REPUBLIC OF KENYA

IN THE HIGH COURT OF KENYA AT NAIROBI

MILIMANI LAW COURTS

CIVIL APPEAL NO. 172 OF 2012

FIBRE LINK LIMITED ……....….APPELLANT/APPLICANT

VERSUS

STAR TELEVISION PRODUCTION

LIMITED……OPPONENT/RESPONDENT

RULING

Before this Court for determination is the Notice of Motion dated 1st March 2013 brought under **Section 1A, 1B, 3A of Civil Procedure Act** and **Order 42 rule 27(1) (b), 28,29 and Order 22 rule 25 of the Civil Procedure Rules.** The applicant is seeking the following orders:

> a. **That pending the hearing and determination of this appeal this honorable court be pleased to stay the decision of honourable Registrar of Trademarks in an Application to Register TMA No. 65503 vide his ruling dated 7th February, 2012.**
>
> **b. That pending the hearing and determination of this suit (Sic) this honourable court is pleased to grant leave to the appellant /applicant to file additional documentary evidence and such evidence be deemed to have been on court record from the date of filling the record of appeal.**
>
> **c. That the cost of this application be in the cause.**

The application is supported by the affidavit of **Wycliffe A. Swanya** dated 1st m

March 2013. Mr Swanya deposes that in the year 2009 the applicant lodged a Trade Mark Registration Number TMA No.65503 '**STARPLUS"** in class 38 on behalf of his client the applicant/appellant herein. The respondent lodged an objection to the registration of the said Trademark and the parties herein commenced hearing before the honourable Registrar of Trademarks.

While the proceedings were pending before the Registrar, the respondent applied for registration of the same mark "**STARPLUS"** which was registered in class 38 in the name of another proprietor, Star Television Production. The Registrar allowed the registration of the mark and the mark moved to the advertisement stage in the name of the respondent in class 41. The applicant was therefore compelled to oppose the registration of the disputed mark in the name of the opponent/respondent herein but the Registrar dismissed the opposition on a technicality before the matter could proceed to full hearing. The

applicant was aggrieved by the ruling of Registrar dated 7th February 2012 and lodged this appeal.

The applicant has urged the court to stay the said ruling in the interest of justice pending the hearing and determination of this appeal.

The application is opposed. The respondent filed a replying affidavit dated 12thJuly 2013 sworn by Peter J. Hime sworn on the same day contending that the ruling and decree of the Registrar of Trademarks is in the negative terms hence it is not capable of being stayed. In addition, it is deposed by Mr Hime that the application for stay if granted will in effect be determining the appeal herein fully and therefore prejudicial to the respondent as the end result will be that the appeal will be determined on merit without according the respondent an opportunity to be heard on merit.

It is further contended that the applicant has not demonstrated that the intended additional evidence could not have been obtained with reasonable diligence during the hearing of the opposition before the registrar of Trade Marks.

It is also contended that the application is fatally defective as the applicant did not annex the alleged intended evidence.

The respondent also avers that the matters raised by the applicant at paragraph 7 and 9 of the affidavit of Wycliffe Swanya in support of the application herein relate to separate proceedings wherein the Registrar of Trademarks duly delivered a ruling in respect of TMA No. KE/T/2010/0069541 in class 41 and there is no appeal in respect of the said decision made in those proceedings.

The respondent states that that is the Trademark which was advertised and not the applicant's application TMA No. 65503 STAR PLUS in Class 38 which is still pending registration hence this application is intended to mislead the court and prejudice the fair determination of the appeal through distortion of facts. He annexed copy of ruling and letter of Kaplan & Stratton PJH-1.

The applicant maintains that the application which the respondent made for registration of the trademark TMA KE/T/2010/0069540 in class 38 was still pending determination of opposition proceedings subject of this matter as shown by copies of letters by advocate for the respondent and the Registrar dated 11th March, 2011 annexed as PJH-2. The respondent further contended that the additional evidence sought is an afterthought as the matters deposed by the applicant were never raised during the hearing of the opposition proceedings relating to TMA No. 95503 STAR PLUS in class 38.

