

REPUBLIC OF KENYA

INDUSTRIAL PROPERTY ACT

IN THE MATTER OF INDUSTRIAL DESIGN APPLICATION NO. KE/ID/2010/001069 ENTITLED
“CONTAINER” IN THE NAME OF DYNAPLAS LTD
AND OPPOSITION THERETO BY SAFEPAK LTD

(Hearing conducted on 14 June 2012)

Counsel for Opponent: Patrick Ikimire, Kaplan & Stratton Advocates

Counsel for Applicant: Anthony Okulo, Okulo & Co. Advocates

Before the Managing Director - Dr. Henry Kibet Mutai)

RULING

INTRODUCTION

This is an opposition matter filed by the opponent, Safepak Ltd. against the registration of Industrial Design application number KE/ID/2010/001069 entitled “Container” in the name of Dynaplas Ltd.

FACTS

On 27 October 2010, the applicant, Dynaplas Ltd., filed an application for the registration of an industrial design entitled “Container”. The application was filed together with four attachments, namely, a Statement of novelty, a Statement of inventorship, a detailed drawing of the container and a diagram portraying two side views of the container.

The application was allocated application number KE/ID/2010/001069 with a filing date of 27 October 2010 and subsequently examined. On 19 November 2010, a formal examination report was issued informing the applicant that two specimens of the article had not been submitted. The applicant was therefore invited to rectify this defect before the application could be processed.

The request would appear to have been complied with as, on 5 January 2011, a formality

examination report was issued informing the applicant that the application had met the formality requirements. On the same date, a substantive examination report was also issued approving the application for publication subject to the payment of the publication fee. The application was subsequently advertised in the Industrial Property Journal of 31 January 2011.

On 24 March 2011, Safepak Ltd filed a Notice of Opposition to the application on the grounds, *inter alia*, that none of the features, shape and configuration embodied in the bottle were new, that prior articles embodying those features had been disclosed or used in Kenya or elsewhere by the opponent prior to the application's filing date, thus rendering the application unregistrable and that the applicant was not the bona fide owner of the design application.

On 12 April 2011, the applicant filed its counter-statement stating *inter alia*, that the features, pattern, shape and configuration were new, denying that there were any prior articles embodying those features and asserting that it was the bona fide owner of the industrial design.

The opponent subsequently filed its statutory declaration dated 17 June 2011 and sworn by its managing director, Tushar Shah. In the declaration the opponent averred, *inter alia*, that it was the proprietor of industrial design registration number 387, which had been registered with effect from 26 September 2003. It further averred that this design constituted sufficient prior art to bar registration of the applicant's opposed design.

On 17 August 2011, the applicant filed its statutory declaration in reply sworn by Bimal Shah, its managing director. In the declaration, the deponent averred, *inter alia*, that the features in its design application were novel, that the features, pattern, shape and configuration embodied in its design were not similar to the opponent's design and that it was the bona fide owner and creator of the design application thus entitled to apply for its registration.

Thereafter the opponent wrote to the Managing Director stating that it did not wish to file a further final statutory declaration and requesting that a hearing date be taken. Both parties were invited to the registry to take a date but upon failure by the applicant's counsel to attend on the appointed day, the hearing date was fixed *ex parte* for 14 June 2012. On the date in question, both parties appeared and made their submissions.

OPPONENT'S SUBMISSIONS

Counsel for the opponent submitted that his client, Safepak Ltd. had filed a notice of opposition against design application number 2010/1069 on 21 March 2011. The exchange of pleadings closed on 28 October 2011 when the opponent confirmed that it did not wish to file a further statutory declaration confined to matters in reply. The opposed design was published in the Industrial Property Journal of 31 January 2011. It had a filing date of 27 October 2010. That filing date was important in determining the question of novelty as compared to prior art in respect of similar designs.

He continued that as advertised, the design was claiming shape, configuration and ornamentation as novel. This was a general statement of novelty without any specific emphasis of novelty being attached to a single feature in exclusion to the other integral features embodied in the whole design.

