



REPUBLIC OF KENYA
IN THE HIGH COURT OF KENYA AT NAIROBI
MILIMANI COMMERCIAL & ADMIRALTY COURT
CIVIL CASE NO 335 OF 2015

LRC PRODUCTS LIMITED.....PLAINTIFF

VERSUS

METRO PHARMACEUTICALS LIMITED.....DEFENDANT

RULING

1. The Defendant is the registered proprietor of the trademark “Durex” which is registered in Kenya under the provision of the Trademark Act, Class 3 and designated trademark No KE/T/1987/0036294, with the effective date of registration being 9th February 2012 to 9th February 2022. On 10th July 2015, the Plaintiff filed an application against the Defendant, which application was predicated upon the provisions of Sections 1A, 1B, 3, 3A, 63(c) & (e) of the Civil Procedure Act, as well as Order 40 Rules 1, 2, 3, 4 & 10 and Order 51 Rule 1 of the Civil Procedure Rules.
2. The Plaintiff sought, amongst other orders, for an injunction restraining the Defendant, whether by themselves, agents, servants or otherwise howsoever from importing, packaging, supplying, selling or offering for sell, distributing or otherwise dealing with the ‘Durex’ products, or packaging products bearing the mark similar or confusingly similar in getup to the trademark owned by the Plaintiff, pending the determination of the application and the main suit.
3. Further, the Plaintiff sought orders to enter into the Defendant’s premises and seize all products or packaged products bearing the Plaintiff’s trademark, or similar trademark and further, seize records of purchases and sales, invoices and any other documents which constitute or would constitute evidence necessary to substantiate its cause of action.
4. The application was predicated upon the grounds that the Defendant has been importing, distributing and selling the ‘Durex’ products, or packaging products bearing the marks similar or strikingly similar to the trademark owned by the Plaintiff, and further, that the Defendant has been infringing on the Plaintiff’s exclusive rights over the ‘Durex’ products in the territory of Kenya.
5. It was further contended that the Defendant had acted contrary to the directions of the Pharmaceutical Society of Kenya, and has continued to act contrary to the said directions. The depositions made in the affidavit in support of the application were reiteration of the grounds as averred.
6. The motion was contested. There was the Defendant’s replying affidavit sworn on 23rd July 2015, wherein it was deposed to that the Defendant was not a manufacturer, but an importer and distributor of

the Plaintiff's product "Durex".

7. Further, it was the Defendant's disposition that there was no infringement of the Plaintiff's trademark on the part of the Defendant, as the products that the Defendant sells are the exact products of the Plaintiff, and further, there was no legal restriction imposed upon the Defendant from legally reselling the Plaintiff's products.

8. It was averred that there was no basis for the Plaintiff's assertion that they exercised exclusive rights over the "Durex" products in Kenya, and further, that they had no control whether the products could be re-sold. Further to the supporting affidavit, the Defendant also filed a supplementary affidavit, wherein it was deposed to that the Defendant, as an importer of the "Durex" products, paid both custom and excise duty, and that they complied with importation regulations.

9. I have considered the depositions made by the parties, their submissions, both oral and written, which essentially reiterated the averments made. It has emerged that there are two aspects that the Court must consider as preliminary issues of disposition; (1) is whether there was infringement and (2) whether the Plaintiff has established a prima facies case with probability of success as enunciated in *Giella v Cassman Brown & Co. Ltd* (1972) EA 358.

10. From the onset, the Defendant has contended that it is neither a manufacturer nor a proprietor of the trademark "Durex". It has asserted, however, that it was an importer of the "Durex" products belonging to the Plaintiff, and that it has never refuted or disputed the Plaintiff's ownership of the products.

11. It was its contention that a mere importer, it could not have impugned upon the rights of the Plaintiff for the use of the trademark "Durex", and that it neither being in direct or indirect competition with the Plaintiff, could not have possibly have infringed upon any rights that the Plaintiff enjoys over the trademark.

12. Further, the Defendant contends that there is no legal or legislative bar to the importation and distribution of the "Durex" products, and that in essence, they are licensed to import parallel to the Plaintiff, from any of its other distributors. Therein, lies the contentious issues to be disposed of by this Court. Reliance was put on the case of *Lord Healthcare Ltd v Salama Pharmaceuticals Ltd* (2008) eKLR where Okwengu, J held inter alia;

"Neither the Plaintiff nor the Defendant is a manufacturer of the product "Budecort-200 Budesonide Inhaler". The product sold by the Plaintiff is manufactured by Cipla Ltd India who has given the Plaintiff exclusive rights of distributorship of the product in Kenya. The Defendant is selling the same product manufactured by Cipla Ltd India under license from the International Registered Owner Fujisawa Deutschland GmH who has international protection under the Paris Convention. The Defendant contends that the "Budecort" products are supplied by Cipla Ltd in more than one country and parallel importation allows for importation of the same product from such other markets. All these are contentious issues which can only be determined at the trial after the Court has had the benefit of hearing full evidence."

13. The circumstances as pronounced in *Lord Healthcare Ltd v Salama Pharmaceuticals Ltd* (supra) are similar to those in the instant matter, save that here the Defendant only claims to be an importer of the "Durex" products from third parties who may have had a distributorship agreement with the Plaintiff's parent company. This, however, is a mere guesswork as none of the parties have averred to the same, and as to whether there was a distributorship agreement between the Plaintiff and other distributors.

14. Further, it has not been established, at this particular juncture how the Defendant, who asserts that it is an importer of the Plaintiff's products, has infringed on any of the Plaintiff's right for exclusive use of the trademark "Durex".

15. As was stated in *Pastificio Lucio Garofalo SPA v Debenham & Fear Ltd* (2013) eKLR citing Unilever

PLC v Bidco Oil Industries (2004) 1 KLR 57, with the registration of a trademark, the proprietor acquires an exclusive right to its use. However, it was enunciated in Pharmaceutical Manufacturing Company v Novelty Manufacturing Ltd HCCC No 746 of 1998 Ringera, J (as he then was) that the infringement of a trademark was a tort of strict liability, and that the Plaintiff has to establish that indeed there was a tortfeasor.

16. In this instant, and from the facts on record, there is no establishment of a prima facie case by the Plaintiff to warrant the Court to issue an order of injunction against the Defendant. The contentious issues raised herein are the preserve of the trial Court, and therefore I would at this particular juncture, not issue orders as prayed for in the application.

17. As was reiterated in Solpia Kenya Limited v Style Industries Limited & Another (2015) eKLR, there are no cogent or strong evidence adduced by the Plaintiff, that it has established a claim befitting a warrant of injunction orders. For those reasons therefore, the application by the Plaintiff is found unmeritorious, and the same is dismissed with costs to the Defendant.

Dated, signed and delivered in court at Nairobi this 26th day of February, 2016.

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C. KARIUKI

JUDGE