Mr Swanya, counsel for the applicant and Mrs. Opiyo for the respondent agreed the hearing of the application to proceeded by way of written submissions that were duly filed by each party, with highlights and this court is now called upon to determine the appeal based on those submissions.

The applicant submitted that the respondent applied for the registration of the trade mark "**STARPLUS"** while the proceedings of the same were pending before the Registrar of trademarks. The applicant believes that had this critical material fact been disclosed to the Registrar it would have assisted the Registrar to arrive at a just, fair and informed decision. The applicant further states that its application to oppose the registration of a similar trademark was dismissed on a technicality. The applicant elucidates that after his application to oppose the registration was dismissed the respondent trademark moved to the next stage of advertisement which was also opposed and the same were dismissed by the Registrar. They submitted that where the advertisement is not opposed or the opposition is not successful the trade mark moves to the next stage which is registration.

The applicant submitted that the registration of the mark in the name of the respondent was invalidly done since there was another proprietor on the registration of the trademark. The applicant further submitted that the Registrar allowed a mark which was already subject matter of litigation pending before the Registrar. The said mark was registered in the name of the respondent on 29th April 2011 while the proceedings were closed in September 2011 and parties were waiting for judgment which was delivered

on 7th February 2012. The applicant submitted that the respondent took advantage of the non disclosure of material fact to obtain unfair and unjust judgment which they are now appealing.

The applicant submitted that their application for additional evidence once allowed is to argue their pending appeal that the respondent took advantage of concealing the material facts he had applied for registration of the trademark in question which was the subject of litigation pending before the Honourable Registrar of Trademarks. The applicant also submitted that they had satisfied the conditions for an application for additional evidence.

The applicant stated that through the sequence of events outlined in their written submissions, it is clear that the respondent concealed this information throughout the proceedings. The applicant submitted that it was not therefore possible for them to know that the respondent had secretly applied to register the trademark subject matter of the litigation. The applicant explained that it would not imagine or expect the respondent to act unprofessionally and in defiance of the law and in contempt of the trademark court. They stated that it was only by chance that they noticed the mark being advertised in the Kenya Industrial Property Institute Journal. It further stated that the proceedings before the Registrar had closed and the parties were awaiting judgment. The applicant also submitted that if such evidence was tendered in evidence during trial before the Registrar, it would have an important influence on the result of the case.

The applicant further submitted that it is also a requirement that the additional evidence must be presumed to be believable and apparently credible. The applicant stated that their evidence is documentary; being application forms signed by the respondent counsel, copy of KIPI Journal in which the trademark in issue is advertised by the Kenya Industrial Property Institute. The applicant claims that the evidence is believable and credible .The applicant referred the court to the Court of Appeal decision in the case of **Joginder Auto Service vs Mohammed Shaffique & Mohammed Parvez Saroya Civil Appeal no. 210 of 2000.**

In response the respondent submitted that the alleged non-disclosure of material facts were not pleaded or raised in the application and affidavit and cannot be raised for the first time in submissions. It is trite law that parties must restrict themselves to pleadings and any material ground not pleaded cannot be argued or adjudicated upon. According to the respondent, to allow such new evidence would amount to trial by ambush. It stated that the issue of material non-disclosure cannot form the basis of their application and the same should be disallowed and disregarded *ex-debito justiciae.*

On the prayer for additional evidence, the respondent submitted it is a baseless and incompetent prayer. It was submitted that the applicant did not indicate with clarity the exact additional evidence it seeks to produce or annex the alleged additional evidence intended to be admitted in respect of its appeal to enable the court and the respondent consider the same with clarity. It further stated that the application does not satisfy the legal threshold for grant of such orders as set out in the Court of Appeal land mark case decision in **Wanje v Sakwa (1984) KLR 275** where the Court of Appeal set out 2 tests. The respondent submitted that the applicant has not satisfied that the intended additional evidence could not have been obtained and produced before the Registrar after exercising reasonable diligence.

The Respondent further stated that the said separate proceedings relate to application for registration of the trademark TMA No. KE/T/2010/0069541 in class 41 wherein a ruling was made on 15th May 2012 and no appeal has been preferred to date. The respondent also stated that the applicant's application was dismissed in the said application and the trademark proceeded to advertisement. The respondent further stated that the present appeal relates to TMA No.65503-STAR PLUS in class 38.

