



UNIVERSITY OF NAIROBI

COLLEGE OF HUMANITIES AND SOCIAL SCIENCES

SCHOOL OF LAW

MASTER OF LAWS

***ADDRESSING PROFESSIONAL NEGLIGENCE IN INTELLECTUAL
PROPERTY RIGHTS BAR IN KENYA.***

***A thesis submitted in partial fulfillment of the requirements for the
degree of Master of Laws (LLM) of the University of Nairobi.***

BY;

SOLOMON KIOKO KIVUVA (G62/68043/2013)

© 30th SEPTEMBER 2015.

DEDICATIONS

To my father Wilson K. Mbevi(deceased) and mother Mary W. Kivuva (deceased) who inculcated to me the culture of hard work, self-drive, the fear of God and respect to fellow men and the environment.

To my dear wife Anne, and my children, wayne and Abigail, for their support, unconditional love and understanding during the writing of this paper.

To all lawyers who work diligently as they execute their clients instructions and avoid professional negligence in their work.

ACKNOWLEDGEMENT

I thank the Almighty God for giving me the ability to finalise this project.

I am highly indebted to Mr. Richard Kariuki who painstakingly supervised the writing of this thesis and whose immense contribution, plentiful suggestions and inspired criticisms helped shape and model this thesis.

Special thanks to, all interviewees who took time to fill in the questionnaire and to give views on this subject, to my professional colleagues especially Antony Mulekyo, Mathias Okuche, James Jengo, Andrew Kiluva, Caroline Muthiani and Timon Oyucho who gave me ideas and helped me shape this paper.

May the Almighty God bless you abundantly.

<u>INDEX</u>	<u>Page</u>
I) Declaration of originality	v
II) Table of Statutes	vi
III) Table of cases	vii
Iv) Table of abbreviations	xxi
1.1. Introduction.	1
1.2. Background of the problem.	3
1.3 Objectives of the study.	4
1.4 Statement of the problem.	5
1.5 Theoretical Framework.	7
1.6 Literature review.	8
1.7 Research Hypothesis.	13
1.8 Research Questions.	14
1.9 Research Methodology.	14
1.10 Chapter Breakdown.	15
1.11 Limitations.	16
 Chapter two	
2. The concept of immunity for liability for professional negligence in the bar in Kenya.	18
2.1. Introduction.	18
2.2. Duties of an advocate to his client in the arena of IPRs.	20
2.2.1 Contractual duties.	20
2.2.2 Tortious duty to client.	21
2.2.3 Fiduciary duties to client.	22
2.2.4 Duty towards third parties.	23
2.3 Reasons in support of the defence of immunity against liability for negligence in the	

bar.	23
2.4.1. The principle of equal treatment.	25
2.4.1 Divided loyalty.	26
2.4.2 Collateral attack.	27
2.4.3 The difficulty of an advocate's work.	27
2.4.4 Vexatious claims.	28
2.4.5 Other reasons given for the defence in other jurisdictions.	29
2.5 Arguments against the defence of immunity against liability for negligence in the bar.	29
2.6 Extend of immunity.	30
2.7 Elements of conduct amounting to professional negligence in the bar in Kenya in the sphere of IPRs.	30
2.7.1 Giving wrong advice.	30
2.7.2 Failure to advice.	31
2.7.3 Explaining legal documents.	31
2.7.4 Ignorance of the law.	31
2.7.5 Error in drafting legal documents and pleadings.	32
2.7.6 Failure to prepare well for the hearing of a matter.	32
2.8 Heads of damages under suits for professional negligence against lawyers.	33
2.8.1 Loss of some financial advantage.	33
2.8.2 Loss of opportunity to acquire or renew an IPR or to defend or prosecute suit.	33
2.8.3 Diminution in value of property.	35
2.8.4 Liability to third parties	35
2.8.5 Wasted expenditure.	35
2.8.6 Costs and interest arising from a dismissed suit	36
2.9 Conclusion	37

Chapter Three;

3.0	Incidences of professional negligence in the bar in Kenya in the arena of intellectual property rights; a study of decided cases.	
3.1	Introduction.	38
3.2	The sample.	38
3.3	Professional negligence in respect of pleadings.	40
3.3.1	Professional negligence in respect of pleadings filed by advocates incourt.	41
3.3.2	Negligence in respect of pleadings filed at KIIPI.	43
3.3.3	Professional negligence in relation to evidence adduced in support of IPRs claim.	44
3.3.4	Negligence in respect of evidence tendered in court	45
3.3.5	Negligence in respect of evidence tendered at KIIPI.	49
3.4	Professional Negligence by advocates during hearing of IPRs disputes.	49
3.4.1.	Negligent conduct of advocates at the hearing of IPRs disputes in court.	49
3.4.2.	Negligent conduct of advocates at the hearing of IPRs disputes at KIIPI.	50
3.5	Delay.	50
3.5.1	Delays by advocates in courts.	50
3.6	Delays by advocates at KIIPI.	51
3.6.1	Negligence by advocates in respect of jurisdiction in court.	52
3.6.2	Negligence on Jurisdiction and KIIPI.	53
3.7	Negligence in respect of the failure to apply IPRs principles in court.	55
3.7.1	Failure to apply legal principles by advocates at KIIPI.	59
3.8	Multiple cases of professional negligence in IPRs disputes.	60
4.1	Introduction.	61
4.2	Data collection method.	61
4.3	Purpose of the study.	62
4.4	Analysis of research findings.	62
4.4.1	Prevalence of professional negligence in the bar and on IPRs issues.	72
4.5	Liability for professional negligence in the bar.	64

4.6 Extend of immunity to be granted to advocates against liability for negligence. 66

4.7 Conclusion. 69

Chapter Four; Dealing with professional negligence IPRs practice; a comparative study of South Africa, England and Canada

5.1 South Africa and IPRs Protection 71

5.2 IPRs Governance in England 74

5.3 Maintaining standards in IPRs practice in Canada 78

Chapter Five; Conclusion and Recommendations.

6.1 Conclusion. 80

6.2 Recommendations. 87

6.3 Avoiding Professional negligence at the bar for IPRs Practitioner 87

6.4 Dealing with professional negligence occasioned by IPRs Practitioners 92

6.5 Bibliography -102

DECLARATION OF ORIGINALITY

I, SOLOMON KIOKO KIVUVA do declare that this is my original work which has not been submitted in any other University for award of a degree and that where other people's work has been used, this has properly been acknowledged and referenced in accordance with the University of Nairobi's requirements.

Signed _____

SOLOMON KIOKO KIVUVA

This thesis has been submitted for examination with my approval as University Supervisor

SIGNED _____

MR. RICHARD KARIUKI

DATED AT NAIROBI THIS DAY OF 2015

TABLE OF STATUTES.

1. The Advocates Act (Chapter 16 Laws of Kenya)
2. The Appellate Jurisdiction Act(Chapter 9 Laws of Kenya)
3. The Bankruptcy Act(Chapter 53 Laws of Kenya)
4. The Civil Procedure Rules (Chapter 21 Laws of Kenya)
5. The Companies Act (Chapter 486 Laws of Kenya)
6. The Constitution of Kenya, 2010
7. The Copyright Act (Chapter 130 Laws of Kenya)
8. The Council of Legal Education Act (Chapter 16A Laws of Kenya)
9. The County Governments Act, 2012.
10. The Criminal Procedure Code Act (Chapter 75 Laws of Kenya)
11. The Evidence Act (Chapter 80 Laws of Kenya)
12. The Industrial Property Act 2001(Chapter 509 Laws of Kenya)
13. the Judicature Act (chapter 8 Laws of Kenya)
14. The Law of Succession Act(Chapter 160 Laws of Kenya)
15. The Law Society Act(Chapter 20 Laws of Kenya)
16. The Limitation of Actions Act (Chapter 22 Laws of Kenya)
17. The Magistrates' Courts Act (Chapter 10 Laws of Kenya)
18. The Oaths and Statutory Declarations Act (Chapter 18 Laws of Kenya)
19. The Penal Code(chapter 63 laws of Kenya)
20. The Trademarks Act (Chapter 506 Laws of Kenya)

TABLE OF CASES

1. *Acton -V- Graham Pearce & Co (A Firm)* (1997) 3 All ER 909.
2. *Agility Logistics Limited And 2 Others –V- Agility Logistics Kenya Limited* (HCCC 840/2010 Nairobi)
3. *Aktiebolaget Jonkoping Volian Industricksfa –Briksaktiebolag -V- E.A The Match Co. Ltd* (1964 IEA 62 (HCU))
4. *Albert Gachers Kiarie T/A Wamaitu Productions –V- Simon Muiruri Kireho T/A One Shop Nooh Music Store* (2008) eKLR (566 Of 2003)
5. *Ali Abdul Kader Salehbhai Assabwalla –V- Khadija Bind Gafoo And Others* (2012)eKLR
6. *Alternative Media Ltd –V- Safaricom Ltd* (2013) eKLR
7. *Amarco Kenya Ltd –V- Minister For Finance* (2008) eKLR
8. *Amarco Kenya Ltd. –V- Minister For Finance And Others* (2005) eKLR
9. *Ananda Marga Universal Relief Team (AMURT) –V- Amurt (International)* (2012) eKLR
10. *Anne Njeri Mungai Kihu E/A Creative Borce Events –V-Standard Group Ltd And Another* (20110 EKLR 435/2011)
11. *APC Lobo And Another -V- Saleh Salim Dhiyebi And Others* [1961] 1 EA 223
12. *Apex Creative Limited And Michael Odhiambo Obera -V- Kartasi Industries Ltd High Court Civil Case No. 416 Of 2011*
13. *Apex Creative Ltd. & Another -V- Kartasi Industries Ltd.* [2011] eKLR
14. *Arthur J S Hall –V- Simons* (2000) 3 All ER 676
15. *Ash -V- Dickie* (1936) 3 All ER 522
16. *Auto Rescue Limited –V- Auto Rescue Limited* 2008 eKLR
17. *Beecham Group Ltd -V- International Product Ltd Another* (1968) EA 398 (HCK) –
18. *Belersdorf Ag –V- Emirchem Products Ltd* (2002) 1 KLR 876
19. *Boyle –V- Ford Motor Co. Ltd* (1992)1 W.L.R. 476
20. *British American Tobacco Kenya Ltd -V- Cut Tobacco Kenya Ltd.* Civil Appeal No. 278 Of 2002
21. *British United Provident Association –V- Bupa (Kenya) Ltd.* (2006) eKLR
22. *Broke Bond Kenya Ltd –V- Chai Ltd* (1971) I EA 15
23. *Brown And Another V Bennett And Others* (2002) 2 All ER 273
24. *Brown –V- Inland Revenue Commissioners* (1965) AC 244.
25. *By K Insurance Agencies Ltd –V- First Assurance Ltd* (2013) eKLR

26. *Caparo Industries Plc -V- Dickman*(1990)2 A.C. 605,
27. *Cellulant Kenya Ltd –V- Music Copyright Of Kenya Ltd* (2009) eKLR
28. *Champion Motor Spares - V- Phadke* (1969) EA 42
29. *Chanan Sigh Gajjan Singh –V- Channan Singh & Handa* (25 KLR 58).
30. *Chloride Exide (K) Ltd & Anor –V- Zakayo Muchai Wainaina T/A Chloride Exide* (2008) eKLR,
31. *Chrisopher Ondieki –V- Safaricom Limited* (2009)eKLR
32. *Christopher Xallion Ondieki –V- Safaricom Limited* (2012) eKLR
33. *Coca Cola Export Corporation-V- Registrar Of Trademarks* (1969)EA 647
34. *Crossley –V- Crowther* (1857) I CH 337.
35. *Cut Tobacco Kenya Ltd –V- British American Tobacco (K) Ltd* (2001)KLR 36
36. *D. Njogu & Co. Advocate -V- National Bank Of Kenya Ltd* [2009] eKLR
37. *D.D Doshi-V- Abdulhessein Hassan Ali Jivani* (25 KLR 55)
38. *Darker (Suing As Personal Representative Of Docker, Deceased) And Others -V- Chief Constable Of The West Midlands Police* (2000) 4 All ER 193
39. *David Engineering Ltd -V- Steel Structures Ltd* IPT No. 55 Of 2007.
40. *David Engineering Ltd. –V– Steel Structures*. HCCC. 189 Of 2007 (Milimani)
41. *De Souza –V- Mandavia* (1964) E.A. 682
42. *Delta Connection Ltd –v- Delta Airlines Incorporated* C.A No. 70 Of 2009
43. *Dipak Emporium –V- Bond’s Clothing* (1973) EA 553
44. *Dunlop –V- Woolarhra Municipal Council* (1981) 2 W.L.R 693
45. *E.A Metal Works Ltd –V- Unique Suppliers And 4 Other* (2011) eKLR
46. *East Africa Industries -V-Trifoods* (1972) 1 EA 420
47. *F.G. Stephens & Co. –V- B.G Allen* (8 KLR) 211
48. *Faulu Kenya Deposit Taking Microfinance Limited -V- Safaricom Limited* [2012] eKLR.
49. *Film Africa (Kenya) Ltd –V- Deutsche Welle & 3 Others* (2011) eKLR
50. *General Plastics Ltd –V- Industrial Property Tribunal And Another* (2007) eKLR
51. *General Plastics –V- Safepark Ltd.* (IPT Case No. 36/ 2012)
52. *George Karanja –V- Moras Group Ltd And Naivas Supermarket & Safaricom Ltd.* (IPT No. 136/2012)
53. *George Ragui Karanja -V- Moras Group Ltd, Naivas Supermarket & Safaricom Ltd,* Industrial Tribunal Court Case No.66 Of 2012
54. *George Ragul Karanja –V- Moras Group Ltd, Naivas Supermarket And Safaricom Ltd* (IPT No. 36/2012 –(12/2/2013)
55. *Giella -V-. Cassman Brown & Co. Ltd* [1973] E.A. 358.

56. *Glebe Sugar Refining Co. Ltd –V- Trustees Of The Port & Harbour Of Greenock* (1921) W.N. 85
57. *Glenmark Pharmaceuticals -V- Les Laboratories Servier*, Industrial Property Tribunal Case Number IPT No. 58 Of 2009
58. *Guardian Bank Limited V Sonal Holdings (K) Limited & 2 Others* [2014] eKLR
59. *Haria Industries –V- P J Product Ltd* (1970) IEA 367
60. *Hassanali M. Sachoo –V- Jonkopings Och Vulcans Tandstichsfabriktiebalag* (1958) EA 463
61. *Henderson –V- Outred* (1995) AC 145(HL)
62. *Hilton -V- Barker Booth And Eastwood (A Firm)* (2005) 1 All ER 651
63. *Holden & Co (A Firm) -V- Crown Prosecution Service And Other* [1990] 1 All ER 368
64. *Hunter -V- Chief Constable Of West Midlands* [1981] 3 All ER 727
65. *Boardman –V- Phillips* (1967) 2 AC 46
66. *In Kenya Association Of Music Producers (KAMP) & 3 Others Ex- Parte Pubs, Entertainment And Restaurants Association Of Kenya (PERAK)* (2014) eKLR
67. *Malyon -V-Lawrence Messer & Co* (1968)2 Llyods Rep. 539,
68. *Midland Bank Trust Co –V- Hett, Stubbs & Kemp* (1979) Ch 84
69. *Owners Of Motor Vessels “Lilian S” - V- Caltex Oil (Kenya) Ltd*, (1989) KLR 1
70. *Supra Studio –V- Tip-Top Clothing Co.* (1971) EA. 489
71. *In The Mater Of Trade Mark Application No. 67288 “Bulzar Energy Drink” INO Kamal Khanbabaei General Trading Co. Ltd And Opposition Hereto By Red Bull GMBH.*
72. *In The Matter Of Design Application Entitled “Juice Bottle” INO Malplast Industries Ltd And Opposition By Safepak Ltd.*
73. *In The Matte Of Trade Mark Application KE/T/2013/79948 Sweet Guard In Class 3 INO Unilever PLC.*
74. *In The Matte Of Trade Mark Application No. 74083 “Germol” In Class 3 INOofamina Limited.*
75. *In The Matte Of Trade Mark Application No. KE/T/2010/67838 FRESHIA In Class 3 INOtanga Pharmaceutical & Plastics Ltd.*
76. *In The Matted Of An Application To Expunge From The Register Trade Mark No. Ke/T/2007/00626653 In Class 3 Uniliver PCC (Applicant) –V- Emami Ltd (Registered Proprietor).*
77. *In The Matter (ITO) Trade Mark No. KE/T/63532 “Mistress” In Class 5 INOagricare East Africa Ltd And Expunge Rest Proceedings Thereto By Osho Chemical Industries Ltd.*
78. *In The Matter Of ‘Patent Application No. KE/2008/00757 Titled ‘Process For Preparation Of Amines’ INO Syngenta Participations AG Ex Parte Hearing Under Regulation 74 Of The Intellectual Property Act. See Also In The Matter Of Patent Application Nos. KE/T/2011/01313*

- Titles 'Prophylactic/ Therapeutic Agent For Cancer' INO Takeda Pharmaceutical Co. Ltd Ex Parte Hearing Under Regulation 74 Of The Industrial Property Act.*
79. *In The Matter Of 'President' And 'President Special Edition Langer' INO E.A Breweries Ltd And Opposition Thereto By Cerveceria Nacional Dominicana*
80. *In The Matter Of "Kinky Bulk" INO Rebecca Fashion Ltd And Opposed By Strategic Industries Ltd.*
81. *In The Matter Of An Application For Expungement By Diamond Industries Limited Of Trade Mark Application No. 64521*
82. *In The Matter Of An Application to Expurge Trade Mark Application No. 57546 In Class 21 In The Name Casabella Associates Ltd And Expungement Hereto By Cornin Incorporated.*
83. *In The Matter Of An Application Of Registered Trade Mark No. Ke/T/2007/006201 Exclamation Mark (Device) In Class 3 And Opposition Thereto by Uniliver PLC (Applicant) –Vs_ Strategic Industries(Opponent)*
84. *In The Matter Of An Application To Expunge From The Register Trade Mark KE/T/2007/00626653 In Class 3 Uniliver PLC (Applicant) –V- Emami Ltd(Registered Proprietor)*
85. *In The Matter Of An Application To Expunge Trade Mark Application No. 57546 In Class 21 INO Casabella Associates Ltd And Expungement Thereto By Cornin Incorporated.*
86. *In The Matter Of an Application To Expurge From The Register Trade Mark No. KE/T/2007/000626653 IN Class 3 Uniliver PLC (Applicant) –V- Emami Ltd(Registered Proprietor)*
87. *In The Matter Of An Application To Register Trade Mark Application No. 57652.*
88. *In The Matter Of An Application To Register Trade Mark Application NO. 67484 " Amolin" I Class 5 INO Beta Health Care International Ltd And Opposition Thereto By Glaxo Group Ltd.*
89. *In The Matter Of An Application To Register Trade Mark Application No.66444 "A Clotas" INO Accord Healthcare (Kenya) Ltd And Opposition Thereto By Novartis AG.*
90. *In The Matter Of An Application To Register Trade Mark Application No. 61998 "Fanikisha" In Class 36 INO Equity Bank Ltd And Opposition Never By Trans National Bank Limited.*
91. *In The Matter Of An Application To Register Trade Mark Application No. 59944 Americana Orange Magic (With Device) In Class 30 INO Tamu Tamu LTD And Opposition Hereto By Rollfast Holdings Limited & Cookies Ltd.*
92. *In The Matter Of And Application To Expurge Trade Mark Application No. 57546 In Class 21 INO Casabella Associates Limited And Expunge Rest Thereto By Corning Incorporated.*

93. *In The Matter Of Application For Security Of Costs For Costs In Delahon To Application To Register Star Plus (Word Mark) Trade Mark Application No. 65503 (Star Plus –Word Mark) Sheet A. Doohiafibre Link Limited (Applicant) –V- Star Television Production Ltd.*
94. *In The Matter Of Application To Register Trade Mark Application No. 59944 Americana Orange Magic(With Device) In Class 30 INO Tamu Tamu Ltd. And Opposition Thereto By Rollfast Holdings Ltd & Cookies Ltd*
95. *In The Matter Of Expungement Application Trade Mark Application No. 55580 (Onion-Word Mark)Doshi Mongers Ltd (Registered Proprietor) –V/S Issaabloy (Applicant).*
96. *In The Matter Of Expungement Proceedings Of Trade Mark Application No. 59512(Resek Omeprazole) (Word& Device Mark) INO Getz Pharma (Private) Ltd. On Application By Golf(Julphaz) Pharmaceutical Industries Ltd.*
97. *In The Matter Of Expungement Proceedings Of Trade Mark Applicant No. 59512 (Risek Omeprazole) – (Word And Device Mark) INO Getz Pharma (PRIVATE) IN AN APPLICATION BY GOLT (JULPHAZ) Pharmaceutical Industries Ltd.*
98. *In The Matter Of Expungment Proceedings Of Trade Mark Application No. 59512 (Risek Omeprazole) (Word And Device) INO Getz Pharma (Private) Ltd On Application By Golf (Julphaz) Pharmaceutical Industries Ltd.*
99. *In The Matter Of Industrial Design Application No. KE/D/2008/00879 Entitled “Water/Juice Bottle” INO Malplast Industries Ltd, And Opposition By Safepak Ltd.*
100. *In The Matter Of Industrial Design Application No. Ke/ID/2010/001009 Entitle Container INO Dynaplas Ltd. and Opposition By Safepak Ltd.*
101. *In The Matter Of Industrial Design Application No. KE/D/00115-1129- INO Nestle Ltd.*
102. *In The Matter Of Opposition Proceedings Of Trade Mark Application No. Ke/2008/063792 Nexome- (Word Mark) INO Surgilnks Limited (Applicant And Astra-Zanecca (Opponent)*
103. *In The Matter Of Opposition To Trade Mark Application No. 54559 (Painamol- Word Mark) Beta Health Care International Limited (Applicant) –V- Smithcline Beecham (PLC)*
104. *In The Matter Of Opposition To Trade Mark Application No. 59060 (Synercef Word Mark) Syner-Trued Pharmaceuticals Limited (Applicant) –V- Glaxo Group Limited*
105. *In The Matter Of Opposition To Trade Mark Application Non 54559 (PAINAMOL –Word Mark) Beta Health Care International Limited (Applicant) –V- Smith Kline Beecham Ltd.*
106. *In The Matter Of Parent Application No. KE/P/2011/01313 Titled “Prophylactic/Therapeutic Agent For Cancer’ INO Takeda Pharmaceutical Co. Ltd*

Exparte Hearing Under Reg. 74, Ipad

107. *In The Matter Of Patent Application No. KE/P/2008/00757 Titled “Process For Preparation Of Amines’ INO Syngenta.*
108. *In The Matter Of T.M.A No. 60347 INO M.A Pandit And Co. Ltd And Opposition Excell Chemicals Ltd.*
109. *In The Matter Of Trade Mark ‘Maxivita –M” (Word) In Class 5 INO Surgilinks Ltd And Opposition Thereto By Agio Pharmaceuticals Ltd.*
110. *In The Matter Of Trade Mark “Mistress” I.N.O Agricare East Africa Ltd And Expungement Proceedings By Osho Chemical Industries Ltd.*
111. *In The Matter Of Trade Mark “Omega School Boards And Accessories” (Word And Device) INO Omega School Board And Accessories Ltd And Expungement proceedings By Omega Chalk Industries (1993) Ltd And Chemical And School Supplies Limited.*
112. *In The Matter Of Trade Mark Application “Charming” In Class 26 INO Rebecca Fashion Ltd And Opposition By Strategic Industries Ltd.*
113. *In The Matter Of Trade Mark Application “Gold Alyssa” INO Rebecca Fashion Ltd And Opposition By Strategic Industries Ltd.*
114. *In The Matter Of Trade Mark Application INO Trade Mark No. Ke/T/2005/57229 “Keberg” In Class 32 INOteplas Ltd And Expungement Proceedings Hereto By Chia Khim Food Industries PTE Ltd*
115. *In The Matter Of Trade Mark Application KE/T/2008/64107 “President” And KE/T/2008/64506 ‘PRESIDENT Special Edition Langer’ INO E.A Breweries Ltd And Opposition Thereto By Cervceria Nacional Dominica C. Por.*
116. *In The Matter Of Trade Mark Application No 43903 “ Rantac” In Class 5 INO T.B Chemicals And Pharmaceuticals Ltd And Opposition There By Glaxco Group Ltd.*
117. *In The Matter Of Trade Mark Application No Ke/T/2005/05800 “ Breezes Beach Club And Spa Zanzibar” In Class 39 And 43 INO Nova Hotels Limited And Opposition Thereto By URL International Limited.*
118. *In The Matter Of Trade Mark Application NO Ke/T/2009/066576 “PIMA” (WORD) In Class 9 INO Inverness Medical Switzerland GMBH Ex Parte Hearing Under Rule 33 Of The Trade Make Rules.*
119. *In The Matter Of Trade Mark Application No Trade Mark Application 62238 (Applicant) And Opposition By Premier Floor Mills Ltd Premier.*
120. *In The Matter Of Trade Mark Application No. (Gulf Energy Follow Us To The Future – Logo) And Trade Mark Application (Gulf Energy –Logo) INO Golf Energy In And*

Opposition By Gulf International Lubricants Limited.

121. *In The Matter Of Trade Mark Application No. “Artequick Artepharm And Star Device” INO East And West Pharmaceuticals And Opposition Thereto By Mepha Ag.*
122. *In The Matter Of Trade Mark Application No. “Maxivita-M” (Word) In Class 5 INO Surgilinks Ltd And Opposition Hereto By Agio Pharmaceuticals Ltd.*
123. *In The Matter Of Trade Mark Application No. 54831 “Cartel” In Class 5 INO Galaxy Pharmaceutical Ltd And Expunge Rest Application By Nabrosphara Put Ltd.*
124. *In The Matter Of Trade Mark Application No. 55857 Beta Health Care Ltd (Applicant) – -v- Smith Klire Beecham Limited.*
125. *In The Matter Of Trade Mark Application No. 5784 “Vestline” (Word And Device) In Class 3 INOtanja Pharmaceutical Plastics Ltd.*
126. *In The Matter Of Trade Mark Application No. 60347 INO Pandit & Sons Ltd And Opposition By Excel Chemicals Ltd. Where The Marks ‘ Raha Tea’ And ‘Raha” Trademarks Were In Contest.*
127. *In The Matter Of Trade Mark Application No. 67840 “Goldy INOtanga Pharmaceutically And Plastics In Exparte.*
128. *In The Matter Of Trade Mark Application No. 68367 “Superstar” And 68368 “Station” INO Royal Tobacco (K) Ltd, And Expungement Proceedings By British American Tobacco (K) Ltd.*
129. *In The Matter Of Trade Mark Application No. 68415 “New Body Ware” In Class 26 INO Rebecca Fashion Ltd & Opposition Hereto By Strategic Industries Ltd.*
130. *In The Matter Of Trade Mark Application No. 71545 INO EMC Corporation.*
131. *In The Matter Of Trade Mark Application No. 7166”In Class 9 INO Samsung Electronics Co. Ltd.*
132. *In The Matter Of Trade Mark Application No. 71724 INO Smart Land Wirely Ltd.*
133. *In The Matter Of Trade Mark Application No. 717254 INO Swartland Winery Ltd.*
134. *In The Matter Of Trade Mark Application No. 71891 Mama And Device INO That Persevered Foods Public Co. Ltd.*
135. *In The Matter Of Trade Mark Application No. 72692 INO Procter & Gamble Co. Ltd.*
136. *In The Matter Of Trade Mark Application NO. 73512 “ Imbo” In Class 29 INO Pioneer Foods (Proprietary) Ltd.*
137. *In The Matter Of Trade Mark Application No. 73513 “Blue Bird (Word) In Class 30 INO Pioneer Foods (Proprietary) Limited.*
138. *In The Matter Of Trade Mark Application No. 73728 INO Laboratories Ltd.*

139. *In The Matter Of Trade Mark Application NO. 74083 “Germol” In Class 3 Cwoamina Ltd.*
140. *In The Matter Of Trade Mark Application No. 74686 INO Mata Amritanadamajimatri (India Trust).*
141. *In The Matter Of Trade Mark Application No. 77067 (Device) In Classes 3, 5 And 10 INO LRC Products Limited.*
142. *In The Matter Of Trade Mark Application No. 80173 Jumpman Design (Device)In Class 9, 35, And 41 In the name of – Nike International Ltd.*
143. *In The Matter Of Trade Mark Application No. Ke/7/2012/74943 M(Device) In Class 9, 38 And 42 INO Merit Lifestyle (Proprietary) Ltd.*
144. *In The Matter Of Trade Mark Application No. KE/T/2008/63532 ‘Mistress” In Class 5 INO Agri Care E.A Ltd. And Expungement Proceedings Thereto By Osho Chemical Ltd.*
145. *In The Matter Of Trade Mark Application No. Ke/T/2010/069500- The Son (Words) In Class 16 And 41 INO Scoot Ltd-Exparte Proceeding Under Rile 3 Trade Mark Rules.*
146. *In The Matter Of Trade Mark Application No. KE/T/2010/67825 (Circular Device) INO*
147. *British American Tobacco (K) Ltd And Opposition Hereto By Philip Morns Products S.A.*
148. *In The Matter Of Trade Mark Application No. Ke/T/2010/67839 Femo Multi-Purpose Lubricating Oil (Word And Device) In Class 4 INO Toinga Pharmaceuticals And Plastic Limited.*
149. *In The Matter Of Trade Mark Application No. Ke/T/2010/69857 Vicher INO Solphia Group INO And Opposition Thereto By Strategic Industries Ltd.*
150. *In The Matter Of Trade Mark Application No. KE/T/2010/69858 ‘HAALICE’ in the name of Solphia Group Iwc And Opposition Thereto By Strategic Industries Ltd.*
151. *In The Matter Of Trade Mark Application NO. Ke/T/2011/070293 “Maxivita-M” (Word) In Class 5 INO Surgilinks Ltd & Opposition Thereto By Agio Pharmaceuticals Ltd.*
152. *In The Matter Of Trade Mark Application No. KE/T/2011/071011 “”Supamandazi” (Word And Device)” In Class 30 INO Triccover Industries (K) Ltd & Opposition Proceedings Thereto By Global Investment Development Limited.*
153. *In The Matter Of Trade Mark Application No. Ke/T/2011/70258 “ Ping” (Word) In Classes 9, 41,42, And 45 INO Apple Incexparte.*
154. *In The Matter Of Trade Mark Application No. Ke/T/2011/71185 “ECO” (Word And Device) In Class 12 INO General Motor Circle.*
155. *In The Matter Of Trade Mark Application No. KE/T/2011/72191 :Yashmire” (Word) In Class 5 INOmakteshim Chemical Works Ltd.*

156. *In The Matter Of Trade Mark Application NO. Ke/T/2011/73304 INO Nabros Phara PVT Ltd & Opposition Thereto By Galaxy Pharmaceuticals Ltd.*
157. *In The Matter Of Trade Mark Application No. Ke/T/2011/73304 INO Nabroahara Put Ltd And Opposition Thereto By Galaxy Pharmaceuticals Ltd.*
158. *In The Matter Of Trade Mark Application No. KE/T/2012/74943 M(Device) In Class 9,38,And INO M Xit Lifestyle (Proprietary) Ltd*
159. *In The Matter Of Trade Mark Application No. KE/T/2012/75575 Dawamoja INO Chandaria Pharmaceuticals (K) Ltd And Opposition By Dawa Ltd And Sonal Holdings Ltd.*
160. *In The Matter Of Trade Mark Application No. KE/T/2012/75787 Nitro +(Word) In Class 1 And 4 INO Shell Brands International AG*
161. *In The Matter Of Trade Mark Application No. Ke/T/201276404 Lunch Bar (Wor) In Class 30 INO Cadbury UK Ltd.*
162. *In The Matter Of Trade Mark Application No. KE/T/2013/0077238 “Philip Morns “(Word & Device) In Class 34 INO Philip Mornns Brands Sail Exparte Ruling By Assistant Registrar Of Trade Mark.*
163. *In The Matter Of Trade Mark Application No. Ke/T2011/0073459 “Niki” In Class 30 INO Tiger Food Brands Intellectual Property Holdings Company (PTY) Ltd.*
164. *In The Matter Of Trade Mark Application No. Ket/2009/065043 ‘Zap Pesamkononi’ In Classes 9, 35, 36 And 38 INO Mobile Telecommunications Co. KSL & Opposition Thereto By Ngoko Enterprises.*
165. *In The Matter Of Trade Mark Application No. Trade Mark Application 555777 INO Doshi Iron Mongers Ltd (Applicant) And Opposition By Ralson (India) Ltd.*
166. *In The Matter Of Trade Mark Application Nos. 63725 “Wakilisha Limited Totally Representing” (Word And Device) And 64269 “Wakilisha”(Word And Device) And Expungement Proceedings By Vision 2030 Delivery Secretarial*
167. *In The Matter Of Trade Mark Application Nos. Ke/T/2008/64107 “President” And Ke/T/2008/64506 “President Special Edition Langer” INO E.A Breweries Ltd And Opposition Hereto By Cervecerial National Dominicanac.Por.A.*
168. *In The Matter Of Trade Mark Application Number 55857 Beta Health Care Ltd(Applicant) –V- Smith Kline Beecham Limited (Opponent*
169. *In The Matter Of Trade Mark Application Number KE/T/2011/73304 In The Matter Of Nabros Phara PVT Ltd. And Position Proceedings Thereto By Galaxy Pharmaceuticals Ltd*
170. *In The Matter Of Trade Mark Application Number KE/T/2012/75575 ‘Dawa Moja’ INO*