Counsel then framed the issues that in his view fell to be determined in this opposition.

These were:

- Did the opposed design embody any features that were not embodied in the prior art design number 387 of the opponent?
- If so, what were these features? Did they substantially distinguish the opposed design from the prior art design number 387, taking into account the similarities of the design features to both to warrant its registration?
- What identical or substantially similar design features were common to both the opposed design application and the prior art design number 387?

Counsel then summarised the opponent's evidence as being comprised of:

1. A copy of certificate of registration of design number 387 marked exhibit TS1;
2. The drawings and the statement of novelty for design number 387 as filed at KIPI on 26 September 2003 and marked exhibit TS2;
3. The drawings and statement of novelty for the opposed design, marked exhibit TS3; and
4. Actual samples of design article 387 and the opposed design application, both of which had been deposited at KIPI and were marked exhibit TS4.

On the other hand, the applicant's evidence in support of its application consisted of:

1. A copy of form IP 43 which was a search request dated 21 September 2010, filed at KIPI by the applicant and attached to the applicant's statutory declaration dated 15 August 2011, marked exhibit BS1;
2. A copy of official examination report dated 5 January 2010 confirming that the opposed design application was new, marked exhibit BS2;
3. Exhibit BS3, which was a request from KIPI to applicant to pay publication fee of Ksh. 3,000/=;
4. Exhibit BS4, which was a copy of receipt evidencing payment of official publication fee and filing fees; and
5. Exhibit BS5, a copy of a letter from KIPI to the applicant's advocates confirming that the application has met formality requirements.

This was the evidence of the respective parties which needed to be evaluated in order to determine whether they fully supported the respective parties' cases on the issue of novelty of the opposed design.

On the opponent's submissions, counsel started by noting that the opponent's registered design number 387 formed the basis of the present opposition. To support this averment were exhibits TS1, that was certificate of registration number 387, filed on 26 September 2003, and TS2, from which one would see the drawings of that design as filed at KIPI and the specific features claimed by design number 387 as novel.

The specific features claimed as novel, as stated at the foot of exhibit TS2 were firstly, the 'features, shape and configuration of the neck defined by the unique dimensions of the lip and the three beads below the lip of the neck' and secondly, the 'features, shape and configuration of the shoulder defined by its unique dimensions and radiuses at various critical points'.

Counsel submitted that under section 86, Industrial Property Act no article could qualify for protection unless it was new. The degree of novelty required was absolute. To the extent that the opponent's design number 387 existed on the Register of registered designs as of 26 September 2003 and had been commercially exploited by the opponent, then, in his submission, it constituted prior art sufficient to bar the registration of the opposed design. He noted that the opponent's registered design number 387 and the opposed design were

both applied to the same article which was a container for packaging liquids. In order for the opponent's registered design 387 to constitute valid prior art, the features and shape embodied in it had to either be identical or substantially similar to the features and shape embodied in the opposed design.

On examination of these features in the respective articles, counsel submitted that the opposed design had no novel features, as claimed, that were different from those embodied in registered design number 387.

This was firstly because both the respective designs had certain common or shared features which were identical. These were an identical round shape, an identical shape or appearance of the lip below the orifice of the container, identical features or shape of the three beads in the neck of the container, identical shape of the shoulder, and the wavy ribs below the shoulder that went round in the body of the container. This, in his view, was the comparison that needed to be made in order to determine whether the prior art was valid. Secondly, counsel argued that what the applicant had done in designing its container was that it had reproduced those features which he had described embodied in the prior art design which had been in the market 7 years before the applicant applied to register its design. Those features were reproduced in every bit and at the time when it filed its design application on 27 October 2010, it claimed that the shape or the configuration embodied in its design application were new when these features had been in the public domain since 26 September 2003.

