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IN THE MATTER OF THE TRADE MARKS ACT CAP 506 OF THE LAWS OF KENYA

AND

**IN THE MATTER OF T.M.A NO. 124837 IN THE NAME OF MARY MUMBI KARIUKI
AND OPPOSITION THERETO BY FAHARESS COMPANY LIMITED**

RULING BY THE ASSISTANT REGISTRAR OF TRADE MARKS

BACKGROUND

On 1st November 2022, Mary Mumbi Kariuki (hereinafter referred to as “the Applicant”) filed an application to register the mark T.M.A No. 124837 “NDOTO MATTRESSES LIMITED” (word). The application was filed in respect to goods in class 20 of the International Classification of Goods and Services as follows:

Class 20: Furniture, mirrors, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of pearl, meerschaum and substitutes for all these materials, or of plastics.

The application was duly examined in accordance with the provisions of the Trade Marks Act, Cap 506 of the Laws of Kenya. By a report dated 3rd January 2023, the Trade Marks Examiner issued an approval for publication of the said application. The application was then published in the Industrial Property Journal of 28th February 2023 at page 76.

On 12th May 2023, Faharess Company Limited (hereinafter referred to as the Opponent) filed an application for extension of time for a period of thirty (30) days to enable them file their notice of opposition. The Grounds on which the application

was based were that the Opponent had made an application for preliminary advice for registration of a trade mark which was received by the registry on the 30th January 2020 and the same was rejected. That barely a few weeks thereafter the same registry under unclear circumstances allowed the continued process for the registration of the same mark in the name and style to be registered under TM No. 124837. The Opponent attached the requests and Form TM 6 (notice of opposition).

On 26th May 2023, the Applicant filed a notice of opposition to the application for extension of time indicating inter alia that the application is prima facie void of reason on the face of it and does not contain any explanation for the delay to even warrant the consideration for extension of time. That the application seeks for extension of time, which is not envisaged under the Act and the succinct provision that the Opponent has quoted and wishes to apply (Section 102 of the Act) does not aid the indolent for having slept on their rights.

Both parties appeared before me on 27th November 2024 and highlighted the key issues for consideration relating to the application for extension of time.

The Opponent indicated inter alia that, the Applicant was the Opponent's customer who was procuring goods in form of mattresses, cushions and foam goods from the Opponent. That the Applicant was aware that the Opponent was in pursuit of the trade mark. It was later that the Applicant informed the Opponent that she had gotten the preliminary advice to register "NDOTO MATTRESSES" trade mark and offered the same for sale. However, the prescribed time to make the opposition to the mark had lapsed thus necessitating the application under Rule 102 of the Trade Marks Rules for extension. The Opponent indicated that the Registrar has discretion to extend time under Rule 102 on conditions that he may specify and pursuant to Section 21 of the Trade Marks Act.

The Opponent indicated that he was relying on Miscellaneous Civil Application 165 of 2012, Republic v. The Registrar of Trade Marks, Sony Holdings Limited & Sony Corporation. The Opponent requested that the application for extension of time be allowed and prayed that the application for opposition be heard on merit, parties

be given an opportunity to give merit and further examine the marks before they can go for registration.

The Applicant on the other hand indicated that in strict application, the application for extension of time should be done within sixty (60) days. That the preliminary advice given by the objectors was not approved by the Registrar in 2020. The reason given was that they were confusingly similar marks and the objector as was, did not pursue any other avenue available to them and so left the name or the application free and open for any citizen.

That the Applicant made an application for a search of a name she found suitable for her business and company and PA 42514 made on 1st November 2022 was returned with an examination report approval of the name sought. With the approval she was okayed to make payment towards registration of the same. Payment was made and the advertisement proceeded in the Industrial Property Journal. The Applicant's opposition to extension of time is guided within the law, that the application for extension of time was not done within the required time. No reason has been brought forth as to why the same was not done. The Applicant was of the view that the Tribunal should not be persuaded to extend time for reasons given above and the rest.

RULING

I have considered the application for extension of time made herein by Counsel for the Opponent and the opposition to the application filed by Counsel for the Applicant. I have also considered the oral and written submissions made by both Counsels on behalf of the Applicant and Opponent as well as the evidence and authorities filed.

I am of the view that the issue for determination in these proceedings is whether or not the Opponent should be granted an extension of time for a period of thirty (30) days and whether the notice of opposition dated 21st March 2023 and filed on 12th May 2023 by the Opponent should be deemed duly filed.

Section 21 (2) of the Trade Marks Act provides that any person may, within the prescribed time from the date of the advertisement of an application, give notice to the Registrar of opposition to the registration.

Section 21 (3) of the Trade Marks Act further provides that the notice shall be given in writing in the prescribed manner, and shall include a statement of the grounds of opposition.

Rule 46 of the Trade Marks Rules provides that:

“Any person may, within sixty days from the date of any advertisement in the Journal or Kenya Gazette of an application for registration of a trade mark, give notice in Form TM 6 to the Registrar of opposition to the registration.”

Rule 102 of the Trade Mark Rules provides as follows:

102 (1) The Registrar may extend, on such conditions as he may specify, the time for doing any act or taking any proceedings under these Rules.

(2) The Registrar may not extend a time expressly provided in the Act, other than the period prescribed under subsection (6) or (7) of section 25 of the Act.

(3) A time limit may not be extended for a period exceeding ninety days, except for a period prescribed by rule 76 which may be extended for a period not exceeding six months.

(4).....

(5) The application shall state the grounds on which the application is based.

(6) An application for an extension of time may be made even though the time has already expired.

(7) The application shall be dealt with upon such notice, and in accordance with such procedures, as the Registrar may direct.

