



**IN THE HIGH COURT OF KENYA AT NAIROBI**

**MILIMANI LAW COURTS**

**COMMERCIAL AND TAX DIVISION**

**CORAM: D. S. MAJANJA J.**

**COMM. CASE NO. E402 OF 2020**

**BETWEEN**

**EMAMI LIMITED ..... PLAINTIFF**

**AND**

**ORANGE PHARMA LIMITED.....DEFENDANT**

**RULING**

**Introduction**

1. The Plaintiff has approached the court by a Plaint accompanied by a Notice of Motion dated 5<sup>th</sup> October 2020 made, inter alia, under **Order 40 Rule 1** of the *Civil Procedure Rules* and **section 7** of the *Trade Marks Act (Chapter 590 of the Laws of Kenya)* seeking, in substance, an order of injunction restraining the Defendant from passing off, importing, manufacturing, selling, supplying, distributing or marketing any products bearing any mark which is confusingly and/or deceptively similar in part or whole to the Plaintiff's trademarks **EMAMI MENTHOPLUS** and **EMAMI MENTHO PLUS** including by use of the marks **KALUMA MENTHO PLUS** and/or **MENTHO PLUS**.

2. The Plaintiff's application is supported by the affidavits of its Vice President- Finance & Business Development, Chirag Sheth, sworn on 5<sup>th</sup> October 2020 and 30<sup>th</sup> October 2020 respectively. It is opposed by the Defendant through the replying affidavit sworn on 22<sup>nd</sup> October 2020 by Javan Omondi Odhiambo, the Defendant's General Manager. The application was canvassed by way of written submissions which were orally highlighted by the parties' respective counsel.

**Plaintiff's Case**

3. The Plaintiff's claim is that since 1987, it has been associated with the trade mark **MENTHO PLUS** in India and around the world while in Kenya it has traded its pain balm under the trade mark **EMAMI MENTHO PLUS** since 2005. It contends that its consumers in the Kenyan market have associated it with pain balms bearing the mark **MENTHO PLUS**. It acquired the trade mark number 62323 in class 5, **EMAMI MENTHO PLUS** from Miraj Enterprises by way of assignment and has registered **EMAMI MENTHOPLUS** in class 5 under trade number 64602. These registrations have been effective since 7<sup>th</sup> November 2007 and 4<sup>th</sup> December 2008 respectively, over 10 years prior to the Defendant's registration of **KALUMA MENTHO PLUS** which was registered in 2018.

4. The Plaintiff states that when it registered trade mark number 64602 **EMAMI MENTHOPLUS**, it did not disclaim the right to exclusive use of any of the words **EMAMI** or **MENTHO PLUS**. That following registration, it is protected under **section 7** of the *Trade Marks Act* and the words **EMAMI** or **MENTHOPLUS/MENTHO PLUS** or any other similar words are not available for registration by any other entity.

5. The Plaintiff accuses the Defendant of passing off its products by not only using **KALUMA MENTHO PLUS** but also exporting other products bearing the word **MENTHO PLUS** from India into Kenya thus violating the Plaintiff's rights and acquired goodwill arising from the use of the trade mark **MENTHO PLUS**. The Plaintiff submits its Indian partner successfully challenged the Defendant's actions at the Commercial Court at Alipore, India which issued an injunction restraining the Defendant from passing off the Plaintiff's **EMAMI MENTHO PLUS** pain balm after appreciating that the trade mark **MENTHO PLUS** belongs to the Plaintiff and finding a striking similarity between the Defendant's and the Plaintiff's products. The Plaintiff urges the court to bar the Defendant from passing off the Plaintiff's **EMAMI MENTHO PLUS** pain balm, as the Defendant's actions are detrimental to it.

6. In determining whether the Plaintiff has made out a prima facie case for passing off, Counsel for the Plaintiff cited the decision in *Aria Industries v P J Products Ltd* [1970] E.A. 367 where the court held that, “the test is whether an average customer acting with reasonable care would be likely to be confused by the article complained of.” Based on the aforesaid test, the Plaintiff submitted that the get up of the Defendant’s **KALUMA MENTHO PLUS** is deceptively similar and confusingly alike to the Plaintiff’s **EMAMI MENTHO PLUS** in the distinctive color of package and general appearance.

