**Shah v Metro-Polykenya Ltd (Civil Appeal E014 of 2022)**
**[2025] KEHC 12587 (KLR) (Commercial and Tax) (16 September 2025) (Judgment)**

Neutral citation: [2025] KEHC 12587 (KLR)

**REPUBLIC OF KENYA**

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

**COMMERCIAL AND TAX**

**CIVIL APPEAL E014 OF 2022**

**H NAMISI, J**

**SEPTEMBER 16, 2025**

**BETWEEN**

**SUHASH RATILAL SHAH ..... APPELLANT**

**AND**

**METRO-POLYKENYA LTD ..... RESPONDENT**

***(Being an Appeal against the entire Judgment and Decree by the Industrial Property Tribunal delivered in Nairobi on 31 August 2022 in IPT Case No. 97 of 2021)***

## JUDGMENT

1. This appeal arises from a dispute before the Industrial Property Tribunal. The Appellant is an inventor and was the registered proprietor of Kenyan Patent No. KE 861, titled 'Wheel Assembly' (the Patent). The Respondent is a manufacturer of, inter alia, wheelbarrow wheels, which successfully sought revocation of the Patent before the Tribunal.

2. From the Record of Appeal and submissions by both parties, the undisputed facts can be discerned and summarised as follows:

    i. On 18 October 2018, the Appellant filed an application with Kenya Industrial Property Institute (KIPI), being application number KE/P/2018/3024, for the grant of a patent for his invention. The application was accompanied by a specification that included an initial set of eight claims;

    ii. On 14 February 2019, KIPI issued a Notification of Substantive Examination Report and Acceptance of Patent Application. A critical feature of this notification was the annexed search Report, which identified two pre-existing patents, US Paten No. US005316377 and UK Patent No. GB 2229975, as prior art that disclosed the invention as claimed in the initial application;

iii. On 30 June 2020, the Appellant filed an entirely new and amended set of 12 claims, which significantly altered the scope and definition of the invention for which protection was sought;

iv. On 23 July 2020, 23 days later, KIPI proceeded to grant Patent No. KE 861 to the Appellant;

v. On 10 May 2021, the Respondent instituted proceedings before the Tribunal requesting revocation and invalidation of the Patent, pursuant to section 103 of the *Industrial Property Act*. The sole pleaded ground was that the invention lacked novelty as required by section 23 of the Act.

vi. On 29 June 2021, the Appellant filed a separate request before the tribunal, alleging that the Respondent was infringing the Patent, and sought injunctive relief and damages under section 106 of the Act;

vii. By consent of the parties, the Tribunal consolidated the revocation request and the infringement request;

viii. After receiving pleadings, statutory declarations, expert evidence and hearing oral testimonies, the Tribunal delivered its judgement, finding in favor of the Respondent and consequently dismissing the Appellant's infringement claim with costs.

3. Aggrieved by the Tribunal's decision, the Appellant lodged this appeal on several procedural and substantive grounds.

**The Appellant's Case**

4. The Appellant's numerous grounds of appeal can be condensed into 5 arguments. First, the Appellant argued that the Tribunal lacked the requisite jurisdiction to hear and determine the revocation request for reason that KIPI, the statutory body that examined and granted the patent, was not a party to the proceedings before it. The Appellant contended that KIPI's expertise and its reason for granting the patent were indispensable for a just determination of the matter.

5. The second ground was that of procedural impropriety. The Appellant submitted that the Tribunal fundamentally erred in permitting the Respondent to introduce and argue new grounds for revocation in its final submissions. whereas the initial request was based solely on lack of novelty, the Tribunal allowed arguments on, inter alia, the lack of substantive examination of the amended claims and uncertainty of the claims. The Appellant argued that this was a violation of the cardinal rule of civil procedure that parties are strictly bound by their pleadings. The Appellant relied on the cases of IEBC & Another -vs- Stephen Mutinda Mule & 3 Others [2014] eKLR and Daniel Toroitich arap Moi -vs- Mwangi Stephen Muriithi & Another [2014] eKLR.

6. The Appellant submitted that the Tribunal did not grant the Respondent leave to amend its pleadings, but instead bestowed upon itself jurisdiction which it lacked by determining the validity of the patent based on new grounds.

7. Thirdly, the Appellant challenged the admission of and reliance upon the statutory declaration and expert opinion of Dr. Isaac Rutenberg, which was tendered by the Respondent. It is alleged that this evidence was filed after the close of pleadings and without leave of the Tribunal, thereby occasioning a miscarriage of justice.

8. Fourhtly, the Appellant asserted that the Tribunal erred in law and in fact in finding that the patented invention was not new and lacked an inventive step. It is the Appellant's case that his invention – a unitary, solid, non-inflatable wheely assembly moulded from a single non-metallic material – is

materially distinct from all prior art cited by the Respondent and represents a genuine non-obvious inventive leap. The Appellant submitted that the Respondent failed to show any actual similarity between previous and existing inventions and the Appellant's patent. The Appellant referred to the UK case of Synton BV -vs- Smithkline Beecham PLC [2005] UKHL 59.