The respondent denied that it concealed any material information from the applicant as alleged by the applicant. The respondent submitted that to the contrary the applicant is guilty of attempting to misrepresent and twist the facts. That the appellant was aware of the proceedings in respect of TMA KE/T/2010/69541 in respect of the registration of STARPLUS in class 41 and indeed lodged opposition proceedings on 19th April 2011.

The respondent submitted that the applicant had every opportunity to raise these issues in opposition

proceedings on 19th April 2011; they also had the opportunity to raise the issue in opposition proceedings in TMA No. 65503 STARPLUS in class 38 but failed to do so. The respondent submitted that the applicant's submission that it was unaware of the separate proceedings is an afterthought as the applicant fully participated in both proceedings. The respondent further submitted that the power to admit additional evidence is discretionary and the applicant has failed to demonstrate that the intended additional evidence could not be obtained with reasonable diligence for them at trial and is therefore not deserving of the discretion of this court.

The respondent also submitted that the additional evidence is not important and would not have influenced the result of the case. The respondent stated that the evidence is irrelevant, the evidence the applicant intends to produce in court relates to separate proceedings of registration in class 41 and not class 38.

The respondent claimed the disposition at paragraph 7 of the affidavit of Mr Wycliffe Swanya are misleading as the applicant has not disclosed that the respondent informed the Registrar to put in abeyance the respondent's application for registration of TMA 69540 STAR PLUS & Device in class 38 pending the determination of proceedings in TMA No. 65503-STAR PLUS in class 38 which relates to the instant appeal. The respondent maintains that the proceedings in TMA No. 65503-STAR PLUS were heard on merit and the dismissal of the applicant's opposition proceedings in KE/T/2010/0069541 would not have been of relevance to the outcome of proceedings in 65503 due to the fact that 65503 related to the issue of confusion and deception of the public as a result of the registration of similar mark.

The respondent further submitted that the additional evidence is an afterthought and an attempt to patch up its case on appeal. The court was referred to the case of **Catholic Diocese of Meru v Obadiah Mwangi Ngugi (2005) eKLR.**

The respondent also submitted that the evidence is superfluous and on the face of it nor credible. It stated that the evidence relate to separate proceedings which the Registrar of Trademarks has already made a ruling on 5th May 2012 and no appeal or review was preferred by the appellant. On this issue the respondent relied on the Court of Appeal decision in **Kuwinda Rurinja Co.Ltd v Kuwinda Holding Ltd & 13 others (2013)eKLR** where the court followed the holding in Mzee Wanjie v Sakwa.

The respondent also submitted that the prayer for stay of the subject decision is untenable and incompetent. It argued that the ruling delivered on 7th February 2012 and decree issued on 16th January 2013 is in negative terms. The respondent submitted that it is trite law that a negative court order is incapable of execution and hence it cannot be stayed. The respondent relied on the decision of **Milcah Jeruto Tallam v Fina Bank Limited (2013) eKLR.** The respondent in its submissions accused the applicant of latches as the application for stay has been filed after a period of over one year since the ruling was made without any explanation of the delay. The respondent also submitted that if the prayer is granted the appellant will register its trademark which is the subject matter of appeal and which will render the appeal nugatory and will result in the appeal being dealt with prematurely before the substantive hearing.

I have considered the applicant's application, the supporting affidavit, the replying affidavit, written submissions filed by both parties' advocates and the brief highlights made in court. The main issue for determination by the court is ***whether on the facts and circumstances of this case the applicant is entitled to the two prayers and orders sought in this*** application.

In the application before the court the applicant is seeking two prayers: ***1) A stay of the ruling of the honourable Registrar of Trademarks in the application to register TMA No. 65503 vide his ruling dated 7th February, 2012.***

2) Leave to file additional documentary evidence and such evidence be deemed to have been on court record from the date of filling the record of appeal.

On the first prayer for grant of stay of the decision of the Registrar of Trademarks refusing the applicant's

application to register the trademark, the power of this court to grant or refuse to grant stay of proceedings/judgment or execution pending appeal is a matter of judicial discretion to be exercised in the interest of justice, which discretion is unlimited save that it should be exercised judiciously.

