RSA Limited v Kenya Industrial Property Institute (KIPI); Toyota Kenya Limited & another (Interested Parties) (Commercial Appeal 007 of 2022) [2023] KEHC 20229 (KLR) (Commercial and Tax) (7 July 2023) (Ruling)

Neutral citation: [2023] KEHC 20229 (KLR)

REPUBLIC OF KENYA

IN THE HIGH COURT AT NAIROBI (MILIMANI COMMERCIAL COURTS)

COMMERCIAL AND TAX

COMMERCIAL APPEAL 007 OF 2022

DAS MAJANJA, J

JULY 7, 2023

FORMERLY CIVIL DIVISION CIVIL APPEAL NO. 692 OF 2019

BETWEEN

RSA LIMITED ..... APPELLANT

AND

KENYA INDUSTRIAL PROPERTY INSTITUTE (KIPI) ..... RESPONDENT

AND

TOYOTA KENYA LIMITED ..... INTERESTED PARTY

CRUISE EAST AFRICA ..... INTERESTED PARTY

(Being an appeal from the Ruling of the Industrial Property Tribunal dated 31st October 2019 in Nairobi IPT Reference No. 2 of 2018)

It is impossible to seek an extension or renewal of an Africa Regional Intellectual Property Organisation industrial design whose term had expired under the Harare Protocol

The appeal was against the decision of the Tribunal which held that there was no power/jurisdiction to renew or restore an Africa Regional Intellectual Property Organisation (ARIPO) industrial design under the Industrial Property Act and the Harare Protocol beyond the 10-year period granted under section 4(6).The court held that once the term of the appellant's industrial designs expired under the Harare Protocol, that meant that no further protections, modifications or alterations were available to it under the Industrial Property Act and it was not possible for the appellant to seek an extension or renewal of its designs thereunder upon expiry of their term under the Harare Protocol. The application for renewal or restoration would only have applied had the designs been registered under the Industrial Property Act.

Reported by Kakai Toili

Intellectual Property Law *– industrial designs - industrial designs registered under the Africa Regional Intellectual Property Organisation (ARIPO) – renewal of industrial designs registered under ARIPO - whether an ARIPO industrial design whose term had expired under the Harare Protocol could be renewed under the Industrial Property Act - whether an ARIPO industrial design could be construed to mean that the design was a national design under the Industrial Property Act -under what circumstance could an application for the renewal of an ARIPO industrial design be allowed under the Industrial Property Act - Industrial Property Act, Cap 509, section 88 and 89(1); Protocol on Patents and Industrial Designs within the Framework of the African Regional Intellectual Property Organisation (Harare Protocol), section 4(6).*

Brief facts

At the material time, in 2007, the appellant registered 15 industrial designs with the Africa Regional Intellectual Property Organisation (ARIPO). The Harare Protocal which was the Protocol on Patents and Industrial Designs within the Framework of the African Regional Intellectual Property Organisation, empowered ARIPO to grant and register patents, industrial designs and utility models on behalf of Member States. Based on section 4(6) of the Harare Protocol, the 10-year term for protection for the appellant's industrial designs lapsed in August 2017. Its advocates applied to the respondent to renew registration of the industrial designs for two further consecutive terms of five years.

The respondent pointed out that the period of protection under section 4(6) of the Harare Protocal and section 88 of the Industrial Property Act were out of sync and being a complex matter, it sought direction of the Tribunal. The Tribunal held that there was no power/jurisdiction to renew or restore an ARIPO industrial design under the Industrial Property Act and the Harare Protocol beyond the 10-year period granted under section 4(6). Aggrieved, the appellant filed the instant appeal.

Issues

i. Whether an Africa Regional Intellectual Property Organisation industrial design whose term had expired under the Harare Protocol could be renewed under the Industrial Property Act.
ii. Whether an Africa Regional Intellectual Property Organisation industrial design could be construed to mean that the design was a national design under the Industrial Property Act.
iii. Under what circumstance could an application for the renewal of an Africa Regional Intellectual Property Organisation industrial design be allowed under the Industrial Property Act.

