



REPUBLIC OF KENYA

IN THE HIGH COURT OF KENYA AT NAIROBI

MILIMANI HIGH COURT

CIVIL CASE NO 314 OF 2015

COLOUR PLANET LIMITED.....PLAINTIFF

VERSUS

SAFARICOM LTD.....1ST DEFENDANT

JULIA OBURA.....2ND DEFENDANT

KENYA POWER & LIGHTING CO. LTD.....3RD DEFENDANT

RULING

1. Before the Court was the Plaintiff's application dated 26th June 2016, brought under the provisions of Sections 1A, 1B, 3A & 63(e) of the Civil Procedure Act, Order 40 Rules 1, 2, 3 & 4 of the Civil Procedure Rules and Sections 7 & 8 of the Trade Mark Act. The prayers sought the following inter alia;

1. *Spent.*
2. ***THAT a temporary injunction do issue restraining the Defendants whether by themselves, servants and/or agents from infringing the Plaintiff's intellectual property rights, the lawful proprietor of Okoa Stima, Trade Mark pending the hearing and determination of the application herein and pending the issuance of the certificate of registration of the trademark Okoa Stima by the Kenya Industrial Property Institute.***
3. ***THAT a temporary injunction do issue restraining the Defendants whether by themselves, servants and/or agents from infringing the Plaintiff's intellectual property rights the lawful proprietor of Okoa Stima Trade Mark pending the hearing and determination of the suit herein.***
4. ***THAT a temporary injunction do issue restraining the Defendants whether by themselves, servants and/or agents to forthwith cease trading, promoting, advertising, marketing, carrying on business and/or any other trade documents of any nature with the said trademark Okoa Stima or in any way dealing in any other way howsoever with the trademark Okoa Stima pending the hearing and determination of the application herein and pending issuance of the certificate of registration of the trademark Okoa Stima by the Kenya Industrial Property Institute.***
5. ***THAT a temporary injunction do issue restraining the Defendants whether by themselves, servants and/or agents to forthwith cease trading, promoting, advertising, marketing, carrying***

on business and/or any other trade documents of any nature with the said trademark Okoa Stima or in any way dealing in any other way howsoever with the trademark Okoa Stima pending the hearing and determination of the suit herein.

