



**REPUBLIC OF KENYA**

**IN THE HIGH COURT OF KENYA AT NAIROBI**

**JUDICIAL REVIEW MISCELLANEOUS APPLICATION NO. 19 OF 2018**

**IN THE MATTER OF AN APPLICATION FOR ORDERS OF PROHIBITION AND MANDAMUS**

**AND**

**IN THE MATTER OF THE CONSTITUTION OF KENYA**

**AND**

**IN THE MATTER OF THE FAIR ADMINISTRATIVE ACTION ACT 2015**

**AND**

**IN THE MATTER OF THE TRADE MARKS ACT CAP 502 OF 2012**

**BETWEEN**

**REPUBLIC.....APPLICANT**

**VERSUS**

**THE REGISTRAR OF TRADE MARKS.....RESPONDENT**

**AND**

**HENRY WANJALA.....1<sup>ST</sup> INTERESTED PARTY**

**SYLVESTER MATETE MAKOBI.....2<sup>ND</sup> INTERESTED PARTY**

**CLIFF NJORA NJUGUNA.....3<sup>RD</sup> INTERESTED PARTY**

**MASAMBAYA FREDERICK NDUKWE.....4<sup>TH</sup> INTERESTED PARTY**

**GEOFFREY SAUKE.....5<sup>TH</sup> INTERESTED PARTY**

**EX PARTE : JOSEPH MUYALE INZAI**

**JUDGMENT**

**The Application**

1. This determination is on an application made by the *ex parte* Applicant herein, Joseph Muyale Inzai (hereinafter “the Applicant”) , by way of a Notice of Motion dated 1<sup>st</sup> February 2018 which was filed on 6<sup>th</sup> February 2018, seeking the following orders:

- a. That this Court be pleased to make an order of Mandamus to compel the Respondent to serve the Interested Parties with the Applicant’s Notice of Opposition to the Trade Mark Application No. 92589.**

**b. That this Court be pleased to make an order of Mandamus to compel the Respondent to hear the Applicant's Objection to the Registration of Trade Mark Application No 92589 "Boys Choir of Kenya" by the Interested Parties.**

**c. That this Court be pleased to make an order of Prohibition to forbid the Respondent from proceeding with the Registration of the said Trade Mark No. 92589 in favour of the Interested Parties.**

**d. That cost of this Application be borne by the Respondent.**

2. The Respondent is the Registrar of Trade Marks, which is a statutory body established by the Industrial Property Act of 2001, and is charged with the mandate *inter alia* of administering industrial property rights. The 1<sup>st</sup> to 5<sup>th</sup> Interested Parties herein are male adults who have sought the registration of the trademark "Kenya Boys Choir" with the Respondent, and to which the Applicant has objected.

3. The facts giving rise to the present application are detailed in the Applicant's supporting affidavit that he swore on 6<sup>th</sup> February 2018 and in summary are as follows. The Applicant made an application for registration of the trade mark No. KE/T/2010/67586 "Kenya Boys Choir," which trademark was registered by the Respondent on 26<sup>th</sup> January 2010. On 11<sup>th</sup> April 2011 the Interested Parties filed an application to expunge the said trademark, and the Respondent expunged the trademark in a ruling it made on the 27<sup>th</sup> February 2015. Being aggrieved by the decision of the Respondent, the Applicant appealed to the High Court, which upheld the Respondent's decision in a judgment delivered on 27<sup>th</sup> January 2016 by Ochieng J. The Applicant then filed an appeal to the Court of Appeal, which appeal is pending determination.

4. The Applicant annexed copies of the Respondent's ruling given in the Matter of Trade Mark No. KE/T/2010/67586 that expunged the Applicant's trademark; of the judgment of the High Court in Nairobi High Court Miscellaneous Suit No. 193 of 2015 which upheld the Respondent's decision on appeal, and of the Notice of Appeal to the Court of Appeal filed on 10<sup>th</sup> February 2016.

