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REPUBLIC OF KENYA

IN THE MATTER OF THE TRADE MARKS ACT CAP 506 OF THE LAWS OF KENYA AND IN THE MATTER OF T.M.A. NO. 89573 “SANIPLAST” (WORD) IN THE NAME OF UNIFEROZ (PVT) LIMITED AND OPPOSITION THERETO BY INDICO LTD RULING BY ASSISTANT REGISTRAR OF TRADE MARKS

BACKGROUND

On 16th October 2015, Uniferoz (Pvt) Limited (hereinafter referred to as “the Applicant”) filed an application to register the mark T.M.A No. 89573 “SANIPLAST” (word). The application was filed in respect to goods in class 5 of the International Classification of Goods and Services as follows:

Class 5: Adhesive Plasters, Adhesive Tapes for Medical Purposes, Bandages for Dressing, Bandages (Hygienic).

The application was duly examined by the Registrar of Trade Marks in accordance with the provisions of the Trade Marks Act, Cap 506 of the Laws of Kenya. The application was then published in the Industrial Property Journal of 30th September, 2022 at page 42.

On 18th October, 2022, Indico Ltd, now Orange Pharma Limited (hereinafter referred to as the Opponent) filed a notice of opposition against registration of the Applicant’s mark. The notice of opposition was duly forwarded to the Applicant through a letter dated 2nd November, 2022 and the Applicant required to file its

counter statement within forty-two days from the date of receipt of the said notice of opposition.

On 10th February 2023, the Applicant filed an application for extension of time requesting that the time for filing the Applicant's counter statement be extended outside the statutory period of 42 days and that the Applicant's counter statement to be deemed to have been duly filed within the enlarged time.

The grounds on which the application was based was that the delay was inadvertent and arose from the delayed receipt of the notice of opposition by the Applicant in that the Applicant was notified about the notice of opposition via email on 17th November 2022 from the Applicant's international counsel (the firm of A&A Associates, Pakistan) upon being notified by the local counsel (i.e. the firm of Wanam Sale Advocates). That accordingly, the statutory period of 42 days within which to file the counter statement expired on 29th December 2022. That the inadvertent delay in filing the counter statement was further prompted by the change of both international and local counsel/agents acting in the matter, which necessitated the need to obtain instructions by the new local agent and international counsel from the Applicant. That the Opponent will not be prejudiced in any way by the extension of time sought. That it is only just and fair to grant the applicant an extension of time to file the counter statement in response to the notice of opposition. It is important to note that the Applicant attached the counter statement to the application for extension of time.

The said application for extension of time was forwarded to the Opponent through a letter dated 25th July, 2023 and the Opponent was required to file their reply over the same within 14 days from the date of receipt of the said letter and attachment.

Through a letter dated 24th October, 2023, the Opponent indicated that Rule 52A of the Trade Marks Rules governs situations where a party fails to furnish the required counter statement or evidence in support within the timelines specified. In such cases, the application or opposition will be deemed to be abandoned and the Registrar of Trade Marks may proceed to make an award of costs. The stipulation

unequivocally outlines the necessity of strict compliance with the stipulated timelines.

That in the circumstances where the Registrar opts not to exercise the powers outlined in Rule 52A, potentially due to a submission made pursuant to Rule 102, it is pertinent to delineate the provisions elucidated within Rule 102 of the Trade Marks Rules. That the Rule offers guidance regarding the Registrar's prerogative to grant extensions of time for actions or proceedings brought under the Rules. Within the purview of Rule 102(1), the Registrar wields discretionary authority to extend the stipulated time, delineating conditions for such extensions. However, it is imperative to underscore that this discretionary power is subject to defined limitations.

In light of the foregoing, the Opponent urged the Registrar to refuse extension of time sought by the Applicant. That upholding the statutory limits and preserving procedural orderliness are fundamental to maintaining a fair and efficient Trade Mark registration process.

The Opponent's letter was forwarded to the Applicant through a letter dated 27th October, 2023 and the Applicant was required to file its reply over the same within 7 days from the date of receipt of the said letter.