Held

1. Section 115 of the Industrial Property Act granted the court wide discretionary powers in making a determination on an appeal. That meant that the court could re-evaluate, re-assess and reanalyze the extracts on the record and then determine whether the conclusions reached by the Tribunal were to stand or not and give reasons either way.
2. The appellant's designs were registered under the Harare Protocal which under section 4(6) provided the duration of such registration as 10 years from the filing date. The appellant chose Kenya as the designated State for its designs, which meant that the registration had the same effect as if it was registered under the Industrial Property Act and the designs, having been registered in August 2007 lapsed after the expiry of 10 years, being August 2017.
3. Section 4(6) of the Harare Protocal only meant that an ARIPO design enjoyed protection of Kenyan laws only in so far as the same was within the term of the Harare Protocal and could not be construed to mean that the design was a national design under the Industrial Property Act.
4. Once the term of the appellant's industrial designs expired under the Harare Protocol, that meant that no further protections, modifications or alterations were available to it under the Industrial Property Act and it was not possible for the appellant to seek an extension or renewal of its designs thereunder upon expiry of their term under the Harare Protocol.
5. The application for renewal or restoration would only have applied had the designs been registered under the Industrial Property Act which under section 88 provided that the registration was only

applicable for 5 years and a renewal of two further consecutive periods of 5 years upon payment of a prescribed fee. The Tribunal only referred to the Banjul Protocal to demonstrate that unlike the Harare Protocol, it had specific provisions for further extension of the mark registered thereunder.

6. Since restoration or renewal was not available to the appellant's ARIPO industrial designs, it was immaterial and of no effect that it made such an application to the respondent. Hence the issue whether the application was made within time or whether its application lodged out of time was fatal, could not arise. Had the appellant been able to apply for a renewal or restoration, its application would have been fatally flawed as it was filed out of time and did not set out any reasons for the delay as demanded by the section 89 of the Industrial Property Act.
7. The respondent did not have the power under the Industrial Property Act to renew or restore an ARIPO industrial design whose term had expired under the Harare Protocol. Even if the respondent had such power, the appellant failed to comply with the provisions sections 88(2) and 89(1) of the Industrial Property Act which would have been a bar to renewal or restoration of an industrial design.

Appeal dismissed with no order as to costs.

Citations

Cases

Kenya

Abok James Odera t/a AJ Odera & Associates v John Patrick Machira t/a Machira & Co Advocates Civil Appeal 161 of 1999; [2013] KECA 208 (KLR) - (Applied)

Statutes

Kenya

Industrial Property Act (cap 509) sections 88(2); 88(3); 89; 92(4); 115; 118- (Interpreted)

Advocates

1. *Mr Mbaluto instructed by Oraro and Company Advocates* for 1st Interested Party.
2. *Ms Dave instructed by LJA Associates Advocates* for 2nd Interested Party.
3. *Mr Kamwendwa with Ms Righa instructed by NM Kamwendwa and Company Advocates* for Appellant.

RULING

Introduction and Background

1. This appeal stems from the decision of the Industrial Property Tribunal ("the Tribunal") dated October 31, 2019 ("the ruling") where the Tribunal, while determining a reference for directions from the respondent held that there is no power/jurisdiction to renew or restore an Africa Regional Intellectual Property Organisation (ARIPO) Industrial Design under the *Industrial Property Act 2001* ("the IPA") and the ARIPO Protocol on Patents and Industrial Designs (1982) ("the Harare Protocol") beyond the 10-year period granted under section 4(6) of the Harare Protocol. The Tribunal further held that the provisions of the law relating to renewal and restoration of industrial designs are specific to Kenya National Industrial Designs and must be complied with and that failure to comply with the renewal and restoration in the IPA would disentitle an applicant to renewal and restoration of Industrial Designs under sections 88(2) and 89 of the *IPA*.

2. The findings of the Tribunal precipitated the instant appeal which is grounded in the amended memorandum of appeal dated June 2, 2022. The appeal has been canvassed by way of written submissions which are on record.