5. The Applicant further averred that a trade mark application was subsequently made by the Interested Parties on 3<sup>rd</sup> June 2016 as application No. 92589, and was published for registration on 31<sup>st</sup> October 2016. The Applicant through his advocates filed a Notice of Opposition to the said registration on 30<sup>th</sup> March 2017, whereupon the Respondent in a letter dated 6<sup>th</sup> June 2017 wrote to the said advocates stating that the said proceedings were *res judicata* and requested them to withdraw the notice of objection, which the Applicant's Advocates declined to do in a letter dated 30<sup>th</sup> June 2017. Further, that the Interested Parties through their advocates thereafter wrote to the Respondent, requesting that they be issued by the certificate of registration of the trade mark.

6. It is the Applicant's case that the issue of *res judicata* can only be raised during the hearing of his Notice of Opposition in proceedings between himself and the Interested Parties, and the Respondent is estopped from raising it before the opposition proceedings are heard and determined, and can only be an arbiter in the said proceedings. Further, that the Respondent has since declined to serve the Interested Parties with the said Notice of Opposition and consequently hear the opposition proceedings. In addition, that by requesting his advocates to withdraw the Notice of Opposition, the Respondent has breached the rules of natural justice and the Applicant's right to be heard.

7. Lastly, the Applicant stated that the purpose of the present proceedings is not to go into the merits of his notice of opposition but to have the Respondent compelled to serve the said Notice of Opposition and hear the opposition proceedings as is mandated by the Act; that the failure to hear the objection is unreasonable, oppressive and in contravention of what is legitimately expected.

### **The Response**

8. The Respondent, though served with the application, did not enter appearance or file any response. The Interested Parties on their part opposed the application through a replying affidavit sworn on 9<sup>th</sup> March 2018 by the 4<sup>th</sup> Interested Party, Masambaya Frederick Ndukwe.

9. The Interested Parties confirmed that there have been proceedings before the Respondent and in the High Court as narrated by the Applicant. Further, that the Applicant thereafter served them with a notice of appeal filed on the 10<sup>th</sup> February 2016, however, that there is no appeal on record against the decision of High Court. Therefore, that having succeeded in the case and there being no appeal, the Interested Parties saw it fit to apply for registration of the Kenya Boys Choir on the strength of the High Court decision, and served the Respondent with the judgment as part of their application.

10. It was their case that the Respondent as required by law published their application; and that they were made aware by the Respondent that a Notice of Opposition had been filed by the Applicant and also received a letter from the Respondent stating that the same had already been determined in an appeal by the High Court. According to the Interested Parties, there is no difference between the new claim being raised by the Applicant and that which had already been determined by the High Court, and in the absence of a stay or an appeal, the dispute as between the Applicant and themselves stand determined.

11. The Interested Parties therefore instructed their Advocates to write to the Respondent seeking issuance of the certificate of registration in their favour on the strength of the Respondent's opinion and decision regarding the Applicant's Notice of Opposition. In addition, that the Trade Marks Act gives the Respondent discretion to hear an opposition to registration of a trade mark or not, after considering the evidence and that while doing so the registrar shall consider whether any conditions or limitations can stop such registration.

12. Furthermore, that the Respondent's opinion and decision as contained in the letter of 6<sup>th</sup> June 2017 followed consideration of the Notice of Opposition, and previous related proceedings and outcomes on the issues in dispute and found that the outcomes did not have the potential to stop registration. Lastly, that the Applicant had already exercised his right to be heard as dictated by the rules of natural justice, and litigation must at some point come to an end. It will thus be in abuse of the process of Court and unfair to the Interested Parties if a party is allowed to use the court process relying on the same facts and law to prevent the Interested Parties from enjoying the use of the trademark "Kenya Boys Choir" and to try and obtain a different outcome.