Through a letter dated 14th November 2023, the Applicant filed its response indicating that the delay occasioned in filing the counter statement by the Applicant was inadvertent, unintended, and not deliberate. That considering the reasons for the delay set out in the grounds for the application for extension of time, there was no unreasonable and inordinate delay between the filing of the counter statement and the application for extension of time (i.e. 10th February 2023 and the statutory deadline for filing the counter statement (i.e. 29th December 2022).

That the Opponent's counsel admits in its response that: "... the extension sought by the Applicant does not strictly exceed the permissible limits..."

That the applicant has always been steadfast in pursuing this matter since the filing of the application for extension of time and the counter statement on 10th February

2023, as noted in the various correspondences between the Applicant's counsel and KIPI which is summarized herein below: -

- A. On 10th February 2023, we filed a counter statement dated 30th January 2023 together with an application for extension of time dated 30th January 2023 and a notice of appointment of agent (TM1) dated 3rd January 2023.
- B. On 28th March 2023, we made up a follow-up with KIPI vide a letter of the same date on the status of the application for extension of time and the counter statement.
- C. On 22nd June 2023, we sent a reminder to KIPI vide a letter of the same date noting our concerns that despite numerous follow-ups and reminders to KIPI, we had not received a formal response from KIPI regarding our application for extension of time and the counter statement. On the same day, our representative collected two letters from KIPI, namely:
 - a) A letter dated 17th May 2023 by KIPI addressed to the firm of Wanam Sale Advocates (the previous law firm acting for the Applicant in Kenya), informing them of our counter statement and application for extension of time and requesting them to respond within 14 days therefrom; and
 - b) A letter dated 29th May 2023 from Wanam Sale Advocates responding to KIPI's letter of 17th May 2023 indicating that Wanam Sale Advocates had informed A.A. & Associates, Pakistan, of the filing of a notice of opposition by Indico Limited, but they had not received instructions from A.A. & Associates or the Applicant (i.e., Uniferoz) to respond to the objection proceedings, and that they were therefore unable to take any further action on the matter.
- D. On 6th July 2023, we sent a letter of the same date, to the firm of Wanam Sale Advocates notifying them that we had been retained by Uniferoz Limited to act on their behalf in the objection proceedings filed by Indico Limited, and proposed to them that we file a joint consent (between Wanam Sale Advocates and OLM Law Advocates LLP) indicating that OLM Law Advocates is the proper agent law firm representing Uniferoz in the objection proceedings.
- E. On 13th July 2023, we received a copy of the signed consent between Wanam Sale Advocates and OLM Law Advocates LLP authorizing KIPI to recognize OLM Law Advocates as the proper agent/law firm representing Uniferoz/the Applicant in the objection proceedings.

- F. On 25th July 2023, we forwarded to KIPI a copy of the consent between Wanam Sale Advocates and OLM Law Advocates LLP authorizing KIPI to recognize OLM Law Advocates as the proper agent/law firm representing Uniferoz in the objection proceedings. On the same day, our representative collected from KIPI a letter dated 25th July 2023 by KIPI (and copied to us) addressed to Indico Limited informing them of our counter statement and Application for extension of time and requesting them to respond within 14 days therefrom.
- G. On 31st August 2023, we sent a letter to KIPI indicating that the 14 days given to Indico Limited had since lapsed and requested an update on the same. Our representative was informed by KIPI officials that Indico had not responded to KIPI's letter of 25th July 2023, and that KIPI would send a final reminder to Indico Limited requesting them to respond to our application for extension of time and counter statement.
- H. On 25th September 2023, our representative collected from KIPI a letter dated 20th September 2023 by KIPI addressed to our firm forwarding a letter dated 25th August 2023 from Simba and Simba Advocates indicating that their firm had been appointed as the Opponent's agent for purposes of the current objection proceedings.
- I. On 2nd November 2023, our representative collected from KIPI a letter dated 27th October 2023 by KIPI addressed to our firm forwarding a letter dated 24th October 2023 from Simba and Simba Advocates responding to our application for extension of time.

