



Thermos Hong Kong Limited v Doshi Ironmongers Limited (Civil Appeal E013 of 2021) [2023] KECA 1436 (KLR) (24 November 2023) (Judgment)

Neutral citation: [2023] KECA 1436 (KLR)

**REPUBLIC OF KENYA
IN THE COURT OF APPEAL AT MOMBASA
CIVIL APPEAL E013 OF 2021
P NYAMWEYA, JW LESSIT & GV ODUNGA, JJA
NOVEMBER 24, 2023**

BETWEEN

THERMOS HONG KONG LIMITED APPELLANT

AND

DOSHI IRONMONGERS LIMITED RESPONDENT

(Being an Appeal against the Judgement made on 11th December, 2019 by the Hon. Justice P J Otieno in Mombasa High Court Civil Appeal No 251 of 2017 consolidated with High Court Civil Appeal Nos 252 and 253 of 2017)

JUDGMENT

1. This appeal arises from the judgement of the High Court (P.J Otieno, J) made on 11th December, 2019 in respect of three appeals being Mombasa High Court Civil Appeal Nos 251 of 2017, 252 of 2017 and 253 of 2017 which were consolidated.
2. The genesis of the dispute was an application dated 12th July, 2006 by the Respondent to be registered as the registered owner of Trade mark "THERMOS". That application was rejected by the Registrar of Trade Marks on 7th September 2007 on grounds that it was identical to an existing mark in the register namely TM No, 17003 "THERMOS' in class 21 in the name of Thermos Limited of Ongar Road, Brentwood, Essex CM 15 9Ay, England. However, by an advert in the Industrial Property Journal of 31st May, 2009, the removal of Trade Mark TM No, 17003 from the register due to non-renewal by the registered owner was published and the Respondent renewed its application for registration of the trade mark "THERMOS" in 2010 which application was approved and the approval published in the same journal on 30th November, 2010.
3. Upon the publication of the removal of its trademark TM No, 17003 "THERMOS", the Appellant made a request for its restoration to the register on the basis that the trade mark had been assigned to THERMOS KK who subsequently assigned and transferred it to the Appellant. The Registrar of



Trade Marks in a letter dated 28th August 2009, declined that request on the grounds that the Appellant had failed to renew its mark. The Appellant, by a letter dated 8th November 2010 responded to the Registrar's letter dated 28th August 2009 clarifying that the renewal notices relating to that mark were addressed to the wrong party (namely Household Container Limited) and to the wrong address and that the said renewal notices were therefore invalid, null and void ab initio and that the subsequent advertisement of removal of TM No. 17003 THERMOS published in Industrial Property Journal was consequently invalid, null and void.

4. That request was allowed by the Assistant Registrar of trademarks, Elvine Apiyo, on 11th January, 2011 who restored the name of the Appellant as the registered proprietor of the trademark TM No. 17003 THERMOS on the basis that the renewal notices had not been sent to the registered proprietor. Pursuant to the said decision, the Appellant then lodged a Notice of Objection to the Respondent's application for registration of its trademark and urged that the same be declined. In response, the Respondent by a counter-statement sought the rejection of the notice of opposition.
5. In the meantime, the Respondent had instituted Judicial Review Proceedings in Miscellaneous Civil Application No. 19 of 2011 - *Republic vs Registrar of Trade Marks Ltd ex Parte Doshi Iron Mongers Ltd and Thermos Hong Kong Ltd (Interested Party)* against the decision restoring the Appellant's trademark on the ground that the Respondent was not given an opportunity of being heard in that process. In his judgement [hereafter referred to as "Judicial Review Judgement"] dated 5th October, 2012, the learned Judge, Tuiyott, J, (as he then was), while agreeing with the Respondent that it ought to have been heard in that process, did not quash the restoration decision as the Respondent had not sought for an order quashing the same. He however found that the Appellant had the locus standi to lodge the objection to the registration of the Respondent's trademark. In the learned Judge's words:

“The answer by the Respondent is that an error had been committed in removing the trade mark and so she had a duty to correct it. The error was that the renewal notices had been sent to the wrong address and so the Registrar had not complied with Rule 66 the Trade Mark Rules which provide...Further details of her decision need not be discussed. Suffice it to say that at the time of effecting the restoration on 1 January 2011, Doshi's application had been accepted for registration and a notice published on 30th November 2020 in the Industrial Property Journal inviting the lodging of any opposition. This court is unable to accept the argument by the Respondent that Doshi had no right to participate or be informed of THKL's request for restoration. It would seem fair for Doshi to be at least informed of the request for restoration because of a decision to accept it would certainly have an implication to its pending application. But, what is to be done in these circumstances? Doshi [read Respondent] has not sought to quash the restoration decision in these proceedings. No effort was made by Doshi to amend its statutory statement under Order

53 rule 4 of the *Civil Procedure Rules* to include this formally as an attack on the Respondent's conduct. The result is that the arguments taken up in that respect do not fall for determination. Ultimately the restoration decision is unchallenged and intact and there is a valid opposition lodged to Doshi's application.”

