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THE TRADE MARKS ACT CAP 506 OF THE LAWS OF KENYA
AND
IN THE MATTER OF TRADE MARK NO. KE/T/2006/60247 "HIGH FLYER SERIES"
(WORDS AND DEVICE) IN CLASS 16 IN THE NAME OF ANTHONY KIAI T/A HIGH
FLYER SERVICES AND EXPUNGEMENT PROCEEDINGS THERETO BY HIGH FLYER
PUBLISHERS

PRELIMINARY OBJECTION
RULING BY ASSISTANT REGISTRAR OF TRADE MARKS

Background

On 28th November 2006, Anthony Kiai T/A High Flyer Services and Publishers (hereinafter referred to as "the Proprietors") filed an application to register their trade mark no. KE/T/2006/60247 "HIGH FLYER SERIES" (WORDS AND DEVICE) (hereinafter referred to as "the mark") before the Registrar of Trade Marks. The application was filed in international class 16 of the International Classification of Goods and Services in respect of "publishing and printing".

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 28th February 2007, page 27. On expiry of the sixty-day statutory period, the mark was entered on the Register of Trade Marks with effect from 28th November 2006 and a Certificate of Registration issued.

On 1st March 2011, High Flyer Publishers (hereinafter referred to as "the Applicants") filed an application for expungement of the mark through their advocates A. M. Kahuthu Advocates. The application was based on several grounds, which included the claim that the Proprietors were not the true owners of the trade mark no. KE/T/2006/60247 "HIGH FLYER SERIES" (WORDS AND

DEVICE) which had been used jointly by both the Applicants and the Proprietors long before the application for registration of the mark was made by the Proprietors. For the said grounds, the Applicants claimed to be an aggrieved person in accordance with the provisions of the Trade Marks Act.

The application was duly forwarded to the Proprietors who on 5th April 2011 filed their Counter-Statement, which was based on various grounds, including the fact that the Proprietors were the true owners of the mark and that the Applicants had no valid claim to the mark. The Counter-Statement was duly forwarded to the Applicants who were required to file their Statutory Declaration within forty-two (42) days from the date of receipt of the said Counter-Statement, in accordance with the provisions of rule 49 of the Trade Mark Rules. However, the Applicants did not comply with the said provisions of the law and in a letter dated 16th February 2012, the Registrar of Trade Marks deemed the application to expunge the mark as abandoned under rule 52A of the Trade Mark Rules.

On 21st March 2013, the Applicants filed another application for expungement of the mark, which was based on similar grounds as the aforementioned application that had been filed on 1st March 2011. The application was made by M.P. Mwangi on behalf of the Applicants. The Application was duly forwarded to the Proprietors who on 22nd May 2013 filed their Counter-Statement reiterating the grounds that they had filed earlier and stating that since there was a matter that was pending before the High Court between the two parties, the Registrar of Trade Marks lacked jurisdiction to hear and determine the expungement proceedings that had been filed by the Applicants.

The Counter-Statement was duly forwarded to the Applicants who filed their Statutory Declaration on 11th July 2013. The Statutory Declaration was sworn by Peter Gichuki Mwangi, the Director of the Applicants who reiterated on oath all the matters that had been stated in the aforementioned application for expungement.

The Applicants' Statutory Declaration was forwarded to the Proprietors who filed their Statutory Declaration on 28th August 2013 reiterating the matters raised in the Counter-Statement that the Proprietors had filed earlier. The Proprietors' Statutory Declaration was forwarded to the Applicants who were required to file their Statutory Declaration in Reply if any, within thirty (30) days from the date of receipt of the Statutory Declaration.

As the Proprietors were filing their Statutory Declaration on 28th August 2013, they also filed a Notice of Intention to raise a Preliminary Objection with regard to the expungement proceedings. The Preliminary Objection was based on the ground that the Registrar of Trade Marks lacks jurisdiction to hear and determine the application to expunge the mark. The Preliminary Objection was duly forwarded to the Applicants who filed a reply on 9th October 2013 opposing the Preliminary Objection on the following grounds:

1. That under section 53 and rules 83 and 103 of the Trade Marks Act the Registrar of Trade Marks has the discretion, power, authority and jurisdiction to hear and determine the application.
2. That under the Constitution of Kenya Article 159, judicial authority and legal process, justice shall be administered without undue regard to procedural technicalities.

