



REPUBLIC OF KENYA

IN THE INDUSTRIAL PROPERTY TRIBUNAL

AT NAIROBI

IPT APPEAL NO.12 OF 2013

IN THE MATTER OF AN INDUSTRIAL DESIGN APPLICATION DESIGN NO

KE/ID/2004/00587 ENTITLED "CONTAINER"

BETWEEN

MALPLAST INDUSTRIES LTDAPPLICANT

VERSUS

SAFEPAK LTD.....RESPONDENT

JUDGEMENT

- 1) Before us is an appeal by M/S Malplast Industries Ltd challenging the decision of the Managing Director Kenya Industrial Property Institute dated 9th November, 2012 which found that the appellant's industrial design lacks the requisite creativity to qualify for registration in light of the prior art design application No. 539.
- 2) The Notice of appeal dated 6th February, 2013 in Form IPT 15 is lodged under Rule 5(3) (e) of the Industrial Property Rules (2002). The grounds of Appeal as set out in that notice are:-
 1. The managing director erred in law and misdirected himself by ruling that the refused opponents industrial design application number 539 constituted prior Art.
 2. The managing director erred and misdirected himself by ruling that Applicant's/Appellant's Industrial Design lacks the necessary creativity to meet the requirements set out in section 86(2) of the Act.

3. The managing Director erred and misdirected himself by holding that there was no evidence on record to suggest that the creator of the Applicant's/Appellant's design was an employee of the company applicant/appellant that would be covered by section 32 of the Act.
3. Ultimately the appellant seeks the following reliefs:-
- a) This appeal be allowed and that the decision of the Managing Director be set aside.
 - b) The applicant's application be allowed to proceed to the next stage of registration.
 - c) The cost of this appeal be awarded to the appellant.
 - d) This Honourable Tribunal be pleased to grant any further relief as the unique circumstances of the case may demand.
4. The Appeal is defended and opposed by Safepak Ltd who has filed a reply/Counter statement dated 2nd April, 2013 received by the Tribunal on 3rd April, 2013.
5. The Respondent seeks the dismissal of the appeal with costs for lack of merits, on grounds that:-
1. The finding by the Managing Director of the Kenya Industrial Property Institute (KIPI) that the article represented by the Respondent's refused design application No. 2003/00539 constituted prior art against the requestor's design application) is correct and proper in law and fact for the reasons set out in the ruling dated 9th November, 2012 of the Managing Director and the Respondent's extensive submissions on this point on record and fully reproduced in the aforesaid ruling.
 2. The decision of the Managing Director of KIPI that the Requestor's refused Application lacked necessary creativity to render it sufficiently novel and impart individual character in general and or in particular with respect to the

features of “hands with thumbs up” is correct in law and fact for the reasons set out in the ruling dated 9th November, 2012 and in view of the Respondent’s extensive submissions on this aspect on record and fully reproduced in the aforesaid ruling.

3. The Managing Director KIPi was correct in his decision that the features and shape embodied in the refused application (which the requestor claimed as novel) lacked individual character as well as the overall impression of the article of the Requestor’s refused application is substantially similar to that of the prior art design application no. 2003/00539 of the Respondent and further that by applying the principle of imperfect recollection, members of the public will not be able to distinguish the two articles as their respective features, shape and manner of application are either identical or substantially similar.
4. The finding by the Managing Director of KIPi that there was no evidence on record confirming that Mr. Bijesh Shah, the creator of the refused application is an employee of the Requestor is correct and proper in law and fact and that is fully supported by the requestor’s pleadings on record and also by the Respondent’s submissions which have fully been reproduced in the ruling dated 9th November, 2012.
6. This appeal emanates from the decision of the Managing Director KIPi dated 9th November, 2012 by which he upheld the opposition by Safepak Ltd to the registration of an Industrial Design lodged by the appellant for registration of an Industrial Design Application No. KE/ID109/00940 entitled “**Juice Bottle**” in the name of Malplast Industries Ltd. The application for registration of the Industrial Design was made on 2nd April 2009 and was opposed by Safepak Ltd by a notice of opposition dated 25th February, 2010.
7. The registration of the Industrial Design was opposed primarily on the ground of lack of novelty/failure to meet the criteria set under Section 86 of the Industrial Property Act (2001). The opponent’s argument before the Managing Director and as urged before us was that there was nothing new in the industrial design presented for registration as it was similar to an earlier industrial design submitted for registration in the year 2003 by the opponent and whose registration was also declined on grounds that it was not new.
8. The other ground taken in opposition was that the design application was incurably defective as it did not comply with Section 87 (3), of the Industrial