In determining that question of whether or not to grant stay, the Court exercises its inherent power under Sections 1A, 1B and 3A of the Civil Procedure Act and the procedural provisions of Order 42 Rule 6 of the Civil Procedure Rules, treating each case according to its own peculiar circumstances.

In **Timmeh Ibrahim v Tipapa Ole Kirrokor& Another Civil Appeal no. 445 of 2014 [2014] eKLR, this court, citing with approval Ringera J (as he then was)** in the case of Global **Tours &Travels Limited; Nairobi HC Winding Up Cause No. 43 of 2000**and the Court of Appeal decision in the **Standard Limited & Others – Vs – Wilson Kalya CA App NRB 369/2001 held that :**

> ***"The Court of Appeal in Standard Limited & Others – Vs – Wilson Kalya CA App NRB 369/2001 developed some principles applicable in application for stay of proceedings to guide the exercise of that power of stay so that the same is not left to caprice and those guidelines are simple and direct as follows:***
>
> > ***a) The appellant must show that his appeal is an arguable one. In other words, he must show that the appeal is not a frivolous one***
> >
> > ***b) The appellant must also show, in addition, that if the order of stay of proceeding is not granted, his appeal, if it were to succeed, would be rendered nugatory.***

In my view the above principles are also applicable in this case and I will apply them accordingly.

But first things first, this court in the circumstances of this case must first appreciate the purpose of stay of execution or proceedings pending appeal. An order for stay pending appeal serves the purpose of preserving the status quo and ensuring that the appeal is not defeated. This principle was enunciated in the case of **BUTT V RENT RESTRICTION TRIBUNAL (1982) KLR 417** that:

> ***"the general principle in granting or refusing a stay is that if there is no other overwhelming hindrance a stay must be granted so that an appeal may not be rendered nugatory should the decision be reversed."***

The applicant's case is that the respondent did not disclose to the Registrar that it had applied for the registration of the same trade mark. The applicant further complains that the Registrar of Trademarks allowed the registration of the applicant's trademark "**STARPLUS"** which was the subject matter of proceedings pending before the Registrar of Trademarks. The applicant argued in their submissions that the Registrar allowed registration of a mark which was already subject matter of litigation pending before the Registrar. The said mark was registered in the name of the respondent on 29th April 2011.

The respondent on their part denied that it concealed any information from the applicant as alleged by the applicant. The respondent stated that to the contrary the applicant is guilty of attempting to misrepresent and twist the facts. It stated that the applicant was aware of the proceedings in respect of TMA KE/T/2010/69541 in respect of the registration of "**STARPLUS"** in class 41 and indeed lodged opposition proceedings on 19th April 2011.

From the foregoing submissions I find the appeal is arguable. The appeal in my view raises issues that cannot properly be determined conclusively at this interlocutory stage. In considering this application, Iam mindful that an arguable appeal is not one that must necessarily succeed, but one in which the court should consider, that whether or not an appeal will be rendered nugatory is a question of fact which will depend on the peculiar circumstances of each case; whether or not what is sought to be stayed, if allowed to happen, is reversible or not and whether an award of damages will be sufficient compensation for the purpose of the application. See **Elegance Investment Limited & Another v Anthony Chinedu Ifedigbo Civil Application No. Nai 321 of 2014 (UR 243/2014)[2015] eKLR.**

However, it is not for this court to delve into the arguableness of that appeal as filed at this stage. The main issue for determination in prayer 1 of the application is indeed, whether the appellant/applicant has established a case to enable this court to grant it the stay orders sought.

The applicant sought a stay of the decision of the honourable Registrar of Trademark in the application to register TMA No. 65503 vide his ruling dated 7th February, 2012. Examining that prayer vis-à-vis the ruling and order of the Registrar of Trademarks made on 7th February, 2012, the ruling clearly declined to allow registration of a trademark as presented by the applicant stating:

"for the reasons set above, the Registrar finds that though the opponent has failed to prove that the mark STARPLUS is well known in Kenya within the meaning of section 15A (1) OF THE Trademark Act, registration of the mark STARPLUS in the name of the applicant would cause confusion and deception to members of the public contrary to section 14. The application shall therefore not proceed to registration."