The Reply was forwarded to the Proprietors and the matter was fixed for hearing on 17th January 2014.

Ruling

I have considered the Expungement Proceedings filed herein by M. P. Mwangi & Company Advocates on behalf of the Applicants herein, the Notice of Preliminary Objection filed by Mwaniki Gachoka & Company Advocates on behalf of the Proprietors of trade mark no. KE/T/2006/60247 "HIGH FLYER SERIES" (WORDS AND DEVICE) and the submissions made by the said Advocates on behalf of the respective parties during the hearing of this matter on 17th January 2014.

The Preliminary Objection herein was filed by the Proprietors on 28th August 2013 on the ground that the Registrar of Trade Marks lacks jurisdiction to hear and determine the application for rectification of the Register of Trade Marks with regard to trade mark no. KE/T/2006/60247 "HIGH FLYER SERIES" (WORDS AND DEVICE). This was based on the fact that there was a pending High Court Civil Suit No. 45 of 2011 that involves both of the parties in these rectification proceedings. I am of the view that the issue that needs to be determined in this matter is as follows:

Does the Registrar of Trade Marks have the powers to entertain the current expungement proceedings?

The Proprietors have stated that the Registrar of Trade Marks does not have the mandate to hear and determine these expungement proceedings for the reason that the aforementioned High Court Civil Suit No. 45 of 2011 - Anthony Kiai T/A High Flyer Services and Publishers and High Flyer Services and Publishers V Peter Mwangi Gichuki T/A High Flyer Publishers and Fortune Traders Limited is still pending at the High Court of Kenya.

It is apparent that the Trade Marks Act provides that expungement proceedings may be filed either at the High Court of Kenya or with the Registrar of Trade Marks. As herein above indicated, the current expungement proceedings have been filed under the provisions of section 35 of the Trade Marks Act which provides for the option of either filing expungement proceedings before the High Court of Kenya or before the Registrar of Trade Marks. However, the said provisions of section 35 are made subject to the provisions of section 53, which states as follows:

"Where under any of the foregoing provisions of this Act an applicant has an option to make an application either to the court or to the Registrar –

- (a) if an action concerning the trade mark in question is pending, the application shall be made to the court;
- (b) if in any other case the application is made to the Registrar, he may, at any stage of the proceedings, refer the application to the court, or he may after hearing the parties determine the question between them, subject to appeal to the court."

From the pleadings filed herein and the submissions made during the hearing of this matter on the said 17th January 2014, it is clear that both parties agree that trade mark infringement proceedings under High Court Civil Suit No. 45 of 2011 - Anthony Kiai T/A High Flyer Services and Publishers and High Flyer Services and Publishers V Peter Mwangi Gichuki T/A High Flyer Publishers and Fortune Traders Limited were initiated by the Proprietors on 16th February 2011. According to the pleadings, the said suit was filed by the Proprietors of trade mark no. KE/T/2006/60247 "HIGH FLYER SERIES" (WORDS AND DEVICE) claiming that the Applicants had infringed on their said trade mark. The bone of contention between the parties is whether or not the said infringement proceedings are still

pending or not. According to the Applicants, the Court concluded the matter as follows at paragraph 18 of the ruling:

“The upshot of the above is that the applicant has not established the elements upon which a prima facie case can be founded. This is a dispute that can only be resolved by the determination of the respondents' objection to the registration of the 1st Applicants' trade mark and a full hearing of this case.”

The Applicants claim that the matter was concluded and that the court gave an order for hearing and determination of the rectification proceedings by the Registrar of Trade Marks. On the other hand, the Proprietors claim that the infringement proceedings were still pending and that what was concluded in the ruling at the High Court Civil Suit No. 45 of 2011 was a ruling for an interlocutory matter that did not dispense with the suit.

