



**REPUBLIC OF KENYA**  
**IN THE HIGH COURT OF KENYA AT NAIROBI**  
**COMMERCIAL & ADMIRALTY DIVISION - MILIMANI**  
**CIVIL SUIT NO. 514 OF 2014**

**GEORGE RAGUR KARANJA..... PLAINTIFF**

**VERSUS**

**STYLE INDUSTRIES LTD... ..DEFENDANT**

**RULING**

**Introduction**

1. The matter before the Court concerns design rights under the Industrial Property Act 2001 and in particular the Plaintiff/Applicant's Industrial Design No. 752 and its alleged infringement.
2. The suit was commenced by a Plaint filed on 10<sup>th</sup> November 2014 and it comes before the Court on an application filed on the same day. The Plaint describes the Plaintiff as a businessman and nothing more. The Defendant is described as a Limited liability company having its registered office and place of business in Nairobi.

**The Application**

3. The Application is brought by means of a Notice of Motion brought under “*Article 165 (3) (a) of the Constitution of Kenya, Section 92 (3) of the Industrial Property Act (Cap 509 of the Laws of Kenya), Section 3A of the Civil Procedure Act Cap 21, Order 40 Rule 1 (a) and Order 50 rule 1 of the Civil Procedure Rules.....*”.
4. The Application seeks Orders that :
  - a. This application be certified urgent.
  - b. A temporary injunction does issue restraining the Defendant/Respondent whether acting by its directors, officers, employees, servants or agents, or otherwise howsoever from further infringing or in any way using the Plaintiff/Applicant's Industrial Design No. 752 without his authority pending hearing and determination of this application and suit.
  - c. A mandatory injunction does issue to compel the Defendant/Respondent whether acting by its directors, officers, employees, servants or agents or otherwise howsoever, to remove all the infringing advertisements and/or paintings of the Defendant/Respondent's corporate colours at the footbridge along Mbagathi Road between Kenyatta National Hospital and Mbagathi District Hospital within Nairobi, or any other ascertained place of infringement within the country, pending

hearing and determination of the suit.

5. The Application is based on the Grounds that:

- a. The Plaintiff/Applicant is the registered proprietor of Industrial Design Number 752 (hereafter called "*the design*").
- b. The Design was registered on 5<sup>th</sup> November 2013 through application NO. KE/ID/2013/001376; and a certificate of registration issued to the Plaintiff on 25<sup>th</sup> May, 2014.
- c. Kenya Industrial Property Institute conducted a search on the Plaintiff/Applicant's application aforesaid and ascertained that the design was new and there were no priority claims in respect thereto at the time of its registration.
- d. Prior to the said registration the Plaintiff/Applicant expended time, and substantial material, financial and intellectual resources in order to develop and secure registration of the subject design.
- e. Registration of the Plaintiff/Applicant's design is, and has at all material times been valid and subsisting. The Plaintiff/Applicant has sole and absolute rights over the design.
- f. The design in respect of whose features, shape, configurations and appearance the Plaintiff/Applicant
- g. Since the design was registered for commercial purposes its use by anyone other than the Plaintiff/Applicant is only tenable under a contract.
- h. Sometime in September, 2014, the Defendant/Respondent painted or caused to be painted in red, the footbridge along Mbagathi Road between Kenyatta National Hospital and Mbagathi District Hospital, which colours are distinctive of the Defendant/Respondent's corporate identity; while adopting the Plaintiff/Applicant's design in its entire form of shape and configuration.
- i. The foregoing acts of the Defendant/Respondent constitute an advertisement which assumes the shape and configuration of the Plaintiff/Applicant's design.
- j. The Defendant/Respondent has applied the design for commercial gain in bad faith and without the Plaintiff/Applicant's authority.
- k. As a result of its conduct aforementioned, the Defendant/Respondent has willfully infringed the Plaintiff/Applicant's Industrial Design No.752.
- i. By reasons of the matters aforesaid, the Plaintiff has suffered and continues to suffer loss of monthly income of Kshs.1,000,000.00 and further losses of business as a result of the Defendant/Respondent's conducts/infringements hereabove.
- m. The infringement has persisted despite the Plaintiff/Applicant having notified the Defendant/Respondent in writing of his proprietary interests in the design; and further pleas for immediate cessation of the infringements and/or non-consensual use of the design.
- n. The Defendant/Respondent's infringing actions are deliberate and mala fides, with the objective to injure the Plaintiff/Applicant's goodwill and cause confusion in the market.
- o The Plaintiff/Applicant is apprehensive that he will continue to suffer prejudice and irreparable loss unless the Honourable Court intervenes through the orders prayed.
- p. It is only fair and just that the orders sought herein be granted to vindicate the Plaintiff/Applicant's rights over the subject design and his interests appurtenant thereto.