3. Before delving into the appeal, a brief background of the dispute and facts will suffice. At the material time, in 2007, the appellant registered 15 Industrial Designs with ARIPO. ARIPO is the acronym for the Africa Regional Intellectual Property Organisation which is an inter-governmental organisation that facilitates co-operation among African states in matters of intellectual property rights. The *Harare Protocal* which is, "The Protocol on Patents and Industrial Designs within the Framework of the African Regional Intellectual Property Organisation" was adopted in 1982 and it empowers ARIPO to grant and register patents, industrial designs and utility models on behalf of Member States.

4. Section 4(6) of the *Harare Protocol* provides that:

> 4(6) On the anniversary of the filing of the application, the Office shall collect the prescribed annual maintenance fees, part of which shall be distributed among the designated States concerned. The amount of the fees shall depend on number of States in respect of which the application or registration is maintained. Provided it is maintained, the registration of an industrial design effected by the Office shall in each designated State have the same effect as a registration effected or otherwise in force under the applicable national law. The duration of such a registration shall be ten years from the filing date. [Emphasis mine]

5. Based on the aforesaid provision, the 10-year term for protection for the appellant's Industrial Designs lapsed in August 2017. Its advocates through a letter dated August 4, 2018 applied to the respondent to renew registration of the Industrial Designs for two further consecutive terms of five years as set out in section 88 of the *IPA* upon payment of the prescribed fee. Section 89 provides for restoration of industrial designs where the registration has expired. The sections provide as follows:

> 88. Duration and renewal of registration of an industrial design
>
> (1) Subject to subsection (2), the duration of the registration of an industrial design shall expire at the end of the fifth year following the date of the application for registration.
>
> (2) The registration of a design may be renewed for two further consecutive periods of five years upon payment of a prescribed fee.
>
> (3) The fee for the renewal of registration of an industrial design shall be paid within twelve months preceding expiration of the period of registration but a grace period of six months shall be allowed for the late payment of the renewal fee on payment of the surcharge, as may be prescribed.
>
> 89. Restoration of registration of industrial designs
>
> (1) Where the protection granted to an industrial design has not been renewed due to circumstances beyond the control of the owner of the design, the latter or any other persons entitled may apply designs for its restoration on the payment of the prescribed renewal fee, as well as of the surcharge, within a period of one year from the date upon which renewal fee was due.
>
> (2) An application for restoration of registration of an industrial design, together with documents proving payment of the fees and surcharge mentioned in subsection (1), shall be sent to the Managing Director and shall contain a statement of the grounds on which the owner or the persons entitled consider the restoration justified.
>
> (3) The Managing Director shall examine the reasons referred to above and shall either restore the design or reject the application if he does not consider the grounds valid.

(4) Restoration shall not entail prolongation of maximum duration of the industrial design.

(5) Restored designs shall be published by the Managing Director in the prescribed form.

6. The respondent replied to the appellant by a letter dated September 14, 2018 noting that the period of the protection of the appellant's Industrial Designs had expired and pointed out that the period of protection under section 4(6) of the *Harare Protocal* and section 88 of the *IPA* were out of sync and this being a complex matter, it sought direction of the Tribunal under section 118 of the *IPA* hence the reference which was then determined by the Tribunal as stated above.

The Appeal and the Appellant's Submissions

7. The appellant's case is that its appeal should be allowed and that its industrial designs should be granted protection for 5 years as provided for by the *IPA* starting from the date of the ruling by this court. The appellant's amended memorandum of appeal and its submissions focus on the following grounds of appeal:

a. The learned honourable tribunal erred in law, by holding that there was no power/ jurisdiction to renew or restore an ARIPO industrial design under the *Industrial Property Act 2001* and ARIPO protocol beyond the 10-year period granted under section 4(6) of the ARIPO protocol.

b. The learned honourable tribunal erred in law by holding that the provisions of the law relating to renewal and restoration of industrial designs are specific to Kenya National Industrial designs and must be complied with, failure to comply with the renewal and restoration provisions in Act would disentitle an Applicant to renewal and restoration of the industrial designs under sections 88(2) and 89 of the *IPA*).