6. When the Appellant's application came for hearing before the Assistant Registrar of Trade Marks, in her ruling dated 24th October 2017, the Assistant Registrar of Trade Marks sustained Appellant's objection to the registration of the Respondent's "THERMOS". The Assistant Registrar expressed herself as hereunder:

“Was the Applicant Supposed to be Part of the Renewal and Restoration Process? The Applicant has pleaded in its Counterstatement that they were denied an opportunity to



be heard and that their constitutional right to a hearing and fair administrative action was breached by the conduct of restoration proceedings before the Assistant Registrar and the rendering of her decision on the said proceedings. It should be noted that the process of renewal and restoration generally as per Rules 64 to 70, is between the registered proprietor and the Registrar and are not proceedings as alleged by the Applicant in his pleadings.”

7. It is the determination of the Notice of Objection which aggrieved the Respondent and led to the institution of the appeals before the High Court. In those appeals, the Respondent sought for the setting aside of decision and ruling of the Assistant Registrar of Trade Marks, delivered on 24th October 2017; that all consequential proceedings emanating from that ruling be stayed permanently; that an order of permanent injunction be issued to restrain the Appellant, its agents, employees, assigns or any other person acting on the Appellants behalf from using, dealing in and/or trading in Trade Mark Number 17003 known as “Thermos” in Class 21; that the Certificate of Registration of Assignment and the Certificate of Renewal of Trade Mark Number 17003 known as “Thermos” in Class 21 issued in favour of the Appellant, Thermos Hong Kong Limited be revoked forthwith; and that an order be issued compelling the Registrar of Trade Marks to issue to the Respondent a Certificate of Registration of Trade Mark Number 17003 known as “THERMOS” in Class 21 pursuant to the Respondent’s application No. KE/T/2006/0059464”.
8. The grounds of the appeal before the High Court were that the Assistant Registrar erred in failing to appreciate that the Appellant had no locus standi to lodge the opposition because it was not the registered owner of the trade mark and could not be; that in upholding her decision to restore the Appellant as the registered proprietor of the mark, the Assistant Registrar failed to appreciate the law and thus erred since restoration is only available to the person who was the registered proprietor on the date of removal; that the counter statement was never considered by the Assistant Registrar and thus the Respondent was denied the right to be heard on the false basis that restoration was an administrative process which required no hearing of the Appellant; that there was an error of law on the part of the Assistant Registrar by making a decision tantamount to sitting on appeal against the decision of the Registrar in the letter dated 28th August, 2009 which refused to restore and did not give room for a revisit.
9. The Appellant’s case was that the trade mark THERMOS is currently registered in Kenya under six certificates with the Appellant as the registered proprietor hence the Respondent not being the registered owner cannot maintain an infringement suit and cannot seek and be granted an injunction pursuant to Section 5 & 7 of the Trademarks Act (hereafter the Act); that the notice leading to removal was invalid null and void and thus all acts undertaken on its strength including the removal were equally invalid; that the ruling of 28th August, 2009 could not sanitize nor override the invalidity in the process; that the impugned ruling merely corrected a fundamental error of sending an invalid notice and that the restoration was validly and legally done; that as regards the issue of the Appellant’s locus standi to lodge the Notice of opposition, the same was of no consequence because the issues regarding alleged winding up of Thermos Ltd was subject of the UK Law with no relevance to this matter as the restoration was validly done and relevant renewal and assignment certificates issued; that the challenge on the renewal of the trademarks was time barred because the law dictates that an appeal to the High Court be made within 60 days from the dates of the decision which were 11th & 14th January 2011; that as the owner of the mark the Appellant had all the right to pursue the notice and oppose the Respondent’s application just as he had the rights to seek the extension of period for the opposition; that the determination by the Assistant Registrar was solid and unassailable because the name sought to be registered was visually and phonetically identical to the Respondent trade mark and if registered would not only confuse but also be a tool for passing-off goods bearing the mark; and that



the Respondent had failed to produce and avail to court the complete record of pleadings filed before the registrar leading to the determination.

