**REPUBLIC OF KENYA**

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

**COMMERCIAL AND ADMIRALTY DIVISION**

**MISCELLANEOUS SUIT NO. 193 OF 2015**

**JOSEPH MUYALE INZAI……...……...…… APPLICANT**

**- VERSUS -**

**HENRY WANJALA, SYLVESTER MATETE MAKOBI, CLIFF NJORA NJUGUNA, . MASAMBAYA FREDRICK NDUKWE AND GEOFFREY SAUKE TOGETHER T/A KENYA BOYS CHOIR……...……...…….……..…….....1ST RESPONDENT**

**HENRY WANJALA, CLIFF NJORA NJUGUNA GEOFFREY SAUKE TOGETHER T/A BOYS CHOIR OF KENYA…….....…….2ND RESPONDENT**

**RULING**

1. On 27th April 2015, **JOSEPH MUYALE INZAI,** (the Appellant) filed a Notice of Motion pursuant to Sections 51 and 52 of the Trade Marks Act, as read together with Rule 117 of the Trade marks Rules.
2. Through that substantive motion, the appellant asked this Court to Review and set aside the decision which the Registrar of Trademarks made on 27th February 2015.
3. The Registrar of Trade marks had ordered the rectification of the Register of Trade marks, by expunging the trade mark number **KE/T/2010/67586,** by the name **"KENYA BOYS CHOIR".**
4. The said trade mark had been registered at the instance of the Appellant, as the proprietor of the name.
5. Having filed the substantive motion, the Appellant, also filed an application for the stay of execution of the decision made by the Registrar of Trade marks on 27th February 2015. Through that interlocutory application the Appellant wished to have the decision of the Registrar stayed until his appeal was determined.
6. It was the case of the Appellant that unless there was a stay of execution, his trademark would be expunged from the Register of Trade marks, thus rendering the appeal nugatory.
7. The appellant expressed the view that an order staying execution of the Registrar's decision would not be prejudicial to the Respondents.
8. Finally, the appellant expressed the view that his appeal had a high chance of success, as he was the proprietor of the trade mark **"KENYA BOYS CHOIR".**
9. Meanwhile, on 28th April 2015, the Respondents, **"KENYAN BOYS CHOIR"** filed their own application, against the Appellant.
10. It was the request of the Respondents that the decision of the Registrar of Trade marks be adopted

as an Order of this Honourable Court.

11. Clearly, the two applications are closely intertwined. The Respondents wish to have the decision of the Registrar of Trademarks adopted as an Order of this court, whilst the Appellant wishes to have the decision set aside. In the light of that inter-connectivity, the parties agreed to have the 2 applications argued together.
12. This Ruling is thus in relation to the 2 applications.
13. For the purposes of this Ruling, **JOSEPH MUYALE INZAI** shall be the Applicant, whilst the **"KENYAN BOYS CHOIR"** and **"BOYS CHOIR OF KENYA"** will be the Respondents.
14. The **"KENYAN BOYS CHOIR"** is made up of the following persons;

i. ***HENRY WANJALA;***
ii. ***SYLVESTER MATETE MAKOBI;***
iii. ***CLIFF NJORA NJUGUNA;***
iv. ***MASAMBAYA FREDRICK NDUKWE; and***
v. ***GEOFFREY SAUKE.***

15. Meanwhile, the **"BOYS CHOIR OF KENYA"** is made up of the following persons;

a. ***HENRY WANJALA;***
b. ***CLIFF NJORA NJUGUNA; and***
c. ***GEOFFREY SAUKE.***

16. The Applicant submitted that the Registrar of Trade Marks erred by holding that the **KENYA BOYS CHOIR** was;

> ***"derived from the Aquinas High School Choir in which the Proprietor was a hired Trainer and Director".***