Counsel submitted that the only concepts or features introduced by the applicant amounted to trivial or immaterial alterations to the existing features in 387 and these were

i) a kidney shaped feature in the wavy ribs below the shoulder of the article. However, the applicant's statement of novelty did not make a specific claim of novelty to the kidney shaped feature as novel as a basis of seeking registration. It instead made a general claim of novelty to the shape without specifying which shape it was claiming implying that it was the whole shape that it was claiming, not a single shape in isolation to the rest.

He argued that the kidney shaped feature alone could not form the basis of registration of the opposed design as that would confer on the applicant statutory rights to all the combined or cumulative features that had not been specified in the statement of novelty contrary to the scope of monopoly it sought in the statement of novelty as filed. If

registered, that would give the applicant the right to sue the opponent for design infringement for exercising its rights granted by registration number 387. He submitted that it would be inappropriate for KIPI to allow commercial articles with common substantial design similarities to co-exist on the register.

With regard to the construction of the statement of novelty, the opponent submitted that shape and configuration normally signified something solid which was 3 dimensional and that pattern and ornamentation were also synonymous and they referred to features that stood out to a certain extent from the article to which it was applied e.g. if they were engraved or embossed on the article.

Counsel submitted that design number 387 of the opponent had a specific claim of novelty as opposed to the general claim of novelty of the applicant. In design number 387, features and shape of the neck defined by the unique dimensions of the lip and the three beads below the lip of the neck were claimed. The second feature claimed was the features and shape of the shoulder. These features were embodied in the opposed design application. Further, design number 387 had not claimed the wavy ribs but the fact that they were embodied in design number 387 meant that they constituted prior art and subsequent applications could not claim wavy ribs as novel because they had been disclosed prior to 27 October 2010 when the applicant filed its design application.

On the other hand, the applicant's statement of novelty was a general one claiming shape and ornamentation meaning that the protection it was seeking would encompass all the features both of shape and ornamentation embodied in the design article.

Since no distinction was drawn or exclusion made by the statement of novelty by the applicant, counsel submitted that he would like to rely on *Copyright in Industrial Designs* (4th ed.), by A D Russell-Clarke, at pages 11 and 12, as well as pages 54 and 55.

On page 55 the author cited Lord Westbury in *Holdsworth v M'Crea* holding that where a design, as exhibited, was filed without any further limitation or description than that given by the design itself, it protected the whole thing "and the entire thing only, and the protection [could] not, at pleasure, be made applicable one day to the entirety, and another day to the separate integral parts or elements of the entire design."

He also referred to case 2 in his list of authorities, *In the Matter of the Industrial Design Application Number KE/ID/2004/00587*, specifically paragraphs 1 and 2 on p. 38.

ii) The second modification was the modification of style of movement of wavy ribs going round the container. What the applicant had done was with regard to the dimensions of the ribs. These wavy ribs and the kidney shaped feature were intended to achieve a functional objective as opposed to aesthetic purpose. They were intended to enhance the strength and stability of the container when it was in actual use and they were not capable of being registered as an industrial design. It was the reason why the opponent did not claim the wavy ribs in 2003.

Counsel argued that according to section 84(2), articles with features intended to obtain technical results were incapable of being registered. In this instance, the functionality of the wavy ribs was corroborated by the applicant's own exhibit BS1 describing features of its own design. The description was what appeared on IP 43. It meant that the features were functional. That was an admission by the applicant that the wavy ribs and kidney shaped features were functional.

Moreover, the alterations did not require reasonable and creative effort of a person reasonably skilled in the art. They were obvious, trivial, immaterial and functional. They did not therefore set apart the applicant's container from the opponent's design number 387.

Turning to the list of authorities relied upon, counsel referred to:

Authority number 5, *Copyright in Industrial Designs* (4th ed.), by A D Russell-Clarke at page 34 where the author stated that novelty should be substantial. The articles should not be mere slight variations.

Authority number 6, *Intellectual Property Law* by Bently and Sherman at page 625 on the requirement of novelty.