The above decision, in my view, having rejected the application by the applicant to register a trademark STARPLUS, has absolutely nothing positive to be executed or acted upon, save to the extend of costs. The ruling did not order any party to do anything or to refrain from doing anything capable of being stopped.

I agree with the respondent's counsel's submissions that negative orders are incapable of execution hence cannot be stayed. Iam enjoined on this point by the many Court of Appeal decisions. In the case of **KANWAL SARJIT SINGH DHIMAN VKESHAVJI JIVRAJ SHAH [2006] eKLR** where the court, while dealing with a negative order held as follows:

> ***"The 2nd prayer in the application is for stay (of execution) of the order of the superior court made on 18th December, 2006 which merely dismissed the application for setting aside the judgment with costs. By the order, the superior court did not order any of the parties to do anything or to refrain from doing anything or to pay any sum. It was thus a negative order which is incapable of execution save in respect of costs only (see Western College of Arts and Applied Sciences V Oranga &Others [1976]KLR 63 p66 Para c)."***

In other words, save for the issue of costs which were ordered to be borne by each party, execution of the ruling of the Registrar of Trademarks made on 7th February, 2012 is incapable of being stayed because there is nothing to execute. The same position had earlier been upheld in **DEVANI&4 OTHER V JOSEPH NGINDARI&3 OTHERS CA NAI 136 OF 2004** where the High Court had dismissed an application for judicial review application and the applicant applied under Rule 5(2)(b) for stay of execution of the order of the High Court. In holding that the application was incompetent, the Court of Appeal stated:

> ***"By dismissing the judicial review application the superior court did not thereby grant any positive order in favour of the respondents which is capable of execution. If the order sought is granted, it will have the indirect effect of reviving the dismissed application."***

A similar holding was reached in **EXCLUSIVE ESTATES LTD V KENYA POSTS AND TELECOMMUNICATIONS CORPORATION &ANOTHER (2005) 1 EA 53** where the Court of Appeal expressed itself thus:

> ***"the stay f execution envisaged by rule 5(2)(b) of the rules of this court is the execution of a decree or order capable of execution in any of the methods stipulated by section 38 of the Civil Procedure Act a decree holder as defined in section 2 of the CPA means:***
>
> ***"any person in whose favour a decree has been passed or an order capable of execution has been made and included the assignee of such decree or order."***

The order which dismissed the suit was a negative order which is not capable of being executed."

The above reasoning was also applied in the case of **MOMBASA SEAPORT DUTY FREE LIMITED V KENYA PORTS AUTHORITY, CA NAI 242 OF 2**006 where it was stated:

"in this case, the superior court merely upheld the preliminary objection and as a consequence struck out the application for judicial review with costs. The order striking out the application is not capable of execution against the applicant."

Similar decisions were made in **CA 180 OF 2013 MARAANGU RUCHU &ANOTHER V ATTORNEY GENERAL and CA NAI 161 OF 2014 WANAINCHI GROUP KENYA LIMITED V COMMISSIONER FOR INVESTIGATION AND ENFORCEMENT.**

Applying the second principle for stay to the facts of this case, it is the respondent's contention that if the prayer for stay is granted the appellant will register its trademark which is the subject matter of appeal which will render the appeal nugatory and will result in the appeal being dealt with prematurely before the substantive hearing. The applicant equally claims that they stand to suffer great prejudice and injustice if the orders sought are not granted. In **Elegance Investment Limited & Another v Anthony Chinedu Ifedigbo Civil Application No. Nai 321 of 2014 (UR 243/2014)[2015] eKLR** the Court of Appeal held that:

" as this court stated in Reliance Bank Ltd v Norlake Investments Ltd,(2003) 1 EA 232, what may render the success of an appeal nugatory must be considered within the circumstances of each particular case…and the court must weigh the claims of both parties in a dispute."

In this case, both parties claim to be the proprietors of the trademark **"STARPLUS."**The applicant claims that if the orders are not granted the disputed mark will be advertised. On the other hand the respondent fears that the applicant will also register the trademark in its name if the orders sought are granted.

