



**REPUBLIC OF KENYA**

**IN THE HIGH OF KENYA**

**AT MERU**

**CIVIL SUIT NO. E009 OF 2021**

**CITY EYE ADVERTISING AGENCY.....PLAINTIFF/APPLICANT**

**VERSUS**

**MWENGE MIRAA SACCO LTD.....DEFENDANT/RESPONDENT**

**JUDGMENT**

1. By an amended notice of motion dated 31/5/2021 under Order 40 Rule 1 & 2 of the Civil Procedure Rules, Sections 3, 3a and & 63 of the Civil Procedure Act and all other enabling provisions of the law, the applicant seeks; a permanent injunction restraining the respondent whether by themselves, servants and / or agents from infringing the applicant's intellectual property rights, the lawful proprietor of T.M No. 73967 Miraa (Khat) Advertising in class 35(branding) and permanent injunction restraining the respondent whether by themselves, servants and/ or agents to forthwith cease trading, promoting, advertising, marketing/carrying a business and/or any other trade documents of any nature with the said T.M NO 73967 Miraa(Khat) Advertising in class 35 (Branding).

2. The application is premised on the grounds on the face of it and supporting affidavit of Zakayo Muchai Wainaina, the applicant's registered owner, sworn on 23/4/2021. He contends that he is the proprietor of trademark No 73967 in class 35(Branding) which the defendant has infringed by branding its Mwenge Miraa Sacco, with a device of Miraa in it. He contends that he had requested the respondent to allow him brand their new office but the respondent did not concede but instead proceeded to brand the offices as aforesaid a development which prompted the applicant to demand compensation. No reply was elicited hence the plaintiff demanded loyalty fee of Kshs 720,000 and sent a draft contract to bestow upon the plaintiff as a proprietor of the trade mark marketing rights as marketing agent but the defendant ignored the invitation as well as the demand.

3. The plaintiff case is that the applicant's trademark has the word MIRAA, a device of miraa and is registered to offer branding services with a disclaimer on MIRAA as DEVICE hence he has the exclusive right as to use thereof hence its use on the branding outside the respondent's office constitutes an infringement. In the application and the suit, it is contended that the Trade Mark Act gives the applicant the exclusive right to use trade mark No. 73967 in branding services by the use of the word MIRAA and the device of miraa thereto as a whole and that the respondent can only use the disclaimed name of miraa in his branding of the office consent of the plaintiff.

4. In opposition thereto, the respondent filed an amended notice of preliminary objection dated 3/8/2021 raising the point that the court lacks jurisdiction to hear a matter touching on intellectual property rights as pertains a registered trade mark, because the same ought to be heard by the Industrial Property Tribunal. There is a second limb to the effect that the miraa device cannot be trademarked as it does not meet the threshold for grant of plant variety protection under plant breeders rights.

5. Parties agreed to canvass the application by way of written submissions, which were respectively filed on 18/8/2021 and 5/8/2021. In the submissions, the plaintiff asserts that that the court had jurisdiction to hear and determine the suit as all infringements emanating from trademarks are adjudicated in the High Court then relied on **Strategic Industries Limited v Solplia Kenya Limited(2019)eKLR, Solplia Kenya Limited v Style Industries & anor(2015)eKLR, British United Provident Association Limited v Bupa Kenya Limited(2020)eKLR, Colour Planet Limited v Safaricom Limited & 2 others(2016)eKLR and National Industrial Credit(NIC) Bank Ltd v National Investment Company(NIC) Micro finance Ltd(2012)eKLR**, which , he asserts, were dealt with by the High Court, yet they were all infringement of trademarks matters. It submitted that its device of miraa is a trademark under the Act and cannot be under the Seed and Plant Varieties Act, as it is not a new variety of plant and the applicant is not a breeder but a proprietor. He urged the court to dismiss the preliminary objection with costs.

6. The respondent submitted that the applicant's suit was incompetent and an abuse of the court process, as the same ought to have been filed before the Industrial Property Tribunal. It insisted that the court was not seized of the indispensable jurisdiction to proceed with the matter and cited the famous case of **Owners of Motor Vessel "Lilian S" v Caltex Oil Kenya Ltd(1989)KLR**, where the principles on jurisdiction was laid down. It then submitted that since Miraa was a recognized cash crop in Kenya, it could only be accorded protection under the plant breeders rights and not as a general trade mark and was in fact incapable of being trademarked. He urged that the suit ought to be struck out with costs while relying on the decision in **Vermont Flowers (EPZ) v Waridi Creations Limited(2014)eKLR** in support of its submissions

that the proper forum for remedying an infringement of a trade mark is the tribunal and not the court.

### **Analysis and Determination**

7. Having considered the pleadings filed including the Notice of Preliminary objection and the submissions, I discern the issues for determination to be whether this court has jurisdiction to entertain the matter and consider granting the reliefs sought.

8. The law remains trite that without jurisdiction the court makes no move and that when it acts without jurisdiction, the action is no more than a nullity. There is also the firm jurisprudence that where there is established by statute or other legal instrument, a forum to address a dispute, such must be, under the doctrine of exhaustion, be strictly resorted to before the court can entertain the dispute. The corollary is that every court has a duty to sit and handle every matter that properly falls on its docket.

9. The objection being grounded on the provision of the Industrial property Act which creates a tribunal, the Industrial Property Tribunal, one must ask what the jurisdiction of that tribunal entails. While a trade mark is indeed an industrial property, it is a genre of industrial property that unlike the rest, is governed by a specific statute. It is thus safe to say that the Kenyan intellectual property legal regime is coded in three statutes; Intellectual Property Act, Copyrights Act and the Trade Mark Act. The argument on the objection I am called upon to determine is really a question of whether Intellectual Property Act and the Tribunal it creates apply to a dispute under the Trade Marks Act.

10. The short title to the Industrial Property Act and the definitions at section 2 determines that the act is intended for the regulation of patents, utility models, technovation and industrial designs. Accordingly when the Act creates the tribunal to determine disputes, such disputes must be those concerned with the statute. I see no invitation of matters trademarks under the Industrial Property Act and I do find that Trade Mark disputes were never intended by Parliament to be governed by the Industrial Property Act.

11. In construction of statutes, it is a rule that if there is to be a conflict between a generic statute and a specific one, the provisions of the specific statute would prevail. I find that the trade Marks Act is a complete code on its subject and that there would be no justification to invite the application of section 105 of the Industrial property Act on a dispute on trade marks. Consequently, I find that the objection was grounded on the misconception that the dispute is governed by industrial Property Act when it is not. Being so misconceived, it lacks merit and is thus dismissed.

12. There was a second limb of the objection contending that Miraa device cannot be trademarked for failure to meet the threshold for grant of plant variety protection. That to me is a matter that must call for factual evidence and cannot pass as a pure point of law. When not a pure point of law, it cannot be argued as such. That equally fails and is dismissed.

13. The upshot is that the objection is dismissed with costs.

**DATED, SIGNED AND DELIVERED AT MERU THIS 23RD DAY OF FEBRUARY, 2022**

**Patrick J.O Otieno**

**Judge**

**In presence of**

Mr. Muchai plaintiff in person

No appearance for the defendant.

**Patrick J.O Otieno**

**Judge**