17. The Applicant insists that the **KENYA BOYS CHOIR** was not even a variant of the Aquinas High School Choir.
18. At most, the Applicant says that the Aquinas High School Choir was associated with the **KENYA BOYS CHOIR.** He emphasized that those 2 choirs were not synonymous, but were independent of each other.
19. For those reasons, the Applicant has made the findings of the Registrar a subject of his Appeal.
20. Secondly, the Applicant hopes to persuade the appellate court that he had provided sufficient proof of proprietorship of the Trade Mark **KENYA BOYS CHOIR,** based on the fact that he was the founding director and music director, as well as the fact that prior to registration of the mark he had used the name in question. Therefore, when the Registrar held that the applicant did not prove that he had some distinctive mark in respect to which he was entitled to proprietorship, the applicant believes that he will persuade the appellate court that the Registrar erred.
21. Thirdly, the Applicant reasoned that the Registrar failed to answer the question;

**"who derived the Kenya Boys Choir from Aquinas High School?"**

22. It was the considered view of the Applicant that if that question was answered correctly, that would demonstrate that he was the proprietor of the mark **KENYA BOYS CHOIR.** His reason for that reasoning is that the act of derivation was an ascertainable fact, which had to be accredited to a natural person. In this case, the applicant hopes to persuade the appellate court that the natural person who derived the **KENYA BOYS CHOIR** from Aquinas High School was him.
23. The fourth point raised by the applicant was that the Respondents had actually tendered proof that it was only Aquinas High School which paid the applicant for his services as a Director of the school choir. His position was that the school never paid for his services as either a director or as a trainer of **KENYA BOYS CHOIR**. Therefore, in his view, that meant that the work he was doing for **KENYA BOYS CHOIR** was being done in his capacity as the proprietor, hence the absence of compensation or payment by anybody.
24. Accordingly, the Applicant believes that he will persuade the appellate court that Aquinas High

School did not and could not compensate him for work which he did not do for their benefit.

25. Next, the Applicant faulted the Registrar for basing her decision on things which were not produced in evidence before her. In particular, it was noted that the *"World Wide Web"* was not produced by any of the parties. Therefore, the Applicant had no opportunity to *"cross-examine"* the said evidence.
26. According to the applicant, the Registrar had descended into the arena of conflict, instead of remaining an independent umpire.
27. But the Applicant also said *that "all the sites"* acknowledged him as the Founder and Director of the Kenya Boys Choir, as well as the Director, Composer and Arranger of all the music uploaded by the Respondents.
28. The sixth issue taken up by the Applicant was in relation to the **TRIPARTITE AGREEMENT** between the Applicants, the Respondents and **UNIVERSAL MUSIC CLASSICAL MANAGEMENT & PRODUCTION LIMITED** of Bond House, London. He reasoned that the Respondents could not claim ownership of the Trade Mark **"KENYAN BOYS CHOIR"** because the Respondents had joined the choir which was already in existence.
29. Whilst appreciating that the participation of the Respondents in the choir had contributed positively to the choir morphing from a simple choir to the status of a national entity, the Applicant insisted that such involvement could not confer ownership on the Respondents.
30. The Respondents were accused of being motivated by bad faith, in breaking away from the **"KENYA BOYS CHOIR"** and forming a parallel choir, whose name was the same as the choir ran by the Applicant.
31. Finally, the Applicant believes that the Respondents were too old to be members of the **"KENYA BOYS CHOIR",** as they were all over 24 years of age. The Applicant said that the Respondents could only form a choir of adult persons, not one of boys.
32. I was therefore invited to find that the Applicant had proved that he was the proprietor of the Trade Mark **"KENYA BOYS CHOIR"** as well as its variants, **"KENYAN BOYS CHOIR" and "BOYS CHOIR OF KENYA".**
33. Consequently, the court was asked to tell the Registrar that her decision to expunge the Trade Mark from the Register of Trade Marks was erroneous.
34. Meanwhile, as regards the Respondents' claim for the adoption of the Registrar's decision, as an Order of this Court, the Applicant submitted that this court lacks the requisite jurisdiction to entertain it.
35. The primary reason for that contention was that the Respondents had invoked the provisions of the **ARBITRATION ACT,** instead of the **TRADE MARKS ACT.**
36. It is the Applicant's understanding that this Court lacks jurisdiction to intervene in matters arising under the Trade Marks Act, using the Arbitration Act.
37. In any event, even if the court had jurisdiction, the Applicant submitted that the Registrar's decision, which was under the Trade Marks Act, was not an Award within the meaning of the Arbitration Act. Therefore, the Applicant insisted that the said decision could not possibly be enforced under the Arbitration Act.
38. Meanwhile, as the Applicant had lodged an appeal to this Court, and as the said appeal was still subsisting, he believes that it would be wrong to enforce the decision which was being challenged.
39. According to the Applicant, there was already an Order for stay of execution until the pending appeal was determined. Therefore, the decision of the Registrar could not yet be enforced.
40. But even if there had been no Appeal or no order for stay of execution pending appeal, the Applicant submitted that the Registrar did not require an order from the High Court, in order to give effect to her decision. For that reason, the Applicant urged the court to dismiss the Respondent's application.
41. In answer to the Applicant, the Respondents submitted that Section 20 (7) of the Trade Marks Acts empowered the Registrar of Trade Marks or the Court to correct any error in or in connection with the application for registration. Such power could be exercised at any time, whether before or after the application for the registration of the trade mark had been accepted.
42. Therefore, the Respondents believe that the Registrar had the requisite authority to order that the Applicant's Trade Mark, **"KENYA BOYS CHOIR"** be expunged from the register.
43. Secondly, the Respondents emphasized that they were an *"aggrieved party"* because the Applicant's actions had caused the Respondents to suffer losses after the Applicant sent malicious