10. On the issue whether the Appellant was clothed with locus standi to lodge and prosecute the Notice of Objection, the learned Judge relied on the doctrine of res judicata and found that the propriety or competence of the notice of opposition was at the core and centre of the determination of 5th October, 2012 in Miscellaneous Civil Application No. 19 of 2011 - *Republic vs Registrar of Trade Marks Ltd ex Parte Doshi Iron Mongers Ltd and Thermos Hong Kong Ltd (Interested Party)*, that there was a valid opposition filed; and that a judge of a competent and concurrent jurisdiction having so delivered himself and his decision having not been challenged on appeal, he was precluded by Section 7 of *Civil Procedure Act* for purporting to revisit the issue; that in addition Section 21(2) of the Act allows ‘any person’ to give notice to the Registrar of opposition to registration. He therefore dismissed that ground for lacking in merits.
11. On whether the Respondent was accorded the right to be heard, it was found that since the Respondent had a pending application for registration over the same mark when the restoration process was initiated and concluded, it was a person who stood to be affected and was indeed affected in that the decision to restore the trade mark effectively thwarted his application and rendered it a still birth; that there was a clear denial of the Respondent’s right to be heard contrary to the decision in JR No. 19 of 2011, in which the judge expressed himself at page 17 that:-

“This Court is unable to accept the argument by the Respondent that Doshi had no right to participate or be informed of THKL’S request for restoration. It would only seem fair for Doshi to be at least informed of the request for restoration because a decision to accept it would certainly have an implication on its pending application.”
12. The learned Judge therefore found that the holding that the Respondent had no right to be heard at the restoration proceedings was a violation of the principles of natural justice and contrary to a court order for which reason the decision could not stand and on that ground he set the same aside.
13. Regarding the issue whether the Assistant Registrar revisited a decision earlier made by the Registrar contained in the letter of 28th August, 2009 by which the restoration of the trademark was refused, and thus purported to sit on appeal over the same, the learned Judge found that there is a power vested upon the Registrar under Rule 68 and 70 of the Trade Mark Rules (hereafter the Rules) to restore a removed trade mark after removal. According to him, the power to remove is mitigated with the power to restore provided the discretion is exercised upon reasons and in accordance with the notions of fairness and justice including observance of the Rules of Natural justice. He however opined that though rules 68 of the Rules permits consideration of an application to restore, it does not include the right of power to review or reconsider an order declining restoration. Any further proceedings after the order declining restoration, according to the learned Judge, remains for the court to review under section 51 or on appeal under section 52 of the Act.
14. The learned Judge, in arriving at this decision referred to this Court’s decision in *Telcom Kenya Ltd vs John Ochanda*, that while the doctrine of functus officio does not bar any engagement by a court with a case that it has already decided or pronounced itself on, it does bar merit- based decisional re-engagement with the case once a final judgment has been entered and a decree thereon issued. In this case it was the learned Judge’s view that the matter having been determined by the Registrar who considered an application for restoration of TMA 17003 and made a merit based decision by a letter of 28th August, 2009, without that decision being set aside by way of review or appeal, by the court, it could never be reviewed by the same Registrar or his assistant since the statute vesting jurisdiction did



- not permit that course. He relied on this Court's decision in *Deer Ltd vs Benjamin Kipkulei & 2 Others* [2018] eKLR and Supreme Court's decision in *Samuel Kamau Macharia -vs- Kenya Commercial Bank & 2 Others*, Civil Appl. No. 2 of 2011.
15. On account of jurisdiction, the court held that it matters not that the order of restoration was not challenged in time or at all. It was void, and one was entitled to deem it so even though it would be neater to have it set aside. The learned Judge therefore found that the restoration proceedings conducted by the Assistant Registrar were null and void and of no effect. In light of the said findings, the learned Judge believed that it was not necessary to deal with the other issues. Pursuant to Section 52 of the Trademarks Act as read with Section 78 of the *Civil Procedure Act*, he allowed the appeal in its entirety set aside the decision of the Assistant Registrar dated 24th October, 2017 together with the decision dated 11th January, 2011 restoring the trade mark no. 17003 (THERMOS). He directed the Respondent's application for registration be considered on its merits and in accordance with the law, by any other Registrar other than Elvin Opiyo.
 16. That was the decision that provoked the instant appeal.
 17. We heard this appeal on the Court's virtual platform on 5th July, 2023 during which learned counsel, Mrs. Opiyo appeared for the Appellant while Mr. Oluga appeared for the Respondent. Both counsel relied on their written submissions which they highlighted.
 18. On behalf of the Appellant it was submitted that the ruling dated 11th January 2011 merely corrected the fundamental error by the Trade Mark Registry in sending the renewal notices for TM No. 17003 THERMOS to the wrong party and wrongly advertising the removal of that mark from the register in the Industrial Property Journal dated 31st May 2009; that the Appellant's letter dated 8th November 2010 together with the attachments indicated that the registered owner of TM No. 17003 "THERMOS" at the time of publication of removal notice was Thermos Limited, not Household Container Limited; that the Respondent filed Judicial Review Proceedings in Miscellaneous Civil Application No. 19 of 2011 - Republic vs Registrar of Trade Marks Ltd ex Parte Doshi Iron Mongers Ltd and Thermos Hong Kong Ltd (Interested Party) in which the Respondent inter alia claimed that Assistant Registrar had acted in bad faith to revisit the decision of the Registrar of 28th August 2009 declining restoration; that in the judicial review judgement dated 5th October 2012, while finding that the Respondent herein ought to have been informed of the request for restoration because of a decision to accept it would certainly have an implication to its pending application, the learned Judge found that in the absence of a prayer seeking quashing of the restoration order, the restoration decision remained unchallenged and intact and there was a valid opposition lodged to Doshi's application for registration.
 19. It was submitted that the learned Judge in the impugned judgement dated 11th December 2019 had no jurisdiction to set aside the Registrar of Trade Marks' decision dated 11th January 2011 on the grounds that judicial review judgement held that the Assistant Registrar's restoration decision of 11th January 2011 was intact and unchallenged and there was no appeal against that decision; that based on *Bellevue Development Company Ltd vs Francis Gikonyo and 7 others* [2018] eKLR, this Court's decision in *Daniel Torotich Arap Moi vs Mwangi Stephen Murithis & Another* [2014] eKLR and Supreme Court decision in Petition 14, 14A, 14B & 14C of 2014 (Consolidated) *Communications Commission of Kenya & 5 Others v Royal Media Services Limited & 5 Others* [2014] eKLR the learned Judge had no jurisdiction to sit on appeal on a decision of a court of concurrent jurisdiction under the twin legal principles of res judicata and issue estoppel. Since res judicata in its extended meaning covers those matters that ought to have been dealt with in the earlier matter, it was submitted that the Respondent ought to have amended its statement to include that issue. In this regard the Appellant cited *Gurbachan Singh Kalsi vs. Yowani Ekori* Civil Appeal No. 62 of 1958.