- Chandaria Pharmaceuticals (K) Ltd And Opposition By Dawa Ltd And Sonal Holdings Ltd,*
171. *In The Matter Of Trade Mark Application President And President Special Opposition By Cervecería National Dominicana C Por A.*
172. *In The Matter Of Trade Mark Mabati Maisha' INO Mabati Rolling Mills Ltd And Expungement Proceeding By Maisha Mabati Mills Ltd.*
173. *In The Matter Of Trade Mark No. 58890 INO Inter- Consumer Products Ltd And Opposition Thereto By L'Oreal And In The Matter Of Trade Marks Application No. 062887 'Tevir EM' In Class 5 INO Ranbaxy Laboratories Ltd & Opposition Thereto By TEVA Pharmaceuticals Industries Ltd.*
174. *In The Matter Of Trade Mark No. 66624-29 INO Keish Commodities Ltd And Opposition Thereto By The Agricultural And Processed Food Products Export Development Authority.*
175. *In The Matter Of Trade Mark No. 68367 'Superstar' And No. 68368 "Stallion" INO Royal Tobacco (IC) Ltd. And Expungement Proceedings By British American Tobacco (K) Ltd.*
176. *In The Matter Of Trade Mark No. 74074- " HIMALAYAN" (Word) In Classes 16 And 32 INO Mount Everest Mineral Water Limited Ex-Parte Hearing Under Rule 33 Of Tm Act.*
177. *In The Matter Of Trade Mark No. Ke/T/2006/60247 "High Flyer Series" (Words And Device) In Class 16 INO Antony Kia T/A High Flyer Services And Expunjerest Processing's Thereto By High Flyer Publishers.*
178. *In The Matter Of Trade Mark No. Ke/T/2009/0066428 "Multibix" (Word) In Class 30 INO Manji Food Industries Ltd And Opposition Proceedings Hereto By Weetabix Ltd.*
179. *In The Matter Of Trade Mark No. Ke/T/2009/066453 "My Cofit" In Class 5 INO Accord Health Care (Kenya) Ltd And Opposition Hereto By Noruatis AG*
180. *In The Matter Of Trade Mark No. Ke/T/2010/69653 "Lion" Words And Device In Class 12 INO Super Motor Cycles Ltd And Opposition Thereto By Cheetah Motors Ltd And Motorcycle Mart Ltd.*
181. *In The Matter Of Trade Mark Nos. KE/T/2009/66734 And 66735 "Pathologists Lancer Kenya' (Word And Device) And In The Matter Of Pathologists Lancer Kenya Ltd And Opposition Thereto By Lancer Labs (2000) Ltd And Elsevier Properties SA*
182. *In The Matter Of Trade Mark Number 71891 'Mama' And Device INO Thai President Foods Public Co. Ltd.*
183. *In The Matter On An Application Of Register Trade Mark Application No. 61101 "Sir" Mulchandmald And Opposition Thereto By Rotamas Of Pall Mall Ltd.*

184. *In The Matter On Trade Mark Application No. 71666 “Kenchic Inn Kuku Mfale” In Classes 35 And 43 INO Kenchic Limited Exparte Hearing Under Rule 33 Of The Trade Mark Rule.*
185. *In The Matter Or Trade Mark Application Number 60347 INO MA Pandit & Co. Ltd And Apposed Hereto By Excel Chemicals Ltd.*
186. *INO Trade Mark Application By Diamond Industries Limited To Expunge The Mark “Aha” Trade Make Application No. 64521 Registered INO Pwani Oil Product Limited.*
187. *INO Trade Mark Application 062887 “Tevir EM” In Clas 5 INO Ranbaxy Laboratories Ltd And Opposition Thereto By Teva Pharmaceuticals Industries Ltd.*
188. *Inter Consumer Products Limited –V- Lordix General Supplies Limited (2009) EKLK*
189. *Interconsumer Products –V- L. Oreal (2009) eKLR*
190. *Islamic Republic Of Iran –V- Denby ((1987) 1 Lloyd’s Rep. 367*
191. *Jenkins –V- Bentham (1854) 15*
192. *Jivani-V- Sanyo Electrical Company Ltd. (2003) KLR 425,*
193. *Jiwani –V- Going Out Magazine & Another (2002)IKLR 856*
194. *Juma & Others -Vs-Attorney General [2003] 2 E.A. 461,*
195. *Kalamazoo Ltd And Another –V- Systems Africa Ltd. (1973)1EA 242*
196. *Kenya Association Of Music Producers (KAMP) And Others Ex Parte Pubs, Entertainment And Restaurant Associations Of Kenya (2014) EKLK*
197. *Kenya Bus Services Management Ltd –V- BTC Electric Fence Building Alarm Systems And Another (2009) EKLK*
198. *Kenya Commercial Bank Limited -V- Muturi, Gakuo & Co. Advocates CA Civil Appeal No. 222 Of 2005 (Unreported)*
199. *Kenya Tea Packers Ltd –V- Limuru Tea Packers And Others HCC 1668 Of 1999*
200. *Kenya Toner Supplier Ltd –V- Director Of Weights And Measures & Others (2012)eKLR*
201. *Kinatwa Co-Operative Savings Credit Society Ltd –V-Nakimu Classic Travellers Sacco Ltd (2013) eKLR*
202. *King Woolen Mills Ltd And Another -V- Kaplan & Stratton Advocates [1990–1994]1 EA 244*
203. *Kirima Estates (U) Ltd –V- K. G. Korde (1963) EA*
204. *Kiwanuka & Co -V- Walugembe [1969] 1 EA 660,*
205. *Kogo -V- Nyamogo & Nyamogo Advocates (2004) 1 KLR 367*
206. *L.H. Harris & Co. Ltd –V- L.G. Harris Co. (E.A) Ltd (2010) EKLK HCC 700/1998*
207. *Laphier –V- Phinos (1838) 8 C& P 497*
208. *Liles –V- Terry (1895) Q.B. 679 C.A*
209. *London Distillers-V- Ponu Monu Suppliers(7.9.2011) ITP No. 47/2006*

210. *London Overseas Trading Company Ltd –V- The Raleigh Cycle Company Limited* (1959) 1EA 1012
211. *Lords Heathcare Ltd. –V- Salama Pharmaceuticals Ltd.* (2008)eKLR,
212. *Macmillan Kenya (Publishers) Ltd –V- Mount Kenya Sundries Ltd* (2008)eKLR HCC 2503/1995
213. *Magnate Ventures Limited -V- Eng Kenya Limited* [2009] eKLR
214. *Magnate Ventures Ltd –V- Ena Kenya Limited* CA 28/2009 (Unreported)
215. *Match Masters Ltd –V- Rhino Matches Limited* (2006)eKLR.
216. *Mathew Ashers Ochieng –V- Kenya Oil Co. Ltd & Another* (HCC 377 Of 2007 –NRB) eKLR
217. *Mathew Peevers –V-Leo Slingerland And Another* (200) eKLR
218. *MCSK Ltd –V- Parklands Shade Hotel Ltd T/A Klub House* (2000)KLR 569
219. *Meadow –V- G.M.C* (2006) EWHC 146
220. *Duchess Of Argl –V- Bevselink* (1922)2 Lloyds 172
221. *Midland Bank-V- Hett, Stubbs And Kemp* (1979) Ch 384
222. *Montana (K) Ltd –V- Antony Maina Kara And Others* (2006) eKLR
223. *Montrious –V- Jeffreys* (1825), 2C & P 113, 172 ER 51
224. *Moses Kipkolum Kogo –V- Nyamogo & Nyamogo Advocates* [2004] eKLR
225. *Moses Wa Malwa Mukamari-V- John O Makali* (HCC 42/2012) (2012)eKLR
226. *Mumias Sugar Company Ltd –V- Njewaka Supermarket* (2006) eKLR
227. *Murage & Mwangi, Advocates V Kenya Power & Lighting Company Limited* [2009] eKLR
228. *Music Copyright Society Of Kenya Ltd –V- Parklands Shade Hotel Ltd T/A Klub House* (2000) KLR 569
229. *Myers –V- Elman* (1940) A.C. 282
230. *Naomi Chege –V- Republic* (2008)eKLR,
231. *National Bank Of Kenya Limited -V- E. Muriu Kamau & Another* [2009] eKLR
232. *Njeri Wangari & Insemia Inc. Publishers-V- Oxford University Press(EA) Ltd.* (2012)eKLR
233. *Noctor –V- Asburton* (1914) AC 932
234. *Olympik Sports House Ltd –V- School Equipment Centre Ltd* (2012) eKLR
235. *Oracle Productions Ltd –V- Decapture Ltd And 3 Others* (2014) eKLR
236. *Osho Chemicals Industries Ltd –V- Agrichem And Tools Ltd And Another* (2008) eKLR
237. *Otter –V- Church, Adams, Tatham & Co.* (1953) Ch. 280
238. *P.A.O And 2 Others –V- AG* (2012) eKLR
239. *Panduit Corp. -V-. Stahlin Bros. Fibre Works, Inc.* (575 F.2d 1152, 197 U.S.P.Q. 726)
240. *Parke Davis & Co. Ltd –V- Opa Pharmacy Ltd* (1961) IEA (556)

241. *Pastificio Lucio Garofalo SPA –V- Dehenham & Fear Ltd* (2013) eKLR
242. *Performing Rights Soc. Ltd –V- Grand Theatre And Another* (1973) EA 576
243. *Peter Nganga Muiruri-V- Credit Bank Limited & 2 Others*. C. A 203 Of 2009
244. *Peter Njoroge Wakaba –V- R* (2000) eKLR
245. *Pharmaceutical Manufacturing Co Ltd. –V- Novelty Manufacturing Ltd.* (2000)eKLR
246. *Pharmaceutical Manufacturing Co –V- Novelty Manufacturing Ltd* (2000) KLR 392.
247. *Phillips –V- Symes* (2004) 4 ALL ER 519.
248. *Polaroid Corp. -V-Eastman Kodak Co.*, 16 U.S.P.Q.2d 1481, 1525-32 (D. Mass. 1990
249. *Premier Food Industries Ltd –V- Al-Mahra Ltd* (2006) eKLR.
250. *Proctor And Allan (EA) Ltd –V- Best Feed (EA) Ltd* (2007) eKLR
251. *R & T Thew Ltd V Reeves* (No 2) [1982] 3 All ER 1086
252. *R –V- Registrar Of Trade Marks And Another Ex-Parte Sony Holdings Ltd* (2014) eKLR-
253. *Ralph C De Souza- V- R Mandavia And Another* [1964] 1 EA 682
254. *Ralson (India) Ltd –V- Doshi Iron Mongers Ltd* (2010) eKLR
255. *Rattan Singh –V- G.R Mandavia* (1961) EA 61
256. *Re An Application By The American Cyanamis* (1968)IEA 270 (HCC)
257. *Re Application By Bourjois Ltd* 1964) IEA 265 (HCC)
258. *Re G And Others (Children) (Care Proceedings: Wasted Costs)* (1999) 4 All ER 371
259. *Rees –V- Sinclair* (1974)1 NZLR 180
260. *Reference Moto Tribunal Vestergaardfrandesen Su, Vesterguardfrandesen Group As And Vesterfuardfrandsen (E.A) And Ole Skaumand And Ittellegen Insect Controll (Sarl) As To Ownership Of Patent Application Vasterguard Frandesees Sa –v- Ole Skouand*
261. *Registrar Of Companies –V- Music Copyright Society Of Kenya* (2004) eKLR.
262. *Republic –V- Kenya Association Of Music Producers(KAMP) & Others & Ex Parte Pubs, Entertainment And Restaurant Association Of Kenya* (2014) eKLR
263. *Republic –V- Minister For Trade And 4 Others Exparte Durran Sounds Investment Company Ltd And Other* (2011) eKLR
264. *Republic –V- Registrar Of Trademarks Ex Parte Sony Holdings Limited* (2012) eKLR
265. *Republic –V- The Kenya Revenue Authority Ex Parte Beirsdofe E.A. LTD* (2011) eKLR
266. *Ridehalgh – V- Horsefield And Another And Other Appeals* [1994] 3 All ER 848
267. *Robert Mwangi V Shepherd Catering Limited & Another* [2012]eKLR.
268. *Rondel–V- Worsley* (1967) 3 ALL ER 993
269. *Rose –V- Counters* (1980)1 Ch. 297
270. *Roy –v- Prior* [1970] 2 All ER 789

271. *Royal Media Ltd –V- AG And Others* (2013) EKLK
272. *R-V- Weisz* (1951) 2 K.B 611
273. *S. N. Valli T/A Baby Steps Kindergarten –v- Hasham Lalj Properties Ltd & Another* [2008] eKLR
274. *Sabaf Spa –V- MFI Furniture*(2003)EIPR 188
275. *Safepak Limited –V- Dynaplas Limited* (2002) eKLR
276. *Safepak Ltd –V- Asili Plastics Limited* (2013)eKLR
277. *Safepak Ltd –V- Power Plast Industries Ltd* (2014) eKLR
278. *Safepark Limited –V- Malplast Industries Ltd* (2007)eKLR
279. *Safepark Ltd –V- Asili Plastics Limited* (2013) eKLR
280. *Saif Ali -V- Sydney Mitchell & Co* [1978] 3 All ER 1033,
281. *Saif Ali--V-- Sydney Mitchell & Co.*(!980) A.C .198
282. *Samaki Industries (Nairobi) Ltd –V- Samaki Industries (K) Ltd* (1995-1998) EA 369
283. *Sanitam Serices (EA) Ltd. -V- Tamia Ltd.* (2012) eKLR
284. *Sanitam Services (E.A) Ltd –V- Rentokil (K) Ltd.* (2012) eKLR.
285. *Sanitam Services (EA) Ltd –V- Rentokil (K) Ltd & Anor* (2002) eKLR
286. *Sanitam Services (EA) Ltd –V- Tamia Limited And 16 Others* (2012) eKLR
287. *Santam Services(EA) Ltd. –V- Rentokil (K) Ltd* (2014)eKLR
288. *Sapra Studio –V- Tip- Top Clothing Co. Ltd* (1971) 1 EA 489
289. *Saudi Arabian Airlines Corporation –V- Saudia Kenya Enterprises Ltd.* (1986) KLR 102
290. *Sharif And Others -V- Garrett & Co (A Firm)* (2002) 3 All ER 195
291. *Smith -V- Linskills* [1996] 2 All ER 353
292. *Sollatek Electronic (K) Ltd –V- Lifting Equipment Co. Ltd* (2010) eKLR.
293. *Spa -V- Jamale And Another* (2000) KLR 223
294. *Stanton And Another -V- Callaghan And Others* (1998)4 All ER 961
295. *Stanton-V- Callaghan* (1998)4 All ER 961
296. *Steel Structures Limited –V- David Engineering Limited* (2007) eKLR
297. *Strategic Industries Limited -V- Sana Industries Limited* [2008] eKLR
298. *Supra Studios –V- Tip- Top Clothing Co.* (1971) 1 EA 489
299. *Swindle –V- Harrison* (1997) 4 All E.R 705
300. *Taylor And Others -V- Serious Fraud Office And Others* (1998) 4 All ER 801,
301. *The Insurance Company Of North America -V- Baerlein And James* (1960) EA 993
302. *In the matter of Trade Mark Application Nos. 63725 ‘Wakilisha’ (Word & Device) INO Wakilisha Ltd & Expungement Proceedings By Vision 2030 Delivery Secretariat.*

303. *Trade Mark Application No. 71143 'Pay Xpress word And Device) In Class 36 INO Ecobank Transnational Incorporate.*
304. *Trade Mark No. 58890 INO Inter-Consumer Products Ltd. and Opposition Thereto By L'Oreal Ltd.*
305. *Triumph Development Limited -V- Golden Biscuits (1985) Limited & Another [2007] eKLR*
306. *Unilever PLC –V- Bidco Oil Industries (2004) 1KLR 57*
307. *Vernon –V- Bosley (No 2) (1997) 3 W.L.R 683*
308. *Village Photoshop Ltd –V- Mercy Wanja Mutegi T/A Digiclicks Photographers & Another (2012)eKLR*
309. *Village Photoshop Ltd –V-Mercy Wanja Mutegi T/A Digiclicks Photographers And Sally Jacquelline Mutegi T/A Digiclicks Photographers (2014)eKLR*
310. *Watson –V- M'Ewan, Watson-V- Jones ((1905) AC 480*
311. *White And Another -V- Jones And Others [1995] 1 All ER 691*
312. *Wilson Muriithi Kariuki T/A Wiskam Agencies –V- Surghipharm Ltd. (2014) eKLR*

TABLE OF ABBREVIATIONS

A.C	Appeal Cases
A.G	Attorney-General
ALL ER	All England Reports
B & C	Barnewall and Cresswell's Report
B & S	Best and Smith's Reports
Batt	Batty's Reports
Beav	Beavn's Reports
Bing	Binghams Reports
Broun	Broun's Justiciary Report
Burr	Burrow's Report
C . A	Court of Appeal
C . B	Common Bench Reports
C . B (N . S)	Common Bench Reports, New Series
Ch	Chancery Law Reports
C . J	chief Justice
cl & Fin	Clark and finnerlly's Reports
Cox & Atk	Cox and Artkinson Registration Appeal cases
CMO	Collective Management Organisation
Dan	Daniell's Reports
Dods	Dodson's Reports
Drew.	Drewry's Reports
E.A	East Africa Report
EIPR	European Intellectual Property Office
E.A.C.A	East Africa Court of Appeal Report
eKLR	Electronic Kenya Law Reports
E & E	Ellis and Ellis's Report
ETMR	European Trade Mark Reports.

Eg.	Exempls gratua, for example
etc	and other things
Exch	Exchequer Reports
Ibid	above
I . e	Indest, that is
IPA	Intellectual Property Act.
IPRs	Intellectual Property Rights
IPT	Intellectual Property Tribunal.
F&F	Faster and Finla Son's Reports
Falc	Falconer's Report
H&C	Hurlstone and Coltman's reports
HCCC	High Court Civil Case
HL	House of Lords
J	(after a judges name) Justice
J A	Judge of Appeal
K. B	King's Bench Reports
KECOBO	Kenya Copyright Board
KIPI	Kenya Intellectual Property Institute.
KLR.	Kenya Law Reports
L . C	Lord chancellor
L. J.	Lord Justice
LLM	Master of Laws
Macg-	Macqueen's Scotch Appeals
M.R.	Master of Rolls
Murr	Murray's Reports
Peake	Peake's Reports
Re.	In the case of
Supra	As stated above
UCC	Universal Copyright Convention 1952
V	Versus
WIPO	World Intellectual Property Organisation
WTO	World Trade Organisation

CHAPTER ONE;

ADDRESSING PROFESSIONAL NEGLIGENCE IN INTELLECTUAL PROPERTY RIGHTS BAR IN KENYA

1.1 Introduction

The work of professional men and women is clearly complex. It culminates from a long period of training and apprenticeship before maturity. It is characterized by specialized skill, ability, or some special qualifications derived from training and experience. Professionals must exercise reasonable degree of care and skill. The test of this standard is the reasonably competent practitioner in a particular circumstance having regard to the standard normally adopted in his profession.¹ However, due to the changing nature of their technical enterprise and emerging technologies, chances of establishing this standard in new areas can be difficult and challenging.

As society advances and information becomes readily available, citizens become exposed to the standards that professionals are bound to maintain. Any unfavorable consequence to a client's case is interpreted negatively on the quality and ability of the professional rather than on other intervening factors. As a result, professional men are increasingly exposed to litigation by their disgruntled clients for breach of duty. Insurance companies occasionally take advantage of this situation as an excuse to increase insurance premiums to diffuse this risk. In response, fees charged by professionals like lawyers, under the official remuneration order, which is hardly ever followed in practice in Kenya due to undercutting, is regularly increased. These increments are intended to cater for increased cost of living including the consequences of litigation arising from suits instituted by their disgruntled clients.² This ultimately leads to high costs of professional services. This problem is more profound in more technical areas of practice by lawyers. For example, in legal practice, Intellectual Property Rights (IPRs) provide technical challenges to judges and lawyers. Litigation involving trademarks, patents, copy rights,

¹ See *Midland Bank-v- Hett, Stubbs and Kemp* as per Oliver J(1979) Ch 384

²Since 2006, for example, The Advocates (Remuneration) Order has been amended three times in 2006, 2009 and 2014 with each new order increasing the charges for services rendered by Advocates significantly. For example a defended claim filed in the High Court whose subject matter is Ksh. 1,000,000/ has advocates fees increased from Ksh.77, 000/ to Ksh. 120,000/ from 2006 to 2014.

industrial designs, and other intellectual properties contain scientific and technological issues which most lawyers and judges are not trained to handle in law schools. Since science and technology develops faster than the law³, many trained lawyers are occasionally unable to catch up with new advances or emerging developments in a particular area. Consequently, the question of the standards of legal practice by lawyers in a field like cybercrime in IPRS becomes quite complex.

As lawyers sign retainers with their clients, chances of breach in terms of contract, negligence in tort, or a violation of a fiduciary duty not to abuse the position of trust in the special relationship, may occur⁴. Immunity is a privilege or insulation available as a defense to certain category of people who would otherwise be exposed to litigation for violations of the law. Judges and judicial officers are immune from litigation that may arise from their official function.⁵ Until quite recently, barristers and solicitors in England enjoyed some form of immunity from litigation emanating from professional negligence.⁶ Our legal experience is borrowed from the English practice, even though it is system is fused⁷. The developments in England are not necessarily adopted in our system without qualification. The scope of this research is to interrogate civil liability against advocates for professional negligence with bias to IPRs in Kenya and to establish why the defense of immunity may not be successfully advanced to shield advocates from liability for professional negligence. Since practice in this area is both complex and demanding, there are limited materials on the suitability of the current legal infrastructure to address the ever changing scientific developments in IPRS and the risks lawyers expose themselves to as they practice in this area.

³ See Sheila Jasanoff, *Science at the Bar; Law Science and Technology in America* (Harvard University Press) , pp 1-23

⁴ See *Noctor-v- Ashurton* (1914) A.C. 932

⁵This is clearly set out in article 160(5) of The Constitution of Kenya, 2010. See (Government Printers, Nairobi, 2010)

⁶ Immunity against liability for negligence in England was confirmed in *Rondley –v- Worsley* (1976) 3 All ER. 993 (HL) and more recently in *Arthur J. S. Hall –v- Simons* (2000) 3 ALL ER 677 (HL) where in a ruling of four judges with three dissenting held that immunity is no longer necessary in civil matters.

⁷ See Justice Spry J in *Champion motors Spares –v- Padke* (1967) EA 44 who made this observation

1.2 Background of the Problem

Kenyans have become increasingly aware of their rights owing to the promulgation of The Constitution of Kenya, 2010. Cases lodged in our courts have steadily increased⁸. Judicial officers are faced with new challenges while conducting official functions.⁹ Complaints against lawyers have increased to dangerous levels.¹⁰ Actions for professional negligence are likely to increase with time.

Surprisingly, judicial officers are immune from actions arising from the performance of their duties¹¹. Prosecutors, parties¹² and witnesses¹³ are insulated from civil actions arising from their testimony and duties conducted in courtrooms. The exception to this rule is the offence of perjury¹⁴, dishonest fabrication of evidence¹⁵ and contempt of court.¹⁶ These exceptions are criminal in nature. The position of the advocate prosecuting or defending the same matter is not clear. What is the justification of this double standard in the practice of law in open court?

⁸ The Chief Justice of Kenya in his address on the state of Judiciary during the period June 2011 to June 2012 noted that a total of 428,827 cases had been instituted in the Kenyan courts. A total of 421,131 cases had been finalized whereas 802,570 cases were still pending. See the [www.judiciary.go.ke/portal/assets/files/reports/STATE OF THE JUDICIARY ADDRESS 2011-2012](http://www.judiciary.go.ke/portal/assets/files/reports/STATE%20OF%20THE%20JUDICIARY%20ADDRESS%202011-2012) accessed on 11.10.2013

⁹ For example in *Moses Wamalwa Mukamari-v- John O Makali* (HCC 42/2012) (2012eKLR.) a Judge was sued, together with other defendants, in her personal capacity by a disgruntled party in a previous matter she had presided over and issued certain orders against the current plaintiff.

¹⁰ This is well documented in Rosaline Korir, *Professional Self -Regulation And The Challenges In Enforcing Professional Discipline, A Case Study Of The Advocates' Disciplinary Process*, (LLM thesis, UON. 2008)

¹¹ See Article 160 (5) of the Constitution of Kenya, 2010.

¹² Justice Dip lock in the English case of *Saif Ali –v- Sidney Mitchell & Co* (1980) AC 198 (HL) said that the immunity of barristers is part of the general immunity enjoyed by all persons participating in court proceedings.

¹³ In England for example, witness immunity was extended beyond civil liability in *Meadow –v- G.M.C* (2006)EWHC 146 and *Phillips –v- Symes* (2004) 4 ALL ER 519 . Lord Halsbury LC held in *Watson-v- Jones ((1905) AC 480* that the necessity of compelling witnesses to attend court in the administration of justice, involves the condition of immunity of witnesses from actions arising from evidence given by them. This privilege extends to the evidence narrated by the witness to the solicitor before attending court. It is based on public policy designed to ensure that trials are conducted without undue stress of possible future litigation on one's evidence. It extends to expert witnesses as was held in *Stanton-v- Callaghan* (1998)4 All ER 961.

¹⁴ See Section 109 of the Penal Code, Cap 63 Laws of Kenya (Government Printers, Nairobi 2010).

¹⁵ In England, this was confirmed in *Evans –v- London Hospital Medical College* (1981) 1 WLR 184.

¹⁶ Offences against judicial proceedings including contempt of court are punished under section 121 of the Penal code. Contempt of court arising from disobedience of a court order is punished using the same procedure followed in the Supreme Court in England. See S 5, The Judicature Act, Chapter 8, Laws of Kenya.

Our legal profession is borrowed from the English experience. In England, two systems consisting of solicitors and barristers exist.¹⁷ Barristers had enjoyed blanket immunity against actions for professional negligence until the House of Lords decided differently in *Arthur J. S. Hall –v- Simons*.¹⁸ Solicitors too enjoyed limited immunity while conducting duties in court until that decision.¹⁹ In Kenya however, the position has never been investigated in detail. Unlike in England, we do not have legislation, policy or regulatory framework on this issue. Furthermore, the English position is persuasive and not necessarily binding in Kenya. It is therefore necessary to investigate the Kenyan position and to make a clear finding on this matter.

Finally, registration and litigation on trademarks, copyrights, patents, industrial designs and other intellectual properties is highly specialized. The risk of falling below the standard of care is real. This misfortune can lead to massive losses to the client. Can a lawyer facing allegations of negligence by a client benefit from the defence of immunity based on the complexity of IPRs protection?

1.3 Objectives of the study

The purpose of this study is firstly to interrogate the prevalence of professional negligence conduct in the bar in Kenya in the field of IPRs. Our study will seek to establish the areas of practice within the field of IPRs where practitioners are culpable for negligence. We will advance the case of immunity as a defence against liability for professional negligence in IPRs practice and see the chances of success of this defence. Litigation and registration of intellectual property rights will be the reference point of our study. This is partly due to the complexity of issues surrounding this practice. Within this general context, we will seek:

1. To enhance the general understanding of the defence of immunity against liability for professional negligence in the arena of IPRs in Kenya. This will involve interrogation of

¹⁷ Justice Spry J.A said in *Champion Motor Spares Ltd –v- Phadke & Others* (1967) EA 42 that English cases are not so helpful since Kenya is a unified profession whereas in England, the system of barristers and solicitors is separate.

¹⁸(2000) 3 All ER 673.

¹⁹ In *Acton –v- Graham Pierce & Co.* (1997) 3 ALLER 909, it was held that no action lay against a solicitor for wrong conduct on a defense against his client.

the theoretical, legal and policy reasons advanced in support and against the defence of immunity against liability for negligence in the bar.

2. To evaluate the prevalence of professional negligence in the legal profession in Kenya in the field of intellectual property rights.
3. To establish the general perception of the society, other professionals and lawyers on immunity as a defence against liability for negligence.
4. To establish why immunity as a defence against liability for negligence is not available for lawyers in Kenya in the cases involving IPRs.
5. To give practical ways in which IPRs practitioners may avoid liability for professional negligence in order to protect the public.

1.4 Statement of the problem.

The practice of law in Kenya is dynamic. It is faced with new challenges in emerging areas of legal practice. The Constitution of Kenya, 2010 has opened up civil liberties of citizens to great levels. Lawyers must now be more professional than before to remain relevant. Negligence in the legal profession will soon be very expensive to advocates. The risk of prosecution for negligence leads to another problem. The annual insurance premium for professional indemnity policy for lawyers has been in a steady increase²⁰. One reason given by brokers is the ever increasing risk of prosecution for professional negligence. Furthermore, as more advocates are admitted to the bar and the society advances, new frontiers in legal practice develop. More litigants are likely to develop appetite for suing their legal advisers for negligence. Lawyers have high chances of being trapped in this web. Practitioners in highly specialized areas of practice are more exposed. If advocates are immune from liability for professional negligence, insurance companies can be persuaded by the Law Society of Kenya to reduce charges on annual premiums for professional indemnity policies.

In Kenya, IPRs practice is relatively new. Many challenges arise in the registration and litigation of disputes involving these rights. Under the regulations published by the Council of Legal Education for admission to the Kenya School of Law, IPRs is not one of the compulsory units

²⁰ For example the author paid Ksh. 50,000/ more for the same insurance cover for the year 2013 than 2012.

required of lawyers before admission.²¹This research is intended to see whether training of lawyers is a critical contributory factor to this negligence.

Judicial officers have not appreciated the concept of immunity. Judgments given in local courts are brief and shallow.²² It is necessary to carry out research in order to lay basis for more robust future judicial pronouncements.

The general public must be protected from negligence by lawyers. This can be done by equipping lawyers with practical skills like proper book keeping, proper preparations, adequate planning and continuous legal education. It is important to interrogate how such skills improve the meticulousness of lawyers and reduce incidences of professional negligence. The study is intended to investigate this aspect and to see how other jurisdictions have addressed this aspect in a practical way.

Finally, clients who request for services in the protection of Intellectual Properties are generally exposed on the science or practice behind this art. For example, in the description and claims on patent disputes²³, many clients are probably more updated on the scientific developments behind these inventions than their lawyers. These clients are generally corporate and therefore financially endowed. They litigate to protect their intellectual rights due to their understanding of the dynamics of our society. Damages arising from infringement of IPRs may be huge since

²¹ Admission of advocates to the bar is governed by the law. Some of the requirements are set out under Regulation 5(2) (a) of the Council of Legal Education (KSL) Regulations, 2009. The relevant qualifications of admission to the Kenya School of Law in the prescribed universities under Paragraph 20 of Part III of the Third Schedule to the Council of Legal Education (Accreditation of Legal Education Institutions) Regulations. There is no mention of any IPRs subject as a core unit under these regulations.

