



**City Eye Advertising Agency v Vivo Energy (Civil Suit E622 of 2021)
[2022] KEHC 3145 (KLR) (Commercial and Tax) (23 May 2022) (Ruling)**

Neutral citation: [2022] KEHC 3145 (KLR)

**REPUBLIC OF KENYA
IN THE HIGH COURT AT NAIROBI (MILIMANI COMMERCIAL COURTS)
COMMERCIAL AND TAX
CIVIL SUIT E622 OF 2021**

A MSHILA, J

MAY 23, 2022

BETWEEN

CITY EYE ADVERTISING AGENCY APPLICANT

AND

VIVO ENERGY RESPONDENT

RULING

1. The Applicant filed a Notice of Motion under Order 40 Rules 1 and 2 of the Civil Procedure Rules, and Section 3, 3A and 63(e) of the *Civil Procedure Act*. The Application is supported by the grounds on the face of it and by the Sworn Affidavit of Zakayo Muchai Wainaina and seek the following orders;
 - a. A temporary injunction do issue restraining the Defendant/Respondent whether by themselves, servants and/or agents from infringing the Plaintiff's intellectual property rights, the lawful proprietor of T.M No. 93225 Collabo Adverts Election Campaign logo and word mark in Class 35 advertising the hearing and determination of this Application.
 - b. A temporary injunction do issue restraining the Defendant/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. 93225 Collabo Adverts Election Campaign logo and word mark in Class 35 advertising or any dealings in any other way whatsoever with the trade mark of the Plaintiff pending the hearing and determination of this infringement proceedings.
2. It is contended that the Respondent has been infringing on the Applicant's rights to the trademark T.M No. 93225 Collabo Adverts Election Campaign logo and word mark in Class 35 advertising despite having been sent a cease and desist letter.



3. In response the Respondent filed grounds of opposition and stated that the Applicant does not have exclusive use of the word Collabo and neither capable of having exclusive user of the said word which is slang and not an invention and the T. M No. 93225 as registered is a composite mark and which the Respondent has not infringed at all.
4. The Respondent further stated that the Applicant has not disclosed any ground to merit the granting of the orders sought as there is no registered mark by the name Collabo thus the orders sought are contra statute and particularly Section 24(1) of the [Trade Marks Act](#).
5. The parties were directed to file and exchange written submissions. Hereunder is a summary of the rival submissions;

Applicant's Case

6. It was the Applicant's case that the Respondent has a trademark by the name Collabo for use in the advertising services which name is not a disclaimer as part of registration requirement. The Respondent has been using this name for advertising by way of promotion as Weka Collabo. This led to the Applicant sending several cease and desist letters dated 24/08/2019 and an email correspondence of the same dated 26/02/2021.
7. The Applicant argued that it has established a prima facie case because the certificate of registration of the Plaintiff's trademark gives it exclusive user of the trademark which therefore gives the Plaintiff the right to the exclusive use of the word Collabo in advertising.

Respondent's Case

8. It was the Respondent's averment that between 1st April 2021 and 30th June 2021, Vivo ran a promotion dubbed "Weka Collabo na Shell" to reward all customers for every purchase of the following brands: Shell FuelSave Unleaded, Shell FuelSave Diesel, all Shell lubricants, Shell coolant, Afrigas, and for shopping at Shell or welcome shops at Shell service stations. Collabo is a street slang for the English word "collaborate" to which no person has any exclusive fights over and neither is the street slang an innovation of the Plaintiff herein.
9. The Respondent submitted that the trademark registered to the Plaintiff is Collabo Adverts Election Campaigns. The sign type is both name and logo. The Mark image is a picture of two clasped hands and the phrase "Collabo Advert Elections Campaigns" and the mark name is NOT "Collabo" but Collabo Adverts Election Campaigns.
10. The Plaintiff has not registered the word "Collabo" as a trademark. He therefore simply cannot claim to be entitled to the exclusive use of the word as required under Section 24 of the Trademark Act.
11. The Plaintiff's trademark is a composite trademark. It is made up of several words and an image of two clasped hands. The Certificate of Registration includes a disclaimer that the registration of the mark shall give no right to the exclusive use of the words "Advert", "Election" and "Campaigns" each separately and apart from the mark as a whole. The Plaintiff argues that because the word Collabo was not expressly disclaimed that he has exclusive right to the word. The Respondent relied on the case of *Unilever PLC v Bidco Oil Industries* [2004] eKLR.
12. The Plaintiff does not have a prima facie case to warrant the grant of an injunction. Firstly, the Plaintiff has not produced any evidence that Vivo is using a mark identical or resembling its composite mark "Collabo Adverts Election Campaigns" so as to cause confusion. Secondly, the word "Collabo" is not a registered trademark and the Plaintiff does not have exclusive right to use the same.



13. The Plaintiff has not demonstrated that it would suffer irreparable injury if the injunction is not granted as Vivo is not in competition with the Plaintiff. Vivo distributes and markets Shell and Engen branded fuels and lubricants to retail and commercial customers in Africa. It is not an advertising agency and it does not do any marketing for third parties. The products marketed under the promotion Weka Collabo are Shell products.
14. An injunction shall greatly inconvenience the Defendant/respondent who has been using the promotional slogans to promote its services/goods. The phrase “Weka Collabo” is renowned as the promotion has been rolled out countrywide both in 2019 and early this year.
15. It was the Respondent’s argument that the Defendant applied for the registration of “Weka Collabo” as a trademark on 24th March 2021. The same was accepted and advertised by the Registrar of Trademarks, however, the Plaintiff/applicant sought and was granted an extension of time within which to file its opposition to the registration of the mark. The extension granted lapsed on 30th December 2021.
16. The Applicant did not file any opposition to the registration of the trademark “Weka Collabo”. The Respondent now awaits the issuance of the registration certificate. The Letter dated 17th January 2022 (annexed to the Plaintiff/applicant’s Supplementary Affidavit sworn on 31st January 2022) from the applicant to the Registrar is not an objection/opposition under the Trade Mark Act. Therefore, the balance of convenience tilts in favour of not granting any injunctive orders against Vivo.
17. It was the Respondent’s submission that that the Applicant has failed to establish the three conditions to warrant the issuance of a temporary injunction. Further, that it would not be in the interest of justice to issue an injunctive order as there are registration proceedings before the Registrar of Trademarks which shall have a bearing on the suit herein.