c. The learned honourable tribunal erred in law by failing to appreciate that there was no conflict between the *Harare Protocal* on patents and industrial designs and the *Industrial Property Act* No 3 of 2001 and if indeed there was such conflict, the *Industrial Property Act* No 3 of 2001 ought to have taken precedence over *Harare Protocal* on patents and Industrial designs

d. The learned honourable tribunal erred in law and fact by failing to appreciate that *Banjul Protocal* had no relevance in the circumstances of this case and in particular the patenting of industrial since the said protocol mainly focused on trademarks unlike the *Harare Protocol*

e. The learned honourable tribunal erred in law by that since the appellant had designated Kenya as one of the designated states and the respondent had on 14/9/2018 permitted the appellant to pay a sum of USD 6,000 as renewal fees for the renewal of its industrial 15 designs, the appellant had legitimate expectation that its designs were to enjoy the same protection under section 88(2) of the *Industrial Property Act* No 3 of 2001 and renewed for a further period of 5 years.

f. The learned honourable tribunal erred in law by usurping the powers of the respondent.

8. The appellant submits that the Tribunal was obliged to give effect to the *IPA* even if there were no extension mechanisms under the *Harare Protocal* and that since the *Harare Protocal* was domesticated by the *IPA*, it should take precedence over the *Harare Protocal* and the extension mechanisms provided for under section 88(3) should prevail and apply to the appellant's ARIPO industrial designs. The appellant argues that once its ARIPO industrial designs were registered locally, they became subject to the national laws of Kenya as the designate state hence all the issues appertaining to the appellant's

industrial designs, including their renewal, was and is subject to section 88(3) of the *IPA* and not section 6 of the *Harare Protocol*.

9. The appellant states that it should enjoy the protection for its industrial designs for a period of 15 years as contemplated under section 88(2) of the *IPA* and that the Tribunal erred in holding that the rights and protection accorded and enjoyed by an ARIPO design holder are only limited to the term of the design and/or there is no power/jurisdiction to renew or restore an ARIPO industrial design under the *IPA* beyond the 10-year period.

10. The appellant complained that the Tribunal erred by referring to the *Banjul Protocal* which is the, "The Protocol on Marks within the Framework of the African Regional Intellectual Property Organisation". It argues that the *Banjul Protocal* had no relevance to the case before the Tribunal and in particular the patenting of industrial designs as it focuses on trademarks unlike the *Harare Protocal* which applies to industrial designs. It submits that the Tribunal committed a fundamental error of law by making comparison and reference to the *Banjul Protocal* .

11. The appellant adds that at the respondent's instance, it paid USD 6,000.00 renewal fees on September 14, 2018. It therefore submits that it had a legitimate expectation that its industrial designs would enjoy the same protection as set out under section 88(2) of the *IPA*.

12. The appellant faults the Tribunal for holding that it failed to comply with the provisions of section 88(3) and 89(1) of the *IPA* and/or that there was a bar to the renewal or restoration of its industrial designs. It submits that it is within the mandate of the respondent to determine whether payment for the prescribed fee was made within the timelines prescribed by the *IPA* and that the Tribunal usurped the mandate and the jurisdiction of the respondent. That by dint of section 88(3) of the *IPA*, the appellant was mandated to pay the fees for the renewal of the registration for its industrial designs for a further period of five (5) years on or before 2nd, 3rd and 6th of August 2017. However, a grace period of a further 6 months (up to February 2018) was allowed for late payment of the renewal fee on payment of a surcharge fee and in view of the foregoing and in light of the mentioned proviso, the appellant having made its application on 3rd July 2017, was within the grace period provided for under the *IPA*.

13. The appellant's further submits that the interested parties should not have been joined to these proceedings as the 1st interested party is not the inventor of the industrial designs in question and their only intent is to ride on the intellectual property of the appellant for their financial benefits. Further, that it has not availed any drawings for anything to prove their alleged/purported industrial designs.