Authority number 1, *In the Matter of an Opposition against Industrial Design Application No. KE/ID/2003/00539* at pages 27-29 where in his ruling, the Managing Director found that certain differences existed between the articles in question and on page 25 he listed those differences. However, he found that they were immaterial details that amounted to common trade variants. The opposed design merely exaggerated some of the features in the prior art. Using the principle of imperfect recollection of the consumer, a consumer who saw both articles in a retail outlet, walked away and then came back and found maybe only the opposed article was on the shelf could not with confidence say the opposed design

was not that of the prior art;

Authority number 2, *In the Matter of the Industrial Design Application Number KE/ID/2004/00587*, where the Managing Director at pages 42 and 43 of his ruling had noted that there were differences between the opposed design and the cited prior art. However, they were not substantial to the extent that an informed user would distinguish;

Authority number 3, the headnote in *Phillips v Harbro Rubber Company*, where the court had held that no design should be considered new or original unless it was distinguished from what previously existed by something different from ordinary trade variants; and lastly

Authority number 4, *LeMay v Welch*, and the holding of the court on page 34 where Bowen, LJ stated, *inter alia*, that not every mere difference of cut, change of length or breadth or configuration, in a simple and most familiar article constituted novelty of design.

With regard to the applicant's evidence, counsel noted that the applicant's evidence BS1 - 5 did not rebut the opponent's evidence on prior art nor did it prove that the opposed design was novel. Moreover, the evidence lacked evidentiary value for the following reasons, firstly, exhibit BS1 was a Form IP43 filed at KIPI requesting a search. It did not prove that the opposed design was new with regard to prior art. A search report issued by KIPI could not form a basis to stop third parties from filing opposition to challenge registrability of a design. Secondly, on exhibits BS2 - 5, counsel submitted that the acceptance of a design application was not absolute. That was the reason why regulation 49 provided for the right of the public to file opposition to registration of a design which had been advertised.

In conclusion, the opponent argued that the parties' pleadings on record established:

1. That the applicant's design had no new or independent features and shape as they were all embodied in design number 387. The modified features of the wavy ribs and the kidney-shaped feature constituted immaterial features and were functional in nature.
2. That the opponent had discharged its evidentiary burden by citing design number 387. The applicant had not in its replying statutory declaration on record rebutted issues of similarity and identical features shared by both articles and it only reproduced BS1 - 5 that was not relevant to prove issue of novelty.

Consequently, counsel submitted that the applicant had failed to discharge the burden of proof that had shifted to it. The opponent thus prayed that the Managing Director allow the opposition and decline to register the opposed design with costs to the opponent. With that, the opponent rested its submissions.

THE APPLICANT'S SUBMISSIONS

In reply, counsel for the applicant submitted that he would rely on points made in the counter-statement filed on 12 April 2011. He would also rely on the statutory declaration filed by Bimal Shah on 17 August 2011 where he claimed that he was the original creator of the designs on the container. In support of the application for registration, he would rely entirely on section 86(1) and (2) of the Industrial Property Act.

Counsel argued that there was no similarity between the opponent's bottle and the applicant's container or rather that the similarity may only be limited to shape. This was because they both presented the same function.

He submitted that according to section 4 of the Industrial Property Act, an industrial design had the meaning assigned to it in section 84. That section defined an industrial design as "any composition of lines or colours or any three dimensional form, whether or not associated with lines or colours: provided that such composition or form gives a special appearance to a product of industry or handicraft and can serve as a pattern for a product of industry or handicraft."

The applicant argued that in this instance specific patterns were at issue. The opponent's pattern was a wave while the applicant's consisted of waves and kidney shapes which fell within the definition.

On the issue raised by the opponent regarding the orifice, he argued that this served a technical function and therefore all containers had the same standard orifice. There was therefore nothing unique or special about it.

He submitted that in order for the opponent to succeed in its application, the opponent had to satisfy the provisions in section 103, Industrial Property Act. Section 103(3) provided the grounds on which the Tribunal could revoke or invalidate the registration of a patent, utility model or industrial design. He argued that, in his opinion, the opponent's ground was based on section 103(i), which was that the invention was not new in terms of section 23.

