

REPUBLIC OF KENYA

INDUSTRIAL PROPERTY ACT

IN THE MATTER OF INDUSTRIAL DESIGN APPLICATION NO. KE/D/2009/00940  
ENTITLED “JUICE BOTTLE” IN THE NAME OF MALPLAST INDUSTRIES LTD  
AND OPPOSITION THERETO BY SAFEPAK LTD.

(Hearing conducted on 10 July 2012)

Counsel for Opponent: Patrick Ikimire, assisted by Emmy Rono, Kaplan & Stratton

Counsel for Applicant: John Muchae, Muchae & Co

Amos Otieno, KIPI

Before the Managing Director - Dr. Henry K Mutai)

RULING

INTRODUCTION

This is an opposition matter filed by Safepak Ltd. (hereinafter referred to as the opponent), against the registration of Industrial Design Application No. KE/ID/09/00940 entitled “Juice Bottle” in the name of Malplast Industries Ltd.

FACTS

On 2 April 2009, Malplast Industries Ltd (hereinafter referred to as the applicant) filed an application for registration of an industrial design in connection with an article entitled “Juice Bottle”. The application was filed together with a statement of inventorship, a statement of novelty, and three colour photographs of the bottle showing two side views and a front view (though the letter accompanying the application referred to four photographs). The application was allocated number KE/ID/09/00940 and subsequently examined.

On 30 April 2009, a Formality Examination Report was issued stating, *inter alia*, that the pictures submitted by the applicant were not of sufficient quality to accurately show the

features of the design. In response to the Report, on 25 May 2009, counsel for the applicant submitted two copies of the drawings of the industrial design. Subsequently, a substantive examination report dated 7 July 2009 was issued approving the application for publication. Thereafter the application was advertised in the Industrial Property Journal of 30 November 2009.

On 25 January 2010, a request for extension of time to file a notice of opposition was received at the Institute and duly granted to 27 February 2010. A notice of opposition dated 25 February 2010 was duly received at the Institute on 26 February 2010.

Thereafter, the applicant filed its counter statement on 23 April 2010.

On 4 June 2010, the opponent filed an application for an extension of time to file its statutory declaration. An extension of time to 6 August 2010 was duly granted. After a further extension of time, on 3 September 2010, the opponent filed its statutory declaration sworn by Tushar Shah, its managing director.

Thereafter, on 18 October 2010, the applicant filed its statutory declaration. As the opponent expressed its intention not to file a further statutory declaration in reply, the matter was fixed for hearing and eventually heard on 10 July 2012.

#### THE OPPONENT'S SUBMISSIONS

Counsel for the opponent started by stating that the opponent had filed an opposition against Industrial Design Application No. 940 on 26 Feb. 2010. The opposed design had a filing date of 2 April 2009. The prior art relied on by the opponent was an industrial design application No. KE/D/2003/00539 that had been refused registration as a result of an opposition and which had a filing date of 10 November 2003. Counsel asserted that those dates were critical in assessing the material date of novelty for the opposed design. Counsel submitted that the opposed design application was claiming the following features as novel:

- I) the overall shape of the design;
- II) the face of a dog both at the front and back of the bottle;
- III) two hands with thumbs up both at the front and back of the bottle;
- IV) three wavy lines round the bottom; and
- V) the name and address of the applicant at the bottom of the bottle.

He asserted that the issues raised by the parties' pleadings for determination were:

1. Whether the claimed novel features were substantially different from the features embodied in the prior art design application No. 539?
2. What differences were there between the overall visual impression created by the prior art design application No. 539 and the overall visual impression created by the opposed design?
3. Were those differences sufficient to confer individual character and novelty on the opposed design?
4. Could the creator, Mr. Bijesh Shah, be said under the law to have assigned his rights to the applicant given the statement of inventorship filed by the applicant for purposes of section 87(3) of the Industrial Property Act?
5. Was the name and address of the applicant a registrable feature of an industrial design?

Counsel then turned to the evidence submitted by the parties in respect of their cases.

With regard to the opponent's case, he submitted that the following evidence had been produced in support of its objection:

- I) Exhibit TS1, which was an extract from the Industrial Property journal of 30 November 2009 containing publication of the opposed design;
- II) Exhibit TS2, which was Form IP 27 drawings and statement of novelty of prior art design application No. 539 as filed at KIPI on 10 November 2003;
- III) Exhibit TS3, which was a sample of bottle representing prior art design application No. 539 of the opponent;
- IV) Exhibit TS4, which was a copy of the statement of inventorship of the applicant as filed at KIPI with the application for the opposed design.

