclose any information and/or any justifiable reason as to the expungement of the trademark QAMAR, Trade Mark No: 96287.

10. The Respondent alleged serving the Applicant with copies of the Form TM 25 and Statement of case. It is aggrieved that the Applicant being a company with a known physical address should have been



served or its' directors as listed in the Applicant's CR-12 and the said Abdulaziz Hassan Oman for Nyawara & Co. Advocate and Vincent Chechi for Oyatta & Associates are not the Applicant's agents and not listed in the CR-12.

11. The Applicant Believes that it has an arguable case as its registration was expunged unheard contrary to Article 50(1) of the 2010 Constitution of Kenya and the Applicant will suffer irreparable harm and/or loss if leave shall not be granted to commence judicial review proceedings.
12. On the issue Whether the leave so granted does operate as a stay of the registration of the trademark name QAMAR of trademark number 96287
13. The applicant relies on the case of *Taib Ali Taib v Minister for Local Government & Others HC Misc. No. 158 of 2006*

“The purpose of a stay order in judicial review proceedings is to prevent the decision maker from continuing with the decision-making process if the decision has not been made or to suspend the validity and implementation of the decision that has been made. It is not limited to judicial or quasi-judicial proceedings as some think. It also encompasses the administrative decision-making process (if it has not yet been completed) being undertaken by a public body such as a local authority or minister, and the implementation of the decision of such body if it has been taken. A stay is only appropriate to restrain a public body from acting. It is however, not appropriate to compel a public body to act.”

#### **Respondent's Case;**

14. The Respondent opposed the Applicant's application through a Replying Affidavit filed on 22<sup>nd</sup> July, 2024. It is its case that on 7<sup>th</sup> March 2017, the Respondent received an application for registration of the Trade Mark No.96287 "QAMAR" (the trade mark) in the name of Newline Trading Company Ltd (the Applicant herein) with respect to goods in classes 29,30,31,32, and 39 of the International Classification of Goods and Services for Purposes of Registration of Marks (the Nice Classification).
15. On 11<sup>th</sup> May 2017, the application was approved for publication and was published in the Industrial Property Journal of 30<sup>th</sup> June 2017, at page 70. Subsequently, upon expiry of the sixty (60) day statutory period, the trade mark was entered on the Register of Trade Marks and a Certificate of Registration was issued effective 7<sup>th</sup> March 2017.
16. On 19<sup>th</sup> October 2018, Bahati Home Food Stuff Limited initiated proceedings to rectify the Register of Trade Marks with respect to the trade mark "QAMAR" by filing the prescribed Form TM 25 and a Statement of Case.
17. On 13<sup>th</sup> November 2018, copies of the Form TM 25 and Statement of Case were forwarded to the Applicant herein who were required to file their Counter-Statement, grounds on which the Proprietors would rely in support of registration of the trade mark, within forty-two (42) days from the date of receipt of the Form TM 25 and Statement of Case.
18. The Registrar served the Applicant herein with the Form TM 25 together with the Statement of Case by registered mail using the last address that was provided to the Registrar of Trade Marks by the Applicant on their Form TM2 application for registration of the trade mark "QAMAR".
19. Vide a letter dated 19<sup>th</sup> February 2020, the Registrar of Trade Marks invited the Ex-parte Applicant to fix the matter for hearing pursuant to the provisions of Section 44 of the *Trade Marks Act* as read together with Rules 103 and 83 (b) of the Trade Mark Rules, within thirty (30) days from the date of receipt of the letter.