Property Act; the argument here being that Malplast Ltd was not the creator of the invention and Mr. Bijesh Shah being the Managing Director and not an employee of the company had not properly and legally assigned his rights to the company; presumably by a Deed of assignment or some other form of contract and therefore the company could not properly apply for registration of the industrial design in the absence of such a formal assignment or contract. The statement contained in exhibit No. TS 4 **“to the effect that I have assigned all my rights title and interest in the industrial design”**; it was contended was insufficient for purposes of conferring any legal rights to the applicant in respect of the opposed design.

9. The Managing Director heard the parties advocates and reviewed the evidence and in a ruling dated 9th November, 2012 which is the subject of this appeal came to the conclusion that the opposed design lacked 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) of the Industrial Property Act 2001. For the sake of clarity Section 82(2) provides that “An Industrial Design shall be deemed new if it has not been disclosed to the public, anywhere in the world, by publication in tangible form or, in Kenya, by use in any other way, prior to the filing date or where applicable the priority date of the application for registration. So basically the Managing Director was saying that in light of the prior art – as disclosed in Industrial Design Application No. 539 the opposed Design application was not new and therefore was not registrable.

10. In reaching this decision the Managing Director found as a fact that except for the feature of “hands with thumbs” up that the applicant placed a lot of reliance on all the other features in the opposed design were materially similar and created similar visual impression as those in the prior art. He concluded that the feature of the “hands with thumbs up” in the opposed design did not confer it with sufficient individual character to make it registrable.

11. The appellant takes issue with this finding in grounds 1 and 2 in the Notice of Appeal. We have independently reviewed the evidence and the submissions tendered by the parties and we find no reason to fault the decision of the Managing Director. We find that though the subject of a monkey in the prior art has been replaced with that of a dog in the opposed design the manner and style of the prior art has been retained. There is the

identical ring around the neck, a slim waist, folded arms and the position of the ears is shared in both designs.

12. We also upon independently reviewing and observing the two bottles come to the conclusion that the new addition of “hands with thumbs up” is as the Managing Director said in his ruling a minor variant that does not confer the opposed design with the requisite individual character required for registrability of an Industrial Design, as the overall visual impression remains substantially similar and indistinguishable from the prior art.
13. On the issue of ownership, of the opposed design and whether the applicant was entitled to apply for registration notwithstanding that there was no deed of assignment or contract transferring the rights of the applicant's Managing Director to the applicant, the Managing Director KIPI found that though there was no evidence on record to suggest that the creator of the design was an employee of the company as contemplated by Section 32 of the Act, this was not fatal to the applicant's right to apply for registration of the design as there was a statement on record by the creator stating that he had transferred ownership to the applicant. He concluded that it would be unjust and bordering on relying on a technicality to hold that the application was incurably defective especially considering that Section 87(3) of the Act did not prescribe a specific form and type of the statement to be filed to confirm assignment or transfer of the rights of the creator of a design to an applicant. We find that the Managing Director's decision on that point is sound.
14. The appellant takes issue with the Managing Director's finding that there was nothing on record to show that the Mr. Bijesh Shah the Managing Director Malplast Ltd was an employee of the applicant. We have independently reviewed the evidence tendered before the Managing Director KIPI and there is indeed no evidence to show that Mr. Bijesh Shah was indeed an employee of Malplast Industries in addition to being its Managing Director.
15. We therefore find the criticism that the Managing Director KIPI erred in finding that the applicant had not proved that the creator of the opposed industrial design was its employee is without merits.

16. In the end we come to the conclusion that this appeal must fail for the reasons set out in the body of this judgment. Consequently the appellant's appeal is hereby dismissed with costs to the respondent.

It is so ordered.

Read and delivered in open court on this 9th day of December, 2016 in the presence of:

Ms. Neema Oruko h/b for Mr. Ikimire for the Applicant.

N/A for the Respondent

Signed by:

HASSAN N. LAKICHA - CHAIRMAN

BROWN M. KAIRARIA - MEMBER

DAVID K. KIPLAGAT - MEMBER

GODFREY OWINO - MEMBER

BRETTAH MUTHURI - MEMBER