With regard to the applicant's evidence in support of its application, counsel submitted that this consisted of:

- I) Exhibit BS1, which was a sample of the bottle of the opposed design application; and
- II) Exhibit BS 2, which was a copy of the drawings of the opposed design.

On the opponent's evidence, counsel started by submitting that both the prior art industrial design application No. 539 and the opposed design were applied to the same article, that is to say, a container. A comparison of the features and shape embodied in the respective bottles revealed that these features and shape had substantial similarities in terms of the features and identical shape of the bottle.

In order to clarify the similarities, counsel made a comparison of the two bottles: Exhibit TS3, which was the sample of prior art design application No. 539 and exhibit BS1, was a sample of the opposed design.

With regard to the prior art design, Exhibit TS2 was a certified copy of the application for Industrial Design Application No. 539 with a Form IP 27 showing the date of 10 November 2003, signed by the agent and the drawings representing prior art and at the bottom the statement of novelty. From the drawings, he noted that you could see the overall visual impression exhibited by a monkey in the article of a container. He continued that the actual samples of the respective bottles gave a clearer, more detailed appreciation of the overall visual impression or appearance of the effect of the features of a monkey on the prior art and the features of a dog on the opposed design. It was immaterial to try to distinguish the overall visual impression purely on the basis of the fact that the prior art bottle was a monkey bottle and the opposed design bottle was a dog bottle.

Counsel submitted that the criteria to apply in making a comparison was to examine the style and manner of application of the features of the respective animals on the respective bottles to see if they created a visual impression that could be regarded as being not merely different but substantially different to impart and create individual character that was unique only to the bottle of the opposed design.

He argued that an examination of the respective bottles revealed the following similarities: Firstly, as regards the shape of the opposed design, the applicant could only produce a bottle in that shape which was being claimed. It had not defined the shape being claimed in the statement of novelty. It was only claiming an overall shape of the bottle. This was a general claim of novelty. What was this overall shape it was claiming? To answer this, counsel submitted that you needed to look at the bottle of the opposed design to assess its shape. He noted that the opposed design had a ring around the neck of the bottle just below the lid, which was not part of the orifice. That feature of the ring around the neck

was present in exactly the same style and manner in the prior art industrial design application No. 539.

Secondly, the opposed design had a slim waist which was the same as in prior art. Both had a slim waist which he referred to as figure 8, so to speak. The shape below the waist with ribs going round the container in the opposed design was present in substantially similar in prior art design application No. 539.

Those were the features of the overall shape and they were identical. As they were identical, counsel submitted that the claim to novelty of the overall shape could not stand since that shape had been in existence since 10 November 2003. Thus the applicant could not claim to have designed that shape to claim novelty six years later.

The other similarity pointed out by counsel was the feature of the face of the dog in the opposed design and the face of a monkey in the prior art design application No.539, which had been construed artistically and applied in the same style to the shoulder of the respective bottles and on both sides and they appeared on the opposite sides of the shoulder of the same bottles.

Again, on the same issue, the ears of the respective animals were applied on the extreme opposite sides of the shoulders of the respective bottles. The faces shared the ears in the prior art. The same ears appeared when looked at from either side. That was exactly the same in the opposed design. He submitted that the designer had thus not created anything new. He had merely copied what was existing in the prior art.

Just below the waist in the prior art design application No. 539 you could see the folded arms of the monkey and this was confirmed by the statement of novelty. The folded arms were in the prior art. Each representation had its own folded arms, they were not sharing unlike the shared ears and they had been applied on the part of the bottle below the waist line. If you checked the opposed design, again, there was identical reproduction of the style and manner of application of the features of the hand of the dog, that was to say that the dogs on the opposite sides of the bottle had their own independent hands, exactly as in the prior art design application No. 539. In the dog bottle of the opposed design, the hands are not then shared by the two dogs on opposite sides of the shoulder in the same way as they are not being shared in the prior art bottle.