²²In *National Bank of Kenya Ltd –V- Muriu Mungai & Co Advocates*, (eKLR.) 2009 the High Court of Kenya sitting at Milimani law courts gave judgment against the defendant, a firm of advocates, for professional negligence for the sum initially claimed by the plaintiff in a previous suit. The initial suit giving rise to this claim involved a bank loan advanced to a debt of the plaintiff. The original suit was dismissed due to a technicality because of the failure by the defendant to file a proper verifying affidavit accompanying the plaintiff's claim. The defence of immunity against liability for negligence was however never raised during the entire trial. This matter is pending in the Court of Appeal in Nairobi. In *Kirima Estates (U) Ltd –v- K. G. Korde (1963) EA 636* an advocate was held liable for misadvising a client. The defence of immunity was also not raised during the trial.

²³ These are provided for under section 34 of the Industrial Property Act 2001.

the period of protection for information disclosure is long²⁴. If a client sues his advocate for loss of use of his IPRs caused by his or her professional negligence, the damages payable, calculated on the basis of these long periods of protection, are massive. It is therefore necessary to examine the training of lawyers, in light of professional negligence in the arena of IPRs in order to increase the wealth of knowledge in this specialized area of legal practice.

1.5 Theoretical Framework

Natural law philosophers argue that law is grounded on justice and common good²⁵. Natural law refers to a type of moral theory and a type of legal theory but it does not refer to the law of nature that science aims to describe. These jurists argue that all humans are governed by laws of nature which are separate and distinct from laws which are legislated. While explaining the concept of social contract, Thomas Hobbes stated that the state of nature in which man lived before social contract was war of every man against every man²⁶. Law and government became necessary for promotion of personal security and for self-preservation.²⁷ Since 'there is a kind perfect justice given to man by nature and that man's laws should conform to this as closely as possible'²⁸ there are some standards to which each society must subscribe to remain relevant. The legal profession must conform to these moral standards established by practice. Lawyers owe a moral duty to protect the rights and interests of their clients in the required degree of skill and diligence. A breach of this moral duty calls for remedial measures through civil action.²⁹ This is because there is no wrong without redress.

Max Weber advanced the theory of distribution in a free market, structured by the state but dominated by private producers³⁰. Weber argues that the main dominance is economic gain

²⁴ For example, patents are protected for a period of 20 years (s 60 of the Industrial Property Act 2001), Trademarks for 7 years (s 23 on The Trademarks Act) while copyrights are protected for the life of the proprietor plus 50 years following his or her death under section 23 of The Copyright Act (Chapter 130 Laws of Kenya).

²⁵ Simmonds, N. E., *Central Issues in Jurisprudence, Justice, Law and Rights*, (London, Sweet & Maxwell, 2002) p. 125

²⁶ Hobbes, T., *The Leviathan*, Pt. 1, Chap. 13.

²⁷ Freedman, M., *Lloyd's Introduction to Jurisprudence*, (London, Sweet & Maxwell, 2008) at P.106 where it is argued that this concept justifies authoritarian rule and dictatorships.

²⁸ Martin, E.A., (ed) *A Dictionary Of Law*, (Oxford University Press New York 1997).

²⁹ Zitrin, R., *Legal Ethics in the Practice of Law* (The Michie Company Law Publisher, Virginia 1995) at page 168.

³⁰ Weber, M., *Economy and Society*, (University of California Press, London 1978) at pages 3- 4.

and attainment of social class. As a by-product of this structure, division of labor emerges and all actors seek protection since unregulated market is intolerable. Professions emerge as a specialized labor to enhance their chances in the market. They set rules to protect and regulate the market for its dominance. In the legal profession for example, rules on immunity against liability for acts done in good faith in the cause of duty by certain actors, like judicial officers, are some strategies used by the legal profession to dominate the market and to protect these actors in the market place.

1.6 Literature review.

Immunity in the bar in Kenya is a virgin concept. Save for the local cases which we will discuss below, we lack academic literature on this topic. Ethics in legal practice has been the main area of focus.³¹ Ethics refers to the moral standards that help guide behavior, actions, and choices.³²

A lawyer has a contractual duty to act skillfully towards his client.³³ The breach of this duty of care may lead to action based on contract or on the tort of negligence.³⁴ Professional negligence is the failure to exercise reasonable competence and skill in the discharge of duty.³⁵ The standard of care is that of a normal competent advocate but not the most experienced lawyer. The specialist advocate's standard of care is above that of the normal legal practitioner³⁶

Furthermore professional men possess specialized skills and qualifications derived from training and experience. In performing their duties, professionals undertake to exercise reasonable care and skill. An advocate does not undertake to win every case, or to use the highest possible

³¹ The best analysis is made by Rosylene Korir, *Professional Self -Regulation and the Challenges in Enforcing Professional Discipline, A Case Study of the Advocates' Disciplinary Process*, (LLM thesis, UON. 2008).

³² Tengku Mohd T. Sembok, *Ethics of Information Communication Technology (ICT)*, paper presented at the "Regional Meeting on Ethics of Science and Technology", 5-7 November 2003, Bangkok, pp. 243-244

³³ *Noctor –v- Lord Ashbury* (1914) A.C. 932 which was quoted with approval by Justice Upjohn in *Otter –v- Church, Adams, Tatha & Co.* (1953) Ch. 280 and later in *Dunlop –v- Woolarhra Municipal Council* (1981) 2 W.L.R 693.

³⁴ In *Midland Bank Trust Co –v- Hett, Stubbs & Kemp* (1979) Ch 84, Oliver J. held that an exhaustive review of the authorities concluded that a solicitor was liable in torts, independently of any liability in contract.

³⁵ It was held in *Henderson –v- Outred* (1995) AC 145(HL) by the House of Lords that a duty of care in torts by a firm of solicitors arose to their client independent of contract.

³⁶ Cranston. R, *Legal Ethics and Professional Responsibility*, (Oxford, Clarendon Press , 1995) at page 10

degree of skill.³⁷ Several legal principles have been developed to justify the concept of duty of care. One such Greek concept is *spondet peritiam artiset imperitia culpa adnumeratus* which implies that a person holding out to do certain work warrants possession of skill reasonably competent for its performance.³⁸ It presumes that professional men and women should possess certain minimum standards that must be displayed in their call of duty. In a nutshell, professional men and women should only be liable for gross negligence. At the same time, professionals should be allowed to practice without unnecessary threats. The balance of this equation is at times difficult to balance.

Many publishers have approached immunity from the arena of professional negligence. Among these authors are Charlesworth and Percy³⁹ in their book on Negligence. This book gives a detailed account on professional negligence by doctors and lawyers. The authors have analyzed professional negligence but have spent less time on the general principles behind the defence of immunity for liability for negligence in the bar in England.

W.V. Rogers in his book 'Winfield and Jolowicz on Tort'⁴⁰, argues that for many years, lawyers were not held liable to their clients for professional negligence while conducting litigation in court or while attending to matters closely connected thereto due to several reasons.⁴¹ The justification was pegged on the advocate's duty to the court. He explains that in order to be relieved from liability for negligence in a suit filed by disgruntled client, a lawyer was granted immunity in order to discharge his duty to the court⁴². Public interest demands that litigation must come to an end. Rogers correctly asserts that a case against a lawyer would amount to a retrial of the original suit. If, for example, the original case was criminal in nature, a subsequent civil matter filed against the advocate to ventilate that conviction may lead to two conflicting decisions on the same facts. This situation may amount to disrepute in the administration of

³⁷ Justice Tindal C.J held in *Laphier –v- Phinos* (1883) 8 & 7 at p 497 that only reasonable skill and care is required, but not the highest possible degree of care.

³⁸ This rule was established in England in *Jenkins –V- Bentham* (1854) 15 CB.

³⁹ Charlesworth, *Charlesworth & Percy On Negligence*, (London, sweet and Maxwell, 1990)

⁴⁰ Rodgers. W, *Jolowicz and Winfield on Torts*, 17th Edition ,(London' Sweet & Maxwell, 2006) pages 220-224

⁴¹ This was confirmed in *Saif Ali-v- Sydney Mitchell & Co.* (1980) A.C .1980) A.C 198.

⁴² *Supra*, no. 13 at page 220.

justice. He supports the House of Lords holding in *Arthur J.S. Hall & Co –v- Simons*⁴³ which swept away this protection on grounds that immunity is no longer tenable and relevant in the English judicial experience.

In his book entitled '*Legal Ethics and Professional Responsibility*', Ross Cranston states that the justification of granting immunity is to allow advocates to pursue a client's case fearlessly and secondly, because of his wider duties to the court⁴⁴. According to the author, the strongest reason for insulation is to ensure finality in litigation, although again this presumes that losing clients have stamina for re-litigation.⁴⁵

Clerk & Lindsell on Torts add voice to this debate⁴⁶. After discussing *Ross –v- Caunters*⁴⁷, the authors opine that a solicitor is liable to third parties for negligence under the special relationship rule established in *Hedley Byrne & Co. Ltd –V- Heller & Partners Ltd*.⁴⁸ This special relationship is based on the contract between the advocate and his or her client, the duty of care in negligence, and the fiduciary relationship of trust consummating this relationship. On barristers, the authors borrow heavily from the celebrated case of *Rondley –v – Worsley*⁴⁹ where the House of Lords confirmed that no civil liability lay on barristers while acting as advocates in court. Later in *Saif Ali –v- Sidney Mitchell & Co. (A Firm)*⁵⁰ a barrister was held to be liable for negligence in pre-trial conference advice. However since there is no contract between the barrister and his client, there cannot be any liability for breach of contract⁵¹. This book does not comment on the current legal developments enunciated by the House of Lords in *Arthur J.S. Hall & Co –v- Simons*⁵² for the simple reason that it was authored in 1982.

⁴³(2002)1. AC 615.

⁴⁴ Lord Denning MR, in *Rondel-V- Worsley* (1966) 3 WLR 950 (HL) at page 962 stated that the advocates duty to the court is paramount. In his words: 'it is a mistake to suppose that he is the mouthpiece of his client to say what he wants: or a tool to do what he directs. He is none of these things. He owes his allegiance to a higher cause. It is the cause of truth and justice'.

⁴⁵ Cranston. R, *Legal Ethics and Professional Responsibility*, (Oxford, Clarendon Press) 1995 at page 11.

⁴⁶Clerk., *Clerk & Lindsell on Torts* (London, Sweet & Maxwell) 1982.

⁴⁷(1980) Ch. 384 (CH).

⁴⁸(1964) AC 465 (HL).

⁴⁹ Supra, note 35 above.

⁵⁰(1980) A.C. 198.

⁵¹ Supra note 44 above.

⁵²(2002)1. AC 615.

On top of the contractual and tortious duties owned by a solicitor to his client, a fiduciary relationship exists.⁵³ Jackson & Powell on Professional Negligence⁵⁴ lists seven areas of fiduciary relationship between a solicitor and his client in which disclosure of material facts may be actionable. These areas are; undue influence⁵⁵, personal dealings with clients⁵⁶, obtaining personal benefit⁵⁷, using a fiduciary relationship to make a personal profit,⁵⁸ obtaining bribes and secret commissions,⁵⁹ and accepting inconsistent engagements.⁶⁰ The authors did not interrogate whether the defence of immunity against liability for negligence is available to solicitors on claims advanced by their previous clients.

In his article on lawyers' duties to court,⁶¹ Hon. Ipp gives a long list of various duties⁶² of lawyers to court, namely; to state the law, not to mislead on the facts and not to knowingly permit a client to deceive the court.⁶³ These duties are not limited to any one suit but to proceedings in other separate cases.⁶⁴ They include the duty not to abuse court process for ulterior purposes,⁶⁵

⁵³ See *Clark Boyce-v- Mouat* (1994) 1 A.C 249.

⁵⁴ Jackson, Rupert m. *Jackson & Powell on Professional Negligence*, (London, Sweet & Maxwell) 2002

⁵⁵ See *Liles -v- Terry* (1895) Q.B. 679 C.A where a voluntary conveyance of property by client to solicitor was declared void for undue influence.

⁵⁶ For example in *Noctor -V- Ashburton* (1914) AC 932 where a solicitor who had a personal interest in a transaction his client was entering into and who acted for the borrower who were the other party to the transaction were held in breach of their fiduciary duties to their client since the solicitor did not disclose his interests in the transaction. This case was approved by Justice Mummery L.J. in *Swindle -v- Harrison* (1997) 4 All E.R (HL) 705 at 732.

⁵⁷ For example, in *Brown -v- Inland Revenue Commissioners* (1965) AC 244, where a solicitor invested client's money on interest for personal gain.

⁵⁸ Like in *Boardman -v- Phillips* (1967) 2 AC 46 where a solicitor bought shares from a non performing company after attending the boards meetings and used the information to make profit while investigating the company. He was in breach of his fiduciary duties.

⁵⁹ In *Islamic Republic of Iran -v- Denby* ((1987) 1 Lloyd's Rep. 367 a solicitor's client, a defendant in a shipping dispute, used his solicitor to pay a commission to obtain a prompt and satisfactory settlement. This was seen by judges as a bribe. He was then forced to refund the money to his client.

⁶⁰ Like in *Bristol West Building Society -v- Mathew*(1998) Ch.1 where a solicitor who acted for both the lender and the borrower in the same transaction and who failed to disclose the borrower's ineptness to the lender was held to be in breach of his fiduciary duties to the lender.

⁶¹The Hon. D.A. Ipp, 'Lawyers' Duties to the Court,' (1998) LQR. 114.

⁶² In Kenya these duties were recently confirmed by justice F Gikonyo in *Guardian Bank Limited -V- Sonal Holdings (K) Limited & 2 others* [2014] eKLR. when he stated; ' must realize that the advocate has a duty not only to himself or his client in the suit, but to the opponent and the cause of justice';

⁶³*Glebe Sugar Refining Co. Ltd -v- Trustees of the Port & Harbour of Greenock* (1921) W.N. 85 at p. 86

⁶⁴As in *Vernon -v- Bosley (No 2)* (1997) 3 W.L.R 683 where it was held that failure to disclose inconsistent evidence tendered in separate proceedings by a party led the court to be seriously misled.

not to corrupt the administration of justice,⁶⁶ and to conduct cases efficiently and expeditiously⁶⁷. These duties are so central that the defence of immunity is not available to counsel upon breach⁶⁸. He asserts that where there is a conflict between counsel's duties to his client and to the court, the duty towards the court will always prevail.⁶⁹ According to this author there many reasons advanced to justify immunity against liability for negligence. These reasons include the divided loyalty of a barrister to his client, the analogy of the protection of the witnesses, collateral challenge to previous proceedings, the cab rank rule under which a barrister cannot choose any brief, and the difficulty of carrying out instructions.⁷⁰

Section 50 of The Advocates Act⁷¹ makes it illegal for an advocate to contract to avoid liability arising from a duty based on contract or torts. Although quiet on the issue of immunity, this section implies that an advocate may be liable for negligence.

Judges in East Africa have also added impetus to this debate. For example, in *Torlachan Singh Rai –v- J. S. Gopal and Others*,⁷² Sheridan J. sitting in the High Court of Uganda held that the 'principles governing the duty of care owed by an advocate to his client in contentious matters are set out in Halsbury's Laws of England (2nd Ed.), Vol. 31, p. 133 (para. 180). It is not for every mistake that an advocate can be held to be professionally negligent'⁷³ This position was later confirmed in *Champion Motor Spares Ltd v Phadke and others*⁷⁴ where it was held that an advocate is not liable for professional negligence for an error of judgment but for gross negligence or for ignorance of clear provisions of the law. The same position was captured in

⁶⁵For example in *R-v- Weisz* (1951) 2 K.B 611, a solicitor filed a suit against a book maker which could not be maintained in law hoping bad publicity would force the bookmaker to pay. The suit was held by Lord Goddard C.J to be in contempt.

⁶⁶ For instance allowing the swearing of a false affidavit as was in *Myers –v- Elman* (1940) A.C. 282.

⁶⁷This was held to be in public interest in *Boyle –v- Ford Motor Co. Ltd* (1992)1 W.L.R. 476.

⁶⁸Lord Denning M.R. in *Kelly –v- London Transport Executive* (1982) 1 W.L.R 1055 held that a counsel cannot escape from breach of duty on account of immunity.

⁶⁹Mason J. confirmed this principle in *Giannerelli –v- Wraith* (1988) 165 C.L.R 543 at p.556 when he said: 'the duty to the court is paramount even if the client gives instructions to the contrary'.

⁷⁰These reasons were discussed by the House of Lords in *Arthur –v- Simons* (2000)3 All ER 686.

⁷¹Chapter 16 Laws of Kenya.

⁷²(1960) 1 EA 989.

⁷³Ibid at page 992.

⁷⁴[1969] 1 EA 42 (CAK).

*The Insurance Company of North America v Baerlein and James*⁷⁵ in which an advocate was held liable for the negligent drafting of a bill of sale. The court found that the error went beyond a normal error of judgment and constituted professional negligence. The defence of immunity was not raised in any of these cases. However in the case of *Chanan Singh & Gajjan Singh –v- Chanan Singh & Handa*⁷⁶, it was held that advocates in Kenya are liable for negligence in respect to non-performance or mal-performance of any duty which in England would normally fail to be performed by a solicitor. In *National Bank of Kenya Limited v E. Muriu Kamau & another*⁷⁷ Justice Warsame held the defendant liable for negligence for drafting an incompetent verifying affidavit leading to the striking out of the plaint. The appeal lodged by the firm in the Court of Appeal was compromised and withdrawn before the matter was due for hearing. The defence of immunity was however not canvassed during the hearing of the matter. Another important suit in this debate is *Apollo Insurance Company Ltd –v- Flavia Rodrigues t/a Flavia Rodrigues & Co Advocates*.⁷⁸ In that case, Justice Mary Ang’awa upheld immunity of advocates as a defence against liability for negligence in the bar. In this case, the advocates had failed to attend court and adverse orders entered against their client. However, even though the defence of immunity against liability for advocates was confirmed, no reasons were advanced for the grant of such immunity in the bar capable of setting a firm position on this issue in Kenya.

Many countries do not shield lawyers against liability for professional negligence. In fact this defence was mainly developed in England to protect barristers due to the cab rank rule. It was thereafter borrowed by some few common wealth countries. Now that the defence was denounced in England, other counties like Ireland and Australia are likely to adopt the decision in the House of Lords in *Arthur J.S. Hall & Co –v- Simons*.⁷⁹ Most advanced jurisdictions like America, Canada, South Africa, India and European Union members do not entertain this defence. In chapter four, will see how some of these countries have managed to address issues of professional negligence in the bar in a more practical way.

⁷⁵1960] 1 EA 993 (HCU).

⁷⁶25(KLR) 55.

⁷⁷[2009] eKLR.

⁷⁸Nairobi HCC 431 of 2002 (unreported)

⁷⁹ Supra 53 above.

1.7 Research Hypothesis

This research is based on the following proposed hypothesis;

1. Conduct amounting to liability for professional negligence in the bar in Kenya in the arena of IPRs is quite common.
2. Lawyers in Kenya do not enjoy immunity from liability for negligence on professional negligence especially in IPRs practice.
3. Professionals in Kenya believe that Lawyers should enjoy limited immunity against liability for professional negligence similar to that enjoyed by solicitors and barristers in England.
4. The general public in Kenya belief that the defence of immunity against liability for professional negligence in the bar in Kenya in the field of IPRs is not justified.
5. Other practical skills should be introduced in order to reduce incidences of professional negligence in the bar.

1.8 Research Questions

This study will seek to answer the following questions;

1. What are the possible reasons for the defence of immunity against liability for professional negligence at the bar in Kenya in the arena of IPRs?
2. Why should this defence be disregarded Kenya?
3. What steps should be taken to reduce incidences of professional negligence among IPRS practitioners in Kenya?

1.9 Research Methodology

The study will adopt a multi-disciplinary approach in order to achieve the intended results. The methods of research will include the following methods;

1. Library research which will provide the opinion of scholars and authors on the defence of immunity against liability for negligence in the bar. Published textbooks, journal articles, historical works, Masters and PHD thesis and other publications will help review the existing literature. Reported cases and internet research will assist us answer part of our research questions.
2. We will also employ qualitative research⁸⁰ by way of a purposeful sampling technique⁸¹ to get the specific information with respect to the objectives of this research. Snowball (or chain referrals) sampling will be employed to get information from experts on this field and members of the public involved in disputes involving IPRs. This will be by way of holding interviews, observations and getting information from a specific target sample. A semi structured questionnaire developed to solicit specific answers central to the research questions will be the main vehicle. The target group will be lawyers, judicial officers, other professionals, the public officers of Kenya Industrial Property Institute (KIPI) and the Kenya Copyright Board (KECOBO).

1.10 Chapter Breakdown

The study will be captured in four chapters made up as follows:

Chapter one entitled 'Introduction' will give the background analysis of the problem, the theoretical framework, the study methodology, justification for the study, the research question, issues significant to the study, the hypothesis for the study, literature review and the chapter breakdown.

Chapter two entitled 'the concept of immunity against liability for professional negligence in the bar in Kenya', will capture, the historical evolution, a critical analysis of the concept of immunity, its relevance in the administration of justice, and its status in Kenya. It will analyze issues surrounding practice of law in IPRS regime in respect to negligence and the defence of immunity against liability for negligence at the bar.

⁸⁰ According to Mugenda, this involves designs and techniques and measurements that do not produce discreet numerical date. See Mugenda. Olive M. *Research Methods: Qualitative & Quantitative Approaches*, (Nairobi, Acts Press, 2003) page 155.

⁸¹ This involves target group of people believed to be reliable for the research. See Kombo. Donald K, *Proposal and Thesis Writing, An Introduction*, (Paulines Publications Africa, Makuyu,).

Chapter three will seek to study the prevalence of negligence in the bar in the areas of practice involving IPRs. It will evaluate reported and unreported cases in the High Court, the Kenya Industrial Tribunal, the Registrar of Trademarks and the General Director of KIPi in order to isolate conduct amounting to professional negligence amongst advocates. It will also summarize our 'Research Findings' in which the data gathered in the field study will be analyzed in order to answer the research questions. It will outline the research methodology, profile of the participants and the integrity of the study whose findings will form the basis of our next chapter.

Chapter four will seek to conduct a comparative study of how other jurisdictions have tackled the issue of professional negligence amongst IPRs practitioners.

Chapter five will contain conclusions of the study and recommend policy and legislative reforms necessary to cure the problems enumerated in the research. It will also capture gaps in the study for future research.

1.11 Limitations

Lawyers in private practice are highly exposed to suits for professional negligence by their clients. Falling in this category, the author has a personal interest in the research. Personal interest will however not affect the main objective of this research.

The time frame for completing this research is short. Personal interviews will be limited to a maximum of one hundred persons across the divide. Out of the proposed number, the researcher will interview at least five judicial officers, five doctors, five engineers and five other professionals, ten lawyers, and at least twenty members of the public. These numbers are minimal. We hope that our sample will give the general feeling of the entire population.

Financial constraint will be a setback to this research. Carrying out personal interviews, extracting information, analyzing data and meeting strict deadlines is costly. Accordingly, the field study will be limited to Nairobi City County which might not necessarily reflect the general views of the rest of the country.

These limitations will not however completely negate the objectives of this paper and the final findings of the research.

CHAPTER TWO: THE CONCEPT OF IMMUNITY AGAINST LIABILITY FOR PROFESSIONAL NEGLIGENCE AT THE BAR IN KENYA.

2.1 Introduction

The principle applicable to all skilled labourers, lawyers included, is '*spondet peritiam artise timperitia culpa adnumeratus*' or as expressed differently '*spondet diligentiam gerendone gotio parem.*' Simply put, a person holding out to do certain work impliedly warrants his possession of skill reasonably competent for its performance. If he has not the skill he is liable for negligence.⁸²This principle implies that the standard of care and skill required is that of a reasonable, competent, and diligent advocate.⁸³On the other hand, the specialized advocate, an advocate of long experience, and a senior counsel must exercise a degree of skill commensurate with his specialty, experience and remuneration. Their standards are above the ordinary degree of care of ordinary advocates.⁸⁴

In Kenya, an advocate will only be liable for gross negligence in the performance of his professional services⁸⁵. A practitioner is not liable for any reasonable error⁸⁶ of judgment or for ignorance of some obscure point of law⁸⁷. He is also not liable for an error on a point of new occurrence or of doubtful construction.⁸⁸ Interestingly however, the determination as to

⁸² This was pronounced by Justice Tindal C.J in *Laphier –v- Phinos* (1838) 8 C& P 497, who added that an attorney undertakes a reasonable degree of care and skill.

⁸³ See *The Insurance Company of North America -v- Baerlein and James* (1960) E.A 993 at page 997) where Sheridan, J. held that the attorney is only liable for *crassa neglencia* (gross negligence) He stated that to maintain an action for negligence the advocate must be guilty of some misconduct, some fraudulent proceedings, or should be chargeable with gross negligence or gross ignorance.

⁸⁴ For example see Megary J in *Duchess of Argl –v- Bevselink* (1922)2 Lloyds 172.

⁸⁵ This was recently confirmed in *National Bank of Kenya Limited v E. Muriu Kamau & another* [2009] elk by Justice War same who found the firm to have been liable in negligence for drafting an incompetent verifying affidavit leading to the striking out of a plaint claiming the sum of Kshs. 10,000,000/ together with compound interest and failing to take any corrective action to protect the Bank. This matter is pending in the court of Appeal in Kenya for determination.

⁸⁶ In *Kogo –V- Nyamogo & Nyamogo Advocates* (2004) 1 KLR 367, the Court of Appeal held that: '*An advocate is not liable for any reasonable error of judgement or for ignorance of some obscure point of law, but is liable for an act of gross negligence or ignorance of elementary matters of law constantly arising in practice.*'

⁸⁷ This was confirmed in *Champion Motors Spares Ltd. –v- Phadke* (1969) E.A. 42 by Spry, J.A. while giving the main judgment after approving the speech of Lord Denning in *Rondel–v- Worsley* (1967) 3 ALL ER 993.

⁸⁸ See *De Souza –v- Mandavia* (1964) E.A 682 where Farrell, J. confirmed that the advocate was not liable for negligence since the point of law on the basis of which the client based his claim was new and novel and was of new occurrence.

whether professional conduct amounts to negligence or an error is a matter to be determined by the court after trial.⁸⁹ This is a very difficult question to determine since the border line between error of judgment and negligence is narrow.⁹⁰

As a matter of fact, the Kenyan legal experience can hardly be separated from that of our former colonial masters. Colonization of our country by Great Britain imported English systems and the common law in 1897 through the statute of general application⁹¹. British imperialists used legal instruments created in Britain to justify their presence in Kenya. Legal infrastructure was imported and developed to justify the colonial grant agenda of dominance. Many English legal practices were imported by our colonial masters into our country prior to independence in 1963. Since independence the development of *sui generis* principles in many areas of our legal environment, have been slow. Many times, judges import entire principles from common wealth countries into our jurisprudence without tailoring specific amendments to fit our practices.⁹² Other commonwealth countries like India, Canada, Australia and South Africa have however developed jurisprudence suited for their own practices. The English principles of professional negligence in the bar are therefore likely to be adopted substantially in our courts. However, our courts are likely to approach this defence with extreme caution since the position in England has already changed.

⁸⁹ See *Arthur J S Hall –v- Simons* (2000) 3 All ER 676 at page 682.

⁹⁰ Justice Duffus Ag V-P (as he then was) while sitting in The Court of Appeal in *Champion Motor Spares v Phadke* (1969) EA 42 at page 47 had this to say on the subject: ‘And moreover I accept the opinion of Tindal, C.J., in *Godefroy -V- Dalton*, 6 Bing. 460, that it would be extremely difficult to define the exact limit by which the skill and diligence which a solicitor undertakes to furnish in the conduct of a case is bounded, or to trace precisely the dividing line between that reasonable skill and diligence which appears to satisfy his undertaking, and that *crassa negligentia*, or *lata culpa* mentioned in some of the cases, for which he is undoubtedly responsible. It is a question of degree and there is a borderland within which it is difficult to say whether a breach of duty has or has not been committed

⁹¹ See section 3 of the Judicature Act (chapter 8 Laws of Kenya)

⁹² See for example the definition of negligence in *Donoghue –v- Stevenson* (1932)A.C. 502 where Lord Atkin defined negligence as the breach of a legal duty of care which results to damage to the claimant in the famous ‘neighbour principle’. Even though the Kenyan position static as per this definition, the English position has added more elements in the definition, which include the tripartite test in the duty of care established in *Caparo Industries Plc. -v-Dickman* (1990)2A.C. 605, where in determining the duty of care one must ask whether the harm was foreseeable, there was sufficient proximity between the parties, and whether the imposition of a duty of care would be fair, just and reasonable.

In order to appreciate the defence of immunity against liability for negligence at the bar, it is important to analyse the duties of an advocate towards his client in the arena of IPRs. This is so because it is as a result of the breach of these duties that actions for negligence arise.

2.2 Duties of an advocate to his client in the arena of IPRs

2.2.1 Contractual duties

The duties of an advocate to his client are condensed in the retainer or the instructions⁹³. Where the instructions are oral, the advocate ought, for the benefit of both parties, to record the terms in a letter to his client at the outset. The instructions can also be recorded in the client's file. The client may be requested to confirm the instructions by email or through other modern permanent ways of communication.⁹⁴ If the advocate neglects this precaution, and a dispute occurs later as to the nature of what was instructed, then the advocate will begin at a disadvantage.⁹⁵ The instructions note amount to an enforceable contract whose breach by either party is actionable⁹⁶. The advocate may, for example, rely on this note to tax his bill of costs against the client. The client may rely on the note to get redress from the negligent advocate.⁹⁷ In Kenya, instructions note is binding even on incidents of undercutting.⁹⁸ If the

⁹³ Under section 44 of the advocates Act (Chapter 16 Laws of Kenya) a presumption is made that the remuneration agreement between the advocate and his client is the basis of taxation of the advocate-client bill of costs although other methods can be used to infer instructions.

⁹⁴ The Evidence Act (Cap 80) at section 106 allows electronic and computer print outs to be produced as evidence. An advocate should use these provisions to ensure that the instructions given by the client are confirmed before execution.

⁹⁵ In England this position was confirmed in *Crossley –v- Crowther* (1857) 1 CH 337.

⁹⁶ See *Rattan Singh –v- G.R Mandavia* (1961) EA 61 where Justice Miles compared an advocate to a doctor, an architect in his or her contractual duties to a client.

⁹⁷ Paragraph 75(1) of the Remuneration Order provides that, 'All drafts and other documents or copies thereof, the preparation of which is charged for, shall be produced at taxation if required by the taxing officer.' Justice Waweru held in *Murage & Mwangi, Advocates v Kenya Power & Lighting Company Limited* [2009] eKLR., 'I find nothing in the record of taxation to indicate that the taxing officer required production by the Advocate of any documents, and that the Advocate was unable to produce them'. Courts are reluctant to ignore remuneration agreements entered between advocates and their clients on fees especially where the advocates accepts to undercut at receipt of instructions, but renegades after completion of the task. The main argument being that public policy demands that courts cannot act on illegalities. See *D. Njogu & Co. Advocate v National Bank of Kenya Ltd*[2009] eKLR where Justice Kimaru stated that '*It would seem that at the time of making the contract the Advocate had the intent to solicit work from the bank, thereby breaking the law. And in my view, at the time of performance he must be held back to the contents and effects of the alleged contract. Plainly, the Advocate submitted himself to what my brother, Ochieng J called a champertous agreement. My opinion is that when an Advocate makes a champertous agreement with his client, the Advocate is more guilty, for he knew the contract stipulated terms contrary to the essence and existence of the Advocates Act*'.

advocate acts in accordance to the instructions of his client, as a general rule, he will not be held liable for negligence, even where the client's instructions are mistaken or misconceived. On the other hand, the failure by the advocate to follow the client's instructions, may lead to an action for negligence, since any advice, however prudent, cannot override the client's express instructions. It is the client's privilege, if he so wishes, to mismanage his affairs. It might be important for the advocate to express his reservations on the client's instructions in a permanent manner. This is key if the advocate is of a contrary view, to avoid future conflicts in the nature of instructions given to him by the client. However this defence will fail if the client was acting on inadequate advice given by the advocate.

