



**Mburugu v Onyango & another (Civil Case E677 of 2021)  
[2022] KEHC 16050 (KLR) (Commercial and Tax) (24 November 2022) (Ruling)**

Neutral citation: [2022] KEHC 16050 (KLR)

**REPUBLIC OF KENYA  
IN THE HIGH COURT AT NAIROBI (MILIMANI COMMERCIAL COURTS)  
COMMERCIAL AND TAX  
CIVIL CASE E677 OF 2021  
WA OKWANY, J  
NOVEMBER 24, 2022**

**BETWEEN**

**PATRICK MUTUA MBURUGU ..... PLAINTIFF**

**AND**

**WILFRED MAKORI ONYANGO ..... 1<sup>ST</sup> DEFENDANT**

**MILELE DENTAL CARE LIMITED ..... 2<sup>ND</sup> DEFENDANT**

**RULING**

1. The plaintiff filed the application dated July 9, 2021 seeking the following orders:-
  1. Spent
  2. An order for injunction do issue restraining the defendants whether by themselves, their servants and/or agents from infringing the plaintiff's intellectual property rights as the lawful proprietor of "Milele" trademark pending the hearing and determination of this application.
  3. An order for injunction do issue restraining the defendants whether by themselves, their servants and/or agents from trading, promoting, advertising, marketing, carrying on business and/or any using any trade documents with the "Milele" trademark or in any way dealing with the trademark pending the hearing and determination of this application.
  4. An order for injunction do issue restraining the defendants whether by themselves, their servants and/or agents from infringing the plaintiff's intellectual property rights as the lawful proprietor of "Milele" trademark pending the hearing and determination of this suit.
  5. An order for injunction do issue restraining the defendants whether by themselves, their servants and/or agents from trading, promoting, advertising, marketing, carrying on business



and/or using any trade documents with the "Milele" trademark or in any way dealing with the trademark pending the hearing and determination of this suit.

6. Costs of this application be awarded to the plaintiff.
2. The application is supported by the plaintiff's affidavit wherein he states that he is registered owner the trademark "Milele", which is registered as Trademark No 1 13179 under class 44 (medical services, veterinary services, hygienic and beauty care for human beings or animals) and has been trading as 'Milele Integrated Medical Services' since 2009. He contends that he has built up a substantial goodwill and reputation in the Githurai area and its environs where its services are recognized by the public as distinctive.
3. The applicant states that on or about September 2009 to 2013, he allowed the 1<sup>st</sup> defendant to operate inside its business premises under the plaintiff's license as a Community Oral Health Officer and in his dentist section. He claims that the 1<sup>st</sup> defendant thereafter opened his own practice using the name "Milele" Dental Care Limited thus prompting the plaintiff to engage the services of an advocate who sent several demand letters to the 1<sup>st</sup> defendant cautioning him to stop using the name "Milele".
4. It is the plaintiff's case that the 1<sup>st</sup> defendant, through numerous letters, admitted the infringement and promised to stop using the trademark. He avers that the 1<sup>st</sup> defendant, vide his replying affidavit, states that he has initiated the process of changing the name "Milele" to "Millenia".
5. The plaintiff further states that despite the 1<sup>st</sup> defendant's admission of infringement, he has continued to use the trade name "Milele" Dental Care Limited" and to offer the same kind of service near the plaintiff's place of business in Githurai and its environs thereby riding on the plaintiff's goodwill and reputation to confuse the public by passing off as the plaintiff. He maintains that the continued use of the plaintiff's trademark "Milele" by the 1<sup>st</sup> defendant has caused a lot of confusion among the clients and loss of sales, damage to the plaintiff's business's reputation and loss of exclusivity in the "Milele" trademark.
6. The 1<sup>st</sup> respondent opposed the application through his replying affidavit sworn on November 3, 2021 wherein he denies infringing on the plaintiff's trademark. He however admits that he is in the process of changing his business name to Millennia Dental Care Limited. He contends that procedures for effecting the name change and approvals to his new name are beyond his control. The 1<sup>st</sup> defendant further averred that: -
  - a. He was the director and proprietor of Milele Dental Care Limited.
  - b. The applicant operated a medical facility named Milele Integrated Medical Services while the respondent operated a medical facility named Milele Dental Care Limited.
  - c. The applicant offered the respondent with space in the respondent's business premises at a fee of Kshs per month on or about September 2009.
  - d. The applicant did not offer dental services while the respondent offered dental services.
  - e. The applicant acquiesced and consented by conduct with the responded using the trade name Milele Dental Health Care Limited from 2009 up until 2013 without any objection.
  - f. About 2013 when the respondent had earned sufficient goodwill and reputation in his trade name of Milele Dental Care, the applicant evicted the respondent from the shared business premises where after the respondent rented a separate premises and registered the business name on May 24, 2013.