With regard to the wavy ribs claimed as novel in the opposed design, counsel claimed that

they were functional in their nature and purpose in the sense that they were aimed at giving strength to the bottle. Further, this was the section for labelling normally so they would not be visible to the eye. Thus, they did not perform any industrial design function. Counsel submitted that what Bijesh Shah had done was to make some trivial, immaterial alterations in design application No. 539. He had taken the prior art, examined it and made some alterations. There was thus no creativity employed.

Counsel argued that some of the alterations were, firstly, that he had substituted the object of the design, a monkey, with a dog but he had retained the same manner and style of application of the dog features as they existed in design application No. 539. Thus, the facial features, the hands and the thumbs had been applied in the same spot and style. The ears being shared but when it came to the hands and thumbs, he had given each dog its own hands just like in the monkey design.

Counsel argued that Bijesh Shah had greater freedom of creativity in applying the dog design. He could have been more creative by, for instance, placing the dog features below the waist and rather than vertically, diagonally in order to give his bottle individual appearance and character in order to distinguish it from design application No. 539. He had not done so. He had not employed that freedom of creativity and as a result the overall visual appearance of the dog bottle was a substantial reproduction to the overall visual appearance of the monkey bottle.

Counsel submitted that using the principle of imperfect recollection, an informed user who had seen the dog bottle at one time and four days later saw the monkey bottle at another retail outlet surely would be confused into thinking that the two bottles were the same or they were one. The reason, he submitted, was because the dog bottle lacked individual character of its own. The alterations by Bijesh Shah were trivial and did not confer design characteristics over and above those embodied in the prior art design application No. 539. Counsel then referred to the list of authorities produced in support of the opposition. First was *Copyright in Industrial Designs* by A D Russell-Clarke, where he was relying on page 34 "That the eye, and the eye alone, is to be the judge of identity, and is to decide whether one design is or is not an anticipation of another, has been laid down time and time again in numberless cases." In this case, he argued, the designer being a skilled workman had made an alteration by replacing a monkey with a dog. It was, in his opinion,

a variation which was minor.

The next authority relied on was *Intellectual Property Law* by Bently and Sherman at page 625. If there were any differences, he submitted that those differences were immaterial details e.g. the shape of the ear of the dog, the shape of the mouth - those differences were immaterial and did not produce substantial differences in the shape.

The next authority relied on was *In re an Opposition Against Industrial Design Application No. 539* specifically at page 25 where it was stated that the Managing Director had to determine whether the differences were material details that affected the overall impression of the design. In that case, the Managing Director found that the prior art and the opposed design had a similar overall impression. The opponent also referred to pages 27 - 29 of that ruling where the issues of individual character and overall impression and eye appeal were canvassed.

Counsel also referred to *In re Industrial Design Application Number 587*, pages 42 - 43. In that case, the Managing Director noted that there were differences between opposed design and prior art. However, those differences were not substantial to the extent that an informed user would not distinguish between the overall impression created by the prior art from that of the designs under opposition.

Counsel also relied on *Phillips v Harbro Rubber Co.* In that case, an action for design infringement was dismissed and the court observed that no design would be considered new or original unless it was distinguished from what had previously existed from ordinary trade variants.

Lastly, counsel referred to *Le May v Welch* at pages 34 - 37 where the question of novelty was discussed and the court stated inter alia that it could not be said that there was a new design every time a coat or waistcoat was made with a different slope or a different number of buttons.

Counsel for the applicant also submitted that the opposed design application was incurably defective as it did not comply with section 87(3). Counsel argued that Bijesh Shah, the creator, was a Managing Director of the applicant. The statement of inventorship, which was exhibit TS 4 stated, *inter alia*, that "I have assigned all my rights, title and interest in the industrial design to Malplast Industries Limited."

Counsel submitted that section 87(3), Industrial Property Act provided that where the

applicant was not the creator, the request should be accompanied by a statement justifying the applicant's right to the industrial design.

The opponent disputed the ownership of the design by the applicant on the ground that the ownership of the design was never transferred to the applicant by the creator as required by law of contract that is contained in page 10 of Tushar Shah's statutory declaration. In their reply, the applicant in paragraph 11 indeed confirmed that Bijesh Shah is a director and created the design as a director of the company.