20. It was further submitted that since the Respondent had not specifically pleaded and sought any prayers for setting aside of the Assistant Registrar's decision dated 11th January, 2011, the learned Judge had no jurisdiction to issue an order in respect of the said decision; that the learned Judge had no jurisdiction to set aside the decision of the Registrar of Trade Marks in the absence of any valid appeal filed in this regard since the Respondent only sought to set aside the decision of the registrar in respect of the opposition proceedings dated 24th October 2017 in which it was indicated that the final decision was that Respondent's application for registration of the trade mark "THERMOS" under TMA 59464 could not proceed and that the Appellant's opposition was upheld. In support of the submissions regarding unpleaded issues, the Appellant cited this Court's decision in *IEBC vs Stephen Mutinda Mule and others* [2014] eKLR.
21. It was submitted that the learned Judge made a fundamental error in failing to address the cardinal issue of whether the Respondent was entitled to register the trademark "THERMOS" in light of the Appellant's prior trademarks registrations in respect of the trade mark "THERMOS".
22. According to the Appellant, though the Appellant in its opposition proceedings relied on Sections 14, 15A and 20 of the [Trade Marks Act](#) and the provisions of the Paris Convention and Article 16(3) of the TRIPS Agreement read together with Article 2(6) of [the Constitution](#), the learned Judge completely failed to interrogate whether the decision of the Registrar of Trade Marks dated 24th October 2017 was correct in light of the above provisions. It was contended that the learned Judge did not deal with the issue of whether the Respondent was entitled to registration of the trade mark "THERMOS" on account of the Appellant's prior registration of the trade mark "THERMOS" as the learned Judge only focussed on the Appellant's trade mark TM 17003 "THERMOS" in class 2 J but failed to take into account trade mark registrations TM Nos. 22376. 567. 568. 569. 570 and 571. To the Appellant, as a result of the Appellant's prior trade mark registrations, the Respondent is not entitled to registration. The case of *Fibrelink Limited v Star Television Productions Ltd* [2017] eKLR was cited for the need to avoid the creation of confusion to the public by registration of similar or identical trademarks.
23. It was submitted that the impugned judgement was inconsistent and contradictory as the learned Judge at paragraphs 20, 21 and 22 thereof, relied on Section 7 of the [Civil Procedure Act](#) (res judicata) in respect of the Judicial Review Judgement in declining to revisit the issue of whether there was a valid Notice of Opposition while failing to find that the court was bound by the Judicial Review Judgement in respect of the Registrar's restoration decision of 11th January 2011, particularly, that part of the Judicial Review Judgement in which the learned Judge found that the restoration decision was unchallenged and intact. This, in the Appellant's view, gave rise to an inference of bias in favour of the Respondent. Further inference of bias, according to the Appellant, can be deduced from the fact that the learned Judge failed to consider the Appellant's oral and written submissions in respect of the opposition proceedings in terms of the fact that the Respondent's trade marks were identical to the Appellant and the Appellant's submissions in respect of res judicata regarding the Registrar's restoration decision dated 11th January, 2011.
24. It was contended that the High Court failed to take into account the fact that the issue of whether the Appellant had locus standi in the Opposition Proceedings was raised for the first time in the appeals having not been raised in the Opposition Proceedings and was therefore not addressed by the Assistant Registrar in the ruling dated 24th October 2017.
25. As regards the issue whether the Appellants were entitled to the orders sought, it was submitted that arising from the Judgment dated 11th December 2019, the Respondent on 4th February 2020 proceeded to apply to the Registrar of Trade Marks for registration of "THERMOS" trademarks who, without any reference to the Appellant proceeded to register TMS 5964, 66337 and 66338 in contravention of