9. Further, the Appellant contended that the Tribunal misapprehended the facts by basing its analysis on the initial 8 claims filed in 2018, rather than the 12 amended claims filed in 2020 upon which the patent was actually granted.

**The Respondent's Case**

10. On the issue of jurisdiction, the Respondent maintained that the Tribunal was properly constituted and had jurisdiction. Reliance was placed on the case of Samuel Kamau Macharia & another v Kenya Commercial Bank Ltd & another [2012] eKLR. The Respondent argued that section 103 of the Act, which governs revocation proceedings, clearly defines the parties as "an interested person" versus "the owner of a patent". There is no statutory requirement for KIPI to be a party. It was the Respondent's argument that the Tribunal, being a quasi-judicial body with its own mandated expertise, is not bound to call the granting authority as a party or witness.

11. On the issue of new grounds, the Respondent argued that in its counter-statement to the Appellant's infringement claim, it had pleaded that the patent was invalid. The Respondent posited that plea of invalidity is broad enough to encompass all reasons for invalidity, including fatal procedural flaws in the grant process. Since the two matters were consolidated, it was necessary to read the pleadings as a whole. The issue of lack of substantive examination was, therefore, properly before the Tribunal.

12. Further, the Respondent submitted that the Appellant did not challenge the evidence of Dr. Isaac Rutenberg on the grounds that it was filed without leave of the Tribunal. The Appellant's challenge was that the expert witness introduced new grounds, which position was disputed by the Respondent. It is on this basis that the Respondent argued that the Appellant was attempting to introduce new grounds at the appeal stage which he had not raised before the Tribunal. The Respondent relied on the case of Walter Enock Nyambati Osebe v Independent Electoral and Boundaries Commisssion & 2 others [2019] eKLR.

13. It was the Respondent's submission that Dr. Rutenberg's evidence was filed pursuant to directions issued on 15 September 2021 by the Tribunal for the filing of further statutory declarations. The Tribunal further gave the Appellant time to file any evidence upon being served with further Statutory Declarations by the Respondent. The Respondent argued that the Appellant was not prejudiced, having been afforded the opportunity to file a declaration in reply and to conduct a full cross-examination of the expert witness.

14. In supporting the Tribunal's decision on the invalidity of the patent, the Respondent contended that the invention was anticipated by prior art. The Respondent argued that the patent grant process was fatally and incurably defective. The evidence on record shows that the amended 12 claims, which form the basis of the grant, were never subjected to a fresh substantive examination as required by section 44 of the Act. The revocation of the patent was, therefore, proper.

**Analysis & Determination**

15. This being a first appeal, the duty of the Court is well settled. It is not merely to scrutinize the decision of the Tribunal, but to reconsider the evidence, evaluate it, and draw its own conclusions. In doing so, this Court must bear in mind that it has neither seen nor heard the witnesses and ought to make due allowance in that respect.

16. Turning to the issue of jurisdiction, section 103 (1) of the *Industrial Property Act* provides as follows:

> Any interested person may in proceedings instituted by him against the owner of a patent, or a registered utility model or industrial design or in proceedings instituted against him by the owner, request the Tribunal to revoke or invalidate the patent, utility model or industrial design registration.

17. The language of the section is plain and admits no ambiguity. It refers to the interested person and the owner of the patent. There is no mention of the granting authority, KIPI, as a necessary party.

18. Section 104(2) prescribes the procedure to be followed after the Tribunal's decision becomes final. It requires the Chairman of the Tribunal to inform the Managing Director of KIPI of the decision for the purposes of registration and publication. This statutory framework established a clear demarcation of roles. The role of KIPI being administrative, while that of the Tribunal being judicial. This demarcation of roles and post-adjudication communication from the Tribunal to KIPI is fundamentally inconsistent with the notion of KIPI being a party to the litigation itself.

19. In the premise, the Appellant's argument on jurisdiction is untenable. The Tribunal, which is composed of members who possess the requisite technical expertise, was properly seized of the matter and had jurisdiction to hear and determine the revocation request without the joinder of KIPI.

20. On the issue of introduction of new grounds in submissions, it was the Appellant's argument that the Respondent ambushed him by raising new grounds of invalidity in the final submissions, which were not pleaded in the initial revocation request and deviated from the initial claim of lack of novelty. In deed, it is a well-established principle that parties are bound by their pleadings. The Appellant's argument, however, overlooks the fact that the revocation request and infringement claim were consolidated. In its Reply and Counter-Statement, the Respondent pleaded that it could not have infringed the Patent because the Patent was invalid. The plea of invalidity, which was the Respondent's defence to the infringement claim, opened the door to any and all arguments that could be marshalled to demonstrate the Patent's invalidity, whether substantive or procedural.

21. Upon consolidation of the two matters, they became one cause. The Respondent's argument that the patent was invalid due to failure to conduct substantive examination of the amended claims was, therefore, not a new ground. Rather, it was a particularisation of the pleaded defence of invalidity, and the Appellant had the opportunity to adduce evidence to the contrary.