2. The application was premised on the grounds that the Plaintiff was the registered proprietor of the trademark Okoa Stima, vide application number 86795 registered under Class 36. The application was approved on 27th May 2015 and subsequently advertised in the KIPJ Journal on 31st May 2015.
3. It was the Plaintiff's contention that the 1st and 2nd Defendants, had infringed upon the lawful registered trademark by, running a campaign, advertising and marketing the Plaintiff's trademark, denying him the use of the trademark and claiming ownership of the same, and therefore, blatantly violating the Plaintiff's exclusive right of use of the trademark.
4. It was alluded to that the proprietorship of trademark had not been successfully challenged, and that in that instance therefore, the Plaintiff had the right to enjoy the benefits that accrued therefrom. The Plaintiff's claims were further canvassed in the affidavit in support of the application sworn on even date, and in which therein, the grounds adduced in support of the application were traversed.
5. In opposing the application, the 1st and 2nd Defendants filed their replying affidavit sworn on 17th July 2015, Therein, it was deposed to that the Plaintiff was not the registered owner of the said trademark Okoa Stima, and that he therefore, did not enjoy any rights of exclusivity over the use of the said trademark.
6. It was reiterated that the application for registration of a trademark did not confer upon the Plaintiff any rights of exclusive use of the trademark, and that in any event, there was pending before the Kenya Industrial Property Institute an application for objection of the registration and use of the trademark Okoa Stima. Further, it was contended that the application had not established any infringement of any right claimed by the Plaintiff, and that, the same is predicated upon the false, erroneous and intentional misrepresentation by the Plaintiff.
7. The application was further opposed by the 3rd Defendant who filed its replying affidavit through one Imelda Chepkoech Bore, sworn on 20th July 2015. It was deposed to that with regards to any allegations of infringement of the trademark Okoa Stima by the Plaintiff, they were strangers and as such do not lie against it.
8. It was further deposed to that the mere application for registration of a trademark and its subsequent gazette in the KIPJ Journal did not infer that the applicant exercised exclusive rights over the use of the trademark or confer ownership thereof. The deponent averred that the Plaintiff has failed to establish proprietary rights over the trademark Okoa Stima, and as such, the instant application, and prayers sought, should not be granted.
9. It was heard before Court that the Plaintiff claimed to be the registered owner and proprietor of the trademark Okoa Stima, which ownership is claimed through application number KE/T/2015/86795 under Class 36, and which application was approved on 27th May 2015, and subsequently advertised in the KIPJ Journal on 31st May 2015.
10. It was also heard that the 1st Defendant filed its Notice of Opposition to the registration of the stated trademark dated 23rd July 2015, and which the Plaintiff responded to 3rd September 2015. At the time of filing the instant application on 1st July 2015, no determination had as yet been made on the challenge to the registration of the trademark by the relevant body.
11. Be that as it may, the Plaintiff seeks an injunctive relief against the Defendants, ostensibly upon the grounds that they have infringed on its trademark Okoa Stima, and continue to do so, regardless of the challenge to the registration and purported rights of ownership claimed by the Plaintiff.
12. The Plaintiff claim was primarily based on the fact that it had accrued exclusive rights over the use of the trademark Okoa Stima, and that as the registered proprietor of the said trademark, enjoyed benefits derived from such purported registration.
13. What they presented before the Court, however, was an application for the registration of the trademark Okoa Stima, which application was approved for advertisement on 27th May 2015 (ACW-1). There was no certificate of registration issued, in this regards, which could establish that the Plaintiff was indeed the registered owner of the trademark.

14. The Plaintiff relied on the case of **Wilson Muriithi Kariuki T/A Wiskam Agencies v Surgipharm Limited (2012) eKLR**, in which the Plaintiff therein relied on the case of **Glaxo Plc & Another v Glaxowellcome Ltd & Another** and **Beiersdorf AG v Emirchem Products Ltd Nairobi HCCC No 559 of 2002** in which it was contended that the registration of a trademark confers right to exclusively use the mark and that infringement of the trademark is a tort of strict liability.
15. Mbaluto, J (as he then was) in the **Beiersdorf AG v Emirchem Products Ltd** (supra) case, had held inter alia;

“The section means and implies that a proprietor of the trademark has the exclusive use of the mark and any person who wishes to use it has to do so with license from the proprietor.”

Further, in **Pharmaceutical Manufacturing Company v Novelty Manufacturing Ltd HCCC No 746 of 1998**, referred to by Gikonyo, J in **Solpia Kenya Limited v Style Industries Limited & Another (2015) eKLR**, Ringera, J (as he then was) had held that;

“Registration of a trademark confers the right of exclusive use of the mark. Infringement of the trade mark is a tort of strict liability. Intention and motive are irrelevant considerations...the right is a statutory one”

16. It is evident from the fore stated cases that in order for the Court to consider an application for injunction, the principles as enunciated in **Giella v Cassman Brown & Co. Ltd (1972) EA 358** are considered, as well as the provisions of the law under the Trade Marks Act. If it is shown and proven that the trade mark was registered for the exclusive use of the proprietor, then the Court would have to allow for an injunction to dissipate confusion in the minds of consumers and further, the eminent chaos that may arise.
17. However in the instant application, there pends a dispute as to the registration of the trademark and its application for registration. The Plaintiff admits, and such admission is well pronounced, when he stated that the application for registration is as good as the registration itself.
18. Further, he alludes that the 1st and 2nd Defendants were aware that he was the registered proprietor of the trademark Okoa Stima, and as such, they were in blatant violation and infringement of his rights accrued. But as was stated in **Pharmaceutical Manufacturing Company v Novelty Manufacturing Ltd** (supra), infringement of a trademark is a tort of strict liability, and one must make concerted efforts in establishing that liability.
19. In **Solpia Kenya Limited v Style Industries Limited & Another** (supra), it was held *inter alia*;