communications to would-be clients of the Respondents, both nationally and internationally. The Respondents deemed these bits of communication to be malicious because the Applicant had abrogated to himself the exclusive right to use the Trade Mark, in a manner which resulted in the Respondents being deemed to be imposters.

44. In the circumstances, the Respondents consider the rectification of the register to be the first important step in curing their stress, even as they sought to pick up the pieces left as a result of the Applicant's actions.
45. Meanwhile, as regards the contention that the court lacked jurisdiction, the Respondents submitted that that was a mere technicality.
46. As far as the Respondents were concerned, if there was a defect in form, one should be allowed to amend his pleadings. The Respondents relied on the Ugandan case of **MICHAEL RICHARDSON Vs. RAND BLAIR T/A MOMENTUM FEEDS & ANOTHER [2012] UG COMMC 39** as authority for the preposition that amendments should be freely allowed unless done *mala fide* or if the same could occasion prejudice or unjustice to the other party, which cannot be compensated by an award of costs.
47. I have no doubt that a mere technicality ought not to be allowed to defeat justice. Article 159 (2) (d) of the Constitution of Kenya expressly states that;

> ***"In exercising judicial authority, the courts and tribunals shall be guided by the following principles –***

a. ***justice shall be done to all, irrespective of status;***
b. ***justice shall not be delayed;***
c. ***alternative forms of dispute resolution, including reconciliation, mediation, arbitration and traditional dispute resolution mechanisms shall be promoted, subject to clause (3);***
d. ***justice shall be administered without undue regard to procedural technicalities; and***
e. ***the purpose and principles of this Constitution shall be protected and promoted".***

48. It is therefore right to allow any party to amend his pleadings freely, if such an amendment was intended to address a technicality, provided that the amendment would not cause undue prejudice or injustice to the other party. Any inconvenience which can be compensated by an award of costs cannot be construed as being capable of causing undue prejudice or injustice. The reason for so saying is that when one party amends his pleadings, the court would ordinarily give an opportunity to the other party to amend his own pleadings, as he may deem necessary.
49. Secondly, when allowing an application for leave to amend a pleading, the court would have deemed the proposed amendment to be necessary in putting forward the real issues in dispute, so that the court can thereafter make a determination of such real issues.
50. In this case, there is no application for leave to amend the Respondents' pleadings. In the circumstances, the court cannot grant any leave to amend the pleadings, not just because it has not been sought, but more so because neither the court nor the Applicant have any idea about the nature and scope of the amendments which the Respondents may have wished to make.
51. In the case of **GITHAMBO GENERAL CONTRACTORS Vs KAY CONSTRUCTION LIMITED, CIVIL SUIT No. 2009,** the Court held that when the plaintiff sued in his Business Name, instead of his own name, that was a mere technicality, which was not fatal. The plaintiff was allowed to rectify the error.
52. In my considered view, that case has no application to the case before me, because there has been no assertion that the Respondents had sued in their Business Name, as opposed to their own names.
53. As I understand the Applicant to be saying, the Respondents invoked the wrong statute altogether. Instead of citing the Trade Marks Act, the Respondents invoked the provisions of the Arbitration Act. The Respondents should have responded to that contention by either seeking leave to amend their pleadings, so as to invoke the correct statute, or they could have sought to demonstrate to the court that the Arbitration Act was applicable to this case which arises from the determination made under the Trade Marks Act.
54. Article 159 (2) (d) of the Constitution did not say that technicalities should be disregarded. It is only the undue regard to procedural technicalities which was said to be wrong.

