



IN THE HIGH COURT OF KENYA AT NAIROBI

CIVIL DIVISION

MISC APPLICATION SUIT NO 244 OF 2014

GLOBAL INVESTMENTS

DEVELOPMENT LIMITEDAPPLICANT

VERSUS

TRICLOVER INDUSTRIES (K) LIMITEDRESPONDENT

RULING

1. A trade mark dispute between the Applicant and the Respondent was on 7th February 2014 resolved in favour of the Respondent by an *Assistant Registrar of Trade Marks* when the Applicant's objection to registration of the Respondent's **Trade Mark No. KE/T/2011/07101 SUPA MANDAZI (WORDS AND DEVICES)** was dismissed with costs. On 3rd March 2014 the Applicant filed **notice of motion dated 3rd March 2014** seeking the following main orders -

(i) **That the decision of the Assistant Registrar of Trade Marks contained in her ruling dated 7th February 2014, in THE MATTER OF OPPOSITION BY GLOBAL INVESTMENTS DEVELOPMENT LIMITED TO THE REGISTRAR OF TMA No. KE/T/2011/071011 "SUPA MANDAZI" IN CLASS 30 IN THE NAME OF TRICLOVER INDUSTRIES (K) LIMITED, to be stayed in its entirety pending the lodging, hearing and final determination of the Applicant's intended appeal.**

(ii) **That this Honourable court be pleased to stay all consequential proceedings from the ruling delivered by the Assistant Registrar of Trade Marks in THE MATTER OF OPPOSITION BY GLOBAL INVESTMENTS DEVELOPMENT LIMITED TO THE REGISTRATION OF TMA NO. KE/T/2011/071011 "SUPA MANDAZI" IN CLASS 30 IN THE NAME OF TRICLOVER INDUSTRIES (K) LIMITED, pending the lodging, hearing and determination of the Appellant's intended appeal.**

2. The application is brought under **Order 42, rule 6** of the **Civil Procedure Rules 2010** (the **Rules**). **Sections 1A, 1B** and **3A** of the **Civil Procedure Act, Cap 21** are also invoked. There is a supporting affidavit annexed to the application. It is sworn by one **Nitin Shah**, the *Chief Executive Officer* of the Applicant. To this affidavit are annexed various documents which give a historical background of the

dispute between the parties.

3. The grounds for the application include –

- (i) That the Applicant has valid grounds of appeal with good prospectus of success and that unless the stay sought is granted its intended appeal will be rendered nugatory.
- (ii) That the Applicant's right of appeal will be further prejudiced should the Respondent effect registration of its trade mark and tax its bill of costs.
- (iii) That the Applicant will suffer substantial loss on account of loss of good will if the Respondent's trade mark is registered.
- (iv) That the orders of stay sought will not occasion the Respondent any prejudice.

4. The Respondent has opposed the application by a **replying affidavit filed on 7th March 2014**. It is sworn by one **Vikul Shah**, a Director of the Respondent. Grounds of opposition emerging from that affidavit include –

- (i) That the Applicant has not demonstrated that it is still the registered proprietor of its claimed rival **Trade Mark No 15660 CHAPA MANDASHI**, given that its renewal certificate annexed to the supporting affidavit as "NS1" expired.
- (ii) That in any event the Applicant has not lodged any appeal which ought to form the basis or substratum of the application at hand.
- (iii) That the Applicant has not demonstrated that it has an arguable appeal.
- (iv) That the orders of stay sought cannot be granted upon a mere intention to appeal.
- (v) That the Applicant has not demonstrated any substantial loss that it might suffer unless the orders sought are granted.
- (vi) That on the contrary, the Respondent stands to suffer great prejudice if the orders sought are granted.
- (vii) That the Applicant has not offered any security for the orders sought.

5. In response to the replying affidavit the Applicant filed a supplementary affidavit on 25th April 2014. It is sworn by the aforementioned Chief Executive Officer of the Applicant. To this supplementary affidavit is annexed a certificate of renewal of the Applicant's **Trade Mark No KE/T/1968/015660**. The renewal is for a further period of 10 years from 25th April 2003. That therefore means that the Applicant's aforesaid trade mark which is a rival to the Respondent's trade mark expired on 24th April 2013.

6. **Section 52** of the *Trade Marks Act, Cap 506* makes provision for the discretion of the Court in appeal in the following terms –

“In any appeal from a decision of the Registrar to the court under this Act, the court shall have and exercise the same discretionary powers as under this Act are conferred upon the Registrar.”

Apart from this section I can find no other provision in the said Act specifically conferring a right of appeal from a decision of the Registrar. But there is **Rule 117** of the *Trade Marks Rules, 1956* made under the Act. The rule provides for appeals to court in the following terms –

“When a person intends to appeal to the court, the appeal shall be made by motion in the usual way, and no such appeal shall be entertained unless notice of the motion is given within 60 days from the date of the decision appealed against, or within such further time as the Registrar shall allow.”

7. As already seen, the Assistant Registrar’s decision against which the Applicant intends to appeal was given on **7th February 2014**. Any appeal against that decision should have been lodged “by motion in the usual way” on or before **8th April 2014**. The Applicant did not file appeal, within or without time. It has not indicated that it has sought extension of time from the Registrar to file appeal. No credible reason has been given why appeal has not been lodged as yet. There should not have been any hindrance to filing the appeal before obtaining a copy of the ruling. Such appeal could always be perfected later by an amendment if need be after obtaining copies of proceedings and ruling.

8. I respectfully agree with the position taken by the Respondent that an appeal duly lodged herein as provided for in the law ought to form the basis or substratum for the orders sought in the present application. Without such appeal the application is at best premature and at worst probably incompetent.

9. Regarding merits of the application, as already noted, the Applicant’s certificate of renewal of its trade mark for a further period of 10 years expired on or about 24th April 2013. The Applicant has not demonstrated any further renewal. Without demonstration of any existing interest in the rival trade mark, what justification would there be to grant stay against registration of the Respondent’s trade mark? I find none.

10. In the circumstances, and having considered the submissions of the learned counsels appearing, including the cases cited, I must refuse the application by notice of motion dated 3rd March 2014. It is hereby dismissed with costs to the Respondent. It is so ordered.

DATED AND SIGNED AT NAIROBI THIS 1st DAY OF OCTOBER 2014

H P G WAWERU

JUDGE

DELIVERED AT NAIROBI THIS 3RD DAY OF OCTOBER 2014