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THE TRADE MARKS ACT CAP 506 OF THE LAWS OF KENYA

AND

IN THE MATTER OF TRADE MARK NO.73976 "EATON TOWERS" IN CLASS 38 IN THE NAME OF EATON TOWERS LIMITED AND OPPOSITION THERETO BY EATON CORPORATION

NOTICE OF MOTION UNDER RULE 52 OF THE TRADE MARK RULES

RULING BY ASSISTANT REGISTRAR OF TRADE MARKS

BACKGROUND

On 28th February 2012, ETW Africa Holdings UK Limited (currently referred to as Eaton Towers Limited) (the Applicants) filed an application to register their trade mark No. 73976 "EATON TOWERS" (word) (hereinafter referred to as "the mark") before the Registrar of Trade Marks. The application was filed in class 38 of the International Classification of Goods and Services in respect of "Telecommunications".

The Registrar duly examined the mark in accordance with the provisions of the Trade Marks Act, Cap 506 of the Laws of Kenya. The mark was approved and published in the Industrial Property Journal of 30th April 2012, page 57.

On 22nd August 2012, Eaton Corporation (the Opponents) filed a notice of opposition against registration of the mark "EATON TOWERS" on various grounds. The notice of opposition was duly forwarded to the Applicants who filed their

counter statement on 8th October 2012. The Opponents filed their statutory declaration on 15th February 2014, the Applicants filed their statutory declaration on 7th June 2013 while the Opponents filed their statutory declaration in reply on 4th October 2013.

The matter was fixed for hearing on 10th April 2014. Thereafter, the parties agreed to proceed by way of written submissions. The Opponents filed their written submissions on 14th March 2014, the Applicants filed their written submissions on 24th March 2014 and the Opponents filed their submissions in reply on 31st March 2014.

Vide a letter dated 6th May 2014, the Opponents sought the leave of Registrar of Trade Marks for admission of certificates of registration and renewal as evidence in support of the opponent's case. In a letter dated 19th May 2014, the Registrar of Trade Marks advised the Opponents to file a formal application for purposes of seeking leave to file further evidence.

On 30th May 2014, the Opponents filed a Notice of Motion dated 29th May 2014 seeking leave to file their evidence out of time. The grounds of the application were as follows:

1. That the Opponent opposes the registration of the mark EATON TOWERS due to the existence in the register of its mark EATON.

2. That the Applicant has raised an objection on the basis that no certificate of registration was tendered as evidence.

3. That it is necessary and in the interest of justice that the copy of the certificate and the renewal certificate be admitted as evidence for determination of the opposition herein.

4. That the Registrar of Trade Marks Office has inherent power to call for any such information and or evidence as may be necessary to assist in the just determination of any mater before it.

The Notice of Motion was duly forwarded to the Applicants on 10th June 2014 and on 23rd June 2014, the Applicants filed their grounds of opposition to the Opponents' Notice of Motion. The grounds of opposition stated as follows:

1. That the application is bad in law, misconceived, incompetent, oppressive and an abuse of process.

2. That the application has been made without appropriate dispatch having been filed more than two months after the preliminary point of law was raised.

3. That the application is an afterthought and aimed at defeating the Respondent's submissions already on record and that are to be highlighted before the Registrar.

4. That the application as drawn offends the terms of Rule 8 of the Advocates (Practice) Rules under the Advocates Act, Cap 16 of the Laws of Kenya.

During the hearing of the matter, Mr. Cecil Kuyo for Coulson Harney Advocates represented the Applicants while Ms. Nancy Karanu for Muriu Mungai & Co. Advocates represented the Opponents.

Submissions by Ms. Karanu:

This is a notice of motion that was filed on 30th of May 2014. It is an application seeking leave to have the Opponents file additional evidence in support of their case and more particularly the certificate of registration of the Opponents' mark and the certificate of renewal which have been annexed in the application as NWK 3a and 3b respectively.

The application is supported by an affidavit sworn by myself which is on the grounds that a preliminary objection was raised in the Applicants' written submissions on the grounds that no certificate of registration was tendered as evidence. It is our submission that it is in the interest of justice that the certificate of registration and the renewal certificate be admitted as evidence for determination of this matter. The Opponents have throughout the opposition proceedings averred that they have a registered trade mark before this Office. It is our submission that this is a public document and can be verified by any party upon payment of the requisite fees. We do seek that this Office should indeed take judicial notice of the existence of the said document. This is anchored on section 60 of the Evidence Act Cap 80 of the Laws of Kenya that provides under which circumstances a court can take judicial notice of facts. Under section 60(1) (o) of the Evidence Act, it is provided that all matters of general or local notoriety are some of the facts where judicial notice can be taken.