6. The Application is brought under a certificate of Urgency which states:

1. Despite having notified of the Applicant's claim over the design constituted in its outdoor advertisement, the Respondent has obstinately declined to acknowledge the Applicant's right and interests in the design thereby unjustly and unlawfully depriving the Applicant of his business, income and livelihood.

2. The Applicant is apprehensive that the Respondent will continue the infringing acts and spread the same to other places to the Applicant's further detriment/prejudice, unless immediately restrained by the Honourable Court as sought herein.

3. The infringing acts complained of herein also expose the Applicant's design to infringements by other people; and will defeat the objective of registration unless stopped.

4. Grounds 8 states that the alleged infringement occurred sometime in September 2014. The Application was not brought until November 2014.

7. The Supporting Affidavit is sworn by the Plaintiff on 5<sup>th</sup> November 2014. In that Affidavit the deponent sets out the entire application process. The Certificate of Registration was said to have been issued on 13<sup>th</sup> May 2014 having been published in the KIPJ Journal dated 28<sup>th</sup> February 2014. The Supporting Affidavit sets out certain characteristics of the Design at paragraphs 7-8.

a. I expended time and substantial material, financial and intellectual resources in order to secure the registration of the design whose sole use, application and purpose is for outdoor advertising.

b. I have created and established in the mind of the populace, goodwill and a distinct connection between the subject design and myself.

8. Paragraph 9 states:

c. I am advised by my Advocates herein which advice I verily believe to be true and sound in law, that the essence and effect of registration of my design is that the Defendant/Respondent and all other persons were and remain precluded from advertising or publicly portraying their businesses in any manner resembling the shape and configuration of the design without my prior authority/consent.

9. The Plaintiff/Applicant complains that the Defendant painted or caused to be painted an advertisement in its distinctive corporate colours upon the footbridge between Kenyatta National Hospital and Mbagathi District Hospital. The Affidavit does not explain but I assume that the reference is to the footbridge across Mbagathi way.

10. Paragraph 9 and 14 of the Grounds sets out the infringement alleged. It is said by the Deponent that:

a. The foregoing acts of the Defendant/Respondent constitute an advertisement which assumes the shape and configuration of the Plaintiff/Applicant's design.

b. The Defendant/Respondent's infringing actions are deliberate and mala fides, with the objective to injure the Plaintiff/Applicant's goodwill and cause confusion in the market.

11. The Design was registered for "*commercial purposes*" according to the Plaintiff/Applicant. It was titled "*Advertising Panel*" (outdoor).