14. As regards the 2nd interested party, it points out that it was incorporated on September 5, 2007, a month after the appellant had already filed for the protection of its industrial designs with ARIPO on various dates between 2nd and August 6, 2007. That it was licensed in the year 2018 as medium workshop/ service/repair contractors and as such do not have the requisite licenses to enable them to engage in the business of fabricating/manufacturing vehicle bodies and vehicle accessories in Kenya. Further still, the 2nd interested party does not have and has not availed any drawings for its alleged/purported industrial designs.

The 1st Interested Party's Submissions

15. The 1st interested party prays that the appeal be dismissed. It submits that whereas there are differing periods of protection for industrial designs under the *Harare Protocal* and the *IPA*, a party must come within the relevant registration regime it seeks to take advantage of. That the appellant's own admissions and KIPI searches show that the industrial designs expired before the appellant attempted to belatedly seek a renewal/restoration. It points out that while section 89 of the *IPA* allows for

restoration of industrial designs that have expired, the applicant must comply with the time by making the application for restoration within one (1) year of expiry and by providing sufficient reasons as to why the restoration should be granted. The 1st interested party reiterates that the industrial designs, whether considered under the *IPA* or the *Harare Protocal* expired more than 1 year before the appellant applied for their renewal. It therefore supports the Tribunal finding that there was no power either under the *IPA* or the *Harare Protocal* to restore an industrial design, whose expiry date exceeded 1 year hence there was not statutory or lawful for restoring the appellant's expired designs.

16. The 1st interested party submitS that for ARIPO rights to have effect in Kenya, they must be subjected to the provisions and conditions of the laws of Kenya. In this case the application provisions and conditions are those stipulated in the *IPA* which include those in section 89. It submits that a party who fails to comply with mandatory provisions of the law in this case the timelines for renewal or restoration of industrial designs cannot cry foul on account of a self-induced predicament.

17. On the issue of payment, the 1st interested party submits that payment of statutory fees to KIPI by the appellant cannot be the basis upon which it is entitled to reliefs which are otherwise not merited or permitted in law. It submits that such an argument is akin to contending that the moment a plaintiff files a plaint and pays filing fees, its case ought to be automatically to be allowed. It maintains that the appellant's attempt to attach some form of weight to payment of filing fees, has no bearing on the merit of its appeal.

The 2nd Interested Party's Submissions

18. The 2nd interested party also prays that the appeal be dismissed. it submits that the appellant cannot renew its industrial designs under section 88 of the *IPA* after having benefitted from protection afforded by section 4(6) of the *Harare Protocal* and that it can only obtain the additional five years' protection if its designs were registered under the *IPA* from the beginning.

19. The 2nd interested party, while appreciating that Kenya is a contracting state to the *Harare Protocal* and hence is subject to the provisions thereof, contends that the industrial design under the *Harare Protocal* is subject to the national legislation only as far as enforcement, administration, compliance, infringement and protection are concerned, but not renewal of the industrial design. That had this been the intention of the law makers, then the laws would have expressly stated that an applicant can renew its industrial design for a further five years under the national law, despite initially registering the industrial designs under the *Harare Protocol*. That in fact, the *Harare Protocal* does not even provide for extension of the registered period of protection and that this would mean that the *Harare Protocal* intended the ten years to be a sufficient amount of time of protection.

20. The 2nd interested party Submits that the Tribunal was correct to hold that section 88 of the *IPA* on renewal and restoration of registration is specific to industrial designs registered in Kenya and it is mandatory for one to make the application for renewal or restoration for protection of the rights. That even if the court were to entertain appellant's contention that its ARIPO Industrial Designs could be considered under the *IPA* for renewal and registration, the appellant did not submit its application for renewal on time and never applied for restoration. The 2nd interested party contends that all the applications for renewal were received by KIPI on September 14, 2018 and all payments for the renewal application were made on September 14, 2018, which was one year and one month after the deadline for the application for a renewal as provided under section 88. That the grace period for the payment for renewal of the appellant's Industrial Designs would have ended on February 6, 2018.

