



REPUBLIC OF KENYA

IN THE HIGH COURT AT MACHAKOS

CIVIL CASE NO. 30 OF 2014

JONATHAN MUTUKU KASYOKA.....PLAINTIFF

VERSUS

MUTHINI KYAA

MUSAU KYAA T/A

MAANZONI PICNIC BAR.....DEFENDANTS

JUDGMENT

Introduction

The Plaintiff claims to be the registered proprietor of the business name known as "MAANZONI PARADISE" under the registration of Business Names Act and has been carrying on the business of a Bar under the said name within Kola Market. He has sued the Defendants, jointly and severally, for an order of permanent injunction to restrain the Defendants from infringing on the Plaintiff's usage of the trade name "MAANZONI" and for general damages for the said infringement and costs of the suit and interest. The Plaintiff averred in a Plaint dated 23rd April 2014 filed in this Court on 4th July 2014, that the Defendants have since October 2013 infringed his aforesaid registered trade name of "MAANZONI PARADISE", and he gave the particulars of the Defendants' infringement as follows:

- a) That the Defendants inscribed and/or painted in bold letters on their building at Kola Market the name MAANZONI Building without the license of the Plaintiff, the said building having no connection with the Plaintiff's business whatsoever.
- b) That the Defendants caused confusion to prospective customers as to who truly runs and owns Maanzoni Paradise Bar and Maanzoni Picnic bar within the same market Kola.
- c) Unwittingly enticing customers to go to Maanzoni Picnic Bar thinking it belongs to the Plaintiff.

The Plaintiff claims he has suffered loss and damage for infringement of the trade name.

The Defendants, who are also businessmen in Kola Market denied the Plaintiff's averments in a Statement of Defence dated 30th July 2014 that they filed in Court on the same date, and put the Plaintiff to strict proof. They averred that the Plaintiff's alleged registration is neither a trade mark or patent capable of being protected in the manner sought, and that their business names and that of the Plaintiff are quite different and distinct, and their respective business are operated in different premises and or

buildings. Further, that the Plaintiff's business permit is fraudulent and misleading as the same is issued in the name of the Defendants' plot situated at Kola market.

The Evidence

The suit first came up for hearing on 18th July 2016 when the Plaintiff gave evidence as PW1, was cross-examined and re-examined. His evidence was that he operates a bar called Maanzoni Paradise Club at Kola market which is registered under the Registration of Business Names. He also testified that he had operated the business for over 10 years since 2004, but that his registration certificate was issued to him on 5th March 2014, after the Defendants starting infringing on his business name.

Further, that at the time he opened his business he was a tenant in the premises of the Defendants, and they gave him notice to vacate after three years, whereupon he moved his business to the next building. The Defendants thereupon painted the name "Maanzoni Building 57" on their Building and operate a bar and sell food in the said building.

The Plaintiff produced copies of his certificate of registration of Maanzoni Paradise and copies of photographs of the Defendants' building and of his Maanzoni Paradise Club which were marked for identification. After cross-examination and re-examination he asked to be stood down to produce the original copies of his registration certificate, photographs and demand letter his lawyer wrote to the Defendants. The Plaintiff was granted leave to produce the said documents on the next hearing date which was 24th October 2016.

On that date, the Plaintiff's counsel informed the court that his client had forgotten to bring the documents and he was granted the last adjournment. When the suit came up for hearing on 7th February 2017 the Plaintiff still did not produce the said documents, and the Court directed that the suit proceeds to hearing. At the time allocated for hearing on that day, neither the Plaintiff or his counsel were present in Court, and the Court directed that the Plaintiffs case be marked as closed and the defence hearing to continue.

The 2nd Defendant, Benson Musau Kyaa gave evidence as DW1 on behalf of the Defendants. He adopted his witness statement dated 30th July 2014 and filed in Court on the same date as his evidence. It is stated therein that the Defendants leased a shop at Kola market to the Plaintiff in a building known as Maanzoni Building Plot No. 57, and the Plaintiff started operating a bar business thereon known as Maanzoni Annex Club. Further, that on 7th July 2013 they gave him notice to vacate the shop, and the Plaintiff moved to plot 58 where he started operating a bar known as Maanzoni Paradise Club, Bar & Restaurant .