That should the Registrar allow the application for extension of time and deem the counter statement to have been duly filed, the grant of such orders sought will not prejudice the Opponent in any way.

That on the contrary, the Applicant will be greatly prejudiced if the orders sought in the application for extension of time are not granted owing to costs already incurred in T.M.A. Number 89573 and in defence of the current objection proceedings filed by the Opponent.

Accordingly, in the circumstances, it would be fair that the application for extension of time be allowed in order for the notice of opposition and the counter statement to be heard on their merit.

Whilst the Applicant acknowledges that extension of time is not a right of a party, but rather, an equitable remedy that is only available to a deserving party at the discretion of the Court or a quasi-judicial body as enunciated in the Supreme Court of Kenya decision in *Nicholas Kiptoo Arap Korir Salat v Independent Electoral and Boundaries Commission & 7 others [2014] eKLR*, we believe that the Applicant has laid sufficient basis to warrant the exercise of the Registrar's discretion in favour of allowing the application for extension of time in line with Article 47 (right to fair administrative action) of the Constitution, Article 159(2)(d) of the Constitution that requires the administration of justice without undue regard to procedural technicalities, Section 4 of the Fair Administrative Action Act, No. 4 of 2015, of the Laws of Kenya requiring administrative action to be conducted in an expeditious, efficient, lawful, reasonable and procedurally fair manner, and Rule 102 of the Trade Marks Rules, 1956.

Based on the foregoing, the Applicant prayed that the Registrar exercises his/her discretion to allow the application for extension of time and deem the counter statement to have been duly filed.

The Applicant's letter was forwarded to the Opponent vide a letter dated 15th July, 2024. Both parties appeared before me on 20th August, 2024 for the hearing of this matter.

RULING

I have considered the application for extension of time made herein by counsel for the Applicant, OLM Law LLP, and the opposition to the application filed by counsel for the Opponent Simba & Simba Advocates. I have also considered the oral and written submissions made by both counsels on behalf of the Applicant and Opponent filed in support and against the application.

I am of the view that the issue for determination in these proceedings is whether or not the Applicant should be granted an extension of time beyond the forty-two (42) days' statutory period and whether the counter statement filed by the Applicant should be deemed duly filed.

Section 21 (4) of the Trade Marks Act provides that the Registrar shall send a copy of the notice of opposition to the Applicant and within the prescribed time after receipt thereof, the Applicant shall send to the Registrar, in the prescribed manner, a counter statement of the grounds on which he relies for this application

Rule 48 of the Trade Mark Rules provides that within forty-two days from the receipt of the duplicate of the notice of opposition, the Applicant shall send to the Registrar a counter statement in Form TM 7 setting out the grounds on which he relies as supporting his application.

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 addition, the Court of Appeal in *Sony Holdings Ltd v Registrar of Trade Marks & another* stated as follows: "*The law requires the Registrar to hear any opposition to an application for trade mark registration before registering it. It is a factor in determining whether or not to extend time to consider whether there are fundamental issues in the dispute that ought to be decided on merit. Like the High Court, we are satisfied that the Registrar judicially and fairly exercised his discretion to extend time. He properly directed himself on the substance of the notice of opposition so that the matter in controversy may be heard and determined with the benefit of evidence. The alternative, suggested by the appellant, namely to terminate the opposition proceedings on a technical procedural point, would be ineffectual, as the registration of the appellant's trade marks would open new front of challenge and dispute between the same parties, on essentially the same issue.*" (Emphasis added).

The Supreme Court in *Wilfrida Arnodah Itolondo v Attorney General & 9 others SC. Application No. 3 of 2021 (E005 of 2021)* while citing the case of *Nicholas Kiptoo Arap Korir Salat v Independent Electoral and Boundaries Commission & 7 others, SC Application No. 16 of 2014; [2014] eKLR (the Nick Salat Case)* stated out as follows with regards to extension of time:

"...it is clear that the discretion to extend time is indeed unfettered. It is incumbent upon the applicant to explain the reasons for delay in making the application for extension and whether there are any extenuating circumstances that can enable

the Court to exercise its discretion in favour of the applicant.