## **The Determination**

13. The Applicant urged the application through written submissions dated 29<sup>th</sup> June 2018 filed by Simba & Simba Advocates, his Advocates on record. The Advocates for the Interested Parties, Mburugu & Kanyonge Associates, filed submissions dated 13<sup>th</sup> July 2018. Ms Matasi, the counsel for the Applicant, and Mr. Kanyonge, the counsel for the Interested Parties also made oral submissions during the hearing of the application.

14. I have considered the pleadings and submission made by the Applicant and Interested Parties, and find that there are two issues before this Court for determination. The first is whether the Respondent denied the Applicant an opportunity to be heard on its Notice of Opposition, and second, whether the Applicant is deserved of the orders sought.

### ***On the Opportunity To Be Heard***

15. On the first issue, the Applicant submitted that the right to fair administrative action is granted under Article 47 of the Constitution and has now been codified under section 4 (3) of the Fair Administrative Act, that where a decision is likely to adversely affect the rights of a person, an administrative body must grant that person an opportunity to be heard.

16. Further, that the Respondent in the letter dated 6<sup>th</sup> June 2018 in which it stated the matters raised in the Applicant's notice of opposition were *res judicata* and that it should be withdrawn offended the procedure laid out under the section 21(4) of the Trademarks Act, which is couched in mandatory terms and requires the Respondent to send a copy of the notice of opposition to an applicant.

17. Therefore, that the Applicant was not accorded due process, and the Respondent arrived at a unilateral decision that the Notice of Opposition was *res judicata*. without first according the parties the opportunity to address it. The Applicant relied on the Court of Appeal decision in **Sony Holdings Ltd vs Registrar of Trademarks and Another (2015) eKLR** that the Respondent has a duty to send out a Notice of Opposition to an applicant before registration and to hear the opposition before any registration takes place.

18. The Interested Parties on their part urged that the dispute they seek to determine has already been heard and determined in **Trademark KE/T/201067586 - Expungement Proceedings by Kenya Boys Choir Against Joseph Muyale Inzai** by the Assistant Registrar of Trade Marks, and on appeal in **Joseph Muyale Inzai vs Henry Wanjale and 4 Others, Miscellaneous Suit No 193 of 2015**. They also relied on the decision in **Sony Holdings Ltd vs Registrar of Trademarks and Another (supra)** where it was found that that the Registrar acted within his scope of powers.

19. Further, that the Applicant ought to have first exhausted the avenue of seeking a hearing before then Registrar as per Rule 103 of the Trade Mark Rules, and that the Respondent was right and acted within the scope of his powers to state that the matter was *res judicata*, as it would be a complete waste of time to hear the same case determined by the same competent authority on the same set of facts. In addition, that the Trademarks Act confers on the Respondent administrative powers and legal authority to determine questions affecting rights of subject.

20. Therefore, that it would be unreasonable to state that the Respondent violated the respondents right to fair administrative acting and legitimate expectation, as he has been given an opportunity to be heard over the years when the dispute has been in different fora. Reliance was placed on the decision in **Rich Productions Limited vs Kenya Pipeline Company and Another (2014) eKLR**.

21. I have considered the pleadings and submissions made on the issue of whether the Respondent acted fairly in the manner it handled the Applicant's Notice of Opposition. A core requirement of the duty to act fairly, as laid down in the Constitution in Article 47 and also by the Fair Administrative Act of 2015 and common law rules of natural justice is the need to ensure that a person affected by a decision has an effective opportunity to make representations before it is taken, so that he or she has the chance to influence it.