2.2.2 Tortious duty to client

In England, it has been held that a solicitor is liable to his client for negligence on tort independent of contract.⁹⁹ Lord Morris of Borth-Y- Gest advanced this guement in *Hedley Byrne & Co –v- Heller & Partners*¹⁰⁰ when he summed it up by stating that 'if anyone possessed of skill undertakes, irrespective of contract, to apply that skill for the assistance of another who relies on such skill, a duty of care will arise¹⁰¹'. In Kenya, Sir Udo Udoma in *Kirima Estates –v- K. G. Korde*¹⁰² found the advocate negligent in tort for his failure to establish the proper valuation of a property before the financier lent money to a customer. The judge observed that the duty of the advocate is based on contract, negligence in tort and the fiduciary duty of trust. This doctrine is an extension of the biblical neighbor principle. In short, a client is a close neighbour that the advocate must have had in mind, while executing instructions.

⁹⁸ Justice L. Kimaru held in *D. Njogu & Co. Advocate v National Bank of Kenya Ltd [2009] eKLR*. 'This court, being both a court of law and a court of equity, cannot allow the advocate to wriggle out of a contract he willingly and consciously entered into with the client even though he knew or ought to have known that the same was illegal'. The court of Appeal held in *Kenya Commercial Bank Limited vs. Muturi, Gakuo & Co. Advocates CA Civil Appeal No. 222 of 2005 (unreported)*) that 'Having re-evaluated the facts of this reference and the applicable law, it is clear to this court that when an advocate enters into an agreement with his client regarding his retainer and the payable fees for such retainer, he cannot turn around and disown the agreement on the grounds that the legal fees agreed were illegal since the same was less than the scale provided under the Advocates Remuneration Order.

⁹⁹ See *Rose –v- Cauntess* (1980)1 Ch. 297 where Sir Meggery V.C confirmed that a solicitor is liable to a beneficiary for negligence for defects in a will leading to the loss of the bequest of the beneficiary.

¹⁰⁰ (1964) AC 502.

¹⁰¹ Ibid at page 503.

¹⁰² (1963) EA 63

2.2.3 Fiduciary duties to a client

This duty requires an advocate neither to abuse, nor to take any secret advantage, of the special situation, that has been created by the advocate- client relationship.¹⁰³ Under this duty, it has been held consistently that an advocate should not accept instructions to act for two or more clients where there is a possibility of a conflict of interest between those clients¹⁰⁴. In the same breath, an advocate cannot act in a manner prejudicial to his client. For example, he may not disclose any confidential information to anyone without the client's consent¹⁰⁵. If the advocate makes secret profit in the process of dealing with the instructions of the client on the transfer, assignment, licensing or other transactions involving any IPRs, then the client must be notified. This duty was confirmed in *Kirima Estates –v- K. G. Korde*¹⁰⁶ where justice Udo Udoma observed that this duty imports 'confidence and the plaintiff company was entitled to trust and to rely on the judgment of the advocate'¹⁰⁷

It is noteworthy to point out that fiduciary duties of an advocates to his client sometimes brings difficulties especially when an advocate elects to act for two clients with conflicting interests¹⁰⁸. For example, if an advocate acts for the vendor, and the purchaser in a sale of a patent transaction, and a bitter court dispute occurs before finalisation of the transfer, the advocate may be put in a very awkward position. He may be compelled to take a stand in favour of one

¹⁰³ This duty was confirmed by Justice Viscount Haldane L.C in the House of Lords decision of *Noctor –v- Asburton* (1914) AC 932.

¹⁰⁴ This was confirmed by the court of Appeal in Kenya in *King Woolen Mills Ltd and another –V- Kaplan and Stratton Advocates* [1990–1994] 1 EA 244 (CAK)

¹⁰⁵ See for example in *King Woolen Mills Ltd and another –V- Kaplan and Stratton Advocates* [1990–1994] 1 EA 244 (CAK) where it was held that an advocate should not accept instructions to act for two or more clients where there is a conflict of interest between those clients. A retainer creates a contractual relationship between the advocate and the client irrespective of whether two or more clients are involved. An advocate cannot therefore act in a manner prejudicial to his client or disclose any confidential information to anyone without the client's consent.

¹⁰⁶ (1963) EA 636.

¹⁰⁷ Ibid.

¹⁰⁸ The House of Lords stated in *Hilton -v- Barker Booth and Eastwood (a firm)* (2005) 1 All ER 651 that 'if a solicitor put himself in a position of having two irreconcilable duties, it was his own fault. If he had a personal financial interest which was in conflict with his duty, he was even more obviously at fault. As a general rule, a solicitor who had conflicting duties to two clients could not prefer one to the other. He therefore had to perform both as best he could. That might involve performing one duty to the letter of the obligation, and paying compensation for his failure to perform the other. In any case, however, the fact that he had chosen to put himself in an impossible position did not exonerate him from liability'.

client against the other. He may be forced to testify in a suit involving two former clients in a sale. Incidences of this nature are embarrassing and must be avoided practitioners.

2.2.4 Duty towards third parties

Advocates can be liable for negligence to third parties who are not their clients. In England for instance, this duty was solidified in *Ross –v- Caunters*¹⁰⁹ where it was held that a solicitor, who is instructed to carry out a transaction that will confer a benefit on an identified third party, owes a duty of care towards that third party while carrying out that transaction. This duty is important if that third party is a person who is likely to be closely and indirectly affected by the advocate’s acts or omissions.

Using this principle, one can argue that an advocate might be liable to a beneficiary of a will who is entitled to benefit from the proceeds of an intellectual property after the death of the registered proprietor of that property. If the will is erroneous, the beneficiary may sue to recoup his losses flowing from negligence by counsel.¹¹⁰

2.3 REASONS IN SUPPORT OF THE DEFENCE OF IMMUNITY AGAINST LIABILITY FOR NEGLIGENCE IN THE BAR IN KENYA

In England, Justice Lawton in his learned judgment in *Rondel –v- Worsley*¹¹¹ wondered, ‘why and when did barristers acquire a reputed immunity which is not enjoyed by any other profession?’ The search for an answer took the learned judge to 1435 AD when the elders of the legal profession, namely, sergeant at law and Judges, accepted that lawyers who did not do their work properly were liable, just as furriers and carpenters, for negligence. He traced immunity at the bar to the era of renaissance and classical studies in sixteenth century influenced by Roman law where it was generally believed that the fees paid to barristers was not received as wages,

¹⁰⁹(1980)1 Ch. 297.

¹¹⁰ Transfer through transmission is possible for trademarks under section 25 of the Trademarks Act (Cap 506 Laws of Kenya) which allows secondary transaction on marks but a registered user of the trademark has no similar rights under section 31(12) of the Act..

¹¹¹(1967)1 WLR. 453

pay, or salary, but to what was referred to as *honorarium* or a gift.¹¹² In fact as way back as 1742, Lord Justice Hardwicke rejected a claim for the recovery of fees by counsel in *Thornhill – v- Evans*¹¹³ on the basis that such fees was *quiddam honorarium*(meaning honorary reward) and not a payment or hire for his labour. The court could refuse to assist the barrister recover his fees. In 1918, the Privy Council presided over *Stephens & Co –v- Allen*¹¹⁴ where an advocate was excused from liability for failure to observe one unfamiliar and remote statute. Several other cases were determined before the House of Lords’ decision in *Rondel –v- Worsley*¹¹⁵ which confirmed immunity to barristers in England. That holding was overturned by the same court in *Arthur J.S Hall & Co –v- Simmons*¹¹⁶. Prior to this judgment, immunity against liability for negligence was protected by statute.¹¹⁷

We must highlight that unlike the English historical development, the Kenyan experience is still nascent. The Kenyan bar is a mix of the practice of barristers and solicitors. Justice Gaselee made this observation way back in 1952 in the Kenya case of *Chanan Singh –v- Chanan Singh & Handal*¹¹⁸. The learned judge observed that since the profession of solicitor and barrister is fused in Kenya, an action for negligence will lie against an advocate, in respect of the non-performance or mal-performance of any duty in which in England, it was actionable against the solicitor. It is surprising that even though professional negligence in the bar in Kenya has been tested through various court pronouncements, no serious debate has been advanced, and no detailed finding has been captured in any judgment, analyzing the defence of immunity against liability for negligence in the bar.

In our view, immunity against liability for negligence is an important debate in our country since we are developing our jurisprudence. The legal profession in England has developed for more

¹¹² The first case ever recorded on this principle on ‘*quiddam honorarium*’ was *Thornill-v- Evans* (1742), 2 Atk. at page 332 which was decided in 1742 was initially unreported but which was adopted by Justice Lawton in *Rondley - v- Worsley* in 1967.

¹¹³ See note 116.

¹¹⁴ Initial suit was reported in (1918) 7.EA.L.R 197 and Appeal in (1921) 8 EA.L.R 211.

¹¹⁵ Ibid note 24.

¹¹⁶ (2000) 3 All ER 673.

¹¹⁷ This is provided for under section 62 of the Civil Procedure Code 1990 and section 3(1) *Halsbury’s Laws*. 4th edn. Re-issue paras. 528-529 and 33 *Halsbury’s Laws* (4th dn. re-issue) paragraph 620.

¹¹⁸ (1952) 25 KLR 58.

than nine hundred and forty eight years¹¹⁹, since the Norman Conquest, yet immunity for liability for negligence amongst barristers was scrapped by the House of Lords in 2000. This long period allowed tremendous growth of the legal profession until it no longer became tenable to insulate barristers. We require to adopt a clear position on this matter for purposes of certainty.

In order to appreciate the legal principles behind this defence, it is important to analyse the reasons advanced in support of, and against the defence of immunity against liability for negligence in the bar in Kenya. The principles in support are;

2.4.1. The principle of equal treatment

In Kenya, judicial officers, witnesses, judicial staff and prosecutors (in criminal proceedings) enjoy absolute immunity in regard to what is said in court in good faith. In fact a witness cannot be charged for defamation for signing witness statements outside court houses in relation to pleadings filed in court. Expert witnesses enjoy protection from statements made jointly with other experts at least in England¹²⁰. If a witness¹²¹, whose testimony involves uttering words defamatory of other people¹²², was under fear of having an action brought

¹¹⁹ The Dark Ages came to an end when the French invaded England in 1066, in the Norman Conquest, so named because the French invaders were from Normandy, and were led by William the Duke of Normandy, who slew the then king of England, King Harold, at the famous Battle of Hastings. He came to be known as William the Conqueror, and he declared that the existing legal system was to remain in force. It included a law that was common throughout the realm, albeit strongly based on local customs. For more details see P.Vines, *Law and Justice in Australia: Foundations of The Legal System*, Oxford University Press, Melbourne, 2009.

¹²⁰ It was held in *Stanton and another –v- Callaghan and others* (1998) 4 All ER 961 that that was so, notwithstanding that the expert did not give evidence at the trial, either because it did not take place or because he was not called as a witness. Such immunity was justified because the public interest in facilitating full and frank discussion between experts before trial required that each should be free to make proper concessions without fear that any departure from advice previously given to the party who had retained him would be seen as evidence of negligence, and it was needed in order to avoid the tension between a desire to assist the court and fear of the consequences of a departure from previous advice.

¹²¹ This protection may however not extend to fabrication of evidence prior to the hearing. The House of Lords in England stated in *Darker (suing as personal representative of Docker, deceased) and Others –V- Chief Constable of the West Midlands Police (2000) 4 All ER 193*, that the immunity of witnesses from civil action did not extend to the deliberate fabrication by the police of evidence which was to be referred to in a statement of evidence and that there was a distinction in between what a witness said in court (or what, in a proof of evidence, a prospective witness stated he would say in court) and the fabrication of evidence, such as the forging of a suspect's signature to a confession, the writing down by a police officer in his notebook of words which the suspect had not in fact said or the planting of drugs on a suspect.

¹²² This was confirmed by the House of Lords in *Taylor and others –V- Serious Fraud Office and others* (1998) 4 All ER 801, where it was established that the test was whether the statement or conduct in respect of which immunity

against him on account of what he said in court, due administration of justice would be impossible.¹²³ Public interest¹²⁴ requires such insulation from subsequent proceedings in order to enhance fair administration of justice.¹²⁵

In the same breath, advocates are is entitled to free speech in court.¹²⁶ In order for advocates to enjoy complete freedom in court, they should be granted immunity against liability for negligence while conducting business in court. Immunity against liability for negligence may encourage advocates to advance new and better arguments culminating to better judgments in our courts.

2.4.2 Divided loyalty

As an officer of the court, an advocate has a duty to the court, to the legal profession, to the public in the sphere of proper administration of justice, and to his client.¹²⁷ These duties have serious implications. For example, advocates may not mislead the court. They must cite the law whether for, or against their case. They must neither embarrass their profession while advancing the case of their clients, nor waste time on irrelevant issues even when their clients

was sought could fairly be said to be part of the process of investigating a crime or a possible crime with a view to a prosecution or a possible prosecution in respect of the matter being investigated. The immunity from suit extended to information and documents in a criminal investigation which were disclosed to the defence by the prosecution under the duty to make available all unused material, and required that such material was not used for collateral purposes; but statements which were wholly extraneous to the investigation and irrelevant and gratuitous libels were excluded from immunity

¹²³ As argued by Lord Morris Of Borth –Y- Gest in *Rondel –v- Worsley* (1973) 3 ALL ER 993 at p.1014

¹²⁴ In the Court of Appeal, Auld LJ said in *Roy –v- Prior* [1970] 2 All ER 729 at 736 that ‘the whole point of the first public policy reason for the immunity is to encourage honest and well-meaning persons to assist justice even if dishonest and malicious persons may on occasion benefit from the immunity. Lord Hoffmann put it in *Taylor v Director of Serious Fraud Office* [1998] 4 All ER 801 at 808, the absolute immunity rule— ‘is designed to encourage freedom of speech and communication in judicial proceedings by relieving persons who take part in the judicial process from the fear of being sued for something they say.’

¹²⁵ See *Robert Mwangi-V- Shepherd Catering Limited & Another* [2012]eKLR.. In *Peter Nganga Muiruri-v- Credit Bank Limited & 2 Others Court of Appeal Civil Appeal No. 203 of 2006*, it was held that all judges derive their authority from the Constitution, and if there had been any violation of any of the constitutional rights a party, such alleged violations should be raised before that court or on Appeal but not in a suit against the judge.

¹²⁶ Lord Diplock in *Saif Ali v Sydney Mitchell & Co* [1978] 3 All ER 1033, argued that immunity ‘is part of the general immunity from civil liability which attaches to all persons in respect of their participation in proceedings before a court of justice’

¹²⁷ This was confirmed in *APC Lobo and another –v- Saleh Salim Dhiyebi and others* [1961] 1 EA 223 where it was held that an advocate who appears for a client in a contested case is retained to advance or defend his client’s case and not his own; this he must do strictly upon instructions and with a scrupulous regard, as an officer of the court, for his duty to the court as well as to his client.

insist otherwise. An advocate must not cast aspersions on the other party or witnesses when there is no proper or sufficient basis to do so, based on the information in his possession.¹²⁸ The English system is quite strict. A solicitor cannot withhold authorities or documents which may testify against his or her client but which the law requires him or her to produce.¹²⁹ Without protection from future claims, advocates are more likely to act to the interest of their client rather than to the wider interest of justice.

2.4.3 Collateral attack

One important tenet in the administration of justice is that there must be an end to litigation. The court hierarchy complies with this philosophy. Superior courts address mistakes of lower tribunals until the most senior court. As a matter of fact, any claim based on negligence against an advocate inevitably leads to reference to the initial dispute.¹³⁰ Let's presume for argument's sake, a prisoner is serving a jail sentence for being in possession of counterfeit goods. What would be the fate of his sentence if the suit for negligence is successful?¹³¹ Cases of this nature may therefore be an embarrassment to the legal profession and to the general administration of justice.

2.4.4 The difficult of an advocate's work

The work of an advocate in the arena of intellectual property is challenging. As noted earlier, the divided loyalty principle puts the advocate in a slippery situation. It is difficult to balance the competing interests of an advocate towards his client, the court, his colleagues, and the general administration of justice.

¹²⁸ As per Lord Reid in *Rodley –v- Worsley*, (1967) 3 All ER 993 at page 999.

¹²⁹ *ibid*

¹³⁰ The rule of public policy that civil proceedings may not be commenced for the purpose of mounting a collateral attack on a final decision against the intending plaintiff which has been made by another court of competent jurisdiction impervious proceedings in which the intending plaintiff had a full opportunity of contesting the decision in the court by which it was made was identified by Lord Diplock in his speech in *Hunter v Chief Constable of West Midlands* [1981] 3 All ER 727 at 73. Three reasons for the rule were identified by the Court of Appeal in *Smith –v-Linskills* [1996] 2 All ER 353 at 361–362 (i) the affront to any coherent system of justice which must necessarily arise if there subsist two final but inconsistent decisions of courts of competent jurisdiction; (ii) the virtual impossibility of fairly retrying at a later date the issue which was before the court on the earlier occasion; and (iii) the importance of finality in litigation.

¹³¹ Infact it was pointed out in *Saif Ali –v- Sidney Mitchell & CO*[1978] 3 All ER 1033 at 1044, that a plaintiff cannot be heard to complain that his lawyers' lack of skill and care prevented him from obtaining an acquittal to which he was not entitled.

During hearings, the advocate is like a warrior fighting on one side of the hill without a clear picture of what is happening on the other side of the hill. He has the duty to protect his colleagues, to fight for his client, to ensure justice prevails, to survive the battle unscathed, and to win the battle. Balancing these multiple and competing interests is delicate and difficult. Even the best warrior may be faced with a sudden, unexpected and fatal attack. While on fire, an honest miscalculation, may lead to fatal consequences. Why should the warrior be blamed for the results of the war when fatalities from human error are part of the motion?

2.3.5 Vexatious claims

As mentioned earlier in chapter one, the Constitutional and Judicial Review Division of the Court of Kenya has experienced tremendous growth in the filing of new petitions. Legal awareness has generated sudden interest in public interest litigation. There is looming danger that unsuccessful parties in ordinary suits will eventually ventilate their anger against their advocates. Public funds and judicial time will be spent to adjudicate multiple disputes between clients and their former advocates. At the end of the puzzle, litigation bordering abuse of court process may develop. Punitive consequences will follow the trend. For instance, suits against lawyers will push legal fees to unaffordable rates. Lawyers will be compelled to avoid practice in risky areas like on IPRs litigation. Monstrous insurance premiums may put pressure on the national economy leading to devastating consequences.

2.4.7. Other reasons given for the defence in other jurisdictions

The cab rank rule has been a valuable tradition of the English bar experience. Under this rule, a barrister may not refuse to act for a client on the ground that he disapproves of him or his case. Unpopular cases are thus prosecuted in English courts with the same veracity as other suits. Barristers were generally instructed by solicitors. They had no direct contracts with the parties they represented in court and their fees is honorarium. However, Lord Steyn observed in *Arthur Hall –v- Simons*¹³² that this practice has since changed. Their practice of law is now commercialized. Barristers may advertise and enter into legal contracts on their services. They can take indemnity covers against liability for negligence. In fact the changing face of legal

¹³²(2000) 3 All ER 673 at page 683.

practice was the main reason the House of Lords scrapped the blanket protection granted to barristers.

2.5 Arguments against the defence of immunity against liability for negligence in the bar.

Arguments against this defence are varied. In the first place, the Constitution of Kenya, 2010 guarantees access to justice for all persons.¹³³ This principle presumes that there is no wrong without a remedy. Immunity violates this general legal tenet. Advocates should be treated just like other professionals who are not insulated from immunity against liability for negligence. Doctors and surgeons perform delicate operations but are not insulated by any immunity against liability for negligence. Doctors are sometimes faced with a tension between duties owed to their clients and to their ethical code¹³⁴. It has been argued that more gains are obtained by scrapping this immunity.¹³⁵ A member of the public may, for example, institute recovery proceedings against his negligent advocate. The fear of liability for negligence is useful in enhancing professionalism and high standards in the legal fraternity. Without immunity against liability, jurisprudence on professional negligence is likely to stagnate. Since advocates are members of a learned profession, they should take responsibility for their actions. Experience in other jurisdictions, particularly Canada, tended to demonstrate that it was unduly pessimistic to fear that the possibility of actions in negligence would undermine the public interest in advocates respecting their duty to the court. As noted earlier in this paper, ending this protection would bring an end to an anomalous exception to the basic premise that there should be a remedy for a wrong, and there was no reason to fear a flood of negligence suits against advocates. The courts should be trusted to differentiate between errors of judgment and true negligence. As the court pointed out in *Arthur –v- Simmons*, claimants would face the very great obstacle of showing that a better standard of advocacy would have resulted in a more favourable outcome.¹³⁶ Finally, the abolition of this defence would strengthen the legal system by exposing isolated acts of incompetence at the bar. Public confidence in the bar and

¹³³ See article 48 of The Constitution of Kenya, 2010.

¹³⁴ For example where an AIDS infected patient asks his consultant not to reveal his condition to his wife. See more conflicts in Ian Kennedy , *Treat Me Right*, Essays in Medical Law and Ethics (2008)

¹³⁵ See note 60 supra.

¹³⁶ (2000) 3 All ER. 673.

the entire legal system in Kenya will not be enhanced by the existence of this defence. To the contrary, appearance is created that law singles out its own for protection no matter how fragrant is the breach by an advocate.

2.6 Extent of immunity

In England, before the decision of the House of Lords in *Arthur –v- Simmons*¹³⁷, it was generally considered that immunity against liability for negligence was available firstly, in respect to the conduct of a barrister during litigation in court, and secondly, to pre-trial work intimately connected with the conduct of the case in court as to amount to a decision as to how it would be conducted at the hearing.¹³⁸ This latter part applies where a particular task was so intimately connected with the conduct of the suit in court that it could fairly be said to be a preliminary decision affecting the cause.¹³⁹

However, in our local circumstances, and considering the recent decision of *National Bank –v- Muriu Mugai*¹⁴⁰, it is doubtful whether our courts would be persuaded to extend this protection this far.

2.7 ELEMENTS OF CONDUCT AMOUNTING TO PROFESSIONAL NEGLIGENCE IN THE BAR IN KENYA IN THE SPHERE OF IPRs

Some of the areas where lawyers are most vulnerable to liability for negligence in the arena of intellectual properties are as follows;

¹³⁷ Ibid.

¹³⁸ As per Lord Hutton in *Arthur J S Simons –v- Simmons* note 144 at page 726.

¹³⁹ As per McCarthy in the *Rees –v- Sinclair* (1974)1 NZLR 180at 187 when he said: ‘... I cannot narrow the protection to what is done in Court: it must be wider than that and include some pre-trial work. Each piece of before-trial work should, however, be tested against the one rule; that the protection exists only where the particular work is so intimately connected with the conduct of the cause in Court that it can fairly be said to be a preliminary decision affecting the way that cause is to be conducted when it comes to a hearing. The protection should and that is why I would not be prepared to include anything which does not come within the test I have stated.’

¹³⁹ (2009) eKLR.

not be given any wider application than is absolutely necessary in the interests of the administration of justice, and that is why I would not be prepared to include anything which does not come within the test I have stated.’

¹⁴⁰ (2009) eKLR.

2.7.1 Giving wrong advice.

One of the principal roles of advocates is to give legal counsel to their clients. On IP matters, this role takes different forms. It could be on registration of rights, protection through litigation, or just general advice or legal opinion to the client.

Generally speaking, advocates are liable for giving wrong advice if that conduct amounts to gross negligence. For example in *Kirima Estates(U) Ltd –V- K. G. Korde*¹⁴¹, an advocate was found reckless for giving wrong advise on the value of a security without engaging a surveyor, leading to losses on realization of the said security.

This scenario is likely to visit the advocate whose advice is relied upon by his client only for the advice to turn out later to have been erroneous.

2.7.2 Failure to advice.

An advocate has a duty to update his client on the progress made in finalizing instructions. This duty is important as it allows the client to give further instructions to the advocate. The client also benefit by making informed decisions on his matter. If a client rejects the advocate’s advice and insists on his way, then the advocate is not liable for negligence.¹⁴²

2.7.3 Explaining legal documents

A client is advised and guided by his counsel in order to understand legal documents¹⁴³. Upon understanding such documents, the client is able to append his signature in order to protect that right. The client must therefore be made by his advocate to understand the materials placed before him.

2.7.4 Ignorance of the law

In England, Justice Abbott once observed ‘that no attorney or judge is bound to know all the law and that no attorney should lose his fair recompense on account that any cautious lawyer may fall into.’¹⁴⁴ A cautious Lawyer may not however take instructions from a client if he lacks

¹⁴¹ (1963) EA 636.

¹⁴² For example it has been held in *D.D Doshi-v- Abdulhessein Hassan Ali Jivani* (25 KLR 55) that the advocate was not negligence on acting on his client’s instructions after explaining the proper position to his client.

¹⁴³ see *National Bank of Kenya Limited v E. Muriu Kamau & another* [2009] eKLR., where it was held ‘It is normally in reliance of the advocate’s advice that the client signs such documents or permits them to be signed on his behalf. The advocate therefore, owes a general duty to explain such documents to the client or at least to ensure that he understands the material and contents of that document’.

¹⁴⁴ This was in *Montrious –v- Jeffreys* (1825), 2C & P 113, 172 ER 51

adequate capacity to carry out those instructions. Under our Penal Code, ignorance of the law is no defence.¹⁴⁵ Failure to be aware of a legal provision on any aspect of intellectual property of constant and common occurrence amounts to gross negligence.¹⁴⁶ However if the provision is quite remote, untested or new, then one might be excused from negligence. That will only happen if a diligent advocate, exercising care and skill may fall into that error of judgment. The limitation period of filing an action in court is a good example of an obvious provision of the law.¹⁴⁷

2.7.5 Error in drafting legal documents and pleadings

Pleadings relating to the enforcement of intellectual property rights must be accurate. As will be shown in chapter three, the failure to understand legal principles in IPRs disputes leads to poorly drafted pleadings and the subsequent failure to call adequate evidence to establish the suit. Pleadings must clearly spell out the rights sought to be protected. Even though the Constitution of Kenya, 2010¹⁴⁸ appears to dispense with technicalities and to encourage substantive justice, pleadings still form the foundation of any claim.

The dismissal of a suit on account of poor pleadings is clear evidence of professional negligence of an advocate.

2.7.6 Failure to prepare well for the hearing of a matter

The core business of a litigation lawyer is to prepare adequately for the trial. In the same breath, counsel must be acquainted with new developments in the law. His arguments must be supported by authority of the law. Witnesses and their statements, exhibits and other necessary trial materials must always be ready. Exhibits should be arranged in a chronological

¹⁴⁵ Section 7 of The Penal Code(chapter 63 laws of Kenya)

¹⁴⁶ This was confirmed by the Privy Council sitting in Kenya in *F.G. Stephens & Co. –v- B.G Allen* (8 KLR) 211 see also *Chanan Sigh Gajjan Singh –v- Channan Singh &Handa* (25 KLR 58) where it was held that the failure to advise the client on the limitation of actions act was negligence since that statute was one of the elementary issues the legal adviser should have borne in mind.

¹⁴⁷ In *Ralph C De Souza- V- R Mandavia and another* [1964] 1 EA 682, it was held that the point of law on the basis of which the defendants claimed that the plaint in the mortgage suit disclosed no cause of action was wholly novel and, even assuming (without deciding) that the plaintiff had made an error in judgment in not arguing that point, it was an error on a point of new occurrence and of nice or doubtful construction and not such an error as to defeat his claim to the remuneration.

¹⁴⁸ See article 159 (2) d.

manner. Failure to prepare well may lead to the dismissal of a good claim coupled with the penalty of hefty costs.¹⁴⁹

2.8 HEADS OF DAMAGES UNDER SUITS FOR PROFESSIONAL NEGLIGENCE AGAINST LAWYERS

The heads of damages recoverable are as follows;

2.8.1 Loss of some financial advantage.

If an advocate is instructed to register a patent, but he fails to carry out those instructions, or delays in executing the instructions as a result of which a third party acquires the invention, the client may suffer great loss¹⁵⁰. Failure to exploit the patent for twenty renewable years can be a monstrous loss to the client. The loss of financial advantage may be occasioned by the failure to observe limitation periods either in pleadings, and the failure to take necessary steps during proceedings.¹⁵¹ The loss incurred is generally based on economic calculations.¹⁵² The assessment is based on the sum of money obtained by selling the articles infringed upon at the time of the conversion¹⁵³.

2.8.2 Loss of opportunity to acquire or renew an IPR or to defend or prosecute a suit.

Lack of meticulousness by an advocate may lead to the loss of the chance to protect or renew an IPR. If a third party takes advantage of this laxity to protect this mark, the client may claim

¹⁴⁹ This was observed in *National Bank of Kenya Limited v E. Muriu Kamau & another* [2009] eKLR. .

¹⁵⁰ In America the 'but for' is the standard mode of establishing damages here. In *Panduit Corp. -v- Stahlin Bros. Fibre Works, Inc.* (575 F.2d 1152, 197 U.S.P.Q. 726) the 6th Circuit court established what has become the classic test for determining "but for" causation. Under *Panduit*, lost profits may be awarded where the patentee establishes: (1) there is demand for the patented product; (2) there are no non-infringing substitutes; (3) the patentee had the manufacturing and marketing capability to exploit the demand; and (4) the amount of profit the patentee would have made absent the infringing conduct.

¹⁵¹ In *Malyon -v-Lawrence Messer & Co* (1968)2 Llyods Rep. 539, where damages were granted for a client against a solicitor who had failed to institute a claim for damages arising from injuries sustained in a road traffic accident case.

¹⁵² One common method for determining the amount of lost profits is the so-called incremental income approach. This approach takes into account the fact that, for any particular level of incremental sales some costs are variable and some are fixed. The fixed costs do not change with increased volume, while the variable costs do change. Lost profits are the difference between the incremental revenue that the patentee would have obtained if it had sold its product in lieu of the infringer's sales, and the incremental, or variable, costs attributable to that incremental sales volume. For details see *Polaroid Corp. v. Eastman Kodak Co.*, 16 U.S.P.Q.2d 1481, 1525-32 (D. Mass. 1990

¹⁵³ See *Ash v Dickie* (1936) 3 All ER 522 where it was held that where, as in the case of an article in a newspaper, it is impossible to apportion to the article any particular fraction of the amount received on the sale of the whole newspaper, the court must make the best estimate it can upon the evidence.

damages for the loss to his or her right.¹⁵⁴ The measure of damages under this head can be punitive. It might however be at the discretion of the judge to estimate the loss using reasonable estimates.¹⁵⁵

Another source of concern is on dismissal of suits *suo motto*, or upon a successful application by the opposing side. If the dismissal is as a result of the default of the advocate to finalise the matter, chances of liability for negligence are high. Furthermore, if the dismissal is as a result of poor drafting of pleadings, a client may lose the right to be heard on merit.¹⁵⁶ Even though the legal burden lies on the plaintiff to establish possible success in the initial suit¹⁵⁷, the presumption lies at the back of the mind of the trial court. This presumption of negligence must be discharged by the advocate.¹⁵⁸ Difficulties may arise in calculating damages payable especially where the initial claim was partly based on general damages or was just difficulty to determine. Courts in Kenya have liberty to exercise discretion judiciously to make a realistic evaluation of the evidence and to arrive at a fair and reasonable finding.¹⁵⁹

¹⁵⁴ This head of damages is common in England especially on civil suits against solicitors following criminal proceedings where it has been held in *Acton –v- Graham Pearce & Co (a firm)* (1997) 3 All ER 909 that in order to decide whether the plaintiff has lost a substantial chance of an acquittal as a result of the negligence of his lawyers and, if so, to evaluate that chance, the civil court does not have to embark on the exercise, described by the Court of Appeal in *Smith -v- Linskills* [1996] 2 All ER 353 at 362, as ‘virtually impossible’, of attempting to decide on the balance of probabilities whether a jury in the earlier criminal trial, properly directed on different evidence, would have been satisfied beyond reasonable doubt as to the guilt of the accused.

¹⁵⁵ In *Acton v Graham Pearce & Co (a firm)* ((1997) 3 All ER 909), it was held that ‘the quantification of the value of a chance lost cannot be an exact science. The task is made more difficult when, as in the present case, the value of the chance lost depends on the evaluation of a sequence of chances; each of which contributes to the loss of a favourable outcome overall. I do not think that the task is assisted by over-refinement. The court must make the best estimate that it can’.

¹⁵⁶ For example in *National Bank of Kenya Limited -v- E. Muriu Kamau & another* [2009] eKLR. the plaintiff bank lost an opportunity to prosecute the initial suit as a result of poor draftsmanship of the defendant and were successful against the firm.