In *Fredrick Chege Wambui vs the Independent Electoral and Boundaries Commission* 2013, on page 4, while quoting the case of *Gupta v Continental Builders Limited* 1978, the Court reiterated the situations where a matter may be taken judicial notice of. I adopt the holding of the Court of Appeal and submit that it is not in dispute that the Opponents have a registered trade mark in class 12 and the same is capable of being verified by the custodian of the records at the Registry of Trade Marks and there is indeed no dispute regarding their accuracy. We pray that this Office takes judicial notice of the fact that the Opponents' trade mark is duly registered before this Office. Further, we submit that this Office has the power under rule 52 of the Trade Mark Rules to grant leave to the Opponents to file further evidence. We are ready to comply with any terms as to costs as this Office may deem fit.

I have perused the grounds of opposition filed by the Applicants and submit that the application before this Office has merit. On ground 4 of the grounds of opposition where it states that the application offends against rule 8 of the Advocates (Practice) Rules under the Advocates Act cap 16 of the laws of Kenya, we submit that the issues canvassed in the application are not contentious, they

are matters that are personally within my knowledge and I cannot be forbidden from swearing an affidavit. See the case of *Ahmednassir Abdikadir & Co. Advocates vs. National Bank of Kenya* on page 3. Rule 8 allows advocates to swear affidavits on "formal or non-contentious matter of fact in any matter". The facts of the affidavit before you are not contentious. As earlier submitted, these are facts that this Office can take judicial notice of as they relate to the existence of the mark in this Office and I will not be called as a witness to testify on behalf of the Opponents.

I pray that the application before you be allowed. It is in the interest of justice that the evidence be brought to the attention of this Office.

Submissions by Mr. Kuyo:

We are opposed to the application. We filed our grounds on 23rd of June 2014. Pleadings in this matter were deemed to have closed on 4th of October 2013 according to the Trade Mark Rules. The 4th of October 2013 is the date when the Opponents filed their statutory declaration in reply that was sworn by Stravros Spyropoulos. The discretion granted to the Registrar of Trade Marks to grant leave to admit fresh evidence should be exercised judiciously so that if the Registrar considers that it is either ineffective, costly or inconvenient, the Registrar may refuse to exercise that discretion. This application is made in response to our preliminary point of objection raised in the written submissions filed on 24th of March 2014 which is more than two months after. In the circumstances, the delay is unreasonable. It is intended to steal a march on the Applicants. No reason has been advanced as to why the evidence was not filed in the statutory declarations for which the records will bear me witness that there was ample time.

Section 107 of the Evidence Act enshrines the basic principle of law that he who alleges must prove. The Opponents alleged that they had a registration under class 12 of the International Classification of Goods and Services. This allegation was not proved and the Applicants were within their right to point out that this allegation had not been proved. On the issue of judicial notice, under section 60 of the Evidence Act, a basis must be laid before one can assert that a fact is of general or

local notoriety. If we were to stretch that argument that the Registrar's Office knows everything, there would be no need to file statutory declarations. This Office should be guided by tenets of law. Opposition proceedings are primarily based on an adversarial system which requires that one side makes their case heard on evidence while the other side responds also based on evidence. The notion that the Registrar is supposed to take judicial notice assumes that the Registrar operates in an inquisitorial system which is not the case.

Finally on the applicability of rule 8 of the Advocates (Practice) Rules, whether a matter is contentious or not is determined by the circumstances of each case. The definition in my understanding of a contentious matter is one which is being objected to by the opposing party. In the case of *Ahmednasir Abdikadir & Co. Advocates v National Bank*, the court stated as follows at paragraph 3, page 3:

"In this case, the matter before the court is an application for review. The application is therefore not a formal one, in any sense of the word as it is contested".

The decision was that Mr. Ohaga had to recuse himself in a matter that was contentious. Rule 8 is addressing a situation where an Advocate involves himself or herself in matters that are contentious exposing him or her to embarrassment or probable embarrassment. Our objection is based on the issue of probable embarrassment on the part of the Advocate in this matter. The issue of admission of evidence this late, upon been raised in our submissions as a preliminary objection clearly alludes to the fact that there are contentious matters. My colleague was not empowered to swear an affidavit and we are seeking that it be expunged from the record and consequently that the application be dismissed with costs.