He submitted that section 32, Industrial Property Act specifically stated that only in situations where an invention or design was created by an employee using the resources of the employer was the ownership automatically transferred to the employer without the need to enter into a contract of assignment. There was a distinction between being a director and an employee of a company. Whilst a director of a company could enter into a separate employment contract with a company in order for any creation of a design to fall under section 32 of the Industrial Property Act, the applicant in this case had not claimed that Bijesh Shah had a dual role in the company and neither had any proof of employment of Bijesh Shah as an employee been tendered in response to paragraph 10 of the statutory declaration of the opponent.

It was his submission that the statement of inventorship did not meet the requirements of section 87(3), Industrial Property Act to constitute documentary proof of justification of the appellant's right to the design from the creator. That statement did not constitute an assignment. As a matter of public policy, the Managing Director had a duty to ensure that industrial design protection was only awarded to parties that were entitled to such protection.

The onus of proving entitlement to the ownership of a design rests with the applicant. Whilst section 87(3) was not specific on the form and type of the statement to be filed, the opponent submitted that the Managing Director had a duty to construe that section broadly within the existing provisions of the law of contract in order to require a contract or assignment where the creator claimed to have assigned his rights to the design in favour of an applicant. This was the only legal proof to establish the rights of the applicant to the design.

Turning to the applicant's evidence, he submitted that Exhibits BS1 and BS2 did not rebut



the opponent's evidence of prior art design application No. 539. This was because this evidence was the same sample and drawings which had been filed at KIPI. There was no additional weight or evidentiary value that these exhibits added to rebut the disputed novelty of the opposed design.

Secondly, he submitted that the cited differences in paragraph 8 of the applicant's statutory declaration dated 15 October 2010 were not noticeable. They were also trivial. If they were not trivial, they would have produced an overall visual impression that was different.

Thirdly, counsel submitted that it was not correct that the opposed design was V and diamond shaped. This was what was claimed in paragraph 5 of the applicant's counter statement of April 2010. This was clear from the comparison given in his earlier submissions. Again the differences relating to the heads contained in paragraph 8c was a claim that if you look at the samples, there was no difference. In the absence of any evidence from applicant to prove that the features are novel, it was clear that all the features in the dog bottle amounted to trivial alterations of the monkey features in the prior art.

Lastly, counsel submitted that the name and address of applicant was not a subject matter of industrial design protection and should be excluded.

With regard to the applicant's list of authorities, starting with *Intellectual Property* by David Bainbridge, counsel stated that he would rely on his submissions on the question of whether the statement of inventorship was sufficient. Secondly, he argued that it was not the law under the Industrial Property Act that inventions or creations by directors were deemed to belong to the company for which they represent in the absence of any contractual agreement proving contrary. If indeed it was true that the present design was transferred automatically to the applicant, it would have been necessary for the applicant to have tendered evidence by production of a contract signed by the creator and the company which provides that any products of creation by Bijesh Shah in his capacity as a director would have been automatically transferred to the applicant.

Regarding authority number 2, *Bakari Ali Ogada & 245 others v Unilever Kenya Ltd*, he argued that this was not relevant as the opponent was not relying on any undue technicalities in the present opposition. The grounds of opposition were matters of

substance and law and not procedure or technicalities.

Thirdly, regarding the *In Re Industrial Design Application No. KE/ID/2003/00539* ruling, counsel argued that this case only reinforced the submissions and grounds of opposition of the opponent and did not propose any principle of law contrary to the principles of comparison and registration of industrial design.

Counsel also referred to the applicant's supplementary list of authorities consisting of Russell-Clarke's *Copyright in Industrial Designs* (4<sup>th</sup> edition) at pages 17 -19 regarding the test of individuality of appearance and *Intellectual Property Law* by Bently and Sherman at pages 633 - 635 regarding the individual character of a design.

On the basis of these submissions and supporting case law, counsel submitted that the opponent was requesting the Managing Director to refuse to register the opposed design application No. 940 and to award costs to the opponent.

#### THE APPLICANT'S SUBMISSIONS

Counsel for the applicant began by stating that, in his view, there were two issues that needed to be decided.

The first issue was whether the design of the applicant was new in terms of the provisions of section 86, the Industrial Property Act. In his opinion, the design was new. He argued that if you examined all the features of the design, you would notice that there was one feature that had not been touched by the opponent and the thrust of the applicant's application was this particular feature. This was the feature of the hand with the thumb up. If it turned out that the other features were completely novel, this particular feature was novel. It was quite important because this feature could be used to communicate different things, for example, it could be used to communicate that the bottle was fantastic. It could also mean that it was excellent, it could mean it was ok or the bottle was strong or perfect or fine.