¹⁵⁷ Under section 107 of the Evidence Act (chapter 80 Laws of Kenya) the burden of proof lies on the person who alleges.

¹⁵⁸ For example in *Sharif and others v Garrett & Co (a firm)* (2002) 3 All ER 195 CA it was held that where a claim had been struck out on the grounds that a fair trial of the issues was no longer possible as a result of delay by the claimants’ solicitors, and the claimant subsequently brought a claim for negligence against the solicitors in respect of the lost claim, the judge, in assessing the claimant’s prospects of success in the original claim, had to start with the conclusion, reached by the judge on the striking out application, that no fair trial had been possible

¹⁵⁹ In Sharif’s case (ibid), it was held that this evaluation is based on two stage approaches namely, (i) that the evidential burden lay on the solicitors to show that the litigation had been of no value to their client, so that he had lost nothing by their negligence in causing it to be struck out, and (ii) that, if and in so far as the court might have greater difficulty in discerning the strength of the claimant’s original claim than it would have had at the time of the original action, such difficulty should not count against him, but rather against his negligent solicitors. The

2.8.3 Diminution in value of property

As observed in chapter one of this paper, market forces determine the real value of goods and services available in the market place. The value of IPRs is normally determined by qualified professionals. The value of these properties is determined by the quality of the right. If the IPR loses protection, the value of the property diminishes. The value of the diminution could be the difference in the price of the right, when protected, and the value of the right upon loss of protection.

2.8.4 Liability to third parties

When advocates are instructed to draft testamentary dispositions, their duty of care is not limited to the testator or the executor of the will. A third party who suffers loss of a bequest may bring a successful suit against the advocate who drafted the will.¹⁶⁰

2.8.5 Wasted expenditure.

Advocates have a duty to ensure that proceedings are conducted expeditiously.¹⁶¹ Any costs incurred in the course of the proceedings occasioned by the advocate's fault may be paid personally by the advocate in a suit filed against him by the client. If for instance, a suit is filed

claimant is expected to show that he had a real and substantial prospect of success. The judge then had to evaluate those prospects by making a realistic assessment of the claimant's prospects of success if the original litigation had been fought out.

¹⁶⁰ See the doctrine established in *White and Carter v McGregor* [1962] 1 All ER 613. Where a solicitor who drew up a will negligently was held liable for loss of bequest to an intended beneficiary.

¹⁶¹ For example in England, it has been held in *Re G and others (children) (care proceedings: wasted costs)* (1999) 4 All ER 371, that when advocates attend a pre-hearing review in care proceedings under the Children Act 1989, they have a collective responsibility to ensure (a) that the issues to be addressed at the final hearing are clearly identified; (b) that the evidence addressing those issues is either already available or that directions are sought from the court to ensure that it is available in good time for the hearing; (c) that all the expert witnesses have been sent, or will be sent before giving evidence, all relevant material which has emerged since their reports had been written, or that the material will be sent and, if necessary, a further report commissioned if the expert has not seen the required material; (d) that the witnesses required to give evidence at the hearing have been identified; (e) that the length of time required for the evidence of each witness has been appropriately estimated; (f) that the witnesses have been timetabled; (g) that expert witnesses, in particular, have been allotted specific dates and times for their evidence, and that the length of time allotted for their evidence has been carefully assessed to ensure that it can be given without the witnesses being inconvenienced by having to return to court on a second occasion to complete their evidence; (h) that the documents required for the case are in good order and bundled appropriately, that there is a chronology and, where required, a short statement of case from each party; (i) that the guardian's report will be available in proper time for the hearing; and (j) that the judge has been allowed appropriate reading time and time for an *ex tempore* judgment. Failure to these duties may lead to a penalty to the advocate personally.

by a limited liability company for the protection of a trademark without a resolution of the board of directors of that company, and the suit is subsequently dismissed, the advocate may personally be liable for those costs.¹⁶² The liability of an advocate for wasted costs is not limited to his conduct in the proceedings. It might extend to advising the client on proceedings and his involvement in drafting of out of court settlements related to the proceedings.¹⁶³ The test here is whether the conduct of the advocate was inexcusable,¹⁶⁴ improper, unreasonable or negligent under the circumstances leading directly to the wasted costs complained of.¹⁶⁵

2.8.6 Costs and interest arising from a dismissed suit

The principle applicable to costs in our adversarial system is that costs follow the event.¹⁶⁶ Costs incurred by a party in a suit as a result of the negligence of his or her advocate are clearly recoverable from the negligent advocate.¹⁶⁷

¹⁶² For example in *Kiwanuka & Co -v-Walugembe* [1969] 1 EA 660, a firm of advocates was found liable to pay costs personally in a suit filed without the mandatory resolution by the board of directors.

¹⁶³ See for example in *Brown and another v Bennett and Others (2002) 2 All ER 273* where it was argued that although the concept of conducting litigation is normally understood to involve the traditional litigation activities of a solicitor, it was appropriate, bearing in mind that a 'right to conduct litigation' was not defined in the 1981 Act, to give that expression a meaning that was less technical and more vernacular. It is then impossible to see why it should not extend to all the activities involved in providing litigation services in a wide sense, whether taking formal steps in proceedings, appearing in court or being a party to preparatory and connected activities, such as drafting or settling of documents and advising on prospects or procedure. In wasted costs applications, the court should ask itself whether, on the balance of probabilities, the costs in question would have been incurred but for the conduct on the part of the lawyers which formed the subject matter of the complaint.

¹⁶⁴ This dictum was established by Lord Denning MR in *R & T Thew Ltd v Reeves (No 2)* [1982] 3 All ER 1086 at 1089, [1982] QB 1283 at 1286 when he held; 'The cases show that it [the jurisdiction] is not available in cases of mistake, error of judgment or mere negligence. It is only available where the conduct of the solicitor is inexcusable and such as to merit reproof.' The House of Lords confirmed the same in *Holden & Co (a firm) v Crown Prosecution Service and other Appeals* [1990] 1 All ER 368 when it held that 'The court retained an inherent jurisdiction in both civil and criminal cases to make an order that the solicitor acting for the defendant personally pay the whole or part of the costs of the other side if his conduct involved a serious dereliction of his duty to the court which caused extra costs to be incurred'

¹⁶⁵ As per the Court of Appeal in England in *Ridehalgh v Horsefield and another and other Appeals* [1994] 3 All ER 848 at 849 'Improper' covered any significant breach of a substantial duty imposed by the relevant code of professional conduct, or improper conduct according to the consensus of professional opinion, 'unreasonable' described conduct which was vexatious, designed to harass the other side rather than advance the resolution of the case and 'negligent' understood in an unethical way to denote failure to act with the competence reasonably expected of ordinary members of the profession.

¹⁶⁶ See sections 26 and 27 of the Civil Procedure Act where the discretion is on the court but generally the winner gets costs as well.

¹⁶⁷ Under section 114(2)(c) of the Industrial Properties Act 2001, the industrial Property Tribunal may make such orders as to costs as it deems fit.

2.9 Conclusion

Advocates who practice in the specialized arena of intellectual properties are easy targets for suits based on professional negligence. Damages for liability are massive. This is because the period of protection guaranteed by statutes varies from seven years, for trademarks, twenty years for patents, and fifty years for copyrights. Loss of business for such prolonged periods as calculated by actuaries can drive the most astute advocate into bankruptcy. Immunity against liability for negligence cushions advocates from suits instituted by their disgruntled clients. The legal principles for this defence are yet to be tested in Kenya. In our next chapter, we will seek to relate these principles to real practice issues in IPRs disputes.

However, rather than to rely on the defence of immunity against liability for negligence, it would be prudent for lawyers to tighten their practice. Notably, a suit is filed against an advocate for professional negligence, his other clients are alarmed. Potential clients become aware of the character of that advocate. Premiums for professional liability cover increase. Nevertheless, it is important for advocates to understand these principles and to develop jurisprudence in this unexploited area of the law. The ultimate loss will be borne by the advocate once his character is tainted.

CHAPTER THREE

INCIDENCES OF PROFESSIONAL NEGLIGENCE IN THE BAR IN KENYA IN THE ARENA OF INTELLECTUAL PROPERTY RIGHTS; RESEARCH FINDING ON DECIDED CASES AND PUBLIC INTERVIEWS

3.1 Introduction.

In order to understand the depth of conduct amounting to professional negligence by lawyers, we undertook conducted public interviews and analysed finding in court rulings and judgments and to relate to our subject matter and made interesting discovery of facts. The case study is based on decisions of the High Court of Kenya, the Court of Appeal, rulings of the Registrars of Trademarks, the Managing Director of Kenya Industrial Property Institute (KIPI) and the Industrial Property Tribunal (IPT). Public interviews were via a well-designed questionnaire directed to members of the public. Our analysis is based on clear aspects of professional negligence evident in those judgments and rulings.

3.2 Research finding on IP Case material

3.2.1 The Sample

As previously observed, there are few reported cases on IPRs disputes in our country¹⁶⁸. Since in some instances original jurisdiction on IPRs disputes is granted to the High Court¹⁶⁹, we got a sample of one hundred cases from our superior courts for this study.¹⁷⁰ We presumed that our sample was a reasonable representation of the entire population of cases handled in our

¹⁶⁸ We could only get 103 decisions of the High Court of Kenya. Two rulings were delivered in the same suit but on different matters and by different judges, after going through volumes of reported and unreported cases in our superior courts in Kenya.

¹⁶⁹ See section 2 of The Industrial Property Act 2001, section 2 of The Trademarks Act (Chapter 506 of the laws of Kenya. However under the Copyright Act (Chapter 130 Laws of Kenya) the decision of the competent authority established under section 21 is final. The implication here is that the decision of the competent authority can only be challenged through Judicial Review or Constitutional petitions again in the High Court.

¹⁷⁰ The cases in our sample are available at Milimani Commercial Courts library, the Electronic Kenya Law Reports (eKLR), the East African Law Reports (E.A) and the Kenya Law Reports K.L.R.).

courts. Most decisions in our sample were delivered in the High Court of Kenya in Nairobi and the Court of Appeal in Nairobi probably because of several reasons.

Firstly, most industries in Kenya are based in Nairobi. Being the Capital City of Kenya, many local, regional and multinational enterprises operating in our country with IPRs interests, have their main offices, distribution or production lines in Nairobi. Secondly, the most established law firms in Kenya, (presumably with the capacity to handle most IPRs disputes), are based in Nairobi. Due to good infrastructure, many foreign investors have easy access to Nairobi as compared with other towns in Kenya. Before The Constitution of Kenya, 2010 was promulgated, and the opening up of more High Court of Kenya Stations, there were few permanent High Court stations in our country.¹⁷¹ Milimani Commercial Court still remains the only Commercial Court in Kenya with capacity to handle most commercial disputes.

The administrative aspect of IPRs issues is another factor that contributes to the high number of cases reported in superior courts in Nairobi. KIPI and KECOBO offices are situated in Nairobi. The proximity of these offices to the law courts in Nairobi make it convenient and less expensive for lawyers pursuing appeals to obtain proceedings and documents necessary to lodge appeals with ease. Appeals from rulings emanating from KIPI are therefore lodged in the High Court of Kenya in Nairobi as a result of this convenience. Furthermore, decisions of KECOBO on copyright disputes can only be challenged before a competent authority which has so far not been established.¹⁷² As a result, copyright dispute are now determined in the High Court.¹⁷³ Most artistic works in Kenya, especially in the music, print, and electronic plat forms are also managed by houses based in Nairobi.

¹⁷¹ These permanent stations were in Nairobi, Machakos, Nakuru, Eldoret, Nyeri , Kisumu, Bungoma, Kakamega, Kisii, Nyeri and Mombasa.

¹⁷² See section 21 of the Copyright Act 2001.

¹⁷³ See *Republic –v- Kenya Association of Music Producers (KAMP) & Others & Ex Parte Pubs, Entertainment and Restaurant Association of Kenya (2014) eKLR*. Where it was that the failure of a copyright dispute to be heard and determined by KECOBO amounts to a violation of the constitutional right of a fair administrative action. The failure to operationalize and to finance KECOBO by the Government was not an adequate reason to circumvent that violation

We also sought to study the decisions of the rulings of the Registrars of Trademarks, the Managing Director of KIPI, and the Industrial Property Tribunal (IPT). Our main objective was to interrogate elements of negligence by advocates while representing clients at the institute. We got another sample of one hundred rulings delivered at KIPI. Some decisions were obtained from the official website of KIPI¹⁷⁴ while other hard copies were obtained from the records of the Registrar of Trademarks.

Our main focus was to establish the prevalence of professional negligence as observed through the eyes of judges and quasi-judicial officers. Our main presumption is that the one hundred decisions give a clear and well balanced analysis of the dispute, the pleadings, the argument advanced by counsels, and the issues in dispute.

These cases demonstrate the following areas of negligence by advocates;

3.3. PROFESSIONAL NEGLIGENCE IN RESPECT OF PLEADINGS

Pleadings form the foundation stone upon which disputes are presented as statements by parties before a dispute resolution tribunal. They are the written statements of the parties in actions begun by writ, served by one party to the other, setting down the material facts on which each relies in support of his claim or defence, as the case may be.¹⁷⁵ Parties are bound by their pleadings.¹⁷⁶ Without proper pleadings, a strong case is bound to fail.

3.3.1 Professional negligence by advocates in respect of pleadings filed court

From our sample, negligence in drafting pleadings is not a major occurrence in IPRs disputes filed in our courts. Only six cases had notable issues of negligence on pleadings. The main

¹⁷⁴ See www.kipi.go.ke for details(accessed on 8.8.2014)

¹⁷⁵ For a more detailed definition of pleadings, their purposes and content see, Jacobs H. I, *Bullen and Leake and Jacob's Precedents of Pleadings*, London, Sweet & Maxwell, 1975, at page 3

¹⁷⁶ See *S. N. Valli T/a Baby Steps Kindergarten –v-Hasham Lalj Properties Ltd & another [2008] eKLR*, where it was held by Justice R. N. Nambuye that; (1).That parties are bound by their pleadings. (2) It is not the business of the court to re-write pleadings for litigants. (3) The duty of the court in so far as the resolution of the dispute is concerned is to confine itself to the four corners of the dispute as displayed by the pleadings of the disputants, facts presented in support of each side, assertions, and the law.

concern is on clarity of pleadings. A Judge, in one case, was dismayed by floppy proceedings¹⁷⁷ presented to court by the advocate for the plaintiff making it difficult to comprehend the issues for determination in the dispute. In Kenya, special damages must be specifically pleaded and proved.¹⁷⁸ Losses suffered by the affected parties may not be specified as was the case of *Sanitam services (EA) Ltd –v- Rentokil (K) Ltd & Another*.¹⁷⁹ In *Njeri Wangari & Another –v- Oxford Press (EA) Limited*, evidence was produced during the hearing in a heap without leading witnesses on the contents of each document.¹⁸⁰ In other cases, advocates fail to file clear pleadings but then lead evidence on issues not reflected in the pleadings.¹⁸¹ For example, in *Sapra Studio –v- Tip-Top Clothing Co Limited*¹⁸², no proper pleadings on special damages were stated in the claim. Damages for conversion were also neither specifically pleaded nor proved in the trademark infringement dispute.¹⁸³ It is also common for advocates to fail to describe the subject matter in pleadings, or to define their client’s right.¹⁸⁴ In one patent infringement dispute, an advocate failed to pray for an order of inquiry as to damages suffered by his client in the plaint.¹⁸⁵ Without such an important prayer, the trial court was left sympathizing with the client since no assessment of damages suffered by the client could have been ordered by the judge.

Several factors appear to dominate the absence of many incidences of negligence on pleadings in the arena of IPRs. Firstly, firms involved in prosecuting matters of this nature have experienced lawyers who presumably draft proper pleadings based on their long period of practice. However, this argument might not be entirely accurate. As will be seen later, some experienced lawyers make serious errors on the differentiation of the principles applicable in

¹⁷⁷ See *Jivanji –v- Sanyo Electrical Company Limited* (2003) eKLR, where the lawyers for the plaintiff mixed issues and failed to plead or prove special damages leading to confusion during the hearing of the suit. The court of Appeal was unable to make head or tail of the claim of the plaintiff especially on special damages.

¹⁷⁸ In *Sapra Studio –v- Tip- Top Clothing Co. Ltd* (1971) 1 EA 489 the court observed that the plaintiff had failed to make a specific prayer on special damages and therefore no damages could be recovered.

¹⁷⁹ (2002) eKLR.

¹⁸⁰ (2012) eKLR.

¹⁸¹ Like was observed in *Dipak Emporium-v- Bond’s Clothing Ltd* (1973) 1 EA 553 which was a case on passing off.

¹⁸² (1971) 1 EA 489

¹⁸³ *Ibid.*

¹⁸⁴ See *Coca cola export Corporation-v- Registrar of Trademarks* (1969)EA 647

¹⁸⁵ For example in *Pastificio Lucio Garofalo SPA –v- Dehenham & Fearr Ltd* (2013) eKLR.

different disciplines of IPRs.¹⁸⁶ Secondly, since most IPRs disputes are related to previous disputes, lawyers study case law to ensure that their pleadings are drafted in conformity with principles enunciated in authoritative decisions. Advocates are also generally generous in sharing precedents with their colleagues. Lawyers copy entire pleadings borrowed from other firms and from established publishers.¹⁸⁷ No wonder most pleadings are drafted in similar style. Finally, since most judicial officers lack adequate training on IP matters, pleadings are probably the last item in their menu while thinking through cases argued before them, while drafting judgments.

Even though courts have been reluctant in dismissing suits relating to IPRs disputes on the basis of negligence in pleadings, a party represented by a negligent advocate may fail to get proper redress. For example, a party may fail to get orders of temporary injunction simply because their negligent advocate pleaded for an order for inquiry as to damages on a claim based on patent infringement.¹⁸⁸ In *Coca-Cola Export Corporation-v- Registrar of Trademarks*¹⁸⁹, the plaintiff's advocate failed to describe the subject matter and the rights infringed upon by the defendant in the pleadings but led evidence at the main hearing of the suit on both issues without amending the pleadings. The error was found fatal to the claim. Furthermore, the failure to get prayers at the interlocutory stage may ultimately lead to the dismissal of the entire suit since the only prayer required at the time of filing the suit was the prayer sought at

¹⁸⁶ For example in *Faulu Kenya Deposit Taking Microfinance Limited V Safaricom Limited [2012] eKLR*, the main argument in the objection to the jurisdiction of the High Court to determine a dispute based on a non-disclosure agreement as amounting to a copyright or on novelty or patents and hence the proper forum being Industrial Property Tribunal was rejected by the trial judge.

¹⁸⁷ During our interviews, most lawyers indicated that they are guided by text books like: Jacobs, I. H., *Bullen and Leake and Jacobs, Precedents of Pleadings*, (London, Sweet & Maxwell) 1975, as updated regularly.

¹⁸⁸ For example, in *Film Africa (Kenya) Ltd –v- Deutsche Welle & 3 others (2011) eKLR*. the applicant pleaded for damages in an application for temporary injunction thereby defeating the principles established in *Giella V. Cassman Brown & Co. Ltd [1973] EA. 358* where Justice Spry, V.P of the then Court of Appeal for East Africa observed at page 360- that “*The conditions for the grant of an interlocutory injunction are now ... well settled in East Africa. First, an applicant must show a prima facie case with a probability of success. Secondly, an interlocutory injunction will not normally be granted unless the applicant might otherwise suffer irreparable injury, which would not adequately be compensated by an award of damages. Thirdly, if the court is in doubt, it will decide an application on the balance of convenience*”. Since damages could be ascertained, then a request for an order of temporary injunction was clearly against the second principle and therefore erroneous.

¹⁸⁹ (1969) E.A. 677.

the interlocutory stage.¹⁹⁰ Affidavits filed by parties in interlocutory applications may lack annexure of crucial exhibits necessary to demonstrate infringement.¹⁹¹ Failure to serve pleadings on time may be punitive. *For example, in Amarco Kenya Ltd. –v- Minister of Finance and others*¹⁹², a replying affidavit was filed on time but served late. It was expunged from the court’s records.

3.3.2 Negligence in respect to pleadings filed at KIPI.

From the sample of one hundred rulings delivered at KIPI, only five rulings had pointers of professional negligence in pleadings filed by advocates on behalf of their clients. We also observed that the IPT and Registrars of Trademarks are less strict on technicalities and draftsmanship of pleadings. Unlike judicial courts where pleadings must comply with certain minimum standards established by procedural rules¹⁹³, there is no similar mandatory rule governing adjudication at KIPI. The High Court has the duty to ensure that IPRs claims are pleaded in the same standards as other commercial disputes. Even though decisions from KIPI borrow heavily from the superior courts, the institute hardly ever takes drastic measures against poor pleadings.

We have also noted a certain pattern in the area of cases displaying multiple negligent pointers by advocates. Out of the fifteen matters displaying multiple negligent pointers by advocates, nine cases had poorly drafted pleadings, all cases lacked evidence in support of the claim, and eight claims had errors on the principles relied upon by counsel to advance these claims. These fifteen cases lead us to make one conclusion. Advocates who draft pleadings carelessly,

¹⁹⁰ See for example *Strategic Industries Ltd V Rebecca Fashion (Kenya) Ltd* [2013] eKLR, while dismissing the suit alleging infringement of a trademark “Afro Kinky” by the defendant’s mark known as “Afro B”, Justice Havelock found out that the determination by Justice Mugo, while dismissing the earlier application for interlocutory injunction, had divulged on the merits of the main suit due to the nature of pleadings and prayers sought in the plaint and the application and there was nothing else left to be determined during full trial.

¹⁹¹ See for example in *Jivani-v- Sanyo Electrical Company Ltd.* (2003) KLR 425, where an affidavit was served upon a defendant without any annexures attached thereof.

¹⁹² (2008) eKLR.

¹⁹³ For example compliance with the procedures set out under the Civil Procedure Rules (Chapter 21 Laws of Kenya), and the Evidence Act (Chapter 80 Laws of Kenya) among others.

probably due to a misunderstanding of the applicable legal principles, have a high propensity to mislead their clients on the evidence required to prove their cases.

Some of the notable negligent practices at KIPI include drafting pleadings in a casual manner,¹⁹⁴ incorrect citation of the law, and lack of clarity in pleadings.¹⁹⁵ The production of inadmissible secondary evidence is of great concern. For example, in a trademarks dispute, advocates erroneously made reference to websites and blogs in their pleadings during a hearing.¹⁹⁶ The Registrar was not amused by their conduct while making comments in her ruling. In *The Matter Of Application to Register Trade Mark Application No. 59944*¹⁹⁷, the failure to describe a trademark in opposition proceedings was held as a major derogation of duty by counsel. Failure to seal documents exhibits at KIPI is another common negligent practice by lawyers.¹⁹⁸

3.3 Professional negligence in relation to evidence adduced in support of IPRs claims

Rules of evidence demand that the burden of proof lies on the person who would fail if no evidence is produced on either side.¹⁹⁹ It is the responsibility of advocates to advise their clients properly on the best evidence rule and to lead them properly during hearings.²⁰⁰ Advocates

¹⁹⁴ Like in the matter of an application to expurge from the register Trade Mark no. KE/T/2007/000626653 In Class 3, Uniliver Plc (applicant) –v- Emami Ltd (Registered proprietor)

¹⁹⁵ See for example *General Plastics –v- Safepark Ltd.* (IPT case No. 36/ 2012)

¹⁹⁶ This was observed by the registrar of Trademarks *In the matter of an application to expunge from the register trade mark KE/T/2007/00626653 in class 3 Uniliver PLC (Applicant) –v- Emami Ltd (Registered Proprietor).*

¹⁹⁷ *Americana Orange Magic (With Device) In Class 30 In The Name Of TamuTamu Ltd. and opposition thereto by Rollfast Holdings Ltd & Cookies Ltd.*

¹⁹⁸ Under rule 9 of The Trade Marks Rules, all documents produced as evidence during the hearing must be signed by the authorized signatory. Many advocates fail to have these documents sealed by the persons authorized to seal them.

¹⁹⁹ Section 108 of the Evidence Act, (Chapter 80 of the laws of Kenya). The registrar of Trademarks made this observation while castigating counsels for their failure to adduce evidence *in the matter of Trade mark Application KE/T/2008/64107 “President” and KE/T/2008/64506 ‘PRESIDENT Special Edition Langer’ In the Name of EA Breweries Ltd and Opposition thereto by Cervecería Nacional Dominica C. Por. A*

²⁰⁰ The Court of Appeal has however held in *Moses Kipkolum Kogo -v- Nyamogo & Nyamogo Advocates [2004] eKLR.* ‘that it was not the duty of the advocates to help the appellant (who was the client) in gathering the evidence with which to prove his case’. The client said he was not receiving pay-slips and when cross-examined he did not say that the pay-roll through which he received his salary was still available and could be produced. So that even if the respondent had told him to bring his pay-slips, the appellant could not have done so because they were not there’. This case demonstrates that the advocate has the duty to advise the client to bring evidence to be relied upon at the hearing of the client’s suit.

must also employ correct procedures to compel their opponents to produce documents in their custody to obtain justice.²⁰¹

3.3.4 Negligence in respect of evidence tendered in Court.

From of our sample, twenty two cases were dismissed on account of negligence on evidence. These cases fell under three categories, namely; the failure to adduce proper evidence, to arrange evidence properly during the hearing, or to call witnesses to testify. Out of the seventeen cases displaying multiple elements of negligence, twelve cases displayed negligence on evidence. We also established that the failure to call proper evidence is the main reason given by courts for the dismissal of IPRs suits.

No doubt it is the primary responsibility of a client to produce evidence to support his suit.²⁰² It is however the responsibility of the advocate to advise the client on the best evidence required guaranteeing success.

We isolated several negligence practices on account of evidence in IPRs litigation. Firstly, casual presentation of evidence during hearings was castigated in *Naomi Chege –v- Republic*.²⁰³ Justice Mbogholi J, while giving his judgment and acquitting the appellant, noted that the prosecution had heaped documents before the lower court without proving possession and presumed that the court will make the necessary presumptions. In *Njeri Wangari & Insemia Inc. Publishers-v- Oxford University Press (EA) Limited*,²⁰⁴ an advocate negligently failed to produce the proper literary works of his client in a copyright dispute produce works authored by a

²⁰¹ Under order 14 of the Civil Procedure Rules (Chapter 21 Laws of Kenya), an application may be made to compel a witness through summons to produce such documents and to give evidence at the instance of a party requiring production of such documents and the evidence.

²⁰² Ibid.

²⁰³ (2008)eKLR., where Justice Msagha Mbogholi observed that it was not enough for the prosecution to produce copies of copyrighted materials without establishing possession. The prosecution just heaped exhibits before the trial magistrate. Possession was not established. This case involved the offence of possession of pirated music.

²⁰⁴ (2012) eKLR, where the action pleaded by the Plaintiffs in the plaint was in respect of the works known as “Mines and mind fields, ‘My Spoken Words” where in the poem ‘Their Eyes’ was published . That publication was found different from the works known as ‘Mines & Mind Fields, “Fading Faces” and there was no explanation rendered to show the connection between the works produced and the works pleaded in the plaint.

different publishing house without leading evidence on the connection between the two different works.

On interlocutory applications, advocates occasionally forget to attach copies of exhibits in affidavits filed in support of their clients' claims.²⁰⁵ For example a trademark registration certificate, though available, was left out completely in the proceedings filed by the claimant in *Lords Healthcare Ltd. –v- Salama Pharmaceuticals Ltd*²⁰⁶ in order to prove ownership.²⁰⁷ While lodging an appeal from the decision of the Registrar of trademarks to the High Court, an advocate once failed to attach a supporting affidavit to the notice of motion application contrary to the provisions of the Civil Procedure Rules.²⁰⁸ In *MCSK Ltd –v- Parklands Shade Hotel Ltd t/a Klub House*,²⁰⁹ advocates on record failed to support their submissions with case law, leaving the judge to carry out independent research on the applicable law. This omission was, in our humble view, quite reckless. Another challenge was noted on changes of names of litigants. After a company is incorporated, it may decide to change its name after the requisite procedure is followed.²¹⁰ The change should be notified to the managing director of KIPi and circulated in the official publication.²¹¹ These changes must be explained to the court by witnesses during the hearing of a dispute. That was the situation in *British United Provident Association –v- Bupa (Kenya) Ltd.*²¹² Here the certificate of grant of a trademark was in the original name contained in the certificate of incorporation of the plaintiff whose name had thereafter changed. Both certificates of incorporation were not attached as evidence to prove the changes and the

²⁰⁵ See for example, *Uniliver PLC –v- Bidco Oil Industries* (2004 1KLR 57, the supporting affidavits did not contain evidence of real confusion to the public between the plaintiff's margarine with the trademark 'Blue band' and the defendant's mark 'Gold band' leading to the dismissal of the interlocutory application for injunction.

²⁰⁶ (2008) eKLR., the plaintiffs failed to prove ownership of a trademark by failing to produce the certificate of registration of the mark from the Registrar of Trademarks.

²⁰⁷ See *Apex Creative Ltd. –v- Kartasi Industries Ltd.* (2011) eKLR., where the certificate of grant of a patent was not produced leading to the dismissal of the application.

²⁰⁸ See rule 117 of The Trademarks Act (Chapter 506 Laws of Kenya) and order L Rule 3 of the Civil Procedure Rules (chapter 21 Laws of Kenya (repealed).

²⁰⁹ (2000) KLR 569.

²¹⁰ Under section 20 of The Companies Act (Chapter 486 Laws of Kenya) a company may, by special resolution and with approval of the Registrar signified in writing, change its name. The change of name does not however affect any rights or obligations of that company.

²¹¹ See for example section 62 of the Industrial Property Act or section 35 of the Trademarks Act which both allow for rectification of the registers in regard to patents and trademarks after changes in ownership of the right.

²¹² (2006) eKLR.

connection between the two names under reference. The owner of the trademark had also failed to notify the Registrar on the changes. The court found no connection between the registered owner of the right and the claimant and dismissed the claim.

Another notable challenge is in respect of proceedings relating to licenses. One must produce the license agreement and the certificate of registration of the license in order to demonstrate capacity to institute proceedings by the licensee. This is because a licensee can only lodge proceedings to protect the mark if the proprietor has been notified on the violation of the trademark and has refused to institute infringement proceeding against the infringer²¹³. For example, in *Wilson Muriithi Kariuki t/a Wiskam Agencies –v- Surghipharm Limited*²¹⁴, an advocate representing a licensee of a trademark failed to produce the registered license accompanied by the authority of the proprietor of the right to institute proceedings leading to the dismissal of the claim. Poor quality exhibits incapable of showing infringement of an IPR were noted in *Film Africa (Kenya) Ltd. –v- Deutsche Welle & 3 others*.²¹⁵ The court observed that the photographs failed to demonstrate similarities between the patented invention and the counterfeit leading to the dismissal of the suit. Worse is situations where an advocate displays, photographs of the infringing sample but fails to attach photographs of his client’s product as was in *Sanitam services (EA) ltd –v- Rentokil(K) Ltd & Another*.²¹⁶ In *Safepak Limited-v- Malplast Industries Limited*²¹⁷ an advocate failed to specifically point out the differences between the protected work and the counterfeit, leading to dismissal of the claim²¹⁸. In infringement proceedings relating to trademarks, a party must demonstrate that the defendant’s mark caused actual confusion in the market place. That can only be established by calling independent witnesses. They must show how they purchased products of the defendant

²¹³ See section 34 of The Trade Marks Act (Chapter 506 Laws of Kenya).

²¹⁴ (2014) eKLR.

²¹⁵ (2011) eKLR.

²¹⁶ (2002) eKLR.

²¹⁷ (2007) eKLR.