Analysis and Determination

21. In determining this appeal, I think it is important that I set out the scope of the court's jurisdiction from the decision of the Tribunal as in this case. Section 115 of the *IPA* provides as follows:

> 115. Appeals to the High Court
>
> (1) Any party to the proceedings before the Tribunal may appeal in accordance with the rules made under this Part from any order or decision of the Tribunal to the High Court.
>
> (2) Upon the hearing of an appeal under this section, the High Court may—
>
> (a) confirm, set aside or vary the order or decision in question;
>
> (b) remit the proceedings to the Tribunal with such instructions for further consideration, report, proceedings or evidence as the High Court may deem fit to give;
>
> (c) exercise any of the powers which could have been exercised by the Tribunal in proceedings in connection with which the appeal is brought; or
>
> (d) make such order as it may deem fit as to the costs of the appeal or of earlier proceedings in the matter before the Tribunal.

22. The above provision grants the court wide discretionary powers in making a determination on an appeal. This means that the court can re-evaluate, re-assess and reanalyze the extracts on the record and then determine whether the conclusions reached by the Tribunal are to stand or not and give reasons either way (see *Abok James Odera t/a AJ Odera & Associates v John Patrick Machira t/a Machira & Co Advocates* [2013] eKLR).

23. In its decision, the Tribunal identified two issues for determination; Whether the ten lifespan of the designs registered under section 4(4) of the *Harare Protocal* can be renewed/extended under section 88 of the IPA upon expiry of the duration of protection under section 4(6) of the *Harare Protocal* and whether failure to comply with section 89 of the *IPA* by a party making an application for renewal/ restoration of an industrial design would bar renewal/restoration of an industrial design.

24. In answering the question whether there is a conflict between the *Harare Protocal* and the *IPA* on the term and renewal provisions, the Tribunal was of the view that one would have to look at the provisions of the *Harare Protocal* and the *IPA* that relate to the application and effect of certain sections of the *Harare Protocal* in Kenya. The Tribunal also stated that it had to consider whether designation converts an ARIPO design to a national design in any given designated state and in relation to this was whether the provisions relating to renewal of a Kenya national design for a further 2 terms of 5 years each and the procedures to be followed for renewal of national designs under sections 88 and 89 of the *IPA* are applicable to ARIPO industrial designs designated for Kenya.

25. The Tribunal held that under section 3(1) of the *Harare Protocol*, an ARIPO design has the same effect and is subject to the same conditions as an industrial design registered in the designated state and that section 92(4) of the *IPA* is in similar terms except that it has a provision for the national office to notify the ARIPO regional office that the registration of the ARIPO design shall have no effect in the designated state before the expiration of 6 months of notification by ARIPO under section 4(3) of the *Harare Protocol*. The Tribunal stated that that provision did not affect the 15 subject designs as there was no notification by the Kenyan National Registration Office(KIPI) to the effect that they

would not have effect in Kenya. Consequently, the Tribunal held that these designs had the same effect of creating exclusive rights in favour of the appellant for the duration of their term, that is, 10 years in terms of section 4(6) of the *Harare Protocol*. That throughout the terms and so long as the annual fees were remitted to ARIPO in terms of section 4(6) of the *Harare Protocol*, the subject designs enjoyed unqualified protection in Kenya as any Kenyan National Design. However, the Tribunal held that designation did not make them Kenyan National Designs and that they remained ARIPO industrial designs by registration, administration and maintenance. That had designation converted them into Kenyan registered national designs, then their term would have been reduced to 5 years which then would have been renewable for a two consecutive term of 5 years each and the annual maintenance fee would then have been payable to KIPI and not to ARIPO in terms of section 4(6) of the *Harare Protocol*.