7. The Plaintiff asserted that the Defendant’s get up contains the words **MENTHO** and **PLUS** prominently appearing in bold red font, similar to the get up of the Plaintiff’s pain balm where the words **MENTHO** and **PLUS** also appear prominently in bold red font. Further, the Defendant’s get up contains an image of a female adult holding her forehead with her hands which image is similar to the image on the Plaintiff’s **EMAMI MENTHO PLUS** pain balm. The word **BALM** on the get up of the pain balm bearing the **KALUMA MENTHO PLUS** trade mark is placed immediately below the words **MENTHO** and **PLUS** which placement is similar to the placement of the word **BALM** on the Plaintiff’s products.

8. The Plaintiff contends that the dissimilarities alleged by the Defendant are trivial and immaterial, and do not outweigh the glaring similarities of the get up. Counsel also referred to **SONAPEN MENTHO PLUS**, which the Commercial Court at Alipore found to be similar to the get up of the Plaintiff’s **EMAMI MENTHO PLUS**. Moreover, it contended that since both the Plaintiff’s and Defendant’s pain balms are over the counter products, customers who have long associated **MENTHO PLUS** with the Plaintiff, are likely to be confused by the striking similarities in the get ups of the Plaintiff’s and Defendant’s pain balms. As a result of the confusion, they are likely to believe that the Defendant’s products emanate from or are one with the Plaintiff’s, which is not the case.

9. Counsel for the Plaintiff also relied on *Githunguri Dairy Farmers Cooperative Society Limited v Uplands Dairies Limited* ML HCCC No. 540 of 2009 [2009] eKLR. In that case the applicant had been processing pasteurized and homogenized milk and milk products since the year 2004. They used a distinctive get up bearing the figure of one white and brown dairy cow standing opposite one black-and-white dairy cow on a green foreground with blue background and white borders and contours. In the year 2009, the Defendant introduced milk products packaged in a similar get up. The Court considered that the applicant began trading the milk as packaged earlier than the defendant, and had a reputation for selling and manufacturing the milk since the year 2004, thus acquiring substantial goodwill and reputation in the get up of the package distinctively associated with their goods. Owing to the striking similarities of the get up, the Court found that the consumers are likely to confuse the products and found that the applicant had established a prima facie case.

10. In the instant case, counsel submitted that the Plaintiff has demonstrated that it has acquired substantial goodwill and association globally and locally with the use of **MENTHO PLUS** and the distinctive get up on its pain balm’s packaging. The Plaintiff urged the Court to protect its long standing rights from the Defendant’s actions.

#### **Defendant’s Case**

11. The Defendant’s case is that the Plaintiff does not have exclusive rights to the use of the combination of the words **MENTHO** and **PLUS** under its registered trade mark **EMAMI MENTHO PLUS** used on its pain balm. It states that under its trade mark number 62323 **EMAMI MENTHO PLUS** on its pain balm, it duly disclaimed the right to the exclusive use of the words **MENTHO** and **PLUS** each separately and apart from the mark as a whole upon registration of that trade mark.

12. The Defendant asserts that it is the proprietor of the trade mark number 100548 **KALUMA MENTHO PLUS** effective from 18<sup>th</sup> January 2018 issued under the same class of goods—Class 5 of Nice Classification. It urges that similar to that of the Plaintiff’s, the registration of its trade mark **KALUMA MENTHO PLUS** is also subject to disclaimer in respect of the use of the words **MENTHO** and **PLUS** in respect of the same class of goods as required by the Registrar pursuant to the said **section 17** of the *Trade Marks Act*. To buttress its case, the Defendant also referred to a similar pain balm sold in Kenya under trade mark number 63794 **SONAPEN MENTHO PLUS** registered on 6<sup>th</sup> August 2008 issued under Class 5 of Nice Classification containing a similar disclaimer and under which a similar pain balm is sold in Kenya.