22. Article 47 of the Constitution provides as follows:

- (1) Every person has the right to administrative action that is expeditious, efficient, lawful, reasonable and procedurally fair.**
- (2) If a right or fundamental freedom of a person has been or is likely to be adversely affected by administrative action, the person has the right to be given written reasons for the action.**

23. Section 4(3) and (4) of the Fair Administrative Action Act provides the key procedural steps that are required to satisfy the requirements of fairness as follows:

- (3) Where an administrative action is likely to adversely affect the rights or fundamental freedoms of any person, the administrator shall give the person affected by the decision-**
  - (a) prior and adequate notice of the nature and reasons for the proposed administrative action;**
  - (b) an opportunity to be heard and to make representations in that regard;**
  - (c) notice of a right to a review or internal appeal against an administrative decision, where applicable;**
  - (d) a statement of reasons pursuant to section 6;**

- (e) notice of the right to legal representation, where applicable;
  - (f) notice of the right to cross-examine or where applicable; or
  - (g) information, materials and evidence to be relied upon in making the decision or taking the administrative action.
- (4) The administrator shall accord the person against whom administrative action is taken an opportunity to-
- (a) attend proceedings, in person or in the company of an expert of his choice;
  - (b) be heard;
  - (c) cross-examine persons who give adverse evidence against him; and
  - (d) request for an adjournment of the proceedings, where necessary to ensure a fair hearing.

24. In the present case, in addition to the aforementioned duty to act fairly, there is an applicable statutory procedure that was required to be followed by the Respondent under section 21 of the Trademarks Act upon an application for the registration of a trademark as follows:

**(1) When an application for registration of a trade mark has been accepted, whether absolutely or subject to conditions or limitations, the Registrar shall, as soon as may be after acceptance, cause the application as accepted to be advertised in the prescribed manner, and the advertisement shall set forth all conditions and limitations subject to which the application has been accepted:**

**Provided that the Registrar may cause an application to be advertised before acceptance if it is made under paragraph (e) of subsection (1) of section 12, or in any other case where it appears to him that it is expedient by reason of any exceptional circumstances so to do, and where an application has been so advertised the Registrar may advertise it again when it has been accepted but shall not be bound so to do.**

**(2) Any person may, within the prescribed time from the date of the advertisement of an application, give notice to the Registrar of opposition to the registration.**

**(3) The notice shall be given in writing in the prescribed manner, and shall include a statement of the grounds of opposition.**

**(4) The Registrar shall send a copy of the notice to the applicant, and within the prescribed time after receipt thereof the applicant shall send to the Registrar, in the prescribed manner, a counter-statement of the grounds on which he relies for his application, and, if he does not do so, he shall be deemed to have abandoned his application.**

**(5) If the applicant sends a counter-statement, the Registrar shall furnish a copy thereof to the person giving notice of opposition, and shall, after hearing the parties, if so required, and considering the evidence, decide whether, and subject to what conditions or limitations, if any, registration is to be permitted.**

**(6) The decision of the Registrar shall be subject to appeal to the court.**

25. The fact that there has been previous litigation between the Applicant and the Interested Parties over the registration of the trade mark “Kenya Boys Choir”, and which was decided in favour of the Interested Parties is not contested. What the Applicant contends is that this fact notwithstanding, he still had a right to have his opposition to the Interested Parties application for registration of the trademark heard. He further contended that the proceedings in court are not about the merits of the decision that the Respondent made, but the fact that they were denied the right to be heard.

26. The Interested Parties on the other hand contended that having succeeded in the previous cases, and there being no appeal they saw it fit to apply for registration of the trademark “Kenya Boys Choir. Further, that the grounds of opposition being raised by the Applicant were canvassed in the previous proceedings before the Respondent and again before the High Court.

27. It is indeed the position, and the Respondent and Interested Parties did not dispute that having received the Notice of Opposition from the Applicant, the procedure set out in section 21(4) and (5) of the Trademarks Act was not followed by the Respondent, in terms of sending of the said Notice to the Interested Parties and conducting a hearing on the same. This finding notwithstanding, the application of the requirements of fairness is flexible, and will vary from case to case depending on the circumstances. It was held in **Lloyd v McMahon [1987] AC 625** by Lord Bridge that rules of natural justice are not cast in stone, and the requirements of fairness depend on factors such as the character of the decision-making body, the kind of decision it has to make and the statutory or other framework in which it operates.