22. This Court finds that the Tribunal did not err in considering the arguments relating to the substantive examination process, as the same were sufficiently anchored in the initial claim of lack of novelty and the broader challenge to the Patent's validity.

23. On the admissibility of the evidence by Dr. Isaac Rutenberg, the record indicates that the Tribunal issued directions for the filing of further statutory declarations by both parties. The Appellant not only filed a Consolidated statutory declaration to Dr Rutenberg's evidence, but also subjected the expert to cross examination. In Christopher Ndaru Kagina v Esther Mbandi Kagina & another [2016] KEHC 3192 (KLR), the Court stated that Expert testimony must be subjected to vigorous cross-examination and ought to be weighed along with all other evidence, as was the case herein.

24. Further, in the Christopher Kagina case (supra), the Court opined thus:

> "The above evidence under the category of expert evidence and the general rule is that questions regarding the admissibility, qualifications, relevancy and competency of expert testimony are left to the discretion of the trial court....

The role of the experts is to give their opinion based on their analysis of the available evidence. The court is not bound by that opinion, but can take it into consideration in determining the facts in issue."

25. In Stephen Wang'ondu vs The Ark Limited, High Court Civil Appeal No. 2 of 2014, the Court articulated principles in considering expert evidence:

> "Firstly, expert evidence does not "trump all other evidence." It is axiomatic that judges are entitled to disagree with an expert witness. Expert evidence should be tested against known facts, as it is the primary factual evidence which is of the greatest importance. It is therefore necessary to ensure that expert evidence is not elevated into a fixed framework or formula, against which actions are then to be rigidly judged with a mathematical precision.
>
> Secondly, a judge must not consider expert evidence in a vacuum. It should not therefore be "artificially separated" from the rest of the evidence. To do so is a structural failing. A court's findings will often derive from an interaction of its views on the factual and the expert evidence taken together. The more persuasive elements of the factual evidence will assist the court in forming its views on the expert testimony and vice versa. For example, expert evidence can provide a framework for the consideration of other evidence.
>
> Thirdly, where there is conflicting expert opinion, a judge should test it against the background of all the other evidence in the case which they accept in order to decide which expert evidence is to be preferred.
>
> Fourthly, a judge should consider all the evidence in the case, including that of the experts, before making any findings of fact, even provisional ones.

26. In its judgement, the Tribunal expressly stated:

> " We have also independently reviewed the cited prior art and we are satisfied that there is nothing new or novel in the subject patent."

27. This demonstrates that the Tribunal did not solely rely on the expert's conclusions, but undertook its own assessment, weighing the expert opinion alongside other evidence, consistent with the principles of judicial assessment of expert testimony. This Court finds no error in the Tribunal's admission and handling of the expert evidence.

28. On the issue of revocation of the Patent, the Appellant asserted that his invention was patent-worthy and that KIPI had issued the patent after reviewing his 12 claims without objection. The Respondent, however, presented evidence regarding the examination process. The Respondent highlighted that KIPI's initial Search Report dated 14 February 2019, which pertained to the Appellant's original 8 claims, already identified prior art that anticipated the claimed invention. This, by definition, indicated a lack of novelty as per section 23 of the Act.

29. Under Section 23, novelty is an absolute standard. An invention is new only it if it is not anticipated by the prior art, which is defined as everything made available to the public anywhere in the world, by any means, before the filing date of the application.

30. Section 24 requires that the invention must not be obvious to a person skilled in the art. Section 34(6) requires that the claim(s) shall define the matter for which protection is sought and shall be clear and concise and fully supported by the description. The requirement for substantive examination of claims is enshrined in section 44.

31. The record shows that the only substantive examination conducted by KIPI was on the original 8 claims. The resulting search report concluded that the invention was disclosed by prior art. The Appellant then filed a completely new set of 12 claims, which ought to have been subjected to substantive examination as mandated by section 44. As the claims define the invention for which protection is sought (section 34(6), it follows that when the claims are fundamentally amended, a new substantive examination is required. The Appellant did not produce any evidence that such an examination of the 12 claims ever took place. Such a procedural lapse is not a mere technicality, but goes to the heart of the patent's system's integrity.

32. The fact that the ultimate claims on which the Patent was granted were not subjected to the rigorous examination, coupled with earlier evidence of prior art for the original claims, constitutes a fundamental flaw in the grant process. This Court finds that the Tribunal had ample basis to conclude that Patent KE 861 was not validly granted due to a lack of novelty and failure to comply with the substantive examination requirements under the Act.

33. In the premise, it is the finding of this Court that this appeal is devoid of merit. The same is dismissed with costs to the Respondent.

**DATED AND DELIVERED AT NAIROBI THIS 16 DAY OF SEPTEMBER 2025.**

**HELENE R. NAMISI**

**JUDGE OF THE HIGH COURT**

Delivered on virtual platform in the presence of:

For Appellant:

For Respondent:

Court Assistant: Lucy Mwangi