²¹⁸ See *Ibid*, where the defendant failed to show the distinctiveness in the design of their bottle as against the protected design of the plaintiff. This failure led the trial court to make presumptions to the detriment of the defendant. See also *Inter-consumer Products Limited –v- Lordix General Supplies Ltd.* (2009)eKLR, where the trademarks ‘bouncy baby diapers’ and ‘Lordix baby diapers’ were not distinguished by the plaintiff during the hearing.

instead of those of the plaintiff as a result of deception or confusion.²¹⁹The failure to adduce evidence of actual confusion of brands in infringement proceedings between two competing brands of cigarettes by a smoker has been held fatal.²²⁰In all these matters, the offending party is normally condemned to pay costs which may be punitive.²²¹

3.3.5 Negligence in respect of evidence tendered at KIPI

Disputes filed at KIPI are established by affidavit and documentary evidence. Nineteen rulings (or almost a fifth of our sample) displayed elements of negligence in the handling of evidence by advocates. The main area of negligence is the failure to establish actual confusion in the market place between two properties.²²²This is so especially between an ordinary mark and a well-known mark in opposition proceedings relating to registration of marks.²²³ Evidence on prior use and distinctiveness of a mark are areas where advocates have been found in error.²²⁴

Instead of adducing evidence from Kenya, some advocates produce evidence from other territories, therefore offending the principle of territoriality of IPRs.²²⁵ The blame is not on claimant's advocates alone. Defence counsels also fail to produce evidence to prove that their clients have honestly and concurrently used trademarks alongside those of the plaintiffs without causing confusion to consumers in trademarks disputes where the defence of honest

²¹⁹ See for example in *Pharmaceutical Manufacturing Co Ltd. –v- Novelty manufacturing Ltd.* (2000)eKLR. 392. Here, the plaintiff failed to adduce evidence to show actual confusion of the prescriptive drugs 'Trihistamin' from the defendant's drug known as 'Tri-histina'. See also *Cut Tobacco Kenya Ltd-v- British Tobacco (K) Ltd* (2001) eKLR, where no evidence was adduced to show actual confusion of the plaintiff's 'sportsman' cigarettes with the defendant's 'Horseman' brand.

²²⁰*British American Tobacco Kenya Ltd v Cut Tobacco Kenya Ltd.* (Civil Appeal No. 278 of 2002).

²²¹ In *Glenmark Pharmaceuticals v Les Laboratoires Servier*, (Industrial Property Tribunal case number IPT No. 58 of 2009), it was held that 'the lesson learned here is that declaration of non-infringement can save on costs and those who ignore it do so at the risk of facing huge costs when litigation is undertaken and especially if unsuccessful in their intransigence'. Costs were granted on the higher scale

²²² See *In the matter of Trade Mark No. 58890 In The Name Of Inter- Consumer Products Ltd and opposition thereto by L'Oreal* and *In The Matter Of Trade Marks Application No. 062887 'Tevir EM' in Class 5 In The Name Of Ranbaxy*

²²³ See for example, *In The Matter Of Trade Mark Application No. KE/T/2012/74943 M (Device) in Class 9, 38, and \$2 In The Name Of Mxit Lifestyle (Proprietary) Ltd.*

²²⁴ Like in the matter of *Trade Mark Application NO. ke/t/2011/73304, In The Name Of Nabros Phara PVT Ltd & Opposition Thereto by Galaxy Pharmaceuticals Ltd.*

²²⁵ See in the matter of *opposition to Trade Mark Application No. 54559 (Painamol- Word Mark) Beta Health Care International Limited(Applicant) –v- Smithkline Beecham (PLC) Ltd.*, where there was no evidence to show that the 'panadol' mark is well known in Kenya and has been widely sold in Kenya.

concurrent use is adopted by the defendant.²²⁶ In *London Distillers –v- Ponu Monu Suppliers*²²⁷, it was negligent to fail to adduce evidence on prior design by the defence, when that evidence was available. The failure to certify and to seal exhibits adduced as evidence is a notable area of negligence by some advocates.²²⁸ However no suit in our sample has been dismissed on account of the failure to seal exhibits produced as documentary evidence at KIPI.²²⁹

4.1 Negligence by advocates while conducting hearings of IPRs disputes in courts

Three cases in our sample had major elements of negligence in the conduct of counsel during hearings. In *David Engineering Ltd v Steel Structures Ltd*,²³⁰ a counsel failed to call a key witness, namely, the examiners of patents, to show the similarities between a protected invention and a counterfeit during the hearing. The advocate also failed to lead a witness to produce the certificate of grant of a patent, which was one of the most basic documents required in the case²³¹. In *Dipak Emporium –v- Bond’s Clothing* a witness was led during examination in chief to evidence on issues that were not pleaded in the statement of claim.²³² In *Kalamazoo Ltd. & Another –v- Systems Africa Ltd*²³³ witnesses were not called by the defense counsel, to challenge the evidence of the plaintiff leaving the court to rely entirely on the unchallenged evidence of the plaintiff. The failure to prepare witnesses properly is also evident during their examination in court.²³⁴

²²⁶ See section 33 of The Trade Marks Act (Chapter 506 Laws of Kenya).

²²⁷ IPT No 47 of 2006 decided on 7.9. 2011.

²²⁸ This is mandatory under rule 10 of the Trade Marks Rules.

²²⁹ See for example, In the matter of ‘President’ and ‘President special edition langer’ in the name of EA Breweries Ltd and Opposition Thereto by Cerveceria Nacional Dominicana. In this reference, exhibits were not sealed by both advocates. However none opposed the production of the exhibits as evidence.

²³⁰ IPT No. 55 of 2007 delivered on 13-12-2011 where the examiner was not called by the applicant who blamed the respondent for not proving their design to the required standards

²³¹ Ibid.

²³² (1973)1 E.A. 553.

²³³ (1973)1E.A. 242.

²³⁴ See for example, in *Agility Longistics Ltd. & Others –v-Agility Longistics Kenya Limited(HCC840/2010)*, where because of the negligence of the defendant’s advocates, witnesses of the defendant were unable to give evidence that the defendant had acquired reputation for the name ‘Agility Logistics Kenya’ as a prior user against the registered trademark ‘Agility Logistics Limited’ which was registered later. This culminated to the loss of the trade mark owned by the plaintiff. See also *Hassanali M. Sahoo –v- Jonkopings Och Vulcans Tandstichsfabriktebalag (1958) EA 463*, where in a passing off claim, an advocate failed to lead evidence on the description of the

3.4.2 Negligent conduct of advocates while conducting hearings of References at KIPI

Most references at KIPIs are heard by way of written submissions. However, when necessary, advocates are allowed to highlight their submissions. Without oral evidence, it is difficult to evaluate, how counsels prepare witnesses for hearings at KIPI.

The misunderstanding of legal principles applicable in IPRs discourse by advocates stated elsewhere in this thesis is also evident during hearings of references at KIPI. For example *in the matter of Trade Mark Application Number KE/T/2011/73304, in the matter of Nabros Phara PVT Ltd. and opposition proceedings thereto by Galaxy Pharmaceuticals Ltd*, counsel failed to attend court and to comply with certain directions given by the Registrar. The Registrar had directed the applicant who was a foreigner with no attachable assets in Kenya, to deposit security of costs.²³⁵ *In the matter of Trade mark 'MAXIVITA' in the name of Surgilinks Limited and opposition thereto by Agro Pharmaceuticals Limited*, the advocates for the applicant, who had sought to register a trademark, failed to understand who had locus to oppose the registration of a mark. He also got confused on the principles of infringement and passing off during opposition proceedings.

3.5 DELAY

3.5.1 Delays occasioned by advocates in courts

IPRs dispute are generally commercial in nature. Delays in finalization of these disputes lead to serious financial consequences.

From our sample, only three cases had elements of delay perpetrated by advocates. Out of the seventeen matters displaying multiple negligence characteristics, only two matters were

defendant's offensive mark during the hearing. See also *Chloride Exide (K) Ltd & Another –v- Zakayo Muchai Wainaina t/a Chloride Exide (2008 eKLR*, where during formal proof, the advocate presumed that since the matter was not defended, strict proof was not necessary to establish infringement of the trademark during that hearing. The advocate failed to lead witnesses to identify the breach of the trade mark 'Chloride Exide' by the defendant's mark and to show evidence of real misrepresentation, leaving the judge to deduce the same from the documents which were produced by the plaintiff.

²³⁵ See rule 56 of the Trade Marks Rules, Chapter 506 Laws of Kenya.

affected by dilatory behavior by advocates. It is safe to presume that delay by advocates in the finalization of IPRs disputes filed in our courts is not very common.

Delay by advocates takes different forms. It may be the failure to observe court directions, the failure to take certain actions²³⁶ like taking hearing dates²³⁷ or to file pleadings like the main reference.²³⁸ It may be an attempt to introduce further evidence when the hearing of a matter has commenced.²³⁹ Pleadings filed out of time may be struck out or expunged from the court record²⁴⁰ if the cause is not sufficiently explained by counsel.²⁴¹ However, we have so far not come across a matter that has been dismissed for want of prosecution or for inactivity by counsel.

3.6 Delays by advocates at KIPI

From our sample, seven matters had elements of delay by counsel in finalizing disputes filed at KIPI. The notable areas of delay include the failure to file the main pleadings,²⁴² counter statements and other subsequent documents.²⁴³ This recklessness is evident when advocates fail explain the reasons for their delay in applications for extension of time.²⁴⁴ For example, delay in responding to the observations of a patent examiner by the applicant for the grant of a

²³⁶ See *Amarco Kenya Ltd. –v- Minister for Finance and others* (2005) eKLR., where an affidavit not served on time was struck out from the court records as a result of the delay.

²³⁷ See for example, *Strategic Industries Limited –v- Sana Industries Limited* [2008] eKLR, where Justice Okwengu refused to dismiss a trademark dispute after a period of 2 years had elapsed after the close of pleadings directing the plaintiff to take hearing dates within a period of two weeks.

²³⁸ See for example, in *Sapra Studio –v- Tip-Top Clothing Co.* (1971) E.A 489. There was delay in instituting the claim on a trademark infringement but the delay was adequately explained.

²³⁹ Like in *General Plastics Ltd –v- Industrial Property Tribunal & another* [2007] eKLR, although the delay of 2 years in presenting further evidence after filing revocation proceedings against a registered patent was held unreasonable by the Industrial Court Tribunal leading to this petition after several intrigues between the parties.

²⁴⁰ See for example, *General Plastics Ltd. –v- Industrial Property Tribunal & Another* (2007)eKLR.

²⁴¹ See *Studios –v- Tip- Top Clothing Co.* (1971) 1 EA 489.

²⁴² See *In The Matter of an Application to Expunge Trade Mark Application No. 57546 in class 21 In The Name Of Casabella Associates Ltd and Expungement thereto by Cornin Incorporated*, even though the delay in lodging the proceedings was not found fatal.

²⁴³ See for example, *In The Matter of Trade Mark Application Number 55857 Beta Health Care Ltd. (Applicant) –v- SmithKline Beecham Limited (Opponent)*, where a delay of 5 days for filing counterstatements was held inordinate.

²⁴⁴ See for example *in the matter of Trade Mark No. 68367 ‘Superstar’ and No. 68368 ‘Stallion’ In The Name of Royal Tobacco (IC) Ltd. and Expungement Proceedings by British American Tobacco (k) Ltd.*, where leave was granted in the interest of justice for the filing of pleadings in response to an application for expungement of a mark despite the failure by counsel to give adequate reasons for the delay.

patent has been noted in two cases.²⁴⁵ The penalty imposed for this delay is usually US\$ 50²⁴⁶. The failure to renew a right or to advise a client to pay the annual subscription is another form of delay.²⁴⁷

It is evident from our research that some factors contribute to few incidences of delay by counsels. As observed earlier, IPRs disputes involve parties with serious commercial interests. Parties are normally huge multinationals with long experience in IPRs litigation. These companies boast of massive financial reserves for IPRs dispute resolution mechanisms. As a result, they follow up with their lawyers to ensure that disputes are properly adjudicated within short timelines. Law firms representing clients in this field also have a reputation to keep. They try to ensure that unnecessary delays do not soil their reputation. Legal fees is normally paid at completion of the dispute. Finally, due to their very nature, courts are reluctant to dismiss suits under the banner of delay. Such terms like fair trial, public interest²⁴⁸, and the interest of justice²⁴⁹ are adopted by judicial officers to give life to suits which would otherwise fail on account of delay occasioned by practitioners.

3.6.1 Negligence in respect of jurisdiction

Jurisdiction is everything.²⁵⁰ A matter filed in the wrong forum is like a still birth. It has no life at inception no matter how well founded the claim. The duty to determine which forum a

²⁴⁵ See *In the matter of 'Patent Application No. KE/2008/00757 titled 'Process for Preparation of Amines' in the name of Syngenta Participations AG Ex Parte Hearing under Regulation 74 of the Intellectual Property Act.* See also *In the matter of Patent Application Nos. KE/T/2011/01313 titles 'Prophylactic/ Therapeutic Agent for Cancer' In The Name Of Takeda Pharmaceutical Co. Ltd Ex parte hearing under Regulation 74 of the Industrial Property Act.*

²⁴⁶ *Ibid.*

²⁴⁷ This was the case *In the matter of Trade Mark Number 71891 'mama' In The Name of Thai President Foods Public Co. Ltd.*

²⁴⁸ *Ibid*, where it was observed that trademark infringement proceedings are a matter of public interest.

²⁴⁹ See however *Juma & Others -Vs-Attorney General [2003] 2 EA. 461*, on what would constitute a fair hearing it was held – “where allowance is made for reasonable time in light of all the prevailing circumstances of a case to investigate properly prepare and present one’s defence, where litigation is open, justice is done, and justice is seen to be done by those who have eyes to see, free from secrecy mystery and mystique.”

²⁵⁰ This was held in *The Owners of Motor Vessels "Lilians" Vs Caltex oil (Kenya) Ltd, (1989) KLR 1.*

dispute should be filed is generally in the hands of the advocate who is presumed to be the legal expert.²⁵¹

As will be demonstrated shortly, professional negligence by advocates on issues related to filing matters before forums that lack Jurisdiction is not a major occurrence in our courts. Only three suits in our sample had elements of negligence on jurisdiction. Out of the seventeen cases displaying multiple negligence elements by advocates, only one was filed in the wrong forum. On the other hand, only one matter from the KIPi had evidence of negligence by counsel on the question of jurisdiction. In that reference, the applicant's counsel had filed a claim based on copyright infringement at the IPT instead of the High Court or at the Competent Authority under Kenya Copyright Board.²⁵²

Several factors contribute to the low number of cases displaying negligence by advocates on jurisdiction in our courts. Firstly, the High Court, where most IPRs disputes are adjudicated, has unlimited original jurisdiction in criminal and civil matters.²⁵³ This court has been reluctant to find that it has no power to hear and determine IPRs disputes. However as will be seen shortly, there is divided opinion amongst judges on the constitutional powers granted to the court in view of the presence of quasi-judicial bodies established to deal with IPRs disputes.

Secondly, the High Court has jurisdiction to determine infringement proceedings on trademark disputes.²⁵⁴ The failure to fund the Competent Authority established under the Copyright Act with powers to determine copyright disputes has given the High Court extra burden.²⁵⁵ As a result of this default, copyright disputes are now heard in the High Court.²⁵⁶

²⁵¹ The Industrial Property Tribunal is slow in dismissing matters for lack of Jurisdiction as compared to the High Court. See for example, in *George Ragui Karanja –v- Moras group Ltd, Naivas Supermarket & Safaricom Ltd*, (Industrial Tribunal Court Case No.66 of 2012), where the tribunal dismissed an application for dismissal where the claim arose from a mixture of copyright and industrial design i.e. two distinct property rights administered by different bodies created under two distinct statutes.

²⁵² See *George Karanja –v- Moras Group Ltd and Naivas Supermarket & Safaricom Ltd*. (IPT No. 136/2012).

²⁵³ See Article 165 (3) (a) of the Constitution of Kenya, 2010.

²⁵⁴ See section 2 of The Trade Marks Act (chapter 506) Laws of Kenya.

²⁵⁵ See section 21 of The Copyright Act, 2001.

²⁵⁶ However, as has been argued in chapter two, the Constitutional Court has recently held that that the failure to operationalize that authority denies citizens of their constitutional right to a fair administrative action. The

The Industrial Property Tribunal (IPT) has general original jurisdiction over all issues relating to IPRs protected under the Industrial Property Act.²⁵⁷ This implies that lodging a patent dispute in the High Court, may stir a challenge on jurisdiction. The judges of the High Court are divided on their role in the determination of patent disputes filed in the High Court under the court's original Jurisdiction. Some judges view the role of the High Court as appellate to the decisions of the IPT.²⁵⁸ Others are of the opinion that the High Court has original jurisdiction in IPRs disputes. That notwithstanding, due to congestion of its diary, disputes should firstly be handled by subordinate tribunals²⁵⁹. A third category of disputes involving multiple IPRs interests pose a different challenge. The High Court has claimed jurisdiction on disputes involving overlapping IPRs, or where a single dispute requires multiple tribunals to adjudicate, or where there is an alleged violation of the constitution. Under its supervisory jurisdiction²⁶⁰, the High Court has exercised that power to refer disputes filed before it to subordinate tribunals established specifically to handle those disputes. In this regard judges have effectively shielded lawyers from suits on professional negligence by failing to dismiss disputes initially filed in that court.²⁶¹ Under those powers, for example, in *Apex Creative Limited and Michael Odhiambo Obera -v- Kartasi Industries Limited*,²⁶² Justice E. K. Ongola referred a patent dispute from the High Court to the IPT for hearing and final determination. That transfer from the High

decision was made in *Republic –v- KAMP & Others Ex Parte Pubs Entertainment and Restaurant Association of Kenya* (2014) eKLR. The High Court directed the chairman of this competent authority, Dr Ben Sihanya, to convene the authority to determine a copyright dispute on the charges payable to a CMO by an association of entertainment spots.

²⁵⁷ See Part XV11 of The Industrial Property Act, 2001.

²⁵⁸ Justice Musinga (as he then was) in the case of *Christopher Xallion Ondieki –V- Safaricom Ltd* (2012) eKLR, ruled that the proper forum for determining issues raised is at the Industrial Property Tribunal established under S.113 of the Act. The reasoning behind this is that the jurisdiction of the High Court is appellate under S.115 of the Industrial Property Act, 2001 and all matters of a primary nature ought to be dealt with by the Tribunal

²⁵⁹ See for example Warsame J. In *David Engineering Ltd. –V – Steel Structures, Milimani HCCC No. 189 of 2007(unreported)* where he stated“. . . Taking into consideration that three of the members of the Tribunal are members with legal background and experience, the Tribunal would be in a better position to remedy any grievance or concern that may be suffered by a Patent holder“. In *Apex Creative Ltd. & Another -v-Kartasi Industries Ltd.*, [2011] eKLR, Justice E. K. O. Ogola added his voice when he said 'I rule that further proceedings in this matter, if any or at all, should proceed before the Industrial Property Tribunal. This action is necessary so as not to allow litigants to flood the High Court and congest its diary with matters whose determination and disposal thereof have been provided in a well thought out forum.'

²⁶⁰ See article 165 (6) of The Constitution of Kenya, 2010.

²⁶¹ This was the position in *Steel Structures Limited –v- David Engineering Limited [2007]* eKLR. Where the dispute was referred to the tribunal but luckily, Each party was ordered to pay owns costs for the transfer.

²⁶² High Court Civil Case No. 416 of 2011(unreported)

Court to the proper subordinate tribunal may at times be subject to payment of costs. The High Court has occasionally dismissed claims for lack of jurisdiction. For example, a patent claim filed directly in the High Court instead of the IPT²⁶³ and another matter lodged in the wrong division of the High Court,²⁶⁴ were dismissed for want of jurisdiction.

When urgent orders are required to protect the client from infringement by the defendant, and the court makes a finding that it has no jurisdiction to hear and determine a dispute, the urgency of the dispute may be overtaken by the negligence of the advocate.

Finally, The Constitution of Kenya, 2010, has opened new avenues for litigants to address fundamental breach of constitutional rights. Out of our sample, nine cases were filed as constitutional references based upon allegations of violations of IPRs as a fundamental right. Out of these nine constitutional petitions, eight were filed under the provisions of the current constitution.

In summary, an advocate must be aware of all these differing voices of local judges before lodging any suit to avoid the dismissal of the claim with costs.²⁶⁵

3.7 Negligence in respect of the failure to apply IPRs principles in court

In chapter two, it was established that the failure to understand general principles of law amounts to gross negligence. However the failure to observe an obscure or rare provision of the law may not amount to gross negligence.

²⁶³See Justice Khaminwa in *Christopher Ondieki –v- Safaricom Limited* (2009)eKLR, where the claim was dismissed with costs to the Respondent.

²⁶⁴ See for example, in *Anandamarga Universal Relefteam(AMURT) –v- Amurt(International)* eKLR, where the claim was filed in the High Court Civil Division instead of the Commercial Court Division due to confusion of IPRs and defamation proceedings.

²⁶⁵In *Sanitam Services (EA) Ltd. -v- Tamia Ltd.* (2012) eKLR., Justice Manjanja held that filing a petition for the protection of a fundamental right in the constitutional court was misplaced since the state had enacted legislation and therefore discharged her obligations of protecting IPRs. These statutes have adequate machinery to protect citizens and their IPRs. He ordered the petitioners to pay costs of Ksh. 40,000/- to the three out of the 8 respondents who had filed their appearances and opposed the petition.

Out of our sample, fourteen cases had elements of the failure by counsel to observe and to apply legal principles on IPRs. Out of the seventeen cases displaying multiple negligence faces by counsel, seven cases had evidence of negligence by counsel to apply IPRs principles succinctly.

One of the most glaring displays of negligence by counsel that the author came across, was on the enforcement of a licensee's right to a trademark in *Triumph Development Limited –v- Golden Biscuits (1985) Limited & Another*.²⁶⁶ The law on this point is quite clear.²⁶⁷ A registered user of a mark may only lodge proceedings to protect a right from infringement only when the proprietor has refused to take enforcement proceedings.²⁶⁸ In that case, an advocate failed to advise the permitted user to obtain the written consent of the registered proprietors before lodging the enforcement proceedings. The proprietor refused to give the consent fearing to be dragged into the litigation. The court rejected an application to amend the pleadings to include the registered owner of the mark who was neither willing to be enjoined in the proceedings nor to protect the mark through litigation.

Once an appeal against the decision of the Managing Director of KIPi on any matter involving the registration of a patent is lodged in the High Court, there is automatic stay²⁶⁹ against the enforcement of the decision appealed against.²⁷⁰ However, some advocates have been filing applications for stay of execution of the decision of the institute in the High Court notwithstanding this clear provision of the law and therefore incurring unnecessary costs on behalf of their clients.²⁷¹

Pleadings must always raise triable issues. A party may have a good defence, but if the issues are not properly framed, it can be struck out. Subsequently, summary judgment may be

²⁶⁶ [2007] eKLR.

²⁶⁷ This is provided for under section 31 of the Trade Marks Act (Chapter 506 Laws of Kenya).

²⁶⁸ See for example, in *Triumph Development Ltd. –v- Golden Biscuits (1985) Ltd. & Another* (2007) eKLR, where the suit was defective since the licensee filed it without demonstrating that the registered owner had failed to institute proceedings.

²⁶⁹ The same applies to appeals based on utility models from Industrial Property Tribunal to the high Court as was held in *Sanitam Services (EA) Ltd –v- Rentokil (K) Ltd*. (2012) eKLR.

²⁷⁰ See section 104(3) of the Industrial Property Act

²⁷¹ See for example in *Santam Services (EA) Ltd. –v- Rentokil (K) Ltd* (2014)eKLR.

entered against the respondent.²⁷² In *Ananda Marga Universal Relief Team (AMURT) –v- Amurt (international)*²⁷³ instead of filing copyright infringement proceedings, an advocate lodged defamatory proceedings claiming loss of credibility for adulteration of an author’s work.²⁷⁴

Other than on the legal principles applicable to IPRs disputes, advocates are occasionally negligent in applying general principles of law. For example, in *Republic –v- Registrar of Trademarks Ex Parte Sony Holdings limited*,²⁷⁵ the petitioner’s advocate prayed for orders of prohibition to restrain the activity of a Collective Management Organization (CMO) from charging new fees rates, instead of seeking for orders of certiorari to quash the decision. In one other extreme case of negligence, a firm of advocates lodged a constitutional petition challenging the decision of the Registrar of Trademarks to extend time to lodge certain pleadings instead of opposing the application.²⁷⁶ In *Sanitam Services (EA) –v- Tamin Ltd and 16 Others*²⁷⁷, a party was penalized for filing a constitutional reference alleging violation of its fundamental rights instead of lodging infringement proceedings,²⁷⁸ while in *Safepak Ltd –v- Asili Plastics Limited*,²⁷⁹ the defence counsel confused infringement proceedings with objection proceedings during the hearing of an objection to expunge a trademark from the register.

An advocate is the key decision maker on the proper parties to a suit. He must determine whether to sue the primary, secondary, indirect infringer, the employer of an infringer under the doctrine of vicarious liability, or whether to sue all joint tortfeasors²⁸⁰. It may amount to professional negligence to have a matter struck out for non-joinder or mis-joinder of parties. It

²⁷² See *Matthew Peevers –v- Le Slingerland & Another* (2000) eKLR, where the defence was struck out for failing to raise triable issues. The defence consisted of mere denials which could not warrant a full trial.

²⁷³ (2012) eKLR.

²⁷⁴ Here, the defendant published some notices in the newspapers explaining their successes in various projects in Kenya. The plaintiff claimed ownership of those projects in a suit based on defamation together with a claim for breach of copyright over the use of the name ‘Amurt’.

²⁷⁵ (2012) eKLR.

²⁷⁶ That was the case in *Republic –v- Registrar of Trademarks Ex Parte Sony Holdings Ltd* (2012) eKLR.

²⁷⁷ (2012) eKLR.

²⁷⁸ See Justice Manjanja in *Sanitam Services (EA) –v- Tamin Ltd and 16 Others* (2012) eKLR. Only 4 out of the 16 Respondents had opposed the petition. If all Respondents had filed replies, the petitioner would have paid the sum of Kshs. 480,000/ as wasted costs. Considering the ruling of the court and the prayers sought, the petitioner was clearly misadvised by her advocate.

²⁷⁹ (2013) eKLR.

²⁸⁰ The test for a joint tortfeasor is that ‘Each person has made the infringing acts his own’ as stated in *Saba Spa –v- MFI Furniture* (2003) EIPR 188.

is also erroneous to have an academic judgment against the wrong party as was the case in *Triumph Development Limited- v- Golden Biscuits (1985) Limited & another*.²⁸¹

Even though the Constitution of Kenya encourages substantive justice as opposed to procedural technicalities in the determination of disputes,²⁸² the failure to observe procedure may occasion substantive injustice to a party. For example, in *Ananda Marga Universal Relief Team (AMURT) –v- Amurt (International)*,²⁸³ the plaintiff instituted defamation proceedings against the defendant for the use of the name ‘AMRUT’ . The plaintiff alleged copyright over the name following prolonged identity. The defendant, who had a similar name to that of the defendant, published an advertisement in the local dailies detailing the projects which they had carried out successfully in Kenya and other countries. This publication caused confusion on the activities of the plaintiff and the defendant to the general public. The plaintiff filed defamatory proceedings against the defendant. Both parties were Non-Governmental Organizations involved in charitable work. The High Court observed, during interlocutory proceedings for orders of interim injunction, that it was not clear whether the matter could be determined substantively in that form.²⁸⁴

It is note worth that general principles of law regulating litigation apply to IPRs disputes lodged in our courts. From our sample, we have observed that lawyers dealing with IPRs disputes quite often display the same level of negligence as other litigation lawyers while dealing with appeals to the Court of Appeal after dismissal of claims in the High Court. A good example is where an application for the grant of an interlocutory injunction is dismissed in the High court and the losing party appeals to the Court of Appeal. It is not rare to find an appellant seeking to stay orders of dismissal issued by the High Court pending the hearing of the appeal.²⁸⁵ This is of course a procedural misconception. Once a matter is dismissed, there is no order capable of enforcement which may be the subject of stay of execution proceedings.

²⁸¹ (2007)eKLR.

²⁸² See article 159 of The Constitution of Kenya 2010.

²⁸³ (2012) eKLR.

²⁸⁴ See also example, in *Village Photoshop ltd –v- Mercy Wanja Mutegi t/a Digiclicks Photographers and Another*(2012)eKLR. Here, the plaintiff sought to protect their IPRs against the defendants, who were their previous employees. The suit was filed in the Industrial Court Division of the High Court as an employment dispute.

²⁸⁵ See *Delta Connection Ltd -v- Delta Airlines Incorporated*. C.A No. 70 of 2009(unreported).

When an advocate has negligently confused the principles applicable in a dispute, multiple difficulties emerge. These difficulties lead to the ultimate collapse of the suit. For example, pleadings may not be correctly drafted, the arguments may contradict, the evidence may fail to establish the claim, and the general attire of the suit is disoriented. No wonder as will be seen below, in claims displaying multiple incidences of professional negligence, the failure to comprehend the applicable principles in IPRs disputes is the most predominant factor in the dismissal of IPRs suits.

3.7.1 Failure to apply legal principles by advocates at KIPI

Professional negligence arising from the failure to apply legal principles in disputes lodged in KIPI is common. From our sample, fourteen cases fell under this category. Out of the seventeen cases displaying multiple elements of negligence from our sample, seven matters had evidence on the failure by advocates to observe legal principles.

Examples of negligence conduct by counsel noted at KIPI include confusion on the first to file principle applicable to patent protection but not in trademarks and copyright matters.²⁸⁶ In *the matter of Trade Mark Nos. 63725 'wakilisha' (Word & Device)*²⁸⁷ the counsel for the Respondent confused infringement proceedings and expungement proceedings during an objection hearing with respect to an objection to the registration of the mark. In another matter, counsel incorrectly raised non-use arguments of a trademark, which defence is only available for expungement proceedings, during the hearing of an appeal from the decision of an examiner.²⁸⁸ Another counsel erroneously argued that the registration of a drug under the Drug and Pharmacy and Poisons Board amounted to the registration of a mark.²⁸⁹ The failure to

²⁸⁶ See in the matter of Trade Mark Application No. KE/T/2008/63532 'Mistress' in class 5 In The Name Of Agri Care EA Ltd. and Expungement Proceedings thereto by Osho Chemical Ltd.

²⁸⁷ In The Name Of Wakilisha Ltd. & Expungement proceedings by Vision 2030 Delivery Secretariat,

²⁸⁸ In The Matter of Trade Mark Application No. 717254, In the Name Of Swartland Winery Ltd.

²⁸⁹ As was in the case of In The Matter of Expungment Proceedings of Trade Mark Application No. 59512 (Risek Omeprazole) (word and Device) in The Name Of Getz Pharma (Private) Ltd on application by Golf(Julphaz) Pharmaceutical Industries Ltd.

appreciate who has locus to file opposition to the registration of a trademark²⁹⁰ has also been a challenge to some advocates.

Senior advocates occasionally fall prey to professional negligence. A good example is *In the matter of registration of the trade mark known as 'Dawa Moja'*²⁹¹ where a lawyer of more than twenty years of practice confused the principles relating to IPRs during submission before the Registrar of Trade Marks. The Registrar noted that 'the applicant's counsel was somehow 'confused and confusing in(sic) submissions ending up supporting the case of the opponent after submitting that the word 'dawa' had acquired common notoriety and universal application therefore ending up supporting the opposition proceedings'.

3.8 Cases of multiple professional negligence conduct by counsel in IPRs disputes

Some advocates display multiple elements of negligence in the conduct of their client's business in the arena of IPRs. Out of our sample of one hundred decisions delivered by our courts, seventeen had characteristics of multiple elements of professional negligence by counsel. Out of these seventeen matters, seven matters had elements of negligence in the legal principles applicable on IPRs matters, eleven matters had pointers of negligence on the nature, mode and content of evidence adduced at the hearing, while twelve had evidence of negligence in the drafting of pleadings.

At KIPI, from our sample, out of the fifteen cases displaying multiple facets of professional negligence, nine matters had evidence of negligence by counsel on pleadings, a similar number had evidence on negligence by counsels on the applicable legal principles, while all these matters failed to be supported by proper evidence.