“... we derive the following as the underlying principles that a Court should consider in exercising such discretion:

1. *extension of time is not a right of a party. It is an equitable remedy that is only available to a deserving party, at the discretion of the Court;*
2. *a party who seeks extension of time has the burden of laying a basis, to the satisfaction of the Court;*
3. *whether the Court should exercise the discretion to extend time, is a consideration to be made on a case- to- case basis;*
4. *where there is a reasonable [cause] for the delay, [the same should be expressed] to the satisfaction of the Court; whether there will be any prejudice suffered by the respondents, if extension is granted;*
5. *whether the application has been brought without undue delay; and*
6. *whether in certain cases, like election petitions, public interest should be a consideration for extending time.”*

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. 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, in instances where the Registrar is dealing with an application for extension of time.

In looking at the grounds cited by the Applicant for making the application for extension of time, the Applicant indicated that that the inadvertent delay in filing the counter statement was prompted by the change of both international and local counsel/agents acting in the matter, which necessitated the needs to obtain instructions by the new local agent and international counsel from the Applicant.

The Opponent on the other hand is of the view that the change in legal representation is not a satisfactory justification for the delay, particularly in this era of immediate email communication. That a day of one week might be justifiable, but a delay exceeding 30 days is not reasonable under the doctrines of equity.

I have considered the views advanced by both the Applicant and the Opponent and the evidence that has been adduced by the Applicant in support of its grounds for the application for extension of time. I am of the view that the reason for requesting more time, would be deemed satisfactory in the circumstances.

In making an analysis on the duration, the Applicant had a period of forty-two (42) days from the date when they received the notice of opposition (14th November 2022) within which to file the counter statement. Accordingly, the counter statement was to be filed by 27th December, 2022. The application for extension of time was therefore filed forty-five (45) days out of time. It is the Opponent's view that the Applicant's delay exceeding thirty (30) days in filing an application for extension of time is not reasonable.

The Applicant on the other hand indicates that the delay in filing a counter statement was never intentional. That it has acted with speed to ensure that the matter is prosecuted without, any further delay. The Applicant has explained the circumstances that caused the delay in filing of the counter statement. It is my view that the Applicant has given a plausible explanation for the delay and the delay of forty-five 45 days was in the circumstances not inordinate.

On the issue of prejudice and inconvenience to the other party, the Applicant is of the view that the Opponent will not be prejudiced in any way. It is my view that there is prejudice and inconvenience suffered by the Opponent. In opposing the

application for extension of time, the Opponent is required by law to file Form TM 8 (Notice to the Registrar of Attendance of hearing). Furthermore, the Opponent did attend a hearing before the Assistant Registrar of Trade Marks on 20th August, 2024. This, in my view, is prejudice to the Opponent as they have incurred expenses. There is also inconvenience to the Opponent in terms of the time required to prepare the responses. These however, can be compensated by costs.

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 Applicant is hereby granted extension of time as requested in its application for extension of time dated 30th January 2023 and filed on 10th February 2023. The grant of extension of time is subject to payment of additional fees of fifty (50) US Dollars, the duration of time for the extension having been 45 days. I note that the initial payment made was for only 30 days;
2. The payment of the additional fees to be made within fourteen (14) days of the date of this decision;
3. The counter statement that had been filed by the Applicant on 10th February, 2023 is hereby deemed duly filed;
4. The Applicant shall compensate the Opponent for the prejudice and inconvenience suffered in preparing and attending the proceedings to object the extension of time by reimbursing the Opponent'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 20th August, 2024 from 10.55am to 11.13am, as allowed under the Advocates (Remuneration)

(Amendment) Order, 2014.

5. The counter statement filed on 10th February, 2023 by the Applicant shall be duly served on the Opponent by the Registrar of Trade Marks and Opponent given time to file its statutory declaration. This is subject to the Applicant paying the additional extension of time fees.

Ruling delivered this 30th day of September 2024.



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CONCILIA WERE

ASSISTANT REGISTRAR OF TRADE MARKS