He submitted that an industrial design did not need to have all its features new in order for it to be registrable. If you looked at the book *Copyright in Industrial Designs* by Russell-Clarke on page 34, it stated, *inter alia*, that the design could be novel "although all the parts are old, and were common general knowledge or were trade variants at the date of registration, for the combination of two or more old and well-known designs or parts of the

designs will certainly constitute novelty, if the effect, i.e., the appearance of the combination as a whole, is new.” It was his submission that this particular feature of thumbs up was sufficient to make the design novel.

The second issue which needed to be decided was whether the design created by Bijesh Shah belonged to the applicant or not. He submitted that if you read section 85, Industrial Property Act together with the provisions of section 32, it was clear that an invention or creation in this case made by the result or commissioned by the company belonged to the company. In this particular case, Bijesh Shah stated in paragraph 11 of the statutory declaration that he designed this creation in his capacity as a director of Malplast.

He could not have done this unless the creation was commissioned by the applicant. A design could also belong to the company if it was created by an employee.

He argued that the fact that Bijesh Shah did not state that he was an employee of the company should not deny the company the right to own the creation of the design.

For this proposition he relied on *Intellectual Property* (6<sup>th</sup> ed) by David Bainbridge at p. 427 where the author stated that

Where the employee is engaged at a high level, such as a director of a company, the employee will face an uphill task in convincing a court that he is entitled to a patent for an invention relating to the company's business. This is because it is almost inevitable that a company director would be held to have a special obligation to further the interests of his employer's obligation.

He submitted that Bijesh Shah had created the design in his capacity as a director.

He relied once again on *Bakari Ali Ogada v Unilever*, where the judges stated that “we are of the view that as far as is possible the courts should encourage the resolution of disputes by hearing both sides on merit, without undue regard to technicalities.”

He argued that the fact that Bijesh Shah created the design as a director and the creation was commissioned by the company, meant that the company should be entitled to make the application because the creator was working for the company. He submitted that the technicality relating to Bijesh Shah's statement in the statement of inventorship that he was assigning the creation to the company should not be relied upon to deny the company. It was his submission that section 87(3) did not apply in light of the provisions of section 85 read together with section 32.

He submitted that the feature of the thumbs up made the design novel even if all the other features were not wholly novel because it gave the design an individual character.

Counsel noted that in paragraph 7 of the opponent's statutory declaration, Mr. Shah stated that the feature of thumbs up was not new and had been used before. No evidence has been adduced to show that this important feature of the applicant's design had been used before and neither had the opponent shown that the refused design had such a feature. It was his submission that this feature gave the design an individual character.

He submitted that when someone looked at the design, the thumbs up feature would appeal to the eye especially these days when thumbs up was used for communication to the members of the public.

He argued that the feature might appear small when embodied in this juice bottle because the juice sold in these bottles was mainly sold to children. The feature might appear bigger when embodied in a bigger bottle and the public might then see the feature.

He noted that in paragraph 11 of the opponent's statutory declaration, Mr. Tushar Shah had stated that the application was accepted in error and as a result it should not have been accepted. Counsel's submission was that once an applicant submitted his application and it was subjected to examination by an examiner and accepted and published in a journal, the burden of proof shifted and this application was properly accepted by the Registrar of industrial designs.

Finally it was the applicant's submission that the design was new and registrable. It was counsel's submission that the opponent had not discharged the onus imposed by section 108, Evidence Act.

He therefore prayed that the applicant's application for registration be allowed to proceed and that the opposition be dismissed with costs.

#### OPPONENT'S SUBMISSIONS IN REPLY

In reply to the applicant's submissions, counsel for the opponent started by noting that it would appear that counsel for the applicant was making an implied acknowledgement and admission that apart from the features of hands with thumbs up, they conceded that all the other claimed features were indeed not new. With that submission by the applicant's counsel, counsel for the opponent argued that the Managing Director was only left to

determine whether the remaining feature was sufficient to impart novelty and individual character to warrant the registration of the opposed design.

He submitted that the argument that the feature of hands with thumbs up was novel because it played an important communication function was irrelevant because functional features were incapable of registration as features of an industrial design.