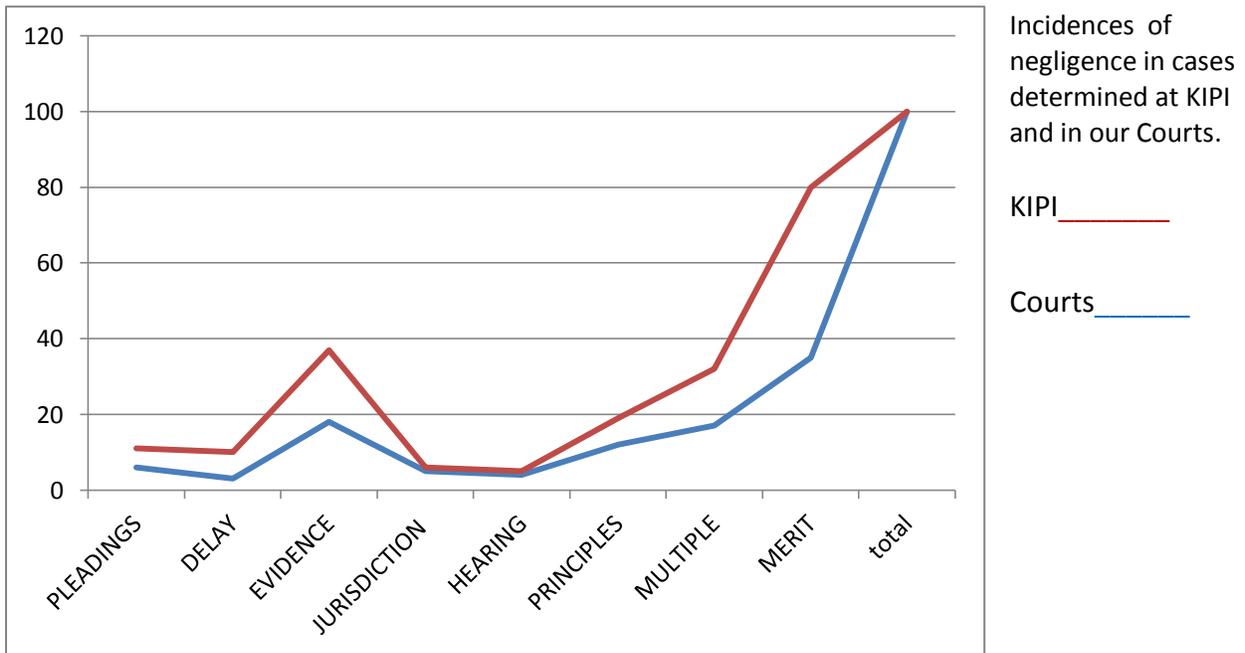
In our view, from these cases, it is safe to presume that once an advocate fails to understand the principles applicable in a dispute, then, the pleadings are likely to be sloppy while the

²⁹⁰ See *in the matter of Trade mark 'Maxivita -M' (word) in class 5 in the name of Surgilinks Ltd and Opposition thereto by Agio Pharmaceuticals Ltd.* other than locus under section 14 and 15 of The Trade Marks Act, the advocates confused infringement, passing off and opposition proceedings.

²⁹¹ *in the matter of Trade Mark Application Number KE/T/2012/75575 'Dawa Moja' In The Name Of Chandaria Pharmaceuticals (K) Ltd and opposition by Dawa Ltd. and Sonal Holdings Ltd.*

evidence adduced is unconvincing. Suits displaying multiple facets of negligence are the classical expression of professional negligence by advocates. Such suits demonstrate complete derogation of an advocate’s duty to a client.

In our analysis, and in comparison, incidences of negligence in the two categories of cases may be represented as follows;-



4.1 Public interviews through questionnaire

In order to compare data generated from court rulings as represented in this chart with the perception of members of the public, we carried out public interviews through a properly designed questionnaire.

4.2. Data collection method

The information gathered for this study was collected through unstructured or open interviews. A questionnaire, directed to a certain target population, was utilized to obtain opinion from the

public on the controversies surrounding this topic. The architecture of our questionnaire was intended to allow our targeted sample express their opinion in a free flowing manner on some issues. The sample consisted of about eighty eight carefully selected individuals. Six out of that number refused to be interviewed. We had circulated one hundred and ten questionnaires but only eighty two were correctly filled and six blank ones returned. In our opinion, the exercise of extracting information from the public was successful as we obtained responses from more than seventy five per cent of our target.

4.3 Purposes of the study

The study was intended to determine the prevalence of professional negligence in the bar in Kenya from the perspective of the consumers of legal services in IPRs protection. Since our research is on the possible defence of immunity against liability for negligence, we tested the hypothesis articulated in chapter one in this paper. We intended to see whether this defence is viable in our country and if so, the logic behind it. We also sought to investigate what should be done to contain professional negligence in the bar.

4.4. Analysis of research findings

4.4.1 Prevalence of professional negligence in the bar on IPRs issues.

In order to determine the prevalence of professional negligence in the bar, we sought to approach this matter from two perspectives namely; negligence in general areas of practice of the law, and secondly, on IPRs matters.

From our study, most lawyers are not generally negligent in the handling of instructions from their clients in general matters of practice. That verdict was given by interviewees who had previous contact with several advocates on various legal issues. In contrast, IPRs practitioners are generally negligent.

The two main areas of professional negligence by lawyers on general instructions are; firstly, unnecessary delays in finalizing instructions and, secondly, the failure to give proper advice. Poor preparations and failure to explain legal documents was noted by some interviewees.

Probably because many interviewees were not well versed with the law, none complained of ignorance of the law by counsel. Only six interviewees complained of poor draftsmanship in legal instruments or on pleadings by lawyers on IPRs matters.

On IPRs protection, the main complaint was negligence in the drafting of pleadings and legal instruments. This was closely followed by the failure to give adequate advice to clients. Out of seven IPRs interviewees, five noted that their advocates were negligent in carrying out instructions on these two grounds.

We noted that the public perceived negligence by lawyers less critically than as seen by judicial officers. Whereas the decisions in our earlier sample indicate a worrying trend on professional negligence on IPRs litigation, the public was less alarmed by that trend. This may be occasioned by several factors. Firstly, many members of the public do not understand the nature of professional negligence. Due to ignorance of the law, many clients do not also comprehend legal principles. Many Kenyans are not therefore able to detect negligence by their advocates. This fact was confirmed by some interviewees who had no idea that judicial officers enjoy immunity from liability arising in the execution of their official functions. Secondly, due to the challenges of backlog in our courts as explained in chapter one, by the time a matter is heard and determined, parties are already tired. Exhausted by reason of this delay, parties take no pleasure in litigation over the same issues or in evaluating the performance of their lawyers. Out of eighty two interviewees, only seven had instructed advocates from different firms. In our view, only these seven interviewees had the advantage of comparing the services offered by different lawyers. Since most interviewees were not familiar with services offered by different lawyers, we noted that many presumed that the law operates mainly in the version explained to them by their advocates.

Many Kenyans cannot afford legal fees required to institute fresh suits against their negligent advocates. This phenomenon probably explains why, from our sample, only seven interviewees, who experienced professional negligence from their initial lawyers, instructed new advocates to finalize their transactions. Interestingly, five out of the seven witnessed fresh incidences of professional negligence from their subsequent lawyers. We could however not establish

whether these interviewees were among a group of difficult clients who disparage lawyers and insist that their work must be done in a particular style, or whether they were genuinely affected by the professional negligence of their lawyers. More research should be conducted in that area to diffuse that question.

4.5. Liability for professional negligence in the bar

The response as to whether advocates should be held liable for professional negligence was overwhelmingly clear. Lawyers should be held liable for professional negligence arising from their call of duty. Less than one per cent of our sample thought otherwise. Lawyers practising in the arena of IPRs should be treated like other lawyers despite not be treated differently due to the technical nature of their practice.

Some interviewees thought that other professionals should be protected from liability for negligence. From our observation, there is reservation to that opinion. Interviewees with bias to a certain vocation sought protection for their profession. For example, two out of seven interviewees practising in the medical world thought that doctors should be protected from liability for negligence due to the technical nature of their work. A nurse thought that immunity from liability for negligence should be granted only to doctors and nurses. From the twenty five interviewees in favour of the grant of immunity against liability for professional negligence to members of other professionals, nineteen proposed police officers while fourteen proposed doctors. We opted to mention doctors and police officers in our questionnaire since these two occupations are well known in Kenya. Surprisingly, no convincing reasons were advanced to justify insulation of the two callings from liability for negligence. For instance, those in support of insulation for police officers argued that the nature of their work, especially on investigations and prosecution, made it prone to multiple suits on negligence. This may reduce their morale to fight crime in the society. On the other hand, the technical nature of a doctor's work was the main reason advanced for the insulation of medical doctors from negligence. Since professionals offer technical services, it is not sufficient to give technicality as the only basis for giving protection against liability for negligence.

Members of the public gave several views as to why advocates are negligent. The pressure of work, lack of passion and commitment to their professional calling, exploitation of innocent clients, unattractive remuneration resulting into less time commitment to a task, lack of specialization, improper training and mastery of the law, poor communication skills, inadequate cooperation from some clients, and poor preparation. Student lawyers at the Kenya School of Law were very critical of the system currently in place for training young lawyers during pupillage. There process for confirming that students are taught by devoted pupil masters to avoid future incidences of negligence. Student masters are not evaluated on their suitability before being commissioned to train students. Lawyers volunteer to train students without being given any corresponding incentive by the law society. As such, half-baked lawyers are released to the profession culminating into low standards by advocates.

4.6. Opinion on the suitability of immunity as a defence against liability for negligence in the bar on IPRs issues.

In chapter one, we established that our courts are divided on the availability of the defence of immunity against liability for professional negligence. It is quite interesting to note that our interviewees were divided almost equally on this issue. The majority (55%) were in favor of the grant of some form of immunity against liability for negligence in the arena of IPRs. The predominant reason given for this protection was the fear of future suits against lawyers for professional negligence while handling cases in court. This fear drives lawyers to lose their freedom of speech while addressing judicial officers in court rooms in strict compliance to instructions given by their clients. In the end, administration of justice is put into disrepute. The second main reason that was given by our interviewees is public policy concerns. Public policy demands that there should be no re-litigation on the same issues. The minority thought that insulation was necessary due to the complex nature of an advocates work. Insulation is also necessary in the general administration of justice.

Out of twenty four professionals excluding lawyers in our sample, half were in favour of the grant of some form of immunity to lawyers handling IPRs issues. Lawyers were however divided on whether this insulation was necessary. Out of eighteen lawyers who gave their views, ten

were opposed to the grant of immunity as a defence against liability for negligence. Out of seven interviewees in the medical world, only three were in favour of insulation.

Our sample might not be adequate to give a conclusive opinion on the general view of Kenyans on the defence of immunity against liability by lawyers for professional negligence. However, it is an indicator of the general divide on this possible protection.

Based on our analysis, it is our opinion that professionals in Kenya are divided on whether or not this insulation is necessary. Most Kenyans are however against protection.

4.7 Extent of immunity to be granted to advocates against liability for negligence

Those in favour of the grant of some form of insulation to IPRs opined that this defence should mainly be limited to work intimately connected to the hearing of a suit but done outside the court room. This view was closely followed by those in favour of insulation during hearings. Only six of the forty two interviewees in favour of protection thought that immunity should extend to deskwork not related to trials in courtrooms. Four interviewees thought that it was necessary for the administration of justice.

Those opposed to any form of protection enunciated various reasons. Some thought that protection will encourage negligence in the bar. Advocates will also be above the law if granted this blanket protection. This insulation would amount to discrimination. No other profession is granted protection. Only high quality and competitive legal services can be offered without this insulation. Others averred that the fear of liability for negligence would make lawyers raise legal standards to higher levels by each new generation. As such, this defence is a set back to the advancement of higher standards of service delivery in the legal profession.

4.8. Other methods of avoiding professional negligence by lawyers in the arena of IPRs

Special training is required to equip advocates with the knowledge necessary to handle IPRs matters. All interviewees concurred that lawyers must receive special training on IPRs. However, the relationship between adequate training of lawyers and occurrence of professional negligence is a study that requires to be done in Kenya to confirm whether training

is the solution to this problem. Specialized training will however reduce some forms of professional negligence like confusion in the application of legal principles.

We sought to get views from the public on whether law should be studied as a second degree programme. Sixty six percent (66%) of the interviewees proposed that a law degree to a second degree while seventy three (73%) thought that a second degree on IPRs matters or special training of lawyers by a specialist institute would reduce incidences of professional negligence in the bar. Interviewees in favour of the establishment of a special institute on IPRs matters were sixty two (62) percent of the respondents. Fifty Eight percent (58%) thought that professional negligence in the bar in the arena of IPRs is generally caused by poor training of lawyers. In order to curb this menace, one strong proposal by law students was to properly train students at law schools and during attachments on issues surrounding professional negligence.

As already observed earlier, training may not necessarily translate into few claims of negligence against lawyers. Some lawyers in Kenya are, for example, trained in India where law is a second degree. No doubt some of the cases referred to in our sample were conducted by lawyers trained in Universities in India where law is studied as a second degree. This notwithstanding, high qualifications coupled with a first degree in another discipline before admission to study law may ensure that lawyers have acquired some form of background training on other disciplines prior to admission to law school. By receiving further and more specialized training on IPRs matters, lawyers will presumably be well equipped with the knowledge necessary to avoid recklessness in practice. Specialized training may be done through either a compulsory masters degree programme or a diploma offered by the institute dealing with IPRs matters. For patent protection, a scientific background would be of added value to advocates. This is more so because patent descriptions are generally scientific in character. Few lawyers in Kenya possess the scientific background necessary to draft claims, descriptions, drawings and abstracts required to protect patent rights. Many advocates therefore lack capacity to protect patents through effective litigation. This handicap in training lawyers on IPRs issues no doubt affects effective protection of these rights.

We also sought opinion on the relationship between training of lawyers in Kenya in the arena of IPRs and the prevalence of professional negligence in the bar. The results were startling. Seventy seven percent (77%) were of the view that IPRs practitioners should undertake a second degree on IPRs or should be trained under an independent institute dealing solely on IPRs matters for negligence in the bar to be significantly reduced. Sixty six (66%) percent were of the view that a system should be established to examine and admit lawyers to the institute. Finally fifty eight percent (58%) were of the view that negligence in the bar in the arena of IPRs is caused by poor training of lawyers. All interviewees were of the view that IPRs practitioners must receive specialized training on IPRs matters.

On the issue of legislating, many interviewees (66%) opined some form of regulations should be enacted to govern issues on immunity against liability for negligence at the bar in Kenya. Interviewees were given freedom to give views on legislating. Several reasons were given in under this head. Some argued that the process leading to legislation will stir national debate in Kenya and high lighten the matter. This exposition might lead to more liability suits against advocates which may help development jurisprudence. Members of the public will ultimately demand for higher quality of services from their advocates. Other interviewees suggested that enactment might be the key to improved standards of service delivery in the bar. That may be so if insulation is denounced by statute. By passing new laws, courts will no longer be allowed to take up the role of the legislature. The judiciary will cease to make laws and observe the doctrine of separation of powers of state organs. In other words, as was observed by some keen interviewee, the failure to legislate leaves this determination solely in the hands of advocates; some sitting as judges while others are in the bar. In the extreme case, lawyers sitting in the bench may, upon retirement, go back to legal practice. Judges may therefore have chances of being found liable for negligence in their sunset days. To avoid this embarrassment, some judges may be persuaded to secure their future by pronouncing favourable judgments to practitioners on liability claims for professional negligence.

Those opposed to legislation thought that this exercise may amount to discrimination. Some argue that the legal profession is not so unique as to demand for special treatment. Other

professionals will demand enactment of similar legislation. The resulting demand will lead to wastage of public funds. Some insisted that precious time of legislators will be lost on trivial issues since only few professionals are reportedly negligent. Others felt that there are adequate mechanisms in the current legal infrastructure to address professional negligence in the bar.

4.7. Conclusion

We asked our interviewees to rank the following persons in terms of their ethics and honesty in their character. The results were as follows;

ETHICS

	VERY HIGH	HIGH	AVERAGE	LOW	VERYLOW	DON'T KNOW
DOCTORS	9%	20%	41%	7%	20%	3%
POLICE OFFICERS	5%	7%	7%	12%	65%	4%
LAWYERS	3%	28%	47%	17%	5%	3%
CIVIL SERVANTS	7%	5%	37%	20%	27%	4%
RELIGIOUS LEADERS	7%	25%	38%	13%	13%	4%
JUDGES	10%	22%	34%	22%	9%	3%
PEOPLE GENERALLY	0	10%	59%	15%	12%	4%

HONESTY

	VERY HIGH	HIGH	AVERAGE	LOW	VERY LOW	DON'T KNOW
DOCTORS	8%	29%	37%	4%	18%	4%
POLICE OFFICERS	1%	5%	12%	20%	59%	3%
LAWYERS	5%	20%	36%	24%	13%	2%
RELIGIOUS LEADERS	9%	26%	29%	22%	11%	3%
CIVIL SERVANTS	1%	5%	48%	18%	25%	3%
JUDGES	9%	19%	49%	18%	4%	1%
POPLE GENERALLY	4%	13%	49%	22%	8%	4%

These findings reflect a sad commentary about professionals in our society. The society views lawyers with suspicion in respect of their ethics and honesty. Advocates are generally ranked below average by many Kenyans on the twin issues. Lawyers have lost public confidence while

rendering their services. Lack of honesty and ethics by professionals to the public, may be evidence of low standards of care in the services rendered by lawyers. Advocates are required to exert more effort in their work to help gain the confidence of the society. The looming reaction, to this sad state of affairs will soon be realized when more suits are filed against lawyers for professional negligence. When the society becomes conscious of professional negligence by lawyers in the arena of IPRs, many reckless lawyers will probably be rendered bankrupt by the massive compensatory claims for professional negligence that will follow. Advocates must reverse this trend in order to save the legal profession in Kenya from falling into shame.

CHAPTER FOUR; DEALING WITH PROFESSIONAL NEGLIGENCE IPRS PRACTICE; A COMPARATIVE STUDY OF SOUTH AFRICA, ENGLAND AND CANADA.

Our study cannot be complete without evaluating how other jurisdictions have addressed negligence and incompetence amongst IPRs practitioners. We may not have adequate time to study how the universe deals with this menace. We have however isolated three countries in three different continents for our purpose. South Africa, England and Canada will in our view provide insights that may be critical if borrowed in Kenya. These three countries are important since they do not shield practitioners from suits emanating from professional negligence.

5.1 South Africa and IPRs Protection.

South Africa has developed one of the most advanced systems of IPRs protection in Africa continent. Professional negligence is not defined as a tort in South Africa. It falls under the concept of general duties of care in the law of delict. A delict may be described as a civil wrong in terms of which a person causes harm to another. Lawyers are therefore liable for negligence under the law of delict. Immunity against liability in the bar in South Africa is a foreign doctrine. However, systems have been developed by the bar and the government to ensure that high standards are maintained in IPRs protection.

The first important body for protection is the Companies and Intellectual Property Commission (CIPC). It was established by the government to administer fifteen different pieces of legislation relating to corporate and intellectual property regulation.²⁹² This commission is established to report, research and advise the Minister of Trade and Industry on matters of national policy relating to company and intellectual property law.²⁹³ It is also responsible for registration of IPRs. CIPC has offices located in the main cities of South Africa for accessibility by the public. Applications are lodged online through e-services and tracked in the system to the point of registration. The electronic system reduces chances of some forms of negligence by practitioners like the failure to attach proper documents in applications.

²⁹² See <http://www.cipc.co.za/> for details of the legislation and other functions. It was accessed on 7.7.2015

²⁹³ Ibid.

The government has incorporated an institute responsible for regulation of IPRs practitioners. It is known as The South African Institute of Intellectual Property Law (SAIIPL).²⁹⁴ Its main role is to admit members to practice in CIPC. SAIPL sets special examinations for admission of six different categories of practitioners. These classes are Honorary Members, Fellows, Associate Members, Ordinary Members, and Student members. Each category demands stringent entry qualification requirements set out under the SAIPL constitution.²⁹⁵ For example, honorary membership is conferred to a member, who has provided extra ordinary services or who has achieved extra ordinary achievements in the name of the institute or in the field of Intellectual property law. Fellowship is granted to members who have demonstrated high standards of academic and practical experience or from among members from certain disadvantaged groups. Associated members and student members must meet such minimum qualifications for admission to the institute. Same for honorary members, special examinations are set for each category of individuals prior to admission. Advocates practicing under SAIPL must also comply with the Uniform Rules of Professional Conduct formulated by the General Council of the Bar of South Africa.²⁹⁶

Once a lawyer is admitted to the bar, he must apply to join the institute after going through training and passing examinations administered by the institute. The institute has its own disciplinary process. The Constitutional, Code of Ethics, Regulations and Disciplinary committee consists of nine members who meet on ad hoc basis as required.²⁹⁷ This committee is responsible for maintaining and amending the Constitution of the Organization, Code of Ethics, and Regulations. It is mandated to investigate complaints raised against members and, if necessary, to recommend to the Council of the Institute the taking of disciplinary steps against such member.

²⁹⁴ According to their website, 'The South African Institute of Intellectual Property Law (SAIIPL) was established in 1952 and represents over 164 patent attorneys, patent agents, trade mark practitioners and academics in South Africa who specialize in the field of Intellectual Property Law. The SAIPL is widely regarded as the custodian of South Africa's intellectual property rights, and comprises practising attorneys, academics, practitioners in businesses and in general, people interested in the protection and enforcement of intellectual property right' see <http://www.saiipl.org.za/about-us> as accessed on 1.10.2014.

²⁹⁵ For details see, <http://www.saiipl.org.za/membership/9-uncategorised/80-memreg> as accessed on 1.10.2014

²⁹⁶ For details see www.capebar.co.za/attachments/article57/GBC or www.sabar.co.za/rules-of-ethics.html as accessed on 30.7.2015

²⁹⁷ See note 4 above.

Practitioners are also controlled by the bar in South Africa. The South African legal practice is similar to the United Kingdom model. It comprises of two main branches of legal practitioners: attorneys, who do legal work of all kinds, and advocates, who are specialists²⁹⁸. Attorneys, like solicitors, are business managers of cases who decide when an advocate is necessary to be engaged to act for the clients. Advocates, like barristers, observe the "cab rank" rule. They have no direct contact with clients. Advocates are said to be in a 'referral' profession.²⁹⁹ Standards of practice are maintained by the General Council of the Bar of South Africa (GCB).³⁰⁰ The bar disciplines members through a system established by the law.³⁰¹ To qualify for admission to the bar, in some provinces, one must at least attain a four year LLB or a three year undergraduate degree (Ba, BCOM, or a BSC) plus a two year LLB from any South African University.³⁰² This system allows the most qualified advocates to represent IPRs clients in disputes, ensures incompetence is punished, and allows multiple counsels handle court disputes.

It is clear that this dual disciplinary process ensures that members of the institute are highly trained. Practitioners are monitored by three independent bodies. Continuous legal education ensures that practitioners are kept updated with emerging issues in the market. Standards are enforced through a code of ethics strictly observed by members and revised regularly. Practitioners know that the law of delict does not entertain insulation. This model ensures that negligence amongst practitioners is minimized and is comprehensively addressed.

²⁹⁸ Corbett CJ observed in *In re Rome* 1991(3) SA 291 (A) at 305I - 306A, that "[h]ere we have what has been described as 'the divided Bar' (see Joubert (ed) *Law of South Africa* vol 14 para 246). It is a legacy from Holland, and also from England. Legal practitioners thus fall into one or other of the two groups, the advocates and the attorneys."

²⁹⁹ See <http://www.sabar.co.za/legal-career.html> for more details on the differences between the two. Accessed on 30.7.2015.

³⁰⁰ For more details, see <http://www.sabar.co.za/members.html> as accessed on 30.7.2015.

³⁰¹ Courts have inherent disciplinary powers over practitioners in cases of misconduct or unprofessional conduct (*De Villiers and Another v McIntyre NO* 1921 AD 425 at 435; *where* Innes CJ said : "The interference of the Court is clearly justified where there has been gross non-discharge or mis-discharge of professional duty. So also where the conduct proved, whether criminal or not, is so morally reprehensible that the person guilty of it is clearly unfit to become or remain a member of the profession. But when we leave the area of criminality, immorality or actual misconduct, the enquiry becomes more complicated ..."

³⁰² See *ibid* for details.

5.2 IPRs Governance in England.

Prior to January 2010, when the Legal Services Act 2007 came into force, two bodies were responsible for regulating standards for attorneys for intellectual property in England. These two bodies were independent of each other. These bodies are; the Chartered Institute of Patent Attorneys (CIPA),³⁰³ responsible for regulation of Patent Attorney, and the Institute of Trade Mark Attorneys (ITMA) for regulating Trade Mark Attorneys. CIPA was founded in 1882 and incorporated by Royal Charter in 1891. On the other hand, ITMA³⁰⁴ was incorporated in 1934 when representatives of trademark practitioners came together to formulate an association to protect their interest. Each body had its own regulation board, namely, the Patent Attorney Regulation Board and the Trade Mark Regulation Board. The boards were responsible for educating, training, setting qualifications, keeping the register of members, setting and applying standards, enforcing the code of conduct and finally, for handling complaints against Patent and Trade Mark Attorneys. The Legal Services Act³⁰⁵ changed the way Intellectual Property Attorneys are regulated. Under the Act, an independent Board known as the Intellectual Property Regulation Board (IPReg) was set up by the regulation boards of the two institutes.³⁰⁶ IPReg was established to separate the regulatory functions from representational functions of the two institutes. IPReg sets standards for patent and trademark attorneys together with their employees. Both bodies work under the Intellectual Property Office (IPO) which is the official government agency responsible protecting IPRs in Britain.³⁰⁷

The composition of IPReg is central to high standards of practice in the profession. IPReg consists of a Chairman, four Lay Members, three Patent Attorneys and three Trade Mark Attorneys. When one of the Regulation Boards sits to determine an issue which affects that profession, the panel consists of the Chairman, the four Lay Members together with the appropriate three professional members of the profession. The composition ensures that both

³⁰³ See www.cipa.org.uk as accessed on 24.7.2015 for more details of the organization

³⁰⁴ See www.itma.org.uk as accessed on 24.7.2015 for more details of the organization

³⁰⁵ See www.legislation.gov.uk for a copy of the same as accessed on 30.7.2015

³⁰⁶ See <http://ipreg.org.uk/public/about-us/how-we-work/> as accessed on 30/7/2015

³⁰⁷ See note 5 supra for more details of the IPO as accessed on 1.8.2015

institutes are represented during the decision making process on matters central to that particular institute. This board is responsible for setting Education and Training requirements for qualification as a Patent or Trade Mark Attorney. It regulates the requirements for Continuous Professional Development for both professions. This exercise ensures that Patent and Trade Mark Attorneys maintain knowledge, skills and expertise of high quality. IPReg is responsible for setting and maintaining a Code of Conduct for the two professions and punishing incompetence.

Attorneys are also subject to the primary code of conduct which is an additional mechanism for accountability and dispute resolution with their clients. The code requires law firms to institutionalize an internal complaints system. Each solicitor's firm must designate a complaints handler whose details are given to the Solicitors Regulation Authority.³⁰⁸ A client dissatisfied with the service of an attorney must raise the complaint with the firm's complaint handler before raising it with the society. If the handler fails to resolve the issue, the complaint is passed to the second level namely, the office of the Legal Ombudsman. The Legal Ombudsman³⁰⁹ is an independent and impartial body set up to help resolve legal service disputes. When complaints are raised against a legal practitioner before the Ombudsman, the facts are weigh-up and if necessary, disciplinary action taken against the negligent attorney. The legal Ombudsman has jurisdiction over all sorts of regulated legal service providers namely: solicitors, barristers, licensed conveyancers, cost lawyers, legal executives, notaries, patent attorneys, trade mark attorneys, law firms and companies providing legal services such as claims management companies. If the complaint is found to be substantial, it may be forwarded to the Solicitors Disciplinary Tribunal (SDT)³¹⁰ established by the Solicitor Regulation Authority.³¹¹ If the complaint is against a barrister, a different cause of action may follow. It may be forwarded to the Bar Tribunal and Adjudication Services (BTAS). BTAS is responsible for

³⁰⁸ For details see <https://www.lawsociety.org> as accessed on 30/7/2015

³⁰⁹ See <http://www.legalombudsman.org.uk> as accessed on 30.6.2015

³¹⁰ This tribunal was established under section 46 of the Solicitors Act 1974 in UK. The tribunal adjudicates upon breaches of conduct relating to solicitors and their firms. See www.solicitortribunal.org.uk as accessed on 30.7.2015 for more details

³¹¹ The jurisdiction of this tribunal extends to Recognized bodies, Registered European Lawyers and Registered Foreign Lawyers and their employees. For more details see www.solicitortribunal.org.uk as accessed on 30.7.2015

appointing disciplinary Tribunals for barristers facing charges of professional misconduct and negligence.³¹² The Council of the Inns of Court (“COIC”) is the body responsible for recruiting, appointing and administering bar disciplinary panels³¹³ for BTAS.

Barristers and Solicitors are required to obtain indemnity insurance policies prior to obtaining license to practice. The cover is a vital financial protection for clients against negligence and monetary losses suffered on account of firms and their employees. According to the Solicitors Regulation Authority Hand book³¹⁴, each unincorporated firm is required to secure professional indemnity insurance to a limit of indemnity of Two Million British Pounds. On the other hand, incorporated bodies are required to obtain indemnity of Three Million British Pounds in any one claim.³¹⁵

However due to poor claims record, major outstanding claims, or other risk factors some firms may not be able to afford or secure that cover. A further system known as Assigned Risks Pool (ARP) has been designed by the SRA to secure clients from such firms.³¹⁶ ARP is managed by a manager appointed by the Solicitors Regulation Authority. Every firm contributes to the SRA fund. It is a common endowment fund in which solicitors who claim under it contribute more premiums than other firms. An unpaid contribution may be recovered as a debt to the society. This system highlights incompetence among practitioners since beneficiaries are named in the records published by the manager of the fund.

The English Judicial System has special courts reserved for disputes involving intellectual properties. The Intellectual Enterprise Courts(IPEC) , initially known as Patents County Courts

³¹² See the Bar standards Board Handbook, 2nd Edition-April 2015 for details of the procedures to be used for disciplining incompetent barristers. This book is available in www.tbta.org.uk- 2nd Edition-Of-the BSB-Handbook as accessed on 30.4.2015.

³¹³ For the procedures see www.barstandardsboard.org.uk as accessed on 30.7.2015

³¹⁴ The latest version is version 14 and was published on 30.4.2015. It is published by the Solicitors Regulation Authority Board under sections, 31, 79, and 80 of the Solicitors Act 1974. www.sra.org.uk as accessed on 1.8.2015

³¹⁵ See section 2.2 of the Solicitors’ Indemnity Insurance Rules 2015, available in www.sra.org.uk/solicitors/handibook/handbookprinciples/content.page as accessed on 1.8.2015

³¹⁶ *ibid*

(PCC)³¹⁷, were developed to enhance access of justice to small and medium sized enterprise(SMEs) and private citizens involved in IPRs.³¹⁸ The Patent Courts (PHC) adjudicates over more complex claims concerning patents, registered designs and plant varieties. Technical cases are heard by two judges who have a science degree and who have specialized in IPRs.³¹⁹ The highly specialized court system guards the public against negligence by practitioners. Only qualified practitioners are allowed to practice in those courts.

The British IPRs protection system compels practitioners to exercise high standards of care and skill. The SRA sets high standards of practice for solicitors authorized to practice law in England. Barristers specialized in IPRs litigation appear before the PHC to argue cases upon instructions from solicitors. The internal dispute resolution mechanisms for solicitors compel practitioners to handle claims for negligence by their clients before compensatory claims are filed against them. The IPReg board monitors policies and standards by practitioners. The high insurance policies coupled with the Assigned Risks Pool system cushions IPRs consumers against losses sustained on account of negligence by practitioners. It is clear that these independent bodies act as check and balance on IPRs protection that ultimately result to higher standards amongst practitioners in intellectual property protection in United Kingdom.

³¹⁷ Following the Intellectual Property Court Users Committee's final report in 2009 and the Jackson Review of the Civil Litigation Costs published in 2010, the IPEC, which was until October 2013 known as the Patents County Court (PCC) – has undergone a series of comprehensive reforms to improve access to the court, streamlining the court's procedures, lowering the costs of litigation, and speeding up the resolution of claims. The reforms achieved greater separation in practice between the types of cases heard at the IPEC and those heard at the High Court (HC) and Patents Court (PHC). For more details of the reforms see *Evaluation of the Reforms of the Intellectual Property Enterprise Court 2010-2013* available in www.gov.uk/government/uploads/system/uploads/attachment_data/file/447710/Evaluation_of_the_Reforms_of_the_Intellectual_Property_Enterprise_Court_2010-2013.pdf as accessed on 1.8.2015

³¹⁸ According to the British CPR Part 63 and Practice Direction 63, this court handles multi-track and a small claims track. There are therefore two alternative procedures for making a claim in the IPEC. The IPEC multi-track has a limit on damages of up to £500,000. Costs orders will be made which are proportionate to the nature of the dispute and subject to a cap of no more than £50,000. The small claims track is for suitable claims in the IPEC with a value of up to £10,000. Costs orders on the small claims track are highly restricted. See www.judiciary.gov.uk as accessed on 6.8.2015 for more details.