The Court of Appeal in ***Civil Appeal No.37 of 2013 Sony Holdings Ltd v Registrar of Trade Marks & Another*** upheld the decision by Justice Warsame which had stated that the Registrar has wide powers under Rule 102 of the Trade Mark Rules to extend time for doing any act where time is not expressly provided in the statute; that where the extension is granted, the Registrar could make as many extensions as he

could except that each of those extensions should not exceed a period of ninety days.

The Judges of Appeal (E.M. Githinji, J.W. Mwera and W. Ouko) in the above mentioned *Sony case* held the view that Rule 102, providing for the Registrar's general power for enlargement of time under the Act, gives him unfettered powers. He can extend the time for doing any act under the Rules on such conditions as he may himself specify.

In *Mobil Petroleum Company Inc. and another v The Director of Intellectual Property in his capacity as the Registrar of Trade Marks (2001) HKLRD 225*, Hartmann J notes that:

"... all matters, including the adequacy of any reason for delay, must be considered, the one weighed against the other, in the exercise of the court's discretion."

In making a determination on this matter, I will consider the reasons/grounds for the request for extension of time, the duration of time and the degree of prejudice to the other party.

Rule 102(5) of the Trade Mark Rules requires that in making an application for extension of time, the application shall state the grounds on which the application is based. In considering an application for extension of time, the grounds cited by an Applicant or Opponent as the case may be, give the Registrar a basis for granting or declining to grant extension of time. The Form TM 53 filed by the Applicant in this case requesting for an extension of time for a period of thirty (30) days indicated in the grounds on which the application is based that the Opponent had made an application for preliminary advice for registration of a trade mark which was received by the registry on the 30th January 2020 and the same was rejected. That barely a few weeks thereafter the same registry under unclear circumstances allowed the continued process for the registration of the same mark in the name and style to be registered under TM No. 124837.

The Opponent also indicated that from 17th March 2020, due to lockdown, Kenya

Industrial Property Institute (KIPI) Offices were inaccessible physically for one and a half years and that is why they filed the application in the year 2022.

The Applicant was dissatisfied with the grounds relied on by the Opponent for not complying with the statutory timeline for filing its notice of opposition and with the fact that the extension of time application has been filed out of time.

It is my view that the Opponent in its Form TM 53 should have given a much more detailed explanation on the grounds why it needed more time to file the notice of opposition out of time. I am not persuaded by the argument raised on lockdown as the KIPI Office operations were ongoing and any applications needed to be filed would still have been sent to the official KIPI emails for consideration. However, looking at the grounds indicated in Form TM 53 and the need to consider the merit on the issues raised, I am of the view that the reason for requesting more time, would be deemed satisfactory in the circumstances. As indicated earlier, the Opponent filed the notice of opposition together with the application for extension of time.

In making an analysis on the duration, the Opponent had a period of sixty (60) days from the date of advertisement of the application (28th February 2023) in the Industrial Property Journal within which to file the notice of opposition. The notice of opposition was therefore to be filed on or before 1st May 2023. The application for extension of time was filed on 12th May 2023. This means that the application for extension of time was filed eleven (11) days out of time. It is my view that the Opponent has within a reasonable time sought extension of time for filing the notice of opposition.

In considering the issue of prejudice and inconvenience, the Applicant was of the view that the Opponent stands to suffer no prejudice or loss and their application is nothing short of a red herring to mislead and delay due procedure. The Opponent on the other hand was of the view that the Applicant stands to suffer no prejudice at all.

I am of the view that there is prejudice and inconvenience suffered by the Applicant. In opposing the application for extension of time, the Applicant had to prepare a response, file Form TM 8 (Notice to the Registrar of Attendance of hearing) and attend a hearing before the Assistant Registrar of Trade Marks. This, in my opinion, is prejudice to the Applicant as she spent money. There is also inconvenience to the Applicant in terms of the time taken to prepare the response, filing the form TM 8 and attendance of the hearing before the Registrar of Trade Marks. These however, can be compensated by costs.

In *Trust Bank Limited v Amalo Company Limited [2002] eKLR* it was stated as follows:

“The principle which guides the court in the administration of justice when adjudicating on any dispute is that where possible disputes should be heard on their own merit. This was succinctly put a while ago by Georges, C.J. (Tanzania) in the case of *Essanji and Another Vs. Solanki [1968] EA* at page 224:

“The administration of justice should normally require that the substance of all disputes should be investigated and decided on their merit and that errors should not necessarily deter a litigant from the pursuits of his right.”

Article 159 (2)(d) of the Constitution of Kenya, 2010 places an obligation on Courts and Tribunals to ensure that justice is administered without undue regard to procedural technicalities. It is my considered view that allowing this matter to proceed to full hearing and consideration on merit would serve the interest of justice.

DECISION

For the reasons set out above and having taken into account all the circumstances of the case, I rule as follows:

1. The Opponent is hereby granted an extension of time for a period of thirty (30) days as requested in its application for extension of time dated 11th May 2023 and filed on 12th May 2023;

2. The notice of opposition dated 21st March 2023 that had been filed by the Opponent on 12th May 2023 is hereby deemed duly filed.
3. The Opponent shall compensate the Applicant for the prejudice and inconvenience suffered in preparing and attending the proceedings to object the extension of time by reimbursing the Applicant's fee incurred in filing Form TM 8 (Notice to the Registrar of Attendance of hearing) and attending the hearing of the application for extension of time on 27th November, 2024 from 10.42am to 11.44am, as allowed under the Advocates (Remuneration) (Amendment) Order, 2014.
4. The notice of opposition filed on 12th May 2023 by the Opponent shall be duly served on the Applicant by the Registrar of Trade Marks and the Applicant given time to file its counter statement.

Ruling delivered at Nairobi this 20th day of January 2025



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CONCILIA WERE
ASSISTANT REGISTRAR OF TRADE MARKS