The Defendants further stated that after the Plaintiff vacated their building, they started a bar business known as Picnic Bar & Restaurant & Lodging Butchery, a name which has been in their use since 1968, and that they also asked the Plaintiff to change his alcoholic drink licence to reflect the building he is in occupation of, which is plot No.58, but he never did so and his license reflects plot No.57 where the Defendants have their business.

DW1 denied that they have infringed the Plaintiff's trade name, since their business is named Picnic Bar Restaurant & Lodging Butchery which is different from Maanzoni Paradise Club Bar & Restaurant, and the Plaintiff is the one who moved with their building's name namely Maanzoni Building, which building was owned by their father who left it to their mother.

The Issues and Determination

The Parties were directed by the court to file written submissions. The Plaintiff's advocates, R.M Matata & Co. Advocates filed submissions dated 4th April 2017, while J.N. Kimeu Advocate stated that he would not file any submissions.

The issues herein are whether the Defendants have infringed the Plaintiff's trademark, and if so, whether the Plaintiff is entitled to damages and the quantum if any. Before addressing the substantive issues, I will address an issue raised by the Plaintiff in his submissions on the proceedings undertaken by this Court.

The Plaintiff in this respect argued, relying on Order 12 Rule 3(1) and 3(3) of the Civil Procedure Rules, that when the Plaintiff did not appear in Court and the Court directed the Defendants to proceed and testify, and that the Court ought to have dismissed the Plaintiff's suit or for any other reason adjourned the same and asked the Plaintiff to pay costs. This is for the reason that the Defendants filed a statement of defence which does not contain a counter-claim.

I have perused Order 12 Rule 3 (1)-(3) of the Civil Procedure Rules relied on by the Plaintiff, and the said provisions address the proceedings consequent to non-attendance by a party as follows:

1. If on the day fixed for hearing, after the suit has been called on for hearing outside the court, neither party attends, the court may dismiss the suit.

2. If on the day fixed for hearing, after the suit has been called on for hearing outside the court, only the plaintiff attends, if the court is satisfied—

(a) that notice of hearing was duly served, it may proceed ex parte;

(b) that notice of hearing was not duly served, it shall direct a second notice to be served; or

(c) that notice was not served in sufficient time for the defendant to attend or that for other sufficient cause the defendant was unable to attend, it shall postpone the hearing.

3. If on the day fixed for hearing, after the suit has been called on for hearing outside the court, only the defendant attends and he admits no part of the claim, the suit shall be dismissed except for good cause to be recorded by the court.”

In the present suit, the Plaintiff did attend the hearing and give evidence which is on record, as shown in the foregoing, and which the Defendant therefore needed to controvert with their own evidence. Order 12 Rules 3(1) and (3) of the Civil Procedure Rules are therefore not applicable to the circumstances of the present case.

On the substantive issues before the Court, the Plaintiff submitted that it is admitted that the name "Maanzoni" was initially used by the Plaintiff and that the new building put up by the Defendants came up after the Plaintiff had been using this trade name of Maanzoni. Further, that the Defendants were aware of this but they deliberately and with malice decided to name their building Maanzoni after they had evicted the Plaintiff with the intention of running him out of business.

I am alive to the fact that trade names are used to identify corporations, partnerships, sole proprietorships, and other business entities. Further, the right to a trade name arises as a result of the use of that name as an indication for a business and requires a certain degree of continuity in the use of the name and the use has to be noticeable to the public. The name has to be actually used to distinguish the business to the outside world for instance on stationery, invoices, on the façade, etc.

Trade name rights exist from the moment that a name is used as a trade name. The right arises without any formalities; the use of the name suffices, and the registration of the business name is not decisive as to the rights to the trade name because as soon as the use of the name stops, the right ends as well. The criteria and threshold for infringement of a trade name therefore is the confusion caused by the similarity of the trade names as a result of the common businesses or activities being carried out by the conflicting parties, or as result of their being in the same business address or area.