³¹⁹ The Patents Court is part of the Chancery Division of the High Court. The first specialist patents judge was appointed in 1950. The Patents Court was created in 1980 by section 96 of the Patents Act 1977, which was subsequently repealed and replaced by section 60 of the Senior Courts Act 1981. It consists of a number of assigned judges of the Chancery Division of the High Court. It operates in accordance with specialized rules contained in CPR Part 6. See *ibid* for more details.

5.3 Maintaining standards in IPRs practice in Canada

The Canadian public enjoys the right to obtain legal advice and to be represented by a lawyer independent of the Government.³²⁰ This constitutional right allows poor IPRs consumers to be represented by lawyers through legal aid during protection of their rights. As a result of that right, professional negligence by lawyers is enforceable. In fact the Supreme Court of Ontario confirmed in *Demarco-v- Ungaro and Barycky*³²¹ that English cases protecting Barristers from professional negligence have no relevance in Canada. Lawyers in Canada are therefore liable for negligence. IPRs practitioners are not exempt from actions emanating from their disgruntled clients.

Since Canadian IPRs system promotes innovation, , the government has established two bodies central to that agenda. Firstly, IPRs practitioners are regulated by The Intellectual Property Institute of Canada (IPIC). IPIC maintains the official register of patent and trademark professionals registered to practice before the Canadian Patent Office and Canadian Trademarks Office. For flexibility and ease of practice, patent and trademark agents are not necessarily lawyers. Registered patent agents boast of expertise in one or more scientific disciplines while their trademark counterparts possess vast knowledge in trademarks protection.

Membership to ICIP is premised on four categories legislated in the by-laws of the institute.³²² These classes are the Affiliate, Associate, Academic and Student membership. A separate classification is preserved to recognize and to honour individuals who have made exemplary contribution to the ideals of IPIC. Such members are honored as Fellows, Emeritus Members,

³²⁰ See Section 10 of the Canadian Charter of Rights and Freedoms. The right to publicly funded counsel in civil matters is a more recent development, with the 1999 Supreme Court of Canada decision in *New Brunswick (Minister of Health and Community Services) v. G.(J.)* (1999), 177 D.L.R. (4th) 124 (S.C.C.) recognizing the need for publicly funded counsel in a case involving the government's actions to keep three children as temporary wards of the Crown. The court ruled that a fair hearing could not take place if the parent did not have legal representation and that she did not have the financial means to hire counsel.

³²¹ (1979) 21 O.R.(2d) 673

³²² See www.ipic.ca for more details as accessed on 1.8.2015

Honorary Members or Members of Distinction.³²³ The standard of care required of each class of membership is dependent on the competence of that class.

In order to enhance high standards in IPRs protection, IPIC occasionally intervenes as appropriate in cases at the appellate level, preferably in the Supreme Court of Canada in which an issue is likely to be finally decided. A policy and a special committee have been developed by the institute for that purpose.³²⁴ Commercial courts set aside for IPRs dispute resolution are usually manned by highly qualified judges who possess vast knowledge on intellectual properties law.³²⁵

The second important body is The Canadian Intellectual Property Office (CIPO).³²⁶ CIPO is a government agency responsible for the general administration for IPRs in Canada. This body administers examinations for admission to practice as a patent or trademarks agent. Examinations are intensive. They are administered separately for trademarks and patent agents before admission.

Apart from IPIC and CIPO, Law Societies in Canada help maintain high standards of practice in IPRs protection. The Canadian Bar Association (CBA) regulates standards of IPRs practitioners licensed as lawyers. Disgruntled clients may lodge complaints against their negligent attorneys to the disciplinary committee of the association. However, a complaint lodged with a society is not made public. It is only published after formal disciplinary proceedings are instituted against the errant member. Negligent lawyers are reported to IPIC and to CIPO for further disciplinary action.

Notably these three countries are not isolated in maintaining high standards in IPRs protection. Other jurisdictions like the United States of America, India, Japan, Pakistan and Philippines, law is talk as a second degree. In other words, to qualify to study law, one must possess a bachelor's degree, preferably from another discipline, before being admitted to law school. In

³²³ Ibid.

³²⁴ See the policy under the council's Intervention Committee www.ipic.ca as accessed on 1.8.2015

³²⁵ These courts are either federal, provincial or territorial. There are over 14 provincial and Territorial law societies in Canada. The Canadian Law Society has been established as the national face of these societies and to regulate national bar standards. For details see www.cba.org as accessed on 2.8.2015

³²⁶ See www.cipo.ca as accessed on 30.7.2015 for details on the functions of this body.

most European countries like Belgium, Croatia, Denmark, France, Finland, Norway, Netherlands, Sweden and Switzerland, one must possess both a bachelor's degree in law, and a masters of laws degree before admission to the bar.³²⁷ High qualifications encourage high standards of practice in the bar in those countries. The systems established in South Africa, Canada and Britain may assist our country enhance standards in IPRs practice without necessary insulating lawyers.

In our next chapter, and based on our findings and practices in other countries, we shall give several proposals and recommendations which might reverse the tragic mockery of lawyers practising in the arena of IPRs by the society. Our proposals might brighten up the legal profession and enhance standards of practice in the field of IPRs. All is not lost. Advocates have a great opportunity to revamp the practice of law in IPRs in order to reverse this negative publicity. Lawyers must seize this moment to address this recurring cancer of negligence in the profession. It is only through hard work that lawyers practising in the area of IPRs will raise standards of practice, avoid incidences of professional negligence, and return the legal profession to the status of respect the founders of the legal profession once claimed, in the critical eyes of our unforgiving society.

³²⁷ For more details see [http://international.lawsociety.org.uk/eu/practise as accessed on 20.10.2014](http://international.lawsociety.org.uk/eu/practise%20as%20accessed%20on%2020.10.2014)

CHAPTER FIVE: CONCLUSION AND RECOMMENDATIONS.

6.1 Conclusion

We have established that immunity as a defence against liability for professional negligence in the bar in the arena of IPRs in Kenya has never been the subject of any in depth study in our country. We will attempt to give a summary of our findings in this chapter as we sum up our research.

Firstly, the Kenyan bar has borrowed heavily from the British legal system. Barristers and Solicitors in England enjoy different rights, and are controlled by separate legislations while the bar in Kenya is unitary. Advocates in Kenya practice both in the superior and lower courts and have direct access to clients. As a result of the long historical evolution of the English bar experience, immunity as a defence against liability in negligence has been the subject of various judgments in the House of Lords. Legislations have been enacted to guard this protection.³²⁸ After a very long period of protection, the House of Lords found it necessary to scrap this protection. The court held that the bar in England had grown to maturity and that the pessimistic fear that the possibility of actions in negligence would undermine the fair administration of justice was no longer tenable.

It is also clear that a person who holds out to do certain specialized work impliedly warrants that he or she possesses skill reasonably competent to perform the task. In determining the standard of care for our purposes, the yard stick is the reasonably competent and diligent advocate. Advocates must therefore exercise skill commensurate with their experience and remuneration. Lawyers are only liable for gross negligence. They cannot however be faulted under negligence for the failure to observe some obscure points of law or new occurrences of doubtful construction. In determining the responsibilities of advocates to their clients, we outlined the three fold duties of advocates. These duties are the contractual responsibilities based on the instructions of their clients, the tortious duties based on the duty of care, and the fiduciary duty to act in the best interest of their clients. These duties extend to third parties

³²⁸ See Halsbury's Laws, Volume 3(1) (4th edn reissue) paras 528-529 and Volume 33 , (4th edn, reissue) paragraph 620

who may suffer as a direct consequence of the inactivity or recklessness of the advocate. For example, beneficiaries of a will, fall under this category. In IPRs disputes, these duties must be obeyed religiously.

In England, the reasons advanced for the insulation of barristers by immunity against liability for negligence were wide and varying. These reasons have been reiterated by various authors and judicial pronouncements in England, Australia and Scotland. Until year 2003, the House of Lords was in support of this defence before finally throwing in the towel and holding that no gain is attained by insulating barristers.³²⁹ On the other hand, judicial officers enjoy blanket constitutional protection from liability for negligence on actions arising from the performance of their official functions. Witnesses, prosecutors and other court officers are similarly protected. Some interviewees who supported this insulation argue that lawyers should be given similar treatment. However, those opposed to this argument averred that advocates take personal responsibility for the instructions given by their clients and should be treated differently.

We also outlined the duties of advocates towards administration of justice and ethics. Under this heading, advocates owe duties to the court, to their colleagues and to their clients. These responsibilities make it difficult for lawyers to balance their loyalty proportionally. It has been argued that this divided loyalty may be adequately balanced when advocates are insulated from liability from negligence by the defence of immunity against liability for professional negligence. The proponents of this argument aver that without this protection, advocates are likely to lean more towards the interests of their clients. The ultimate effect is disrepute in the administration of justice since advocates would be slow to disclose information about their clients which may lead to subsequent suits for negligence by their clients. Multiple suits over the same matter also offend another important legal principle, namely; there must be an end to litigation. A suit against an advocate ultimately leads to reference and retrial of the initial suit. The attainment of finality to the determination of a dispute would be a mirage if advocates are

³²⁹ See for example in *Rondel-V- Worsley* (1966) 3 WLR 950 and in *Arthur J. S. Hall –v- Simons* (2000) 3 ALL ER 677 (HL)

sued for negligence after judgment. During the hearing of the subsequent suit, collateral attack on the conduct of the initial suit might also put the administration of justice into disrepute.

We also noted another finding. In intellectual property, the task of an advocate is clearly difficult. For example in computer software litigation which is protected as literary works in copyright, the task of defending infringement is complex. This is more so if the dispute is filed before ordinary courts in Kenya. These courts are ordinarily manned by judicial officers with little appreciation or training on IPRs matters. The complexity of the architecture of software is challenging to people who lack advanced training in mathematics and physics. Lawyers and judges in Kenya generally fall in this category. Other than the technical nature of IPRs, more general problems face advocates. Some of these challenges relate to the general conduct of proceedings in our courts. For instance, Judges record proceedings manually. Without stenographers, it is absolutely difficulty to establish some forms of negligence by advocates especially on their failure to advance arguments or to examine witnesses during hearings. This is simply because the manual recording of proceedings by a judge may not accurately capture every argument advanced by an advocate, or every answer given by a witness in court during the hearing. However the requirement of filing written submissions has significantly mitigated that form of negligence.

We established that liability for negligence may arise from the failure to advise, the failure to explain legal documents, ignorance of the law, errors in drafting pleadings and legal documents, improper preparations for hearings, and the giving of wrong advise to the client. Due to the huge losses flowing from infringement of IPRs especially in the west and other advanced jurisdictions, damages for profession negligence may be prohibitive. These huge compensatory claims may force the most established law firm into bankruptcy. Advocates must therefore be extremely vigilant while executing instructions given by their clients to avoid future embarrassment.

In chapter three we examined the incidences of professional negligence in the eyes of judicial officers in the arena of IPRs. We note that professional negligence is quite common when analyzed from the findings of judges in their rulings and judgments. Out of a sample of one

hundred cases determined in the High Court of Kenya which were painstakingly collected from multiple sources, only thirty five were determined on merit. Forty five out of another sample of one hundred references determined at KIPI were made on merit. We established that incidences of mishandling of evidence by advocates form the highest level of negligence by advocates. Generally speaking, due to the complexity of issues involving IPRs, many advocates have challenges collecting, compiling and presenting evidence in support of their clients' claims. This is coupled by challenges faced by some advocates in understanding and applying the legal principles involved in IPRs litigation and protection. Lawyers face another challenge while representing their clients in our courts. Many judges lack adequate training on IPRs subjects. As a result, many claims fail on account of the failure by these courts to appreciate IPRs principles. If a lawyer representing a litigant appears before a court when he or she is not properly prepared, and the judicial officer presiding over that dispute does not comprehend the legal principles involved in the matter, the client may become the victim of double tragedy. It might be difficult to make head or tail of the proceedings in that matter. All the blame may however be placed upon the shoulders of the lawyer in a suit on professional negligence since the court is generally granted blanket immunity.

Other common areas of negligence include the failure to draft proper pleadings, delay in finalizing disputes, and the failure to file disputes before the correct forums. It was also clear from our analysis that advocates display multiple elements of professional negligence in some matters. For instance, when the legal principles involved in a dispute are not clear, the chances of drafting incorrect pleadings and calling improper evidence are quite high. This chapter clearly proved our hypothesis that professional negligence in the legal profession is clearly common. We thereafter sought to explore whether our proposal for the grant of immunity against liability for negligence was receptive in Kenya.

We sought views from members of the public and analyzed the findings succinctly. That finding painted a dark picture on the prevalence of professional negligence by advocates. Interviewees were unanimous on one point. Advocates should be held liable for professional negligence in Kenya. It is important to reiterate one important finding. The High court is divided on whether

this defence is available to advocates. The majority argued that advocates, like other professionals, must be held liable for their actions. However, some few interviewees felt that some form of protection was necessary for IPRs practitioners. To these interviewees, insulation was only necessary while handling matters intimately related to a hearing and while conducting business in courtrooms. They felt that the main reason for grant of insulation was to protect lawyers against future liability for professional negligence. Some thought that protection was necessary in general administration of justice and also due to the difficultness of an advocate's work. The minority saw the protection justified on grounds of public policy against re-litigation over the same subject matter. Many interviewees stated that professionals should never be given protection from negligence since insulation would catapult them to be above the law. In order to stimulate national debate and to ascertain the nature of protection necessary to protect lawyers against liability, some felt that it is necessary to enact legislation to determine this issue with finality. Since enactment requires public participation. Kenyans will be given an opportunity to express their views before the final law is enacted. Under this arrangement, courts will no longer be at liberty to legislate through their judgments. However others forcefully argued that legislating may be an unnecessarily expensive affair considering that there is adequate legal machinery to address this problem and since more professions would demand similar treatment. Public funds reserved for development and job creation may be converted to facilitate that debate.

All these different voices lead us to make one conclusion. The defence of immunity against liability for professional negligence in the bar in Kenya is not necessary. We are not lone rangers on this finding. Judges in England created this insulation and have now held that the grounds for maintaining it are no longer persuasive. The defence can no longer be justified in the global market place of ideas. In many countries including the United States of America³³⁰ and Canada, no similar protection is granted to attorneys and yet the legal profession has advanced to great levels. Advocates should be treated like other professionals in Kenya, who work in an

³³⁰ See the Supreme Court decisions of *Imbler –v- Pachman* (1976)424 US 409 and *Ferri –v- Ackerman* (1979) 444US 193 which confirmed that the federal law of judicial immunity which protected prosecutors and grand jurors did not extend to defence attorneys since he owed nothing more than a general duty to the public and was required to serve the undivided interests of his client.

environment where decisions and exercise of judgment are made in often difficult and time constrained circumstances, and who enjoy no form of insulation. Like in England, the practice of law in Kenya has changed dramatically. Barristers pick and choose their clients, against the 'cab rank' rule. A barrister's clerk is allowed to raise fees for their bosses within reasonable limits. Barristers, just like solicitors and advocates in Kenya, are able to advertise their services to the public. There is no hard evidence that any damages for liability for professional negligence would be unsustainable, disproportionate or excessive. In our honest view, the analogy of the protection granted to officers who participate in court proceedings may not be adequate justification for insulation of advocates. As already observed in chapter three, this latter reason is based on public policy demands. Public Policy encourages free speech in court in order for courts to have full information about disputes before delivering verdicts. However, public policy does not exist in a vacuum. It must be examined against the background of sociological facts of the society in question. It cannot justify recklessness by advocates. Public policy also restrains parties from re-litigating over decisions made by courts of competent jurisdiction. However, other legal principles like *res judicata*, *estoppel*, and *abuse of process*, as understood in private law should be adequate to cope with this risk. The duties of an advocate to the court, which amount to divided loyalty, cannot justify insulation. A comparison of the duties of a doctor or a surgeon to their patients may be worthy borrowing. Doctors owe duties to their patients and to their ethical code. They are sometimes faced with a tension between these duties. For example, an Aids infected patient may ask his doctor not to reveal his condition to his wife.³³¹ Such decisions may be as difficult as those facing advocates and yet nobody argues that doctors should be insulated. The technical nature of the work of an advocate in IPRs protection is therefore not unique to the legal profession alone and cannot justify this protection. It is important to reiterate another observation. A judge is given protection because the law considers that it is in public interest that he should not be harassed by vexatious litigation initiated by a disgruntled litigant. A judge owes his duties to the society. He must ensure that justice is done without fear or favour. Unlike an advocate to his client, he owes no professional duties towards the parties that appear before him. Furthermore, more benefits will be gained

³³¹ See Ian Kennedy, *Treat Me Right. Essays in Medical Law and Ethics*. (Sweet and Maxwell, 1988)

by abolishing this protection. It will bring to an end an enormous exception to the basic premise that there should be a remedy for a wrong. The exposure of isolated acts of incompetence at the bar will strengthen rather than weaken the legal system. Last but not least, insulation tends to erode confidence in the legal systems, if advocates alone, among professional men, are immune from liability for negligence.

In our view, there are better ways of avoiding suits based on professional negligence by advocates other than seeking protection through this defence. These ways will be discussed in our recommendations below. It is important for advocates to be diligent while carrying out instructions given by their clients in order to avoid suits based on professional negligence which have the potential of tainting and damaging their careers.

6.2 Recommendations

In order to address professional negligence in Kenya, the bar must take steps to avoid incidents of liability and deal with the negligent IPRs practitioner when found culpable. The approach is twofold. We recommend as follows;

6.3 Avoiding Professional negligence at the bar for IPRs Practitioner

In Kenya, an advocate is bound to obtain an annual professional indemnity cover before a practising certificate is issued³³². Under the regulations, the required minimum cover is for the sum of one million shillings Kenya Shillings.³³³ This amount may not satisfy a claim for professional negligence against an advocate since damages in IPRs disputes are generally huge.³³⁴ For example in a patent infringement suit between Apple and Samsung, Apple was

³³² Section 2 of the Advocates (Professional Indemnity) Regulations, 2004 available on <http://www.kenyalaw.org/klr/fileAdmin/pdfdownloads/Acts/AdvocatesAct.pdf> as accessed on 3.10.2014

³³³ Ibid.

³³⁴ In the European Union for example see the report of the task force on, Civil Damages in Intellectual Property Rights Cases: Analysis, Recommendations and Best Practices, it was observed that 'In implementing the EU's Directive on the Civil Enforcement of Intellectual Property Rights ("IPRED"), Member States are required to provide compensation for various types of detriment suffered by the right holder, which include lost sales and consequential damage (such as to the value of the brand). Member States also are required to award the right holder the reasonable costs of investigating, taking legal action against, and rectifying the infringement'. This position can also be adopted in Kenya leading to huge damages. The entire report may be assessed in http://www.ec.europa.eu/internal_market/iprenforcement/.../damages_en.pdf as accessed on 1.10.2014

awarded damages of US\$119 million.³³⁵ If a suit of that magnitude was lost by an advocate in Kenya, this nominal professional indemnity cover would be useless. It may not even satisfy the costs of the initial suit.³³⁶

In order to avoid the problems arising from this minimum professional indemnity cover, we propose that a mechanism be set out to ensure that practitioners subscribe to a higher professional indemnity cover. This could be implemented in a number of ways.

Firstly, KIPi may create regulations to ensure that advocates applying to practice under the institute possess a minimum professional indemnity policy of Kenya Shillings Fifty Million. In our opinion, this would weed out brief case lawyers who practice as agents under the institute. Since insurance policies of this magnitude demand huge premiums, advocates who practise under the institute will be forced to invest heavily in order to make profit. KIPi could also encourage consumers of IPRs services to demand possession of this higher professional indemnity cover from their advocates. Our proposal is not entirely new. Many corporate organizations require advocates to possess insurance policies of certain minimum insurable sums before qualifying to join their panels. A system of this kind may be adopted by the institute to cushion clients against losses that may flow from professional negligence of their lawyers.

Secondly, KIPi may also lobby the Law Society of Kenya to amend its regulations to increase the minimum indemnity policy to Kenya Shillings Fifty Million. This increment would ensure that all advocates are treated equally. However, this latter proposal is bound to receive resistance from members of the Law Society of Kenya, many of whom have no pending actions against them for professional negligence. The financial burden that flows from such increment will be the crust of opposition to this proposal.

Thirdly, it would be appropriate if a special institute is established to oversee legal practice in the area of IPRs. The institute would be independent from the official government body

³³⁵Case Number:5:11-cv-00630 –LHK which is reported at www.cand.uscourts.gov/lhk/applevsamsung as accessed on 17.4.2015

³³⁶For example in

responsible for registration of IPRs. The Kenya Intellectual Property Office will be like the Canadian Intellectual Property Office (CIPO) or the Intellectual Property Office of the United Kingdom. This institute should be responsible for training and setting up regulations for standards of practice in the arena of IPRs. Automatic admission of advocates to the institute will cease. Advocates who meet specific qualifications, pass entry examinations set by the institute, and possess the minimum indemnity cover of Kenya Shillings Fifty Million, should be the only ones allowed to practice under the institute. Once those regulations are put in place, a further step should be taken to protect IPRs clients. This should be through the establishment of an association of IPRs advocates. With the association in place, an Insurance Fund would be established for the association. The fund will guarantee that a client of a member of the association will suffer no loss through recklessness of his advocate, in cases where the policy of the member is inadequate to cover the loss, is repudiated or where the member dies or is declared bankrupt. The policy may adopt of the British Assigned Risks Pool (ARP) model. However, professional advice on the details of this policy must be developed. Many details on the policy would be considered. These include the scope of the risk, the lower and upper limits of the insurance coverage and the mode of financing of the policy in view of individual member policies among others. Most probably, financing would be through an annual charge payable by individual members on their annual subscription to the institute. As the fund builds up reserves, the annual subscription by individual lawyers will eventually come down. In fact this idea is not entirely new. An insurance scheme of this kind had been in place among solicitors in England for the better part of the last century. The annual cost for each solicitor was a few pounds. The system was so established that it virtually became a custom. This system may provide the foundation of a fund for our purposes.

A system of this nature would be quite innovative and advantageous to clients with IPRs interests. These clients would be assured of double protection in cases of negligence by their lawyers. This double cushion would most likely deter lawyers from carrying out instructions carelessly. An action against a negligent advocate would be known by the entire association because of the fund. Lawyers whose clients get compensated by this fund will contribute punitively to the fund. The responsibility taken by the association on behalf of its lawyers

through this fund, would catapult advocates to better relations with the general public. It would elevate advocates of this association to higher levels since it would be known that clients under them enjoy double protection. In real practice, advocates would put their colleagues on their toes during all levels of practice since negligence by a single advocate would amount to a huge loss for all advocates under the scheme. A suit against a lawyer under the scheme would reduce the total value of the fund. This way, professional negligence by advocates practising under the institute would hopefully be reduced to very minimum levels.

IPRs practitioners should be made to undergo special trainings. They should possess special qualifications before being admitted to practice under the institute proposed in this thesis. This proposal is quite simple. Other than possessing a practising certificate issued by Law Society of Kenya, another certificate or license should be issued to all advocates managing IPRs clients after meeting certain qualifications.³³⁷ After admission to this institute, lawyers must be compelled to go through such compulsory continuous legal trainings for each year to ensure that they are abreast with the new developments on IPRs matters. These trainings should be independent from the ones currently run by LSK under the continuous legal education programme.³³⁸ They should be particularly designed to enhance the capacity of IPRs practitioners. In our view, such stringent measures would ensure that advocates become more informed through sharing of ideas. This would also weed out general legal practitioners from masquerading as IPRs experts. Incidents of professional negligence based on misapplication of IPRs principles would be significantly reduced. Specialization would ensure that the standard of drafting pleadings is high. The compilation, preparation and production of evidence will be uniform as a result of these high standards.

It may not be possible to protect IPRs through litigation if these disputes are determined in normal commercial courts. In Kenya, there are very few judges trained in IPRs issues. As indicated earlier in chapter three of this paper, many judges are appointed from the bar. Since

³³⁷ For example, to qualify to practice as a Certified Public Secretary, one must be admitted to practice after going through training and sitting for several examinations. See section 20 of the Certified Public Secretaries Act of Kenya (Chapter 534 Laws of Kenya)

³³⁸ See Regulation 11 of the Advocates Act (Continuing Legal Education) Regulation, 2004 states

few lawyers appreciate the unique character of IPRs discourse, many judges lack capacity to adequately address IPRs disputes because of this general problem. Without proper training, judges may not be able to perceive negligent conduct of advocates who appear before them. Judges may also misconstrue the technical aspects of a dispute argued before them. They may not be able to castigate a negligent lawyer because of their inability to appreciate all aspects of the dispute brought before them. A blind man may not see another blind man or lead that other blind man into safety. We propose that a special division of the High Court be preserved for IPRs disputes. Once established, many Kenyans will file IPRs matters before this division. The advancement of the law on intellectual property would be the ultimate gain. Negligence by lawyers will be perceived clearly by these trained judges. As a result, lawyers appearing before these specialized courts will ensure that they are properly prepared in order to avoid being embarrassed. There will be no more room for negligence by advocates if both the bench and the bar become specialized on IPRs matters.

IPRs practitioners may also be required by the institute to keep books relating to their clients in a more organized manner. The institute may come up with standard computer software for IPRS practitioners for proper book keeping. Problems arising from the manual bring up system in advocates offices would be shelved. Automatic reminders will ensure that negligence arising from failure to renew protection or to observe deadlines is eliminated. In order to enforce compliance, a special committee should be established by the institute to carry out regular inspection of offices of practitioners. Advocates will be compelled to work towards enhanced management skills of their shops when such steps are taken by the institute.

In order to put to rest the debate on whether the defence of immunity on liability against negligence by lawyers should be granted, we propose that legislation be enacted on this issue. An act of parliament may be the only tool that would ensure uniform judgments by our courts on the defence of immunity against liability for professional negligence in the bar. The enactment may be through an amendment to the Advocates Act to include one paragraph on this matter. Enactment may be through normal miscellaneous amendment to statutes made in bulk by parliament, to avoid unnecessary attention. The Law Society of Kenya can come up

with a proposal that may be subjected to public debate before being forwarded to parliament for further scrutiny and enactment. Obviously many details need to be worked out before this amendment is passed. More debates must be carried out in various forums. More public participation is central to the success of the legislation. Without legislation, divisions in our courts will continue to exist. Since insulation of lawyers was created by courts in England, parliament will confirm its legislating power by passing this amendment and denying our courts the power to legislate.

6.4 Dealing with professional negligence occasioned by IPRs Practitioners

Professional negligence by IPRs practitioners may at times border on ethics. The legal profession world over is generally regulated by rules of Professional Conduct for Legal Practitioners. Ethics generally refers to established standards of right and wrong that prescribe what humans ought to do, usually in terms of rights, obligations, benefits to society, fairness, and specific virtues. Ethics of the legal profession refers to the actions of members of the bar in the discharge of duties and obligations and in the exercise of their rights and privileges. Professional negligence, to a great extent, amounts to breach of this ethical code of conduct. Gross negligence, or simply put, incompetence, may be a violation of that established standard of practice and therefore unethical. In Kenya, the disciplinary process commences with the lodging of a complaint with the advocates Disciplinary Committee or the Advocates Complaints Commission. The Commission is a department of the Attorney General which investigates complaints against advocates and forwards the substantive complaints to the Tribunal. The challenge of this process is that it involves 'misconduct that is dishonorable conduct incompatible with the status of an advocate.'³³⁹ One may argue that professional negligence is outside the powers granted to the commission since it may not be dishonorable as such.

It is therefore important to amend the Advocates Act to make possible for advocates guilty of professional negligence to be put through the disciplinary process. On the other hand, the special institute proposed in this paper may come up with its own mechanisms for disciplining errant IPRs practitioners. The new disciplinary mechanism should be a special vehicle for IPRS

³³⁹ See section 60(1) of the Advocates Act (Chapter 16 Laws of Kenya).

practitioners. Once found negligent, on top of admonishing, suspending, striking out, compensating the offended party, or fining the advocate, it may order the advocate to undergo further training, or to be supervised by a more senior member of the association for a specified period. This way, the disciplinary process may be effective, punitive and corrective. The process will ensure that issues of incompetence are addressed in a more practical manner.

Even before disciplinary processes are formally engaged against a practitioner, internal dispute resolution systems should be established by the law society to reconcile lawyers with their clients before the society's disciplinary processes are engaged. Dispute handler should be introduced to help resolve complaints between advocates and their clients before losses are incurred and the formal disciplinary process by the law society is engaged.

Disciplinary causes and court rulings on negligence are not adequately published. Publication on a widely circulation platform will deter lawyers from negligence. Members of the public will be made aware on the professional capability of each lawyer. The particulars of each lawyer will include pending and decided cases against them for professional negligence. Competition in the legal mine field will eventually drive the reckless practitioner out of business. The stigma of negative publicity will push practitioners to concentrate and perfect services for their clients.

Our proposals are easy to implement. They are not very expensive to enforce. They are practical and necessary to weed out negligence at the bar in the arena of IPRs. These recommendations will ensure that high standards of care are maintained by advocates who practice in the arena of IPRs. The society will be the ultimate beneficiary of enhanced standards of care by advocates in the administration, arbitration and protection of IPRs in our country.

BIBLIOGRAPHY

1. Charlesworth, *Charlesworth & Percey On Negligence*, (London, Sweet and Maxwell, 1990)
2. Clerk, J., *Clerk & Lindsell on Torts* (London, Sweet & Maxwell) 1982
3. Cranston. R, *Legal Ethics and Professional Responsibility*, (Oxford, Clarendon Press , 1995)
4. Freedman. M., *Lloyd's Introduction To Jurisprudence*, (London, Sweet & Maxwell, 2008)
5. Hobbes. T, *The Leviathan*,
6. Jackson, Rupert m., *Jackson & Powell on Professional Negligence*,(London, Sweet & Maxwell) 2002
7. Kombo. Donald K., *Proposal and Thesis Writing,: An Introduction*,(Paulines Publications Africa, Makuyu,)
8. Martin.E.A., (ed) *A Dictionary Of Law*, (Oxford University Press New York 1997)
9. Mugenda. Olive M. *Research Methods: Qualitative & Quantitative Approaches*, (Nairobi, Acts Press, 2003)
10. Rodgers. W, *Jolowicz and Winfield on Torts*, 17th Edition ,(London' Sweet & Maxwell, 2006
11. Rosylene Korir , *Professional Self -Regulation And The Challenges In Enforcing Professional Discipline, A Case Study Of The Advocates' Disciplinary Process*,(LLM thesis, UON. 2008)
12. Simmonds, N. E. *Central Issues in Jurisprudence, Justice , Law and Rights*,(London, Sweet & Maxwell, 2002)
13. The Hon. D.A. Ipp., '*Lawyers' Duties to the Court*,' (1998) LQR 114.
14. Weber. M., *Economy and Society*, (university of California Press, London 1978)
15. Zitrin. R., *Legal Ethics in the Practice of Law* (The Michie Company Law Publisher, Virginia 1995)

Web sites

1. <http://www.cipc.co.za>
2. <http://www.saiipl.org.za>
3. www.capebar.co.za
4. <http://www.sabar.co.za>
5. www.cipa.org.uk
6. www.itma.org.uk
7. www.legislation.go.uk
<http://ipreg.org.uk>
8. <https://www.lawsociety.org>
9. <http://www.legalombudsman.org.uk>
10. www.solicitorstribunal.org.uk
11. www.tbtas.org.uk
12. www.barstandardsboard.org.uk
13. www.barstandardsboard.org.uk
www.barstandardsboard.org.uk
14. www.sra.org.uk
15. www.gov.uk
16. www.judiciary.gov.uk
17. www.ipic.ca
18. www.cba.org
19. www.cipo.ca
20. <http://international.lawsociety.org.uk>
21. <http://www.kenyalaw.org>
22. <http://www.ec.europa.eu>
23. www.cand.uscourts.gov
24. www.kipi.go.ke