13. The Defendant rejected the Plaintiff’s argument that the words **MENTHOPLUS** and **MENTHO PLUS** or any other similar words are not available for registration in Kenya by any other entity other than the Plaintiff and has no legal basis owing to successful registration of other trademarks bearing the combination of the words **MENTHO** and **PLUS**, including the said **SONAPEN MENTHO PLUS** and **KALUMA MENTHO PLUS** under which similar goods are sold within Kenya.

14. The Defendant submitted that the Plaintiff is not only guilty of misrepresentation but also guilty of non-disclosure of material facts as it deliberately failed to disclose the fact of the disclaimer in respect of the use of the words **MENTHO** and/or **PLUS** under its prior registered trade mark number 62323 **EMAMI MENTHO PLUS**, which is the mark used on its pain balm, or produce any certificate of registration thereof from Kenya Industrial Property Institute (“KIPI”).

15. The Defendant accused the Plaintiff of relying on its trade mark number 64602 **EMAMI MENTHOPLUS** which was registered subsequent to registration of the trade mark number 62323 **EMAMI MENTHO PLUS** used on its pain balm in an attempt to unlawfully claim the right to the exclusive use of the combination of the words **MENTHO** and **PLUS**, despite the fact that the Plaintiff has no registered trade mark known as **MENTHOPLUS** and/or **MENTHO PLUS** capable of protection within Kenya. It further submitted that the Plaintiff’s previous attempt to register **MENTHOPLUS** as its trade mark in Kenya in 2008 was rejected hence its claim of the right to exclusive use thereof must fail. The Defendant further submitted that it has proved that the attempt by another person to register **MENTHO PLUS** as a trade mark in Kenya in 2009 was rejected for lack of distinctiveness as required by **section 12** of the *Trade Marks Act* and advising that the terms **MENTHO PLUS** in relation to goods in Class 5 of the Nice Classification need to be disclaimed as they are descriptive rendering them unregistrable on their own without being combined with other distinctive terms. The Defendant therefore submits that its use of its duly registered trade mark 100548 **KALUMA MENTHO PLUS** on its pain balm is protected by **section 7** of the *Trade Marks Act* and does not infringe on the Plaintiff’s trade mark rights in respect of its registered trade mark **EMAMI MENTHO PLUS** used on its pain balm.

16. The Defendant rebuffed the Plaintiff’s claim that the Defendant’s trade mark is confusingly similar with the Plaintiff’s trade mark

because it contains the words **MENTHO** and **PLUS**. The Defendant submitted that the combination of the words **MENTHO** and **PLUS** are available for use or registration by another party, owing to the disclaimer and registration of at least two other trademarks in Kenya: **SONAPEN MENTHO PLUS**; and **KALUMA MENTHO PLUS** under which similar pain balms are sold. In addition, there exist other pain balms in the Kenyan market bearing the words **MENTHO PLUS**, including **ROSMED MENTHOPLUS BALM** sold by a different person other than the Plaintiff or the Defendant.

17. The Defendant states that its trade mark **KALUMA MENTHO PLUS** and Plaintiff's trade mark **EMAMI MENTHO PLUS** used on the parties' respective pain balms are distinguishable by the trade names/words **KALUMA** and **EMAMI**, which have different pronunciations visually, phonetically and rhythmically. The Defendant submits that the words **MENTHO PLUS** are only descriptive and a common parlance amongst the general public in relation to goods of that class. The word **MENTHO** is a short form or slang for **MENTHOL**, which is a compound from which that cooling minty taste or odour of the products herein is derived from; and the word **PLUS** is an adjective denoting extra ingredients, for example the minty taste associated with the two products herein. It points out that it's and the Plaintiff's get ups, design, packaging and overall general appearance are distinctive and are not likely to cause deception or confusion in the market; they are distinguishable by their prominent distinctive marks/words **KALUMA** and **EMAMI** in their trade marks as opposed to the descriptive common words **MENTHO PLUS** used in goods of that class sold in Kenya, including pain balms **ROSMED MENTHOPLUS BALM**, **SONAPEN MENTHO PLUS**, **KALUMA MENTHO PLUS** and **EMAMI MENTHO PLUS**.