“Therefore, as a principle of law, the fact of registration of trademark per se does not entitle the proprietor of a trademark to an automatic injunction to restrain the use of the trademark by a person who has continuously used the trademark prior to, during and after the registration of trademark. In other words, in the face of a claim of prior user of trademark, and absent other strong and cogent evidence, the fact of registration of trademark does not invariably constitute a prima facie case with a probability of success in the sense of the case of Giella v Cassman Brown. Where Section 10 is called into play, the Court should be careful not to use the fact of registration of trademark as the sole basis for restraining the use of the trademark by the person claiming prior use of the trademark.”

The sole basis upon which the Plaintiff’s application is predicated upon is that it was the proprietor of the registered trademark Okoa Stima.

However, the provision of Section 10 of the Trademark Act, as read together with Section 7 thereof, come into play. At Section 10, it is provided that;

Nothing in this Act shall entitle the proprietor or licensee of a registered trademark to interfere with or restrain the use by any person of a trademark identical with or nearly resembling it in relation to goods in relation to which that person or predecessor in title

of his has continuously used the trademark from a date anterior-

- a. to the use of the first mentioned trademark in relation to those goods of the proprietor or a predecessor in title of his; or
 - b. to the registration of the first mentioned trademark in respect of those goods in the name of the proprietor or a predecessor in title to his, whichever is the earlier, or to object (on such being proved) to that person being put on the register for that identical or nearly resembling mark in respect of those goods under subsection (2) of Section 15. (Emphasis added).
20. As was succinctly enunciated in **Solpia Kenya Limited v Style Industries Limited & Another** (supra), as well as in **Webtribe T/A Jambopay v Jambo Express Ltd (2014) eKLR**, if it is, to the mind of the Court, other issues that need to be expounded and extensively illustrated before its determination, then it is not a matter that should be enjoined, but the Court may, allow for the same to be ventilated through a litigation progress.
21. In an allegation for infringement, as has been well stated in the **Solpia Kenya Limited v Style Industries Limited & Another** (supra), the registration of a trademark does not constitute a prima facie case. Further, in **Benjamin Nzioka & 7 Others v Juma Khamisi & 8 Others HCCC No 3224 of 1993**, an interlocutory injunction will not issue where facts upon which the application for it is based on a dispute.
22. At present, there are two (2) application pending before the Registrar of Trademarks; one by the Plaintiff and the other by the 1st Defendant. There also subsists an objection that has yet to be determined as well.
23. The issues raised by the Plaintiff with regards to loss of revenue from the use, and alleged infringement of its purportedly registered trademark, are issues requiring of proper and adequate evidence placed before the Court in order to make an informed determination.
24. In the instant, the evidence placed before the Court is not sufficient to sustain the instant application, and the Court, in seeking further proof of infringement, and subsequent claim for damages, if any, may direct that the matter be heard, and require each of the disputing parties to adduce cogent and sustainable evidence.
25. As was enunciated in **Webtribe T/A Jambopay v Jambo Express Ltd** (supra), the balance of convenience will lie in favour of proceeding with this case on a more intrinsic test of evidence and the law. In the instant, the Plaintiff has not explicitly shown what rights, if any, have been infringed upon by the Defendants, whether jointly or severally, by the use of the yet unregistered trademark Okoa Stima. It has also failed to show what damages, if any, would be sustained, if the said application was not allowed and the prayers sought not granted. It has therefore, failed in establishing the principles enunciated in **Giella v Cassman Brown & Co Ltd** (supra), as well as **Mrao v First American Bank of Kenya Ltd & 2 Others (2003) eKLR**.
26. In other words, the Court finds that the application is without merit, and the same is dismissed with costs to the Defendants.

Dated, signed and delivered in court at Nairobi this 19th day of February, 2016.

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C. KARIUKI

JUDGE