Issues For Determination

18. Having considered the Application, Response and the written submissions by the parties; the Court has framed the following issue for determination;
 - a. Whether a temporary injunction should issue against the Defendant?

ANALYSIS

19. The Applicant sought a temporary injunction against the use of T.M No. 93225 Collabo Adverts Election Campaign logo and word mark in Class 35 by the Respondent. The Application was brought under Order 40 Rules 1 and 2 of the *Civil Procedure Rules* seeking injunctive reliefs.
20. In *Aktiebolaget Jonkeping – Vulcan Industrifabriksatebolag v East African Match Company* [1964] EA 64 the court held thus;

“As a general proposition of law, I think I am right in stating that the burden of satisfying the Court that there has been an infringement of its trade mark is on the plaintiff company. It is for the plaintiff company to prove that there is a resemblance between the two marks, and that such resemblance is deceptive. It is also a well-established principle of law that it is the duty of the judge to decide whether the trade mark complained of so nearly resemble the registered trade mark as to be likely to deceive or cause confusion in the minds of the public. From that duty the judge cannot abdicate.”
21. In accordance with the case of *Giella –vs- Cassman Brown* (1973) E.A 358, the Applicant must establish the following conditions precedent for grant of an interim injunction:



- a. *A prima facie* case with a probability of success;
 - b. Demonstrate that he shall suffer irreparable harm that cannot adequately be compensated by an award of damages;
 - c. Where there is doubt, the Court will decide the Application on a balance of convenience
22. The Applicant argued that it has established a prima facie case because the certificate of registration of its trademark gives it exclusive user of the trademark. The registered trademark therefore gives the applicant the right to the exclusive use of the word Collabo in advertising.
23. On the other hand, it was the Respondent’s contention that the Applicant has not made out a prima facie case to warrant the grant of an injunction. The Applicant did not produce any evidence that Vivo is using a mark identical or resembling its composite mark "Collabo Adverts Election Campaigns" so as to cause confusion. In addition, the word "Collabo" is not a registered trademark and the Applicant does not have exclusive right to use the same.
24. The Court of Appeal in *Mrao Ltd v First American Bank of Kenya Limited and 2 others* [2003] eKLR explained that a prima facie case is,
- “a case in which on the material presented to the Court, a tribunal properly directing itself will conclude that there exists a right which has apparently been infringed by the opposite party to call for an explanation or rebuttal from the latter.”
25. Has the applicant established a ‘prima facie’ case? The Applicant annexed a copy of the registration of the trademark which on the face of it shows that the Applicant’s trademark is the word “Collabo” and the same certificate indicates that the Applicant was not given exclusive rights to the words “Adverts, Elections and Campaigns”.
26. To support the Application, the Applicant equally attached a letter dated 9th March 2021 from the Registrar of Trademarks who stated that the word “Collabo” was registered under T.M 93225 and that it was not available for registration.
27. The Respondent has also stated that it is awaiting the registration of the trademark “Weka Collabo”.
28. In the light of the registration and the letter of 9/03/2021 from the Registrar of Trademarks it is this Court’s view that the Applicant has established a prima facie case and the other disputed issues surrounding the trademark can only be dealt with during the full hearing of the suit.
29. Will the Applicant suffer irreparable harm that cannot adequately be compensated by an award of damages? The Applicant did not demonstrate that it is likely to suffer irreparable harm that cannot be compensated by an award of damages. Neither did it explain the exact loss it would suffer if the order was not granted; It is trite law that it is not enough for an Applicant to merely put forward general vague assertions of irreparable harm. When exercising its discretion the Court does not consider assertions on the face value but is guided by adequate and proper material placed before it.
30. Does the balance of convenience tilt in favor of the Applicant? The Applicant has demonstrated that there is an infringement to its trademark. The Respondent on the other hand, has been using this name for advertising by way of promotion as “Weka Collabo”. Moreover, the Respondent in its submissions admitted that pending registration its business uses the “Weka Collabo” promotional slogans and photos to market their products.



31. From the material placed before it, this Court is satisfied that the balance of convenience tilts in favour of the Applicant in granting the injunction sought.

Findings and Determination

32. For the forgoing reasons this court makes the following findings and determinations;

- (i) The application is found to have merit and it is hereby allowed;
- (ii) A temporary injunction do issue restraining the Defendant/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. 93225 Collabo Adverts Election Campaign logo and word mark in Class 35 advertising or any dealings in any other way whatsoever with the trade mark of the Plaintiff pending the hearing and determination of this infringement proceedings;
- (iii) The Applicant to furnish the Respondent with a Letter of Undertaking for security for costs and damages within fourteen (14) days from the date hereof;
- (iv) The Applicant shall bear the costs of this application;
- (v) Mention on 14th June 2022 before the Deputy Registrar for Case Management.

Orders Accordingly.

DATED, SIGNED AND DELIVERED ELECTRONICALLY AT NAIROBI THIS 23RD DAY OF MAY, 2022.

HON. A. MSHILA

JUDGE

In the presence of;

Mr. Zakayo the plaintiff/Applicant- present in person

Mr. Mwangi for the defendant

Lucy-----Court Assistant