26. The Tribunal stated that the term "shall have the same effect and be subject to the same conditions" must be construed to mean that the ARIPO design registered holder would enjoy exclusive rights and protection available to Kenya national design holders for the duration of the term under section 4(6) of the Harare Protocol. That the *Harare Protocal* does not give power to member states to alter the term of the ARIPO design which has been fixed at 10 years by either reducing or extending it and that if the contracting states contemplated a renewal of the ARIPO designs beyond the 10 years set out in section 4(6) of the Harare Protocol, they would have said so expressly like they have done the *Banjul Protocal* which at section 7 states that the registration of a mark shall be for a period of 10 years from the filing date and that registration may be renewed for further periods of 10 years on payment of the prescribed renewal fee.

27. The Tribunal therefore concluded that in the absence of a clear and express provision in the *Harare Protocal* authorizing extension of the life of an ARIPO registered design, the Respondent has no power to alter the term of the ARIPO design. Thus, the Tribunal held that the provisions for renewal of industrial designs are specific to Kenya national designs and do not extend to ARIPO designs.

28. The Tribunal also disposed of the second issue in the affirmative that failure to comply with the provisions of sections 88(2) and 89(1) of the *IPA* would be a bar to a renewal or restoration of an industrial design as the said provisions are couched in mandatory terms.

29. It is common ground that the appellant's designs were registered under the *Harare Protocal* which under section 4(6) provides the duration of such registration as 10 years from the filing date. It is also not in dispute that the appellant chose Kenya as the designated state for its designs, which meant that the registration had the same effect as if it was registered under the *IPA* and that the designs, having been registered in August 2007 lapsed after the expiry of 10 years, being August 2017.

30. The question before the Tribunal was whether a party which has chosen Kenya as the designated state could apply for an extension of its ARIPO registered design under Kenyan law due to the fact that this registration has "the same effect as a registration effected or otherwise in force under the applicable national law". I agree with the Tribunal that this provision only meant that an ARIPO design enjoyed protection of our laws only in so far as the same is within the term of the *Harare Protocal* and cannot be construed to mean that the said design is now a national design under the *IPA*. Once the term of the appellant's industrial designs expired under the *Harare Protocol*, this meant that no further protections, modifications or alterations were available to it under the *IPA* and it was not possible for the appellant to seek an extension or renewal of its designs thereunder upon expiry of their term under the *Harare Protocol*. This application for renewal or restoration would only have applied had the designs been registered under the *IPA* which under section 88 provides that the said registration was only applicable for 5 years and a renewal of two further consecutive periods of 5 years upon payment of a prescribed fee. I wish to point out at this stage that the Tribunal only referred to the *Banjul Protocal* to demonstrate

that unlike the Harare Protocol, it has specific provisions for further extension of the mark registered thereunder.

31. Since restoration or renewal was not available to the appellant's ARIPO industrial designs, it was immaterial and of no effect that it made such an application to the respondent hence the issue whether the application was made within time or whether its application lodged out of time was fatal, could not arise. I also agree with the Tribunal and the interested parties' submissions that had the appellant been able to apply for a renewal or restoration, its application was fatally flawed as it was filed out of time and did not set out any reasons for the delay as demanded by the section 89 of the *IPA*.

32. It is for these reasons that I find that the Tribunal was right to conclude that the respondent did not have the power under the *IPA* to renew or restore an ARIPO industrial design whose term had expired under the *Harare Protocol*. That even if the respondent had such power, the appellant failed to comply with the provisions sections 88(2) and 89(1) of the *IPA* which would be a bar to renewal or restoration of an industrial design

Disposition

33. The appellant's appeal fails and is dismissed with no order as to costs.

SIGNED AT NAIROBI BY

D.S. MAJANJA

JUDGE

DATED AND DELIVERED AT NAIROBI THIS 7TH DAY OF JULY 2023.

F. MUGAMBI

JUDGE

Court Assistant: Mr M. Onyango.

Mr Kamwendwa with Ms Righa instructed by N. M. Kamwendwa and Company Advocates for the Appellant.

Mr Mbaluto instructed by Oraro and Company Advocates for the 1st Interested Party.

Ms Dave instructed by LJA Associates Advocates for the 2nd Interested Party.