12. The damage complained of is set out in Supporting Affidavit that:

a. By reasons of the matters aforesaid, I have suffered and continue to suffer loss of monthly income of Kshs.1,000,000.00, and further losses of business as a result of the

Defendant/Respondent's conducts/infringements hereinabove.

b. The infringement has persisted despite having notified the Defendant/Respondent of the Plaintiff's proprietary rights/interests in the design; hence the need to prohibit the Defendant/Respondent from conducting any business or activity that undermines those proprietary rights/interests in the design in any manner at all.

c. The Defendant/Respondent's infringing actions are mala fides and are deliberately designed to injure my goodwill and cause confusion in the market and amongst business people interested in the design.

d. As a result of the Defendant/Respondent's unlawful actions herein, I have suffered financial and business loss, damage and harm which will be irreparable unless the Defendant/Respondent is restrained as sought.

e. The infringing acts complained of herein also expose my design to infringements by other people, and will defeat the objective of registration unless immediately stopped.

f. The conduct of the Defendant/Respondent complained of hereinabove inhibits and dwarfs inventive and innovative activities which are key pillars of our country's Vision 2030, and should be prohibited.

g. It is only fair and just that the orders sought herein be granted to obviate further loss of income and business by me, and to vindicate my rights over the subject design and all interests thereon. I stand to suffer irreversible damage/prejudice if the orders sought are not granted.

h. 30. All relevant documents are annexed hereto and marked "GRK".

13. As to evidence of Infringement the Advertisement shown at page 7 and 8 of the Exhibit does not bear any obvious connection with the Respondent but relates to an entity known as "Virgin Atlantic and depicts a woman wearing what appears to be a red uniform.

14. The Defendant opposes the application by firstly filing its Grounds of Opposition. In summary the Grounds of Opposition challenge the existence of any intellectual property rights in the shape and structure of the footbridge. Further it is said if there exists a work of intellectual property that does not belong to the Plaintiff. Thirdly it is said the design and structure of the footbridge pre-dates the registration of the Industrial Design for which protection is now sought.

15. The Defendant has also filed a Replying Affidavit and a Statement of Defence on 28<sup>th</sup> November 2014 and 15<sup>th</sup> December 2014 respectively. The Replying Affidavit replies to the Application in detail and ceases with the words "...the Plaintiff has not established a case with a probability of success. The Exhibits include an Agreement with Andrew Investment for outdoor advertising. That Agreement is dated 1<sup>st</sup> October 2010 and had a commencement date of the same day.

In it Andrews Investments agrees to provide Strategic Industries (the predecessor or of the Defendant) with site where it could advertise by means panels called flexi panels

16. Both Parties have filed Written Submissions which they highlighted on 11<sup>th</sup> November 2015.

17. In his submissions the Plaintiff confirms that he is seeking temporary and mandatory injunctions against the Defendant/Respondent in respect of violations to his Industrial Design aforesaid. The Plaintiff asserts that he claims novelty over the features, shape, configurations and appearance of the design applicable to outdoor advertising. The Plaintiff also claims that he suffers a loss of Kshs.1,000,000/- of monthly income. Section B set out the issues for determination. Interestingly it makes no reference to the criteria Order 40 of the Civil Procedure Rules or the well known Authority of **Giella vs. Cassman**

**Brown 1973** in the list of issues and only addresses it in paragraph 44.

18. The Plaintiff sets out Section 84 of the Industrial Property Act and quotes extensively from the authorities relied upon. It also asserts various facts on behalf of KIPI.

19. At paragraph 29 the submissions on behalf of the Plaintiff argues that the Defendant's position that the architectural design of the footbridge (incorrectly stated as "*at the foot of the bridge*" including the colours were in the public domain does not lie because what is protected is the design and not the substratum on which it is recorded. That argument is illogical as the bridge comprises a shape and it is that shape the Plaintiff claims is his. The Plaintiff says he does not lay claim to the bridge but the manner in which such bridge has been put to use.

20. Between paragraphs 30-34 the Plaintiff asserts that paragraph 6 of the Replying Affidavit amounts to objection proceedings which should be properly before KIPI. In fact such proceedings should be before the Tribunal. The authority relied upon is **Safepack Ltd vs. Asili Plastics Ltd.** Although the preposition on challenge is correct. The statement that the Judge was "*faced with the same situation*". is not a correct reflection of the facts.

21. The Plaintiff