18. The Defendant also points out the Plaintiff has not disputed the fact that the dominant trade name **KALUMA** on the Defendant's pain balm is well known in Kenya since 1950 and is solely associated with the Plaintiff's wide range of products including **KALUMA INHALER**, **KALUMA STRONG**, **KALUMA KING**, **KALUMA PLAST**, **KALUMA PAIN BALM**, **KALUMA TOOTHPASTE**, **KALUMA FINE POINT** and **KALUMA MILKING JELLY**. Accordingly, consumers of pain balms bearing the trade mark **KALUMA MENTHO PLUS** will associate that product solely with the Defendant and not with the Plaintiff, contrary to the Plaintiff's allegations of passing off of its pain balm **EMAMI MENTHO PLUS**.

19. The Defendant asserted that the words **KALUMA** and **EMAMI**, the images on the two products are very prominent and a distinguishing feature between the two pain balms. For instance, the Defendant uses a prominent image of an adult female in pink shirt on its get up, while the Plaintiff uses a prominent image of an adult male in yellow shirt on its get up. It submitted that an ordinary consumer of the products is very unlikely to confuse an image of a man with that of a woman especially when different colours are used like is the case with the two products.

20. As regards the suit in the Commercial Court in Alipore, India which, has on the interim basis, restrained the Defendant from passing off the Plaintiff's **EMAMI MENTHO PLUS**, the Defendant submits that decision should be disregarded on several grounds. First, the order is an ex-parte interim order that which is valid until 21<sup>st</sup> October 2020. Second, the order is not enforceable within Kenya and last, the Defendant's impugned pain balms are sold only in Kenya and not in India.

#### **Determination**

21. In order to succeed in an application for an interlocutory injunction, the Plaintiff has to satisfy the conditions established in the case of **Giella v Cassman Brown [1973] EA 348** where the court held that a plaintiff must demonstrate that it has a prima facie case with a probability of success, demonstrate irreparable injury which cannot be compensated by an award of damages if a temporary injunction is not granted, and if the court is in doubt show that the balance of convenience is in its favour. In **Nguruman Limited v Jan Bone Nielsen and 2 Others NRB CA Civil Appeal No. 77 of 2012 [2014] eKLR**, the Court of Appeal added that the three conditions are to be applied as separate, distinct and logical hurdles which an applicant is expected to surmount sequentially.

22. As to what constitutes a prima facie case, the Court of Appeal in **Mrao Ltd v First American Bank of Kenya Limited and 2 Others [2003] eKLR** explained that it 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." The Plaintiff is therefore to demonstrate that the Defendant has infringed on its registered trademark.

23. Under section 7 of the **Trade Marks Act**, the registration of a trademark confers on the owner the right of exclusive use of the mark (see **Solpia Kenya Limited v Style Industries Limited & Another ML HCCC No. 138 of 2014 [2015] eKLR**). In order succeed in an action for infringement or breach of a trademark, the Plaintiff needs to prove that it is the registered proprietor of the mark, that the alleged infringement was a mark identical which, or so nearly, resembles that of the registered mark so as to be likely to deceive or cause confusion in the course of trade or in connection with the provision of services in respect of which it is registered, that the use of the mark is without consent or authority of the proprietor; and that the use of the mark is such that it is likely to cause injury or prejudice to the proprietor or licensee of the Trade Mark.