the said judgement which directed that the matters should be considered on merits and in accordance with the law. It was submitted that arising from the fact that the High Court in its Judgment had no jurisdiction to set aside the Restoration decision of 11th January 2011 hence the orders setting aside the impugned judgment and the cancellation of the Respondent's TM Nos. 5964, 66337 and 66338 which according to the Appellant were issued by the Registrar of Trade Marks without according the Appellant a right to be heard contrary to the impugned judgment and the *Fair Administrative Action Act*. In support of this submission, the Appellant cited this Court's decision in *Musk Deer Ltd vs Benjamin Kipkurui and Another* 120181 eKLR and *Republic vs Karisa Chengo and 2 others* [2017] eKLR.

26. We were therefore urged to allow the appeal with costs.
27. On behalf of the Respondents, it was submitted that the Respondent, in its Counterstatement filed on 11th April 2013, raised the failure to be accorded a hearing opportunity as a ground of complaint before the Assistant Registrar and invited the Assistant Registrar to make a finding on it, by either setting aside the decision of 11th January 2011 or affirming it; that the Assistant Registrar rejected the Respondent's arguments and upheld the decision in her ruling of 24th October 2017; that dissatisfied with, inter alia, the Assistant Registrar's failure to set aside her decision of 11th January 2011 despite the same having been made ex parte, the Respondent appealed against the said decision in the High Court on the ground that "the assistant registrar failed to consider the Appellant's counterstatement and to accord the Appellant a hearing"; that in those circumstances the grounds in support of that particular ground of appeal were pleaded; that the learned Judge dealt with the failure to accord the Respondent a hearing opportunity as raised in the said ground in his judgment under a clear and distinct heading "Was the Appellant accorded the right to be heard?"; that the learned Judge determined the issue in favour of the Respondent by faulting the Assistant Registrar.
28. It was therefore submitted that the failure by the Assistant Registrar to accord the Respondent a hearing opportunity before making the decision of 11th January 2011 was not a new one raised for the first time on appeal at the High Court; that the setting aside of the decision of the Assistant Registrar of 11th January 2011 naturally flowed from the finding of the Judge that the same was arrived at without according the Appellant an opportunity to be heard; that even without expressly making an order setting aside the decision of 11th January 2011, by simply agreeing with the Respondent that the decision was faulty because it was arrived at in breach of the rules of natural justice, it naturally followed that the decision stood set aside by allowing the appeal; that however, for the avoidance of doubt and out of abundance of caution, the learned Judge expressly stated that the decision of 11th January 2011 also stood set aside as a consequence of the setting aside of the ruling of 24th October 2017; that the High Court had jurisdiction to deal with the propriety of the decision of the Assistant Registrar dated 11th January 2011 and set the same aside because the issue was dealt with in the ruling of 24th October 2017 and subsequently raised by the Respondent in the appeal and therefore squarely placed before the High Court for determination.
29. On the issue whether the challenge to the decision of 11th January 2011 was res judicata, it was submitted that the decision of the Assistant Registrar dated 11th January 2011 was not challenged in Misc. Civil Application No. 19 of 2011 (JR) and no determination was ever made by the said Judge on whether the said decision is proper or not; that therefore, the issue of whether the restoration decision was right or wrong is not res judicata as alleged by the Appellant; that the legality of the restoration decision was raised for the first time before the Assistant Registrar who upheld the same in her ruling of 24th October 2017 after which the issue was then escalated to the High Court on appeal; that if the challenge to the restoration decision of 11th January 2011 was indeed res judicata, the Assistant