20. On 5<sup>th</sup> May 2020, the Registrar of Trade Marks received a letter from Bahati Home Food Stuff Limited indicating that the Exparte Applicant herein had not complied with the contents of the said letter dated 19<sup>th</sup> February 2020.
21. Vide a letter dated 3<sup>rd</sup> February, 2022, the Registrar of Trade Marks sent a letter to Bahati Home Food Stuff Limited indicating that since the Applicant herein had failed to file its Counter Statement or fix a hearing date, they were required to file a Statutory Declaration within thirty (30) days from the date of receipt of the letter.
22. On 31<sup>st</sup> October, 2022, Registrar of Trade Marks delivered a Ruling on the matter and upon stating the basis on which the decision was made, the Register of Trade Marks was rectified by expunging Trade Mark No.96287 "QAMAR" from the Register.
23. From 28<sup>th</sup> November 2018 to 3<sup>rd</sup> February, 2022, which is a period of more than three (3) years, the Registrar gave the Applicant more than ample time to file grounds in support of Trade Mark No.96287 "QAMAR" remaining on the Register of Trade Marks but they failed to do so.
24. Reliance is placed in the case of Ibrahim Mungara Mwangi v Francis Ndegwa Mwangi/2014] eKLR where the court quoted the following passage from Snell's Equity by John MC Ghee Q.C. (31st Edition) at page 99: "The Court of equity has always revised its aid to stale demands where a party has slept upon his rights and acquiesced for a great length of time. Nothing can call forth this court into activity but conscience, good faith and reasonable diligence; where these want the court is passive, and does nothing."
25. The Applicant had enough time to file their Counter Statement and even fix a date for hearing before the Register of Trade Marks. In the interests of natural justice, parties need to be heard and decisions made after the hearing.
26. Disputes need to come to an end and in resolving disputes, the rights of both parties to the case must be considered. This would require a balance between the expectations and rights of the Applicant one hand and those of Bahati Home Food Stuff Limited on the other, which the Respondent duly considered.
27. According to the respondent, The Applicant ought to have been aware of the fact that rights with rights, comes obligations and in this case, it had an obligation to act, which it neglected and or refused to comply with and as a result their mark was expunged from the Register of Trade Marks.
28. It is its case that, the Registrar of Trade Marks exercised discretion as provided for in law, followed the procedure as prescribed in law to the letter, there was no abuse of process, and that the trade mark "QAMAR" was removed from the Register of Trade Marks due to the indolence and negligence of the Applicant.
29. It submits that the Registrar of Trade Marks made on the 31<sup>st</sup> October, 2022 to remove the Applicant's mark from the Register of Trade Marks was made with a lot of caution and in consideration of the provisions of the *Trade Marks Act*.
30. It invokes Section 44 of the *Trade Marks Act* which provides as follows: "Where any discretionary or other power is given to the Registrar by this Act or the rules, he shall not exercise that power adversely to the applicant for registration or the registered proprietor of the trade mark in question without (if duly required so to do within the prescribed time) giving to the applicant or registered proprietor an opportunity of being heard."



31. Rule 83 (b) of the Trade Marks Rules further states that the Registrar shall not rectify the register or remove the mark from the register merely because the registered proprietor has not filed a counter-statement.
32. Rule 103 of the Trade Marks Rules provides that before exercising adversely to any person any discretionary power given to the Registrar by the Act or these Rules, the Registrar shall, if so required, hear that person thereon.
33. The Applicant was given a duration of 42 days from the date of receipt of the Form TM 25 and Statement of Case to file a Counter Statement. The Registrar of Trade Marks while taking into consideration the provisions of Section 44 of the *Trade Marks Act* as well as Rules 83(b) and 103 of the Trade Mark Rules, gave a further 30 days to the Applicant so that it could take a hearing date in liaison with the Opponent's Advocates so that it could be heard before a decision would be made on the expungement Application.
34. It argues that the Exparte Applicant was thus supposed to defend its mark but failed to do so even after the Registrar of Trade Marks gave the Applicant thirty (30) days to take a hearing date in liaison with the Opponent's Advocates so that it could be heard before a decision would be made on the expungement Application. By the time the Registrar of Trade Marks was making a decision to expunge the Applicant's mark from the Register of Trade Marks on 31<sup>st</sup> October, 2022, the 30 days had already lapsed, and thus the Respondent acted within its powers and in accordance with the law. The decision by the Respondent to expunge the mark from the Register was procedural, fair and lawful.
35. This goes a long way in establishing that the Applicant was given a reasonable opportunity to defend itself before the decision by the Respondent was made.
36. It is its case that the Exparte Applicant was duly served as required by law. Rule 11 of the Trade Marks Rules provides as follows:
  - “(1) All applications, notices, statements, papers having representations affixed or other documents authorized or required by the Act or these Rules to be made, left or sent, at or to the office, or with or to the Registrar or the court or any other person, may be sent through the post by a prepaid or official paid letter;
  - (2) Any application or any document so sent shall be deemed to have been made, left or sent at the time when the letter containing the same would be delivered in the ordinary course of post; and in proving the sending it shall be sufficient to prove that the letter was properly addressed and put into the post.”
37. Rule 13 (5) of the Trade Marks Rules also provides that any written communication addressed to a party or person as aforesaid at an address given by him, or treated by the Registrar, as his address for service shall be deemed to be properly addressed.
38. Reliance is placed in the case of *Dancan K. Owino ta Bio Path Healthcare v Breeze Petroleum Station Limited* (Civil Appeal E042 of 2023) [2024]KEHC 3831 (KLR) (19 April 2024) (Judgment) where it was stated that: "A party cannot claim to have been denied a right to be heard, when it is his own actions or omissions that prevent him from accessing justice." It is therefore the Respondent's submission that the Applicant refused and or neglected to act on the contents of the letter from the Respondent and should not in any way hold the Respondent liable for its failure to act which resulted in the Applicant's mark being removed from the Register of Trade Marks.