As it was, all the features included in the statement of novelty were what would determine whether the opposed design could be registered or not and not just the feature of hands with thumbs up. He argued that it was not open for the applicant to amend the basis of registration of its industrial design to limit it only to the feature of hands with thumbs up. As the design application had been opposed, the applicant did not have the liberty of making proposals at this late stage on how it could reduce the scope of monopoly of the proposed registration in order to address the grounds of objection of the opponent.

Regarding the applicant's reliance on Russell-Clarke at p. 34, he argued that the question to be determined was whether that single feature was sufficient to impart the character of novelty and originality to the whole compared to the prior art. If the applicant was claiming the feature of thumbs up was new then the overall visual impression of the bottle was not altered by the feature of the hands with thumbs up to distinguish it substantially with the overall visual impression of design application No. 539.

In any case, he argued, the feature of the hands with thumbs up was so minute as to be invisible and this had been admitted by counsel for the applicant when he said that if applied to a bigger scale bottle it would be more visible. He continued that the scale of the bottle which the applicant has submitted was the one on record and it was speculative to state that were the bottle to be produced in a bigger scale dimensions then the feature would have been more pronounced. Lastly, on this issue, counsel submitted that if you looked at the colour of the bottle, it was white (sic) and transparent, and the feature of hands with thumbs up was not clearly pronounced and visible because it had been applied on a transparent object. Even if the feature was novel enough to confer individual character on the opposed design, the present application could not proceed to registration on the ground that the statement of novelty covers other features which had been contested and which from submissions of applicant's counsel had questionable novelty claims.

Counsel argued that in the ruling, it was not possible to allow partial registration of certain features and decline to allow certain features claimed as novel to proceed to registration. The point was the design application was either new with all features claimed or it was not. With regard to the issue of ownership, counsel argued that the submissions by counsel for the applicant indicated that the applicant commissioned the creation of the design to Bijesh Shah and went on to say that section 87(3) did not apply to the requirement to tender proof of ownership in view of section 32. Counsel for the opponent's response was that that submission had no legal basis. Nowhere in the Industrial Property Act did it say that section 87(3) was not applicable. It was mandatory. Proof of entitlement had to be submitted.

Moreover, he submitted that no evidence of contract of commission to Bijesh Shah had been tendered to prove commissioning. In fact, the statement of inventorship contradicted the submission that the creation was as a result of commissioning. Further, section 32, Industrial Property Act was not available as a defence to the objection taken by the opponent because that section only covered situations where the creation was by an employee and not a director. He could be an employee but there had to be proof of employment because the director would have dual capacities. No evidence of employment had been produced to justify reliance on section 32.

In fact, counsel submitted, nothing would have been easier than for the applicant to tender suitable documentary evidence to the issues raised in paragraph 10 of Tushar Shah's statutory declaration of 2 December 2010. The applicant had therefore not rebutted the opponent's claim that the title in the design never passed from the creator to the applicant. Counsel argued that though counsel for the applicant had submitted that the opponent had not submitted evidence to show that thumbs up was not new, in view of the submissions of the opponent earlier made on the test to be applied to determine individual character, the overall impression and the fact that it was the entire features covered in the statement of novelty that were relevant to determine registrability of the opposed design, it was unnecessary to look at the question of novelty of the feature of thumbs up in isolation from all the other features.

Secondly, with regard to the ruling in *In Re Industrial Design Application No. 539*, which had been produced and relied on by both the opponent and the applicant, counsel referred to

page 28, paragraph 3. He argued that this holding meant that the features of thumbs up could be regarded as an immaterial alteration of a feature with no significant visual impact as compared to the prior art. It did not contribute to creating a difference in the overall visual appearance.

Lastly, regarding counsel for the applicant's reference to paragraph 11 of Tushar Shah's statutory declaration, he submitted that it was not a correct position of law that the burden shifts to the opponent. In fact, he agreed that the opponent who was in a similar situation had the onus to prove its case. He submitted that in this case, the opponent had discharged that evidentiary burden by the production of the prior art design application number 539 as a basis of its objection. That burden had shifted now to the applicant as the applicant was required to disprove the applicability of the prior art by distinguishing the features claimed in prior art and features in opposed design.