- Registrar should not have pronounced herself on it; that the moment the Assistant Registrar made that determination, she opened the issue to appeal even assuming that the same had been determined in Misc. Civil Application No. 19 of 2011 (JR) (which is not the case).
30. Regarding whether the Judge erred by failing to address the issue of whether the Respondent was entitled to register the trademark in light of prior registrations, it was submitted that Appellant's allegation that it was the proprietor of six other trademarks Nos. 22376, 567, 568, 569, 570, and 571 ("the six trademarks") was not true; that the six trademarks together with Trade Mark No. 17003 were originally owned by Thermos Limited; that vide a letter dated 25th June 2009, the Appellant through Kaplan & Stratton Advocates applied for registration of assignment of the trademarks in the Appellant's favour; that vide a decision communicated to the Appellant through the letter dated 28th August 2009, the Managing Director of Kenya Industrial Property Institute, then Prof. James Otieno Odek rejected the Appellant's application on many grounds listed on the face of the said letter; that one of the reasons was that the registered proprietor of the trade marks (Thermos Limited) had not made any application for restoration of the trade marks into the Register and the application was made by a person (the Appellant) who was not the registered proprietor thereof; that the Appellant did not appeal the said decision but instead, the purported to submit more documents vide a letter dated 8th November 2010; and that from that point, the matter did not go to Prof. Odek but was instead hijacked by Elvine Apiyo, the Assistant Registrar whom vide a letter dated 11th January 2011 purported to overturn the decision of Prof. Odek and entered the name of the Appellant in the register; that the learned Judge did not go into the merits of whether the Appellant was entitled to be entered into the register and whether the Appellant had similar marks registered in its favour but made a decision based on jurisdiction of the Assistant Registrar.
 31. The Respondent then proceeded to submit on why the Appellant's case was also bound on its merit.
 32. Submitting on the issue of locus standi being raised for the first time in the High Court, it was contended that the issue was determined against the Respondent and in favour of the Appellant hence the Appellant ought not to complain about it. In the Respondent's contention, there was no inconsistency in the judgement since P.J.O Otieno, J agreed with the decision in Misc. Civil Application No. 19 of 2011 (JR) that the Appellant had locus standi to file the opposition and stated that he could not revisit the issue since the learned Judge in Misc. Civil Application No. 19 of 2011 (JR) had determined it and it is therefore res judicata.
 33. Whether the Appellant is entitled to the prayers sought, it was submitted that Appellant did not join Registrar to this appeal and cannot defend himself/herself against the allegations; that the allegations levelled against the Registrar are not contained in the Memorandum of Appeal but have been raised for the first time in the Appellant's submissions; that this court cannot overturn the Registrar's actions unless the Registrar is made a party hereto and the complaints against the Registrar are specifically pleaded. In any case, it was submitted. The learned Judge ordered the Registrar to consider the Respondent's application for registration on merits and there is no evidence been tabled before this court to prove that the Registrar did not consider the application on merits as ordered; that following the decision of the High Court the process of registration of the Respondent's trade mark continued from where it had stopped before the opposition by the Appellant; that since the process did not require fresh advertisement or fresh hearing of objections, was therefore improper for the Appellant to contend that it ought to have, been summoned for hearing; that the Respondent's applications were not required to commence de novo; that doing so would have meant that the Appellant is allowed to file yet another opposition which would be ruled on by the Registrar and then appealed again to the High Court; that since the Appellant has opted not to appeal against the decision made vide the letter dated 30th June, 2020, it cannot challenge it directly before this Court.



34. We were therefore urged to dismiss the appeal with costs.

Analysis And Determination

35. We have considered the evidence on record, the written and oral submissions by and on behalf of the parties to this appeal and the authorities cited.

36. This is a second appeal since it arises from the decision of the High Court in exercise of its appellate jurisdiction albeit doing so from a decision, not of a court of law but of a registrar of Trade Marks. Section 72 of the *Civil Procedure Act* Chapter 21 Laws of Kenya – provides that:-

“(1) Except where otherwise expressly provided in this Act or by any other law for the time being in force, an appeal shall lie to the Court of Appeal from every decree passed in appeal by the High Court, on any of the following grounds, namely-

- a. the decision being contrary to law or to some usage having the force of law;
- b. the decision having failed to determine some material issue of law or usage having the force of law;
- c. a substantial error or defect in the procedure provided by this Act or by any other law for the time being in force, which may possibly have produced error or defect in the decision of the case upon the merits.

37. This court differently constituted in the case of *Maina v Mugiria* [1983] KLR 79 considering that issue of jurisdiction held that on a second appeal only matters of law may be taken. Accordingly, as held in by the Court of Appeal of *Uganda in Mutazindwa v Agaba & Others* [2008] 2 EA 265, the duty of the second appellate court is not to re-evaluate the evidence but to consider whether the first appellate court properly carried out the functions of reappraisal of the evidence. According to Chesoni, Acting JA (as he then was) in *Stephen Muriungi & Anor v Republic* (1982 -88) 1 KAR 360, a position well established in English case of *Martin v Glywed Distributors Ltd (t/a MBS Fastenings)* 1983 ICR 511:

“Where a right of appeal is confined to questions of law only, an appellate court has loyalty to accept the findings of fact of the lower court (s) and resist the temptation to treat findings of fact as holdings of law or mixed findings of fact and law, and, it should not interfere with the decisions of the trial or first appellate court unless it is apparent that, on the evidence, no reasonable tribunal could have reached that conclusion, which would be the same as holding the decision is bad in law.”

38. Therefore, on a second appeal, the Court confines itself to matters of law only, unless it is shown that the Courts below considered matters they should not have considered or failed to consider matters they should have considered or looking at the entire decision, it is perverse. See also Kenya *Breweries Ltd v Godfrey Odongo*, Civil Appeal No.127 of 2007 and *Stanley N. Muriithi & Another v Bernard Munene Ithiga* [2016] eKLR.