- g. On November 11, 2016, the respondent subsequently registered Milele Dental Care Limited as a company.
  - h. The registrar of business names and the registrar of companies had no objections to the name Milele Dental Care Limited hence its registration.
  - i. The respondent has operated under the name Milele Dental Care since 2009.
  - j. As a result of the animosity and disruption by the applicant the respondent moved to a new different location to operate his business but the respondent still followed up destroying the signposts as affixed, teasing up and steering the respondent's clients against the respondent.
7. Parties canvassed the application by way of written submission which I have considered. The main issues for determination are as follows:-
- 1. Whether the defendants are infringing upon the plaintiff trademark.
  - 2. Whether the defendants have been passing off their services as those of the plaintiff.
  - 3. Whether the plaintiff deserves the orders sought.
8. On the alleged infringement of the plaintiff's trademark, I note that it was not disputed that the plaintiff is the registered owner of the "Milele Trademark". Even though the 1<sup>st</sup> defendant denied that he was using the plaintiff's said trademark, the plaintiff's annexures marked "PM 4", "PM 5", "PM 6", "PM 7", "PM 8" and "PM 19" tell a completely different story. The said annexures are letters from the defendant wherein he admits/concedes that he is using the plaintiff's said trademark.
9. Section 2 of the [Trade Marks Act](#) defines a trade mark as follows:-
- "Trade mark" means, (except in relation to a certification trade mark) a mark used or proposed to be used-
- (a) in relation to goods for the purpose of indicating a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user to use the mark, whether with or without any indication of the identity of that person or distinguishing goods in relation to which the mark is used or proposed to be used from the same kind of goods connected in the course of trade with any person;
  - (b) in relation to services for the purpose of indicating that a particular person is connected, in the course of business, with the provision of those services, whether with or without any indication of the identity of that person or distinguishing services in relation to which the mark is used or proposed to be used from the same kind of services connected in the course of business with any other person;"

Section 2 of the Act also defines a 'mark' as follows:-

"mark" includes a distinguishing guise, slogan, device, brand, heading, label, ticket, name, signature, word, letter or numeral or any combination thereof whether rendered in two-dimensional or three-dimensional form;"

10. Section 7(1) of the [Trademark Act](#) provides that registration by a person as the proprietor of a trademark if valid gives to that person the exclusive right to use the said trademark. This means that any



person who not being the proprietor or registered user of a trademark, uses a mark which is identical to or so nearly similar as to be likely to deceive or cause confusion in the minds of consumers in the course of trade or in connection with the goods or services in question infringes on that trademark. This is the position that was taken in *Pharmaceutical Manufacturing Company -Vs- Novelty Manufacturing Ltd* HCCC No 746 of 1998, where it was held that: -

“Registration of a trademark confers the - right of exclusive use of the mark. Infringement of the trademark is a tort of strict liability. Intention and motive are irrelevant consideration.”