39. The Respondent's decision to expunge the mark "QAMAR" from the Register of Trade Marks was thus made in adherence to the provisions of the Trade Marks Act and Rules.
40. In *Peninah Nadako Kiliswa v Independent Electoral & Boundaries Commission (IEBC) & 2 others /2015/ eKLR* stated that:

"The well-recognized principle in such cases, is that the court's target in judicial review is always no more than the process which conveyed the ultimate decisions arrived at. It is not the merits of the decision, but the compliance of the decision-making process with certain established criteria of fairness. Hence an Applicant making a case for judicial Review has to show that the decision in question was illegal, irrational or procedurally defective."

### **Analysis and determination;**

41. I have considered the Application, the Verifying Affidavit and Statutory Statement, the response on record and the rival submissions by counsel. The issues for determination are whether the court has jurisdiction and whether the Application for leave to commence judicial review proceedings and the stay order are merited.

This court has to first determine whether it has jurisdiction to proceed with the matter before it.

42. According to Section 2 of The Trade Marks Act "trade mark" means, (except in relation to a certification trade mark) a mark used or proposed to be used—
- a. In relation to goods for the purpose of indicating a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user to use the mark, whether with or without any indication of the identity of that person or distinguishing goods in relation to which the mark is used or proposed to be used from the same kind of goods connected in the course of trade with any person;
  - b. In relation to services for the purpose of indicating that a particular person is connected, in the course of business, with the provision of those services, whether with or without any indication of the identity of that person or distinguishing services in relation to which the mark is used or proposed to be used from the same kind of services connected in the course of business with any other person;
43. The following matters shall be deemed to be Commercial matters, suitable for trial by the Commercial Division of the High Court situated in New Milimani Commercial Courts, Upper Hill Nairobi.
1. All proceedings in which an injunction is sought to restrain the realization of securities whether debentures or charges.
  2. All company matters and applications including winding-up, excluding cases in which a Company is suing or being sued as an entity.
  3. All Bankruptcy matters.
  4. All matters relating to arbitration other than enforcement of awards; excluding any matter relating to land affected by the Land Control Board.
  5. All intellectual property matters.



6. All claims for the recovery of unsecured debts (but including claims against guarantors) due to a bank or other financial institution in which a defence is filed. On the filing of the defence the matter to be automatically transferred to the Commercial Court.
  7. Such matters as are certified by a Judge of the Commercial Court as being suitable for determination in the Commercial Court having regard to the amount involved; the need for a speedy hearing and the nature of the case. It was felt that in considering the nature of the case the Judge could be guided by the wording similar to the definition of a commercial action in the English Order 72 Rule 1 (1), namely: 'arising out of the ordinary transactions of merchants and traders and, without prejudice to the generality of the foregoing words, any cause relating to the construction of a mercantile document, the export or import of merchandise, affreightment, insurance, banking, mercantile agency and mercantile usage.'
44. I am satisfied from the Application, the supporting and the replying Affidavits and the rival submissions by the parties that the cause of action herein revolves around the issue of a trade mark by the name Trade Mark No.96287 'QAMAR'.
45. In the circumstances this court cannot preside over the Application given that it lacks jurisdiction and it has to down its tools.

**Determination;**

46. This suit relates to a decision predicated on an issue of the aforementioned trade mark and the issues flowing therefrom can fall within the domain of the Commercial Division of The High Court and this court lacks jurisdiction to hear and determine in this suit.

**Order;**

1. This suit is hereby transferred to the Commercial Division of The High Court for hearing and determination.
2. There shall be no orders as to costs.

**DATED, SIGNED AND DELIVERED AT NAIROBI THIS 6<sup>TH</sup> DAY OF FEBRUARY, 2025.**

.....

**J.M. CHIGITI (SC)**

**JUDGE**