24. The court must, of course, bear in mind that in an interlocutory application it is must be careful not to make conclusive findings of fact without the benefit of evidence that may be available at the trial (see **Said Ahmed v Manasseh Denga and Another NRB CA Civil Appeal No. 37 of 2015 [2019] eKLR**). In **Cut Tobacco Kenya Limited v British American Tobacco (K) Limited NRB CA Civil Appeal No. 126 of 2020 [2001] eKLR**, the Court of Appeal cited with approval the following observations of Spry JA., in **EA Industries Limited v Trufoods Limited [1972] EA 420** in a case where the court was dealing with the get up of similar products:

*Here we have two bottles, substantially similar in size and shape, with two differences which are readily apparent to anyone who knows them or compares the bottles but which might not be noticed by someone who saw them separately. They bear labels which are substantially similar in size and shape. The design of the labels is generally similar but there are differences of detail and they bear names which in themselves are not confusing. I do not think it is desirable to go into the matter more fully, because the issue of deceptive similarity has to be decided in the suit (emphasis added by us). I do not think we should say more than is absolutely necessary, particularly because the ultimate decision may depend on evidence called at the trial. Mr Deverell suggested that it is unlikely that any evidence will be called of any great significance and that we can fairly reach a conclusion on the evidence of our own eyes. That may well be so, but we do not know what evidence will be called and we cannot speculate.*

25. In this case, the Plaintiff relied on the fact that it was the registered owner of two trademarks, **EMAMI MENTHOPLUS** (64602) and **EMAMI MENTHO PLUS** (62323) which the Defendant infringed by dealing in the similar products using its own registered trade mark **KALUMA MENTHO PLUS** (100548). More importantly, the Plaintiff asserted in the deposition of Mr Chirag Sheth that:

*[14] THAT the Plaintiff also learned that the Defendant was unlawfully manufacturing and selling KALUMA MENTHO PLUS, a pain balm of similar description and get up to the Plaintiff's and which bear the words 'MENTHO' and 'PLUS' which by virtue of the trade mark number 64602 are reserved for exclusive use by the Plaintiff.*

26. The Plaintiff also relied on the fact that it had acquired considerable goodwill related to its product and that the Defendant only started marketing its product recently.

27. The thrust of the Defendant's case is that the Plaintiff failed to disclose that the trademark **EMAMI MENTHO PLUS** (62323) was registered subject to the disclaimer of the words **MENTHO** and **PLUS** each separately and apart from the mark as a whole. As a result of the disclaimer, it had the right to use the word **MENTHO** and **PLUS** with the **KALUMA** as it too, had disclaimed the use of the two words upon registration.

28. The effect of a disclaimer was described as follows in *Kerly's Laws of Trademarks and Trade Names*, 14<sup>th</sup> Ed, Para. 9-082:

*Where a trademark is registered subject to a disclaimer of the rights of the exclusive use of a specified element of the registered mark, the rights conferred by registration are restricted accordingly. It follows that an objection based upon an earlier registration cannot succeed where the only resemblance between the marks in issue is an element for which protection has been disclaimed.*

29. Thus the Defendant was entitled to use the words **MENTHO** and **PLUS** in conjunction with **KALUMA** to describe its product as those words were disclaimed. As this stage, I would observe that **EMAMI MENTHOPLUS** (64602) as a registered trademark comprises a single word **MENTHOPLUS** which is different from the two words used distinctly. Although the Defendant referred to a letter dated 26<sup>th</sup> February 2008 from KIPI to the Plaintiff in which it refused to register the combination of words **MENTHOPLUS**, the letter was not attached to the deposition.

30. The Defendant has however shown that there are other products that exist in the market; **SONAPEN MENTHO PLUS** registered with the same disclaimer in 2008 and another product on sale with the name **ROSEMED MENTHO PLUS**. There is also evidence that KIPI rejected an application in 2009 on the grounds that the words **MENTHO** and **PLUS** has been disclaimed as they are merely descriptive. All this shows that the Plaintiff's relief does not depend on whether the Defendant used the words **MENTHO** and/or **PLUS** separately as used in the Plaintiff's products and which were disclaimed.

31. The Defendant produced the Certificate dated 21<sup>st</sup> October 2020 in respect of the trademark number **EMAMI MENTHO PLUS** 62323 which on the face of it, bears the following disclaimer: "Registration of this mark shall give no right to the exclusive use of the words 'MENTHO' and 'PLUS' each separately and apart from the mark as a whole" The same disclaimer is repeated in the registration Certificate of the Defendant's trademark number **KALUMA MENTHO PLUS** 100548.