I agree with the Proprietors in their contention that High Court Civil Suit No. 45 of 2011 still pending in court. The decision made by the Court in the said matter did not in my view dispense with the said suit and the same is therefore still pending at the High Court of Kenya. The Court only refused to grant the interlocutory orders sought for the reason that the Applicant in that case did not establish “the elements upon which a prima facie case can be founded”. The pending case amounts to “an action concerning the trade mark no. KE/T/2006/60247 “HIGH FLYER SERIES” (WORDS AND DEVICE) as envisaged by the provisions of the aforementioned section 53 (a) of the Trade Marks Act. Therefore, it is my view that the pending High Court Civil Suit No. 45 of 2011 would be the appropriate forum for the expungement proceedings to be determined since the Trade Marks Act gives the High Court the mandate to hear and determine both expungement and infringement proceedings. The rationale for this is that it would be more appropriate for matters regarding a specific trade mark to be canvassed in one forum. This way, a situation where the Registrar of Trade Marks rectifies the Register of Trade Marks by expunging the Plaintiff's mark from the Register while the High Court finds that the Defendant has infringed on the non-existent trade mark, would be avoided.

The Applicants stated that the Registrar of Trade Marks has jurisdiction to hear and determine this matter for the reason that section 53 of the Trade Marks Act and rules 83 and 103 of the Trade Mark Rules empower the Registrar to do so. The Applicants are of the view that the provisions of section 53 (b) specifically empower the Registrar of Trade Marks to hear and determine the rectification proceedings herein with an option to refer the matter to the High Court. I had earlier stated that the High Court Civil Suit No. 45 of 2011 is still pending at the

High Court. This means that the rectification proceedings should be considered under the provisions of section 53 (a) and not section 53 (b) of the Act. With regard to the provisions of rule 83 of the Trade Mark Rules, the same regulates the procedure for rectification proceedings as provided for under sections 29, 35 and 53 of the Trade Marks. Where the Registrar lacks the power to hear and determine rectification proceedings, then rule 83 is rendered irrelevant. The Applicants also relied on rule 103 of the Trade Mark Rules. The said rule 103 provides that before the Registrar of Trade Marks exercises discretionary power adversely against any party, the Registrar should give that party a hearing. I am of the view that rule 103 does not apply to the current proceedings for the reason that the proceedings have nothing to do with any adverse discretionary power that the Registrar is required to exercise. This is not about the discretionary powers of the Registrar but about the appropriate jurisdiction for the current expungement proceedings.

With regard to the provisions of Article 159 of the Constitution, I agree with the Proprietors that the current proceedings are not about procedure or technicalities but about jurisdiction. As aforementioned, sections 35 and 53 of the Trade Marks Act have set out the manner in which the jurisdiction for purposes of expungement proceedings should be determined. In the case of the Owners of Motor Vessel "Lillian S" v Caltex Oil (Kenya) Limited KLR 1 the Court of Appeal stated as follows:

"I think that it is reasonably plain that a question of jurisdiction ought to be raised at the earliest possible opportunity and the court seized of the matter is then obliged to decide the issue right away on the material before it. Jurisdiction is everything. Without it, a Court has no power to make one more step. Where a Court has no jurisdiction, there would be no basis for a continuation of proceedings pending other evidence...."

I therefore hold that the Registrar of Trade Marks has no mandate to hear and determine the current expungement proceedings because of the pending High Court Civil Suit No. 45 of 2011. Entertaining the said expungement proceedings would be contrary to the provisions of sections 35 and 53 of the Trade Marks Act.

For the above-mentioned reasons, I have come to the conclusion that the Proprietors have succeeded in the Preliminary Objection for the reason that

- (a) there is an action pending in court with regard to trade mark no. KE/T/2006/60247 "HIGH FLYER SERIES" (WORDS AND DEVICE);

(b) The appropriate forum to hear and determine expungement proceedings with regard to the said trade mark no. KE/T/2006/60247 "HIGH FLYER SERIES" (WORDS AND DEVICE) would be the High Court of Kenya in accordance with the provisions of sections 35 and 53 of the Trade Marks Act, Cap 506 of the Laws of Kenya; and

(c) I give no order as to costs.

A handwritten signature in black ink, appearing to read 'Eunice Njuguna', with a stylized flourish at the end.

Eunice Njuguna
Assistant Registrar of Trade Marks
14th March 2014

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

Eunice Njuguna
Assistant Registrar of Trade Marks
14th March 2014