The applicant's application in essence seeks final orders that would dispose of this appeal without hearing both parties on merit. As I have stated, the nature of the prayers are not like those normally sought in mandatory injunctions.

This being an appeal and the orders being sought seek a stay of a negative order which is incapable of execution in any way, Justice will not be served by granting the prayer for stay as that will be an exercise in futility. It will mean that this court goes behind the scenes to compel the Registrar of Trademarks to register TMA No. 65503 in the name of the appellant thereby setting g aside the Registrar's order of refusal as per his ruling, which will leave nothing pending for the appeal herein which can only be heard and determined by a two judge bench. This court can only set aside or order substitution of the Registrar's order with its own order after hearing both parties and upon hearing the merits of the appeal, and not at this interlocutory stage.

The only solution for the applicant is for it to fast track the hearing and determination of the appeal as filed as there is nothing capable of being stayed.

On whether the court should allow additional evidence

The applicable law as regards the admission of additional evidence by an appellate court is Section **78 of the Civil Procedure Act which provides that: -**

"(1) Subject to such condition and limitations as may be prescribed, an appellate court shall have power –

(a) to determine a case finally;

(b) to remand a case;

(c) to frame issues and refer them for trial;

(d) to take additional evidence or to require the evidence to be taken;

(e) to order a new trial.

(2) Subject as aforesaid the appellate court shall have the same powers and shall perform as nearly as may be the same duties as ate conferred and imposed by this Act on courts of original jurisdiction in respect of suits instituted therein."

The procedural Rules that are hand maidens to Section 78 of the Civil Procedure above provide under Order 42 rule 27 of the Civil Procedure Rules that:-

"(1) The parties to an appeal shall not be entitled to produce additional evidence, whether oral or documentary, in the court to which the appeal is preferred; but if –

(a) the court from whose decree the appeal is preferred has refused to admit evidence which ought to have been admitted; or

(b) the court to which the appeal is preferred requires any document to be produced or any witness to be examined to enable it to pronounce judgment, or for any other substantial cause, the court to which the appeal is preferred may allow such evidence or document to be produced or witness to be examined.

(2) Wherever additional evidence is allowed to be produced by the court to which the appeal is preferred the court shall record the reasons for its admission."

Generally, appellate courts have been very reluctant to allow parties to adduce additional evidence on appeal except where there are exceptional circumstances. The principles for adduction of new evidence on appeal were set out in **TARMOHAMED &ANOTHER V LAKHANI &CO (1958) EA 567 where the Court of Appeal in adopting the Judgment of Lord Denning in LADD V MARSHALL (1954)1 WLR, 1489, the Court of Appeal for Eastern Africa stated that:**

"except in cases where the application for additional evidence is based on fraud or surprise:

"to justify reception of fresh evidence or a new trial, three conditions must be fulfilled: first, it must be shown that the evidence could not have been obtained with reasonable diligence for use at the trial; secondly, the evidence must be such that , if given, it would probably have an important influence on the result of the case, though it need not be decisive; thirdly, the evidence must be such as is presumably to be believed, or in other words, it must be apparently credible, though it need not be incontrovertible."

In **NATIONAL CEREALS AND PRODUCE BOARD V ERAD SUPPLIES &GENERAL CONTRACTS LTD (CA 9 OF 2012), THE ADMINISTRATOR, H H THE AGHA KHAN PLATINUM JUBILEE HOSPITAL V MUNYAMBU (1985)KLR 127 the Court of Appeal** emphasized that the principal rule in admission of additional evidence is that there must be exceptional circumstances to constitute sufficient reason for receiving fresh evidence at the appellate stage. In **Wanjie &others v Sakwa & others(1984) KLR 275** the Court of Appeal considered at length the rationale for the obvious restriction of reception of additional evidence in Rule 29 of the Court of Appeal Rules. Chesoni JA observed at page 280:

"this rule is not intended to enable a party who has discovered fresh evidence to import it nor is it intended for a litigant who has been unsuccessful at the trial to patch up the weak points in his case and fill up omissions in the Court of Appeal. The Rule does not authorize the admission of additional

evidence for the purpose of removing lacunae and filling in gaps in evidence. The appellate court must find the evidence needful. Additional evidence should not be admitted to enable a plaintiff to make out a fresh case in appeal. There would be no end to litigation if the rule were used for the purpose of allowing the parties to make out a fresh case or to improve their case by calling further evidence. It follows ***that the power given by the rule should be exercised very sparingly and great caution should be exercised in admitting fresh evidence."***