11. On whether the 1<sup>st</sup> defendant have been passing off their services as those of the plaintiff, I find that the plaintiff established the same through the admission by the 1<sup>st</sup> defendant as contained various letters exhibited in the plaintiff's annexures. The essentials of passing off were stated in the case of *AG Spalding Brothers —vs AW Gamage Ltd & another* (1914-15) All ER Rep 147; (1915) 32 RPC 272 HL as follows: -
  - a) A misrepresentation
  - b) Made by a trader in the course of trade
  - c. To prospective customers of his or ultimate consumers of goods or services supplied to him.
  - d. Which is calculated to injure the business or goodwill of another trader (in the sense that this is a reasonably foreseeable consequence); and
  - e. Which causes actual damage to a business or goodwill of the trader by whom the action is brought or (in a quia timed action) will probably do.
12. In the present case, I find that the plaintiff established that he had built up a substantial goodwill and reputation in medical services in Githurai area and its environs for a period of over 13 years. The plaintiff's case was that the 1<sup>st</sup> defendant worked in his business before bolting out to start his own business using his 'milele' trademark.
13. My finding is that the plaintiff proved that the 1<sup>st</sup> defendant has been presenting his services as those of the plaintiff going by the similarity in the business names of the plaintiff's trademark name "Milele Integrated Services" and the 1<sup>st</sup> defendant's services and "Milele Dental Care Limited". To my mind, the similarity in the names poses the probability of confusion among the clients seeking medical services in the area. I am guided by the decision in *Beierd of AG vs Emirchem Products Limited*; HCCC No 559 of 2002 (UR), where the court found that the trade mark "Nivelin" was strikingly similar to the trade mark "Nivea" and would probably cause confusion to consumers
14. On the issue of whether the plaintiff deserves the orders sought, I note that the main prayer sought by the plaintiff is an order of injunction to restrain the respondents from infringing on its trademark. The principles governing the granting of orders of injunction are settled. I need not belabor the said principles in this ruling but suffice is to say that they were expressed in the oft cited case of *Giella vs Cassman Brown* (1973) EA 358 as follows: -

“First, an applicant must show a *prima facie* case with a probability of success. Secondly, an interlocutory injunction will not be normally 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.”



15. What amounts to a *prima facie* case was explained in *Mrao vs First American Bank of Kenya Limited & 2 Others* (2003) KLR 125 as follows:-

“It is a case which, on the material presented to the court or a tribunal properly directing itself will conclude that there exists a right which has apparently been infringed by the opposite party as to call for an explanation or rebuttal from the latter.”

16. The plaintiff argued that his case meets the threshold for the granting of the orders of injunction while the 1<sup>st</sup> defendant opposed the application while citing section 8 (2) of the *Trade Marks Act* which stipulates as follows:

“In any action for infringement of the right to the use of a trade mark given by registration in part B of the register, otherwise than by an act that is deemed to be an infringement by virtue of section 9, no injunction or other relief shall be granted to the plaintiff if the defendant establishes to the satisfaction of the court that the use of which the tainti com zains is not tikez to deceive or cause confusion or to be taken as indicating a connection in the course of trade between the goods and some person having the right either as proprietor or as licensee to use the trade mark or in respect of services that a person having the right either as proprietor or as licensee to use the trade mark is connected in the course of business with the provision of the services”

17. I find that the plaintiff established that he is the registered owner of the trademark in question and is therefore entitled to the protection provided for trademark owners under the *Trademark Act*.

18. On whether the plaintiff will suffer irreparable loss unless the orders sought are granted, I find that the plaintiff demonstrated that he had invested a lot of resources and time in building his business reputation. The loss that the plaintiff may suffer unless his business trademark is protected cannot be gainsaid. I further find that the balance of convenience tilts in favour of granting the injunctive orders sought.

19. For the above reasons, I find that the application dated July 9, 2022 is merited and I therefore allow it as prayed.

20. The costs of this application shall abide the outcome of the main suit.

**DATED, SIGNED AND DELIVERED VIRTUALLY AT NAIROBI THIS 24<sup>TH</sup> DAY OF NOVEMBER, 2022.**

**W. A. OKWANY**

**JUDGE**

**In the presence of: -**

No appearance of parties

Court Assistant- Sylvia