39. Having carefully considered the record in the light of the rival submissions set out above and the principles of law relied upon by the respective parties; the matters of law that fall for our determination are:



- a. Whether the issue of validity of the restoration order had been settled by Tuiyott, J (as he then was) in Misc. Civil Application No. 19 of 2011 (JR): *Republic v Registrar of Trade Marks Ex Parte Doshi Ironmongers Limited* and therefore was caught up by res judicata or estoppel;
 - b. Whether respondent pleaded setting aside of the decision of the Assistant Registrar of 11th January, 2011 restoring the Appellant's Trade Mark registration as opposed to the decision of 24th October, 2017 in respect of opposition proceedings;
 - c. Whether there was an error in the failure to address the issue of the registration of the Respondent's trademark "THERMOS" in light of the Appellant's prior trademark registrations in respect of the trade mark "THERMOS";
 - d. Whether the impugned judgement was inconsistent and contradictory;
 - e. Whether the issue of the Appellants' locus standi in the opposition proceedings was properly taken up before the learned Judge; and
 - f. Whether subsequent registration of the Respondent's TM pursuant to the decision of the learned Judge was proper without hearing the appellant.
40. We wish to start our determination with issue nos. (c), (e) and (f) above whose determination pause no difficulty. On the issue whether there was an error in the failure to address the issue of the registration of the Respondent's trademark "THERMOS" in light of the Appellant's prior trademarks registrations in respect of the trade mark "THERMOS", the short answer to that is that the learned Judge did not pronounce himself on the other trademarks that were registered in the name of the Appellant. The issue before him was whether the Assistant Registrar had the power to take the action that it did. The issue of the merit of the registration of the Respondent's Trademarks was yet to be disposed of the Registrar, as the Respondent's application was yet to be determined on its merits.
41. The Appellant took issue with the fact that the learned Judge entertained the challenge regarding the Appellant's locus standi in the opposition proceedings in which the Appellant objected to the application for registration of the Respondent's trademark. However, as rightly pointed out the issue was resolved in the Appellant's favour. The learned Judge apart from finding that the issue had been resolved in Misc. Civil Application No. 19 of 2011 (JR): *Republic v Registrar of Trade Marks Ex Parte Doshi Ironmongers Limited* held that Section 21(2) of the Act allows 'any person' to give notice to the registrar of opposition to registration. Rule 77(3)(a) of the *Court of Appeal Rules* provides that:
- Each notice of appeal under sub-rule (1) shall state whether it is intended to appeal against the whole or part only of the decision and, where it is intended to appeal against a part only of the decision, shall—
- a. specify the part complained of;
1. The importance of this rule was emphasised by this Court in *Richard Kanyago & 2 Others v David Mukii Mereka* Civil Appeal No. 94 of 2001 where the Court held that:

“Where a consent has been recorded on special damages it is not open to the Appellant to indicate in their notice of appeal that they were dissatisfied with the amount of special damages the Superior Court awarded with their consent as it would amount to reviving an issue which the parties had agreed would not be the subject matter of adjudication by the trial court even if the agreed special damages



are conditional on the Appellant's being found liable. Such a notice does not accord with rule 74(3) of the Court of Appeal Rules which requires in mandatory terms that the notice does specify whether the intended appeal is against the whole or part only of the decision and if part only, the part complained of."

43. A party is only expected to appeal against a decision that it is aggrieved with. To take up a ground of appeal in respect of a decision that went in favour of a party, in our view amounts to an abuse of the court process. Accordingly, we do not intend to spend our time dealing with the said ground.
44. Regarding the issue whether the decision to register the respondent's trademark subsequent to the decision appealed against was proper, it is clear that that registration took place after the decision appealed from had been made. It was not the subject matter of the proceedings before the High Court and no decision was made and could not be made in that regard. This Court, sitting on appeal from the High Court, only deals with the errors committed by the High Court. The decision to register the respondent's trade mark was not a decision of the High Court but that of the Registrar of trademarks. If it was improperly made, then recourse lies elsewhere and not before this Court. See *Stallion Insurance Company Limited v Ignazzio Messina & C.S.P.A* [2007] eKLR.
45. In any case as rightly submitted by the Respondent, since the decision in question was made by the Registrar of trademarks who is not a party to these proceedings, it would be prejudicial to determine the action taken by that office without affording it an opportunity of being heard. That ground fails.
46. As regards the effect of the decision of Tuiyott, J (as he then was) in Misc. Civil Application No. 19 of 2011 (JR): *Republic v Registrar of Trade Marks Ex Parte Doshi Ironmongers Limited* on the proceedings appealed from, in his decision, the learned Judge expressed himself in his judgement dated 5th October 2012 follows as hereunder:

"The answer by the Respondent is that an error had been committed in removing the trade mark and so she had a duty to correct it. The error was that the renewal notices had been sent to the wrong address and so the Registrar had not complied with Rule 66 of the Trade Mark Rules...Further details of her decision need not be discussed. Suffice it to say that at the time of effecting the restoration on 1 January 2011, Doshi's application had been accepted for registration and a notice published on 30th November 2020 in the Industrial Property Journal inviting the lodging of any opposition. This court is unable to accept the argument by the Respondent that Doshi had no right to participate or be informed of THKL's request for restoration. It would seem fair for Doshi to be at least informed of the request for restoration because of a decision to accept it would certainly have an implication to its pending application. But what is to be done in these circumstances? Doshi has not sought to quash the restoration decision in these proceedings. No effort was made by Doshi to amend its statutory statement under Order 53 rule 4 of the Civil Procedure Rules to include this formally as an attack on the Respondent's conduct. The result is that the arguments taken up in that respect do not fall for determination. Ultimately the restoration decision is unchallenged and intact and there is a valid opposition lodged to Doshi's application."

47. It is clear that in its case in the above matter, the Respondent herein did not seek for the quashing of the decision made by the Assistant Registrar on 11th January, 2011 restoring the Appellant's trademark onto the register. The learned Judge in that decision did not therefore determine the issue of quashing



of the said decision which according to him remained unchallenged and intact. That however is not the end of the matter. Explanation 4 to Section 7 of the *Civil Procedure Act* provides that:

Any matter which might and ought to have been made ground of defence or attack in such former suit shall be deemed to have been a matter directly and substantially in issue in such suit.

48. The law as restated in *Gurbachan Singh Kalsi v Yowani Ekori [1958] EA 450* is that:

“Where a given matter becomes the subject of litigation in, and of adjudication by a court of competent jurisdiction, the court requires the parties to that litigation to bring forward their whole case, and will not, except under special circumstances, permit the same parties to open the same subject of litigation in respect of a matter which might have been brought forward as part of the subject in contest, but which was not brought forward, only because they have, from negligence, inadvertence, or even accident, omitted part of their case. The plea of res judicata applies, except in special cases, not only to points upon which the court was actually required by the parties to form an opinion and pronounce a judgement, but to every point which properly belonged to the subject of litigation, and which the parties exercising reasonable diligence, might have brought forward at the time.”

See *Henderson v Henderson* 67 ER 313 at 319; *Yat Tung Investment Co. Ltd v Dao Heng Bank Ltd [1975] AC 581, 590.*

49. There is no doubt that the Respondent could have attacked the decision of the Assistant Registrar made on 11th January, 2011 in Misc. Civil Application No. 19 of 2011 (JR): Republic v Registrar of Trade Marks Ex Parte Doshi Ironmongers Limited. It did not do so and therefore whether the omission to do so was deliberate, from negligence, inadvertence, or even accident, the Respondent squandered the opportunity of doing so. It could not be permitted to have a second bite at the cherry as it were. It is in that light that we understand, the learned Judges’ decision in Misc. Civil Application No. 19 of 2011 (JR) that matter that “the restoration decision is unchallenged and intact”. That being the position, we agree with the Appellant that the Respondent was estopped by the principle of res judicata from raising the issue in the subsequent proceedings and the learned Judge erred in dealing with it.

50. It is in this light that we agree that the decision of the learned Judge was inconsistent and contradictory. Having found that the issue of the Appellant’s locus standi to file the opposition to the Respondent’s application for registration of trademark had been settled in the Judicial Review proceedings, he ought to have found, in light of our finding above that the same applied to the relief for setting aside the restoration order, assuming that it was sought.

51. Another reason why the learned Judge erred in dealing with the restoration order was that it was not the subject of the attack before him. It could not have been the subject of attack because rule 117 of the Trademarks Rules provides that:

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 motion is given within sixty days from the date of the decision appealed against or within such further time as the Registrar shall allow.

52. In our view, what the Respondent sought to do was to evade the strictures of this rule by purporting to challenge the decision of 11th January, 2021 under the guise of appealing against the decision of 24th October, 2017. We therefore agree with the appellant that the learned Judge erred in dealing with and setting aside a decision when the issue of setting the same aside was not properly before him.



53. In the premises, we find merit in this appeal which we hereby allow. We set aside the judgement of the High Court (P J Otieno, J) made on 11th December, 2019 in respect of the three consolidated appeals being Mombasa High Court Civil Appeal Nos 251 of 2017, 252 of 2017 and 253 of 2017. We substitute therefor an order dismissing the said appeals with costs to the appellant. The appellant will also have the costs of this appeal.

54. It is so ordered.

DATED AND DELIVERED AT MOMBASA THIS 24TH DAY OF NOVEMBER, 2023.

P. NYAMWEYA

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JUDGE OF APPEAL

J. LESIIT

.....

JUDGE OF APPEAL

G. V. ODUNGA

.....

JUDGE OF APPEAL

I certify that this is the true copy of the original

Signed

DEPUTY REGISTRAR