Hancox JA as he then was in the same case above stated that ***the requirement for reasonable diligence is meant to discourage litigants from leaving until the appeal stage all sorts of material which should properly have been considered by the trial court.***

On the other hand, courts have been urged to administer justice by exercising a delicate balance and in exceptional circumstances, new evidence should be allowed after weighing the two interests, that of doing justice and that of avoiding being mired by endless litigation which would occur if parties were allowed to adduce fresh evidence at any time during and after the trial without any restrictions. (see **GENERAL PARTS (U) LTD V KUNNAL PRADIT KARIACA NO 26 OF 2013 UCA.**

In the **Wanje V Sakwa** (supra) case, the court dismissed an application for additional evidence because most of the evidence sought to be admitted was not new, having been used before the trial court and because the applicants were merely trying to have a second bite at the Cherry. Courts have also disallowed such applications where the evidence sought to be admitted was in possession of the applicant at the time of the hearing before the trial court **See CHEPKOECH SALAT V JOSEPHINE CHESANG CHEPKWONY SALAT CA APP 211/2014.**

In **WALTER JOE MBURU V ABDUL SHAKOOR SHEIKH & 3 OTHERSCIVIL APPEAL NO. 195 OF 2002 [2015] EKLR** it was stated:

> *"Having considered the application, the various affidavits for and against it, as well as the submissions made and authorities cited, we come to the inescapable conclusion that this application for the taking of additional evidence is wholly devoid of merit. First, the taking of additional evidence lies in the discretion of the Court and is intended to aid in the attainment of the ends of justice. Being a plea to the Court's discretion, we take the view that the length of time it takes to bring the application, in this case well over a decade, is a relevant consideration that militates against a favourable exercise of our discretion. The delay is inordinate and no attempt was made to explain it. Its timing bears the hallmarks of dilatoriness and is not in keeping with the salutary object of expeditious justice.*
>
> > *…..,that the principal rule has been that there must be exceptional circumstances to constitute sufficient reason for receiving fresh evidence at this stage."(emphasis added).*

In the instant case, the applicant claims that the respondent concealed the information on the pending proceedings before the Registrar on a similar trademark. The applicant argues that had the respondent disclosed the information during hearing the same would have had an important influence on the result of the case. The applicant's counsel relied on two decisions of the High Court in **Douglas Ojwang and another v Leakey Gitau Mwaura (2005) eKLR and Catholic Diocese of Meru v Obadiah Mwangi Ngugi**. In both decisions, the learned judges were confronted with the same issue as to whether or not to grant leave to adduce additional evidence and the applications were dismissed. The said decisions applied the principles set out herein for granting of such leave and both were in agreement that the additional evidence sought to be adduced was an afterthought and intended to patch up the applicant's cases on appeal. The said decisions therefore are not of any help to the applicant's case herein.

The respondent in opposing this prayer for additional evidence submitted that the additional evidence is not important and would not have influenced the result of the case. They argued that the evidence is irrelevant in that the documentary evidence intended relates to separate proceedings of registration in class 41 and not class 38.

Examining the affidavit sworn by Mr Wycliffe Swanya advocate for the applicant herein which annexes some documentary evidence that the applicant by implication intends to introduce, the 1st document marked SAD 1 is a registration form which shows the mark "**STARPLUS"** and the proposed proprietor is the respondent in this case. The second document shows that the registration was rejected on the ground that there was a similar trademark in the name of **FIBRE LINK LTD**, the applicant herein. The third document shows the advertisement of the trademark in the Kenya Industrial Property Institute Journal dated 28/02/2011.

In the said affidavit, Mr Swanya clearly deposes that the respondent herein applied to register the disputed mark TMA No 65503 "STARPLUS" in class 38 and the applicant herein opposed the registration thereof and while those proceedings were pending before the Registrar, the respondent herein applied in its own name to register the same mark "STARPLUS" which the Registrar rejected on 30th November 2010 on the grounds that the same mark had been registered in favour of the applicant herein Fibrelink Limited. Mr Swanya also clearly deposes that the Registrar having rejected the respondent's application nonetheless allowed the respondent to advertise the same mark in the KIPI Journal.