To maintain a [cause of action](#) for trade name infringement, a plaintiff must establish that it owned the right to operate its business under a certain name and that the defendant violated this right by use of a deceptively similar name. The right to use a particular trade name ordinarily is established by priority of adoption either by way of registration for protection of that name as a trademark under the Trademarks Act or through public use, which means that the law will afford protection only if it can be demonstrated that a business and its trade name have become inseparable in the public's mind. Once a business has established the right to use a particular trade name, it must then prove that the defendant fraudulently attempted to pass itself off as the plaintiff through use of a deceptively similar name.

In **Gilbert Kyumwa Mutulu & 2 others v Oscar Omurwa Rosana & 4 others**, [2014] e KLR Kimondo J., while citing the decision by Lord Diplock in **Erven Warnick BV v Townend & Sons (Hull) Ltd** [1979] 2 All ER 927 at 932, summarised the essential elements of a passing off action thus : first, that the claimant's goods or services have acquired a good will or reputation in the market and are known by some distinguishing feature; secondly, that there is a misrepresentation by the defendant (whether or not intended) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the claimant ; and, thirdly that the claimant has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

This Court has detailed out the law on trade name infringement in the foregoing to facilitate an analysis of the Plaintiff's evidence in light of the key elements of his cause of action that he required to prove. The finding of this Court in this regard is that the Plaintiff has failed to prove his case for two reasons.

Firstly, the Plaintiff did not produce any exhibits as to the existence of, and use of the said trade name of Maanzoni Paradise. It is noted in this regard that he did mark copies certain documents and photographs for identification, but did not avail himself to produce the originals as exhibits. I am in this regard guided by the Court of Appeal decision in **Kenneth Nyaga Mwige v Austin Kiguta & 2 Others**, [2015] eKLR where it was held as follows:-

"Once a document has been marked for identification, it must be proved. A witness must produce the document and tender it in evidence as an exhibit and lay foundation for its authenticity and relevance to the facts of the case. Once this foundation is laid, the witness must move the court to have the document produced as an exhibit and be part of the court record. If the document is not marked as an exhibit, it is not part of the record. If admitted into evidence and not formally produced and proved, the document would only be hearsay, untested and an unauthenticated account.

The documents marked for identification by the Plaintiff did not become exhibits and they have no evidential weight.

Secondly, the Plaintiff did not call any witnesses to establish the Defendants' use of a similar name as that of the Plaintiff's trade name, and that the same had caused them confusion or enticed them to the Defendants' business as pleaded. The onus was on the Plaintiff to prove the resemblance, deception, infringement and the attendant damage. See in this regard the decisions in **Aktiebolaget Jonkoping v East Africa Match Company Limited** [1964] E.A. 62, **East African Industries v Trufoods Limited** [1972] E.A 420, **Cut Tobacco Kenya Ltd v British American Tobacco Ltd** [2001] KLR 36, **Martinair Africa Limited v Global Freight Services** [2012] eKLR, **Dinah Bhoke Makini t/a Dr Mary Riziki v Willis Wanjala & 4 others** [2005] eKLR and **Anne Njeri Kihui v Standard Group Limited**,[2011] eKLR.

It was necessary for the Plaintiff to adduce evidence of a member of the public to show the confusion in the passing off his goodwill as was held by Ringera J. (as he then was) in **Supa Brite Limited vs Pakad Enterprises Limited**, Nairobi High Court Case 287 of 2001 (unreported) as follows:

"I am of the opinion that like in the case of personal reputation, evidence of goodwill must, whether at interlocutory stage or final hearing of a suit, be offered by members of the public and not the subject of the reputation himself or the trader and his consultant as the case may

be”

The Plaintiff’s suit is accordingly dismissed with costs to the Defendants for the foregoing reasons.

Orders accordingly.

Dated, signed and delivered in open court at Machakos this 2nd day of August 2017.

P. NYAMWEYA

JUDGE