28. In addition, the main test in establishing a breach of the duty to act fairly is that the claimant must in addition to establishing that there is a defect in the decision making process, also show that the said defect rendered the procedure as a whole unfair. The main question to be answered in this regard in the present application is whether the Notice of Opposition by the Applicant were new proceedings before the Respondent, on which he was not heard, or a continuation of the previous proceedings and dispute between the Applicant and Interested Parties.

29. This Court is inclined to find that the latter situation obtains, for reasons that the previous proceedings between the parties and the Applicant's Notice of Opposition related to the registration of the same trademark, namely that of "Kenya Boys Choir". In addition, the issue as to whether the Applicant has a valid and legal claim to the trademark Kenya Boys Choir was one which was canvassed and on which the Applicant was heard in the previous proceedings before the Respondent and on which a specific finding was made by both the Respondent.

30. The history of the dispute between the Applicant and Interested Parties and the previous course of dealings between the parties in my view are material in determining whether there was any unfairness caused by the procedure adopted by the Respondent. Given that the Applicant had the opportunity before the Respondent and in the High Court to argue his claim to the trademark in issue, I find that there was no breach of the duty to act fairly or of the statutory procedure by the Respondent in its decision and proceedings as regards the Applicant's Notice of Opposition, as the substance of his claim to the trademark had already been heard and determined. To hold to the contrary would be to abet an abuse of the legal and court process, and the Applicant should therefore pursue his claim in the Court of Appeal.

31. It is also notable in this regard that under section 22 of the Trademarks Act, the Respondent can proceed with registration of a trademark upon making a finding that an opposition has been decided in favour of an applicant, as was the case herein.

32. The decision of the Court of Appeal in **Sony Holdings Ltd vs Registrar of Trademarks and Another (2015) eKLR** was relied upon by both the Applicant and Interested Parties in support of their respective cases. The said decision is however distinguishable on two fronts. Firstly, in that case there had been no previous proceedings on the trademark in issue, and the Notice of Opposition therein were the first proceedings on the same. Secondly, the issue in that case was whether the Respondent had the power to extend the time within which to file a notice of opposition, which the Court of Appeal found was within its powers.

33. The findings made by this Court are however guided by the findings by the Court of Appeal in **Sony Holdings Ltd vs Registrar of Trademarks and Another (supra)** that the Respondent has the power and discretion to apply itself to the substance of a notice of opposition to ensure that the matter in controversy is heard and determined fairly.

#### **On the Orders Sought**

34. On the issue of the remedies sought, the Applicant relied on the case of **Kenya National Examinations Council vs Republic ex parte Geoffrey Gathenji and 9 Others (1997) eKLR** and submitted that his case meets the threshold for the grant of the order, and the respondent is under a duty to afford the applicant an opportunity to be heard before proceedings with the registration of any trade mark. And that the order will be directing the applicant to perform its statutory duty of sending the notice of opposition to the applicant as required under section 21(4) of the trademarks Act. The Interested Parties arguments on this issue were sufficient grounds have not been given as to why the order of mandamus should be granted.

35. This Court has found that the Respondent was not in breach of its duty to act fairly in the procedure it adopted with respect to the Applicant's Notice of Opposition. The Applicant is thus not entitled to the remedies of mandamus and prohibition that he seeks, as they were predicated on a finding that the Respondent acted unfairly.

36. The Applicant's Notice of Motion dated 1<sup>st</sup> February 2018 is accordingly not merited and is hereby denied. In addition, in light of the previous proceedings on the trademark in issue, the Applicant shall meet the Interested Parties' costs of the said Notice of Motion.

Orders accordingly.

**DATED AND SIGNED AT NAIROBI THIS 1<sup>ST</sup> DAY OF OCTOBER 2018**

**P. NYAMWEYA**

**JUDGE**