At paragraph 8 of the said affidavit, Mr Swanya deposes:

> " 8. ***THAT the appellant/applicant opposed the registration of the disputed mark in the name of the opponent/respondent herein but the Registrar dismissed the opposition on a technicality before the matter could proceed to full hearing to be decided on the merits.***
>
> ***9. THAT having been aggrieved by the Ruling, the appellant/applicant herein lodges this appeal."***

Clearly, this appeal is challenging the ruling of the Registrar made on 7th February, 2012 refusing to register the application by the applicant in application No.TMA 65503"STARPLUS" in class 38 and not any other ruling.

This court has not seen any appeal respecting the dismissal of the applicant's opposition to the application for registration of the mark TMA No. KE/T/2010/009540 "STARPLUS" which was advertised in the KIPI Journal.

Indeed, and I agree with counsel for the respondent's submissions and contentions that the applicant is attempting to mislead this court and to steal a match on the respondent by mixing up the two matters which were conducted separately, and with the involvement of the applicant who even objected to the application wherein it alleges documents were withheld by the respondent. If the applicant was dissatisfied with the ruling that dismissed his opposition for registration of the mark, which opposition was dismissed on a technicality or otherwise, he cannot be allowed to patch up that issue with the present one.

The record shows that the decision of the Registrar of Trademarks which is the subject of this appeal was issued on **7th February** 2012 after the advertisement of the disputed mark in the KIPI Journal on 28/02/2011.

The respondent has also availed evidence in the sworn affidavit of Peter Hime showing the participation of the applicant in the separate application. Surely, the applicant cannot claim that it did not have knowledge of the proceedings until after the advertisement and even if that was the case, the remedy for being dissatisfied with his objection in a totally different matter does not lie in this appeal.

I have also carefully perused the ruling by the Registrar of Trademarks made on 7th February, 2012 and I do not find anything on record that would suggest that had the evidence sought to be adduced now been availed at that hearing, then the Registrar would have been influenced to make an order in favour of the applicant. In my view, if the respondent did register a trademark that was subject of litigation using a different class altogether, then the applicant's remedy lies in challenging those proceedings wherein the

application for registration took place. Further, the applicant does not disclose when and how it accessed the said documents if at all they were withheld from the Registrar and the applicant.

I also find it necessary to point out that the applicant has embarked on attacking the respondent for withholding material before the Registrar, which attack is only found in their advocate's submissions. There is absolutely no material in the applicant's affidavit that refers to those facts which are submitted in the written submissions. Submissions are not evidence.

There is no affidavit evidence showing the need for the new additional evidence and demonstrating that after due diligence, the evidence could not be accessed and used at the trial before the Registrar of Trademarks. Submissions by counsel from the bar have never been a means of the parties tendering their evidence in court. Submissions are only meant to clarify issues and not for purposes of giving evidence. Furthermore, counsel's role in proceedings has never been that of witness giving evidence on behalf of their clients unless they are called as witnesses in which event they would then relinquish their role as advocates for the party and step into the witness box to be cross examined, or unless they are parties to a particular dispute. That is not the case here.

The applicant's application and affidavit were barren of any material that would persuade this court to exercise its discretion in favour of the applicant. So as things stand, there is no evidence on record upon which I, as a court of law, can find that the evidence intended is necessary or relevant. There are averments in the application by way of a prayer for adduction of additional evidence and serious submissions that the respondent withheld the material information from the Registrar and the applicant. Nonetheless, the applicant must place before the court affidavit evidence to sustain those averments. Pleadings and written submissions are not evidence. There was no such evidence placed before the court to persuade it to grant the orders sought.

In the end I find the applicant's Notice of Motion dated 1st March 2013 on all fours lacks merit and I accordingly dismiss it.

Costs of the application shall be in the main appeal.

Dated, signed and delivered in open court at Nairobi this 14th day of July, 2015

R.E.ABURILI

JUDGE