55. In my considered opinion, when a party moves the court, he ought to invoke the correct legal provisions which are applicable to his case. By so doing, the applicant would enable the court and the respondent to ask themselves whether or not the ingredients set out by the requisite law or rule, had been met.
56. However, if the applicant did not cite the correct provision, that, of itself would not be sufficient ground to reject his application. But the applicant would then have the onus of demonstrating that the respondent was not so prejudiced that he could not be compensated by an award of costs. An example of what the applicant could show is that the respondent could clearly see, from the relief sought, that the applicant was asking for a specific order. If that be the position, the respondent would have known what exactly to answer to, even though the applicant did not either specify the relevant statutory provision or the provision which was specified was not the correct one.
57. In this case it is evident that the Applicant was well aware of the relief which the Respondents were seeking. I so find because the Applicant submitted an answer to the quest by the Respondents for the court to adopt the decision of the Registrar of Trade Marks, as a judgement of the court.
58. In the circumstances, although the Arbitration Act was not applicable to this case, the Applicant was not misled at all, regarding the relief which the Respondents were seeking.
59. In determining the 2 applications, I have reminded myself that the appeal is yet to be canvassed.
60. However, from the issues canvassed before me, it is evident that the Applicant has serious concerns regarding the determination by the Registrar of Trade Marks.
61. The issues he has raised are not of a trivial nature, nor can they be simply wished away. The matters are definitely arguable.
62. In the circumstances, if the registered Trade Mark was expunged from the Register before the appeal was determined, the said appeal may well have been rendered nugatory.
63. On the other hand, if the trade mark is retained on the Register, it may give to the Applicant, the requisite authority to continue using it.
64. If the Applicant went about putting to use the trade mark **"KENYA BOYS CHOIR"** at the same time as the Respondents were using their registered Trade Names **"KENYAN BOYS CHOIR"** and **"BOYS CHOIR OF KENYA",** there would be a high probability of confusion and conflict between the parties.
65. Therefore, it is important that this court should take steps to limit the possibility of the confusion and conflict.
66. In the result, whilst I order that there shall be a stay of the order to expunge the Applicant's trade mark from the Register until the appeal was heard and determined; I further order that during the period before the determination of the appeal, the Applicant will not be permitted to use his trade mark **"KENYA BOYS CHOIR".**
67. Finally, there is no provision in the Trade Marks Act, which is comparable to that in the Arbitration Act, which stipulates that an Arbitral Award would be enforced by the court, after the court had adopted the award as a judgement of the court.
68. The Arbitrator would, normally, have no mechanism for enforcing his award. His primary role was to make a determination of the claims placed before him.
69. After making the determination, the role of the Arbitrator would have come to an end. It is for that reason that the law laid down the procedure through which the court would give effect to the award.
70. In contrast, the Registrar of Trade Marks has express authority and power to rectify the Register of Trade Marks. The Registrar does not require the process of the court, to give effect to her decision.
71. Accordingly, the Respondents application dated 27th April 2015 was wholly un-necessary. It is therefore dismissed.
72. Finally, the costs of the 2 applications shall be in the appeal. If the appeal fails, the Applicant will meet the costs of the applications. However, if the appeal succeeds, the Respondents will also meet the costs of the applications.

**DATED, SIGNED** and **DELIVERED** at **NAIROBI** this **6th day** of **October** 2015.

**FRED A. OCHIENG**

**JUDGE**

***Ruling read in open court in the presence of***

Miss Mwangi for the Applicant.

Kanyonge for the 1st Respondent

Kanyonge for the 2nd Respondent

Collins Odhiambo – Court clerk.