32. A simple reading of the disclaimer shows that it was intended to bar the exclusive use of the words **MENTHO** and **PLUS** meaning that only **EMAMI** is to be used exclusively by the Plaintiff and that only **KALUMA** is to be used exclusively by the Defendant and not **MENTHO** and **PLUS**. I therefore find and hold that the Plaintiff does not have exclusive rights to the words **MENTHO** and **PLUS**. I find that the Defendant is entitled to use those words as the Plaintiff's right to use **EMAMI** in conjunction with the two words was restricted to that extent.

33. The Plaintiff's case must therefore rest on whether the **KALUMA MENTHO PLUS** is identical to **EMAMI MENTHO PLUS** or so nearly resembles it so as to be likely to deceive or cause confusion in the course of trade or in connection with the provision of services in respect of which it is registered. Bearing in mind that I am not at this stage conducting a trial of the cause, I have looked at the get up of the Plaintiff's and Defendant's products. Both parties agree that their respective products are over the counter products. The words **KALUMA** and **EMAMI** have different pronunciations visually, phonetically and rhythmically. I have also looked at the get up of the products. The words **EMAMI** and **KALUMA** on both products is distinctive and stands out. **KALUMA** is displayed boldly in red while **EMAMI** is displayed boldly in black. The Plaintiff's product is represented by an adult male in a yellow shirt touching the forehead with one hand while the Defendant's product bears an adult female in the pink shirt touching both sides of the forehead with the both hands. Taken together with the distinctive names, I am not satisfied at this stage that the members of the public would be deceived or confused into thinking that **KALUMA MENTHO PLUS** is a product of the Plaintiff.

34. There is also another reason why I am disinclined to grant an injunction. It is because the Plaintiff failed to disclose material facts. The duty of an ex-parte applicant to disclose material facts was discussed in *Owners of the Motor Vessel "Lillian S" v Caltex Oil Kenya Limited [1989] KLR 1*, where the Court of Appeal, cited with approval the following dicta by Warrington LJ., in *The King v The General Commissioners for the Purposes of Income Tax Acts for the District of Kensington: Ex parte Princess Edmond De Pligac [1917] 1 KB 486, 509* that:

*It is perfectly well settled that a person who makes an ex parte application to the Court that is to say, in the absence of the person who will be affected by that which the court is asked to do – is under an obligation to the court to make the fullest possible disclosure of all material facts within his knowledge, and if he does not make that fullest possible disclosure, then he cannot obtain any advantage from the proceedings, and he will be deprived of any advantage he may have already obtained by him. That is perfectly plain and requires no authority to justify it.*

35. The Plaintiff failed to disclose that upon registration of trademark **EMAMI MENTHO PLUS** (62323), it had disclaimed the words **MENTHO** and **PLUS**. It did not annex a copy of its registration certificate which clearly sets out the disclaimer. I hold that this was material

non-disclosure for the reason that the Plaintiff's case was hinged the fact that it was the registered owner of the **EMAMI MENTHO PLUS** and had the exclusive right to the use the words **MENTHO** and **PLUS** in conjunction with **EMAMI**. Those words were indeed available for registration to other parties on condition that they were disclaimed. In addition, the Plaintiff appeared to rely on its trademark **EMAMI MENTHOPLUS** (64602) at as a basis for is action yet the product on sale and subject of its complaint is based on the trademark **EMAMI MENTO PLUS** (62323). Had the applicant disclosed these facts, the court would have taken a different view of the matter at that stage.

**Disposition**

36. For the reasons I have set out, the Plaintiff has not made out a case to warrant the grant of an interlocutory injunction. The Notice of Motion dated 5<sup>th</sup> October 2020 is dismissed with costs to Defendant. The interim orders in force are hereby discharged forthwith.

**DATED and DELIVERED at NAIROBI this 23<sup>rd</sup> day of DECEMBER 2020.**

**D. S. MAJANJA**

**JUDGE**

Court of Assistant: Mr M. Onyango

Ms Mwangi instructed by CFL Advocates for the Plaintiff.

Mr Mochu instructed by Mochu Kahura and Company Advocates for the Defendant.