The intention to scuttle the matter is clearly evident by what was reported today where we would have been highlighting submissions on the substantive opposition proceedings but now we are having to be pulled back by an application that has been made so late in the day. Those are our submissions.

Reply by Ms. Karanu:
I reiterate my earlier submissions. Rule 52 of the Trade Mark Rules provides that no further evidence shall be left by parties to opposition proceedings but the Registrar may at any time give leave to the party to adduce further evidence. From the reading of rule 52, any party may at any time approach the Registrar and seek to adduce further evidence. That is all.

Ruling
I have considered the application made herein together with the supporting affidavit, the grounds of opposition as well as the submissions made by the Counsels before me. The issue to be determined is as follows:

Should leave be granted by the Registrar to file evidence out of time?

Rule 52 of the Trade Mark Rules provides that the Registrar may at any time give leave to either the applicant or the opponent to file further evidence. The Rule provides as follows:

"No further evidence shall be left on either side, but, in any proceedings before the Registrar, he may at any time give leave to either the applicant or the opponent to leave any evidence upon such terms as to costs or otherwise as he may think fit."

This rule allows the Registrar to exercise discretion and permit additional evidence to be tendered in proceedings before the Registrar. The exercise of the discretion should not be arbitrary and prejudicial to any of the parties in the proceedings.

I note that in the Opponents' Notice of Opposition, the Opponents had referred to registration of their trade mark application number 27138 "EATON LOGO" at paragraph 3.2. The Opponents gave a representation of the trade mark as it appears in the records that are maintained by the Registrar of Trade Marks. In their Counter-Statement, the Applicants referred to the Opponents' trade mark at paragraphs 5, 6 and 7. Further, in their statutory declaration dated 15th February 2013, the Opponents averred on oath what they had indicated in their Counter

Statement. In paragraph 12, the Opponents stated that "The Opponent is the proprietor in Kenya of trade mark registration 27138 EATON logo in class 12". In their statutory declaration that was filed on 7th June 2013, the Applicants did not raise an issue regarding the Opponents' omission to submit evidence relating to registration of their mark. It is my view that had the Applicants raised the issue then, the Opponents would have had a chance to file the evidence while filing their statutory declaration in reply.

As the Opponents submitted, they are seeking to produce documents that are deemed to be public documents. These are documents which any person may obtain from the Registrar of Trade Marks upon payment of the prescribed fees. In Trade Mark application No.63288, in the name of *Heritage Distillers Limited and Opposition thereto by Decas Limited*, the Registrar of Trade Marks, stated as follows:

"The issue of inordinate delay needs to be counterbalanced with the interest of justice to determine disputes based on merits of the case. The resolution of disputes requires that merits and all evidence should be tendered and heard before a final decision is made."

In this case, the Opponents have sought the leave of the Registrar to file evidence which they did not include while filing their statutory declaration. It is only fair and in the interest of justice that leave be granted to allow the Opponents to file the certificates of registration and renewal. Further, it is my opinion that failure to allow the Opponents to file the two documents for the reason that there was inordinate delay on the part of the Opponents as stated by the Applicants would be a consideration of this matter on technicalities. This would be a contravention of the provisions of Article 159 (2) (d) of the Constitution of Kenya 2010 that requires that justice be administered without undue regard to technicalities. I do not see the prejudice that the Applicants would suffer if the Opponents filed the two certificates at this stage of the opposition proceedings.

Conclusion

(a) For the reasons above, leave is hereby granted to the Opponents to file further evidence, comprising of copies of the Certificate of Registration and the Certificate of Renewal of their trade mark application number 27138 "EATON LOGO", in accordance with the provisions of rule 52 of the Trade Mark Rules;

(b) Arising from the contents of item (a) above, the copies of Certificate of Registration and the Certificate of Renewal that were filed by the Opponents on 9th May 2014 are hereby deemed to have been properly filed;

(c) The Applicants may file a response to the evidence filed, if any, within fourteen (14) days from the date hereof; and

(d) I make no order as costs.

Eunice Njuguna
Assistant Registrar of Trade Marks
18th December 2014

I certify that this is a true copy of the original.

Eunice Njuguna
Assistant Registrar of Trade marks
18th December 2014