To support its application, the opponent relied on *Interlego v Tyco* where the court stated at p. 225 that ‘A design which is old can be changed using normal design changes without a risk of an action for infringement of industrial design’ and at page 226 where it stated, *inter alia*, that ‘If a design is for purely functional purposes, but in fact the article has eye appeal, then the design is registrable.’

He submitted that industrial designs were about eye appeal. Would a customer find the applicant’s wavy ribs and kidney shape more appealing than the wavy lines on the opponent’s bottle?

The applicant’s final submission was that the opponent’s counsel had failed to prove that there were grounds for revocation or invalidation of the industrial design under section 103, Industrial Property Act. The mere assumptions of infringement were not to be determined by the Managing Director. The issue at hand was whether the applicant satisfied section 86. It was counsel’s prayer that the opposition be dismissed and the design registered with costs to the applicant.

OPPONENT’S SUBMISSIONS IN REPLY

In reply to the applicant’s submissions, counsel for the opponent submitted that the cases cited and the sections relied on by the applicant did not provide satisfactory answers to the question of whether the alterations of the features in the applicant’s design could be regarded as substantial alterations to qualify for registration.

On the authority cited by the applicant, he submitted that the citation was a general statement of design law that could only be relied on if it was relevant to specific circumstances of each particular case. Further, on the statement referred to on page 227, he asserted that the question was what were the design features of the opposed design article which supported the claim of novelty to qualify it for registration? The answer, in his view, was that there was none as compared to the prior art. The alterations made were functional and that had not been disputed by the applicant in its statutory declaration of 15 August 2011. Moreover, the alterations did not impart distinctive character to its design article to create an overall impression that was unique to distinguish it from design number 387.

Counsel continued that *Interlego v Tyco Industries* did not state that functional features

were registrable as an industrial design neither did it state that features that amounted to trivial alterations qualified for registration. The features of orifice and neck in as much as they were functional were not issues of dispute in the present opposition and in fact, they had not been addressed as features of comparison.

Counsel for the applicant had indicated that there were no similarities but acknowledged that there may be similarities in shape. He had relied on the definition of an industrial design. The key proviso in section 84 was, provided that the pattern gave special appearance to the article. In applying that proviso to the present opposition, did the cumulative features in the opposed design give it special appearance? He submitted that the answer was no, it did not.

On a point of law, counsel disputed the applicant's submission that the opponent was relying on section 103. He asserted that it was not. Section 103 related to invalidation or revocation proceedings filed before the Industrial Property Tribunal. The applicant had not registered its design. It was still pending and under opposition. The opponent was therefore not applying to revoke the opposed design because there was nothing to revoke as it had not yet been registered. The present opposition proceedings had been brought under regulation 49 so the relevant provision was regulation 49 and not section 103, Industrial Property Act. To that extent, counsel argued that all submissions made pursuant to section 103 should be disregarded including the submission that the opponent had failed to prove grounds of revocation when it was clear that the proceedings were not for revocation or invalidation but opposition.

Lastly, counsel submitted that the emphasis of the applicant's submissions seemed to centre on the wavy ribs and kidney shaped. He recalled his lengthy submissions regarding these features and argued that the bottom line was that they did not impart individual character as opposed to the prior art. Moreover, they were functional in nature as admitted by the applicant in exhibit BS1.

THE ISSUES TO BE DETERMINED

Counsel for the opponent has submitted that the applicant's industrial design application should not be allowed to proceed to registration on the grounds, *inter alia*, that it was anticipated by prior art in the form of its own registered industrial design number 387.

The applicant, on the other hand, contends that the opposed design meets the statutory requirements set out in sections 84 and 86 of the Industrial Property Act 2001, and that there are remarkable differences between the two designs.

In order to resolve this conflict, the key issue that falls to be determined is whether the applicant's opposed design is anticipated by the opponent's registered industrial design number 387.