He submitted that the applicant had failed to rebut the evidence tendered by the opponent because the differences cited by the applicant on examination amounted to mere differences which did not result in creating visual impression of the design application that was substantially different to that created by prior art bottle.

He therefore requested the Managing Director to decline to allow the request to register the design and to decline the request to order costs against the opponent.

#### ISSUES TO BE DETERMINED

Having read the evidence on record, the authorities relied on by the parties and listened to their oral submissions, I have identified two key issues whose resolution will determine this matter. These are, firstly, the issue of novelty and, secondly, the issue of ownership.

#### Novelty

Section 86 of the Industrial Property Act provides that

- 1) An industrial design is registrable if it is new.
- 2) 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.

Counsel for the applicant objected to the registration of the applicant's design on the ground that the claimed novel features in the design were not substantially different from those embodied in the prior art design application No. 539. He argued that a comparison of the prior art and opposed design showed that both were applied to the same article, that is to say a container, and that they shared a number of features. Specifically, counsel argued that the overall visual impression created by the application of the features to the respective bottles did not impart and create individual character to the bottle of the opposed design.

Counsel submitted that even though there were a number of differences between the two designs, the creator of the opposed design had had greater freedom of creativity but had not employed that freedom to give his bottle an individual character. As a result the dog bottle was a substantial reproduction of the monkey bottle.

In *In the matter of an opposition against the Industrial Design Application No.*

*KE/ID/2003/00539*, relied on by both parties, the Managing Director stated that

In assessing the novelty of a design against a prior design the following areas must be looked at to distinguish the design in suit against the one cited as the prior art. Each of these elements that are subjective in nature will be looked at individually.

- Are the differences “immaterial details”?
- Are the differences merely in features which are variants commonly used in trade?
- Does the design possess individual character?
- Does the design have a visual impact and/or an overall impression distinctive from that of the prior art?

Counsel for the opponent argued that the substitution of a dog for a monkey by the designer amounted to no more than a minor variation and the other differences were immaterial in nature. Counsel for the applicant appeared to concede this when he focussed on the feature of the thumbs up on the hands in the opposed design.

Applying the test set out above to the designs in question and specifically, to the features so ably highlighted by counsel for the opponent, I am in agreement with him that the opposed design lacks the necessary creativity in light of the existence of the prior art design application No. 539 to meet the requirements set out in section 86(2).



Though the applicant correctly argued that industrial design law does not require that an industrial design be made up entirely of new features and, in fact that a design can be registrable even if it is composed of already existing features, in this instance the features of the opposed design do not confer it with sufficient individual character to make it registrable. The feature of hands with thumbs up that the applicant placed so much reliance on is a minor variant that does not confer the opposed design with the requisite individual character required for registrability of a design.

### Ownership

With regard to ownership of an industrial design, section 87(3), the Industrial Property Act provides that

Where the applicant is not the creator, the request shall be accompanied by a statement justifying the applicant's right to the registration of the industrial design.

The opponent argued that the ownership of the design had never been transferred from the creator to the applicant as required by the law of contract and that, as a result, the application was incurably defective. In this connection, the opponent submitted that, being a director of the applicant, the creator was not covered by the provisions of section 32 which caters for situations where a patent created by an employee is deemed to be owned by the employer. It argued that the statement of inventorship on file did not therefore meet the requirements of section 87(3).

The applicant, on the other hand, argued that sections 85 and 32, Industrial Property Act, when read together meant that a design made by the result of or commissioned by the company belonged to the company. Counsel for the applicant also relied on the *Bakari Ali Ogada* judgment to argue that the technicality regarding the words used in the statement of inventorship should not be used to deny the company the right to apply for registration of the design.

On this issue, I am in agreement with the opponent that the applicable legal provision is indeed section 87(3) and that there is no evidence on record to suggest that the creator of the design was an employee who would be covered by section 32. However, as the opponent correctly pointed out, section 87(3) is not specific as to the form and type of

statement to be filed. As a result, where, as in this instance, there is a statement on record by the creator stating that he has transferred ownership to the applicant, it would be unjust and bordering on relying on a technicality contrary to what the Court decided in Bakari Ali, to hold that the application was incurably defective.

I therefore find that the applicant in this instance had a right to file the application.

## 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 for lack of novelty.
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 9<sup>th</sup> day of November 2012.



Dr. Henry Kibet Mutai  
Managing Director