



REPUBLIC OF KENYA

IN THE HIGH OF KENYA

AT MERU

CIVIL SUIT NO. E008 OF 2021

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

VERSUS

CAPITAL SACCO SOCIETY LIMITED.....DEFENDANT/RESPONDENT

RULING

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 & 63(a) Civil Procedure Act and all other enabling laws, the applicant asks the court to grant to it, in the main, an order of permanent injunction directed at and restraining the respondent whether by themselves, servants and / or agents from infringing the applicant's intellectual property rights as the lawful proprietor of the trademark registered as **T.M No. 73967 Miraa (Khat) Advertising in class 35(branding)** as well as an order of 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) pending the hearing and determination of the suit.

2. The application was premised on the grounds on the face of it and supporting affidavit of Zakayo Muchai Wainaina, whose gist is that the respondent's use of a Miraa device in advertising its financial product is an infringement of the applicant's registered trade mark and further that its registered trade mark gives it the exclusive right to use the word MIRAA in its branding services.

3. In opposition to the application, the respondent filed a replying affidavit sworn by its Chief Executive Officer, Eliezer Kaburu, on 4/6/2021 and vehemently denied having infringed in any way upon the applicant's trade mark then invited the court to dismiss this application. The respondent in particular asserts that in its core business of serving its cooperators, it came up with a product to finance Miraa trade and farming in Kangeta area. It was asserted that the plant miraa has many many names including Khat and veve and that to advertise its product branded "**Miraa product veve**", it printed a brochure with the image of miraa held by two hand and posted same on its offices. When the plaintiff made its demand on the alleged infringement a denial was made I which it was held that the certificate of registration never gave to the plaintiff the exclusive use of the word and aimage of miraa, that the plaintiff has no monopoly for the use of the word miraa and that there had been no misrepresentation by the defendant to ride upon the plaintiff's reputation and goodwill of the word miraa. The court was then invited to compare the marked image with that in the defendant's brochure and find that there are no similarities and thus no infringement on the plaintiff's mark.

4. Without the leave of the court, the applicant files a supplementary affidavit 21/6/2021 reiterating the averments in its supporting affidavit and adding the fact that the respondent had not exhibited anything to prove its entitlement as asserted in the Replying Affidavit.

5. Parties agreed to canvass the application by way of written submissions, which were respectively filed on 21/6/ 2021 and 30/6/ 2021. In the submissions, the applicant relied on the standards set out in **Giella v Cassman Brown & Co (1973) EA**. It further cited the provisions of **Section 7(1) of the Trademarks Act** to support its claim of existence of a prima facie case and therefore being entitled to be granted the order sought. It was then pointed out that the defendant had exhibited nothing to show that it is engaged in money lending.

6. The respondent in its submissions dissected the applicant's application from every angle. It began with alleging that the application is defective as it is not supported by a supporting affidavit. It relied on **Re Estate of NMM (Deceased) [2012] eKLR**, **Gideon Sitelu Konchellah v Julius Lekakeny Ole Sukuli & 2 Others (2018) eKLR** and **James Peter Mina Muriuki V Moses Maina Ngugi & Another (2008) eKLR** to back that claim up.

7. It further submitted that the applicant has neither established a prima facie case nor shown special circumstances to warrant a mandatory injunction adding that since the applicant had already quantified the damages payable to KShs 380,000, the loss could adequately be compensated by award of damages. In concluding the submissions, the defendant contended that the applicant's trade mark was not absolute and there was no misrepresentation on its part, to ride on the reputation and goodwill of the applicant.

8. Having considered the application, the affidavits and the rival submissions of the parties, I discern the mandate of the court to demand a determination whether there was a prima facie case shown on infringement of a trademark and if the thresholds of grant of the injunctive orders sought had been met.

9. Before I delve into the issues, I wish to address the respondent's submission that the amended application is improper and incompetent because it is not supported by an affidavit. That to me is a mere technicality which Article 159(2)(d) of the Constitution frowns upon because that amended motion states unequivocally that the same is supported by the affidavit filed with the original motion. I find no merit on that objection to warrant rejecting the application.

10. On whether a prima facie case has been made out, I note that the certificate of registration exhibited by the applicant indeed make it clear that the applicant was not to enjoy the exclusive use of the words *Miraa, advertising* and the devise of *miraa pe se*. that being the case it is prudent not to be in a hurry to injunct the respondent who says it operates the business of financial services within a miraa growing area. In addition, no pleading has been availed, other than registration to show that the plaintiff has a trade where the device in the mark is employed and that is exposed to injury by the defendant's brochure. Those two facts when added to the fact that the plaintiff has quantified his possible losses to the last cent clearly place the case away from those deserving the grant of a temporary restraining order.

11. On a different consideration, the prayer sought in the application are expressed to be permanent in nature and are the very prayer sought in the plaint. Granting them would in effect be granting the substantive prayer at an interlocutory stage before the matter is heard on the merits. That may be seen to affront the notions of fair hearing. In my understanding, at this interlocutory stage only a temporary injunction need be issued to forestall an injury demonstrated to loom against an established prima facie case. A permanent injunction must wait hearing on the merits.

12. Having come to the foregoing conclusion, I have restrained myself from any comment that would go to the merits of the case so that no prejudice is visited on either side. It suffices to conclude and say that the application lacks merit and it is therefore dismissed with costs.

DATED, SIGNED AND DELIVERED VIRTUALLY, VIA MICROSOFT TEAMS AT MERU THIS 27TH SEPTEMBER, 2021.

PATRICK J.O OTIENO

JUDGE

In presence of

Mr. Karanja for defendant/respondent

Plaintiff in person (absent)

PATRICK J.O OTIENO

JUDGE