The applicable law is to be found in section 86(1), Industrial Property Act which provides that "An industrial design is registrable if it is new" and section 86(2) which provides that

An industrial design shall be deemed to be new if it has not been disclosed to the public, anywhere in the world, by publication in tangible form or, in Kenya, by use or in any other way, prior to the filing date or, where applicable, the priority date of the application for registration.

The statement of novelty regarding the applicant's design is to the effect that "The novelty of the design is in the shape, configuration and ornamentation" - see exhibit TS3, annexed to the opponent's statutory declaration dated 17 June 2011. As correctly pointed out by the opponent, this is a general statement of novelty that lays no specific emphasis on any single feature to the exclusion of other features embodied in the whole design.

The question that then arises is whether the opposed design, as a whole, is anticipated by the opponent's registered design number 387, which dates back to 26 September 2003.

Counsel for the opponent described the similarities and differences between the two designs in some detail so there is no need for me to repeat them here. I am in agreement with the opponent that for its design to constitute valid prior art, the features, shape and configuration embodied in it have to be either identical or substantially similar to the features, shape and configuration embodied in the opposed design.

Having made the requisite comparison of both designs and the features embodied therein, it is clear that there are substantial similarities between the two. These relate to the overall round shape, the appearance of the lip, the three beads in the neck of the container and the wavy ribs below the shoulder. There are also a few differences, as acknowledged by counsel for the opponent, and the question that arises with regard to the differences is firstly, whether they are trivial or immaterial, and secondly, whether they serve a functional purpose.

On the question of triviality/immateriality, I find that the kidney-shaped feature in the wavy ribs is not trivial in nature as it is totally absent in the opponent's prior art design. However, as the opponent pointed out by reference to *Copyright in Industrial Designs* (4th ed.), the legal position is that where an applicant does not make any limitation regarding its statement of novelty then the protection sought is for the entire thing only, and the protection cannot, be made applicable one day to the entirety, and another day to the separate parts or elements of the entire design. Thus, having claimed novelty in the shape, configuration and ornamentation of the design, the applicant's design's novelty cannot now be restricted to the kidney-shaped features. I accordingly find that the applicant's design has failed to meet the novelty requirement under the law.

Furthermore, on the question of functionality, the Industrial Property Act clearly provides in section 84(2) that protection under the Act is not extended to 'anything in an industrial design which serves solely to obtain a technical result.' The opponent argued that the wavy ribs and kidney-shaped features served a technical function and that this was corroborated by the applicant's own evidence of exhibit BS1, the request for search (Form IP43), which described the subject matter as "A bottle with a unique design of grooves that enables the user to firmly grip the bottle and prevent the bottle from slipping." The opponent further submitted that this functional nature of the wavy ribs was why it had not claimed them in its 2003 application. The applicant, on the other hand, argued that the waves and kidney shapes were patterns that fell within the definition in section 84(1). On this issue, I am in agreement with the opponent that, apart from already being in the public domain, the registrability of the wavy ribs would be contrary to the provisions of section 84(2) by virtue of their functional nature.

The final issue that needs to be addressed is the applicant's contention that the opponent was required to satisfy the provisions of section 103, Industrial Property Act in order to succeed. On this issue, with all due respect, the applicant was wholly misguided. Section 103 relates to proceedings before the Industrial Property Tribunal regarding the revocation or invalidation of a patent, utility model or industrial design registration. As the opponent correctly pointed out, in this instance the design has not yet been registered thus there is nothing to revoke. The proceedings are governed by the provisions of regulation 49, Industrial Property Regulations 2002 and not section 103. The applicant's submissions

regarding section 103 are therefore of no relevance to these proceedings.

DECISION

For the reasons set out above, the Managing Director finds as follows:

1. That the opposed design does not meet the statutory requirements for registration contained in section 84, Industrial Property Act.
2. That the applicant's industrial design application shall not proceed to registration.
3. Costs are awarded to the opponent.

Ruling dated and delivered at Nairobi this 2nd day of August 2012



Dr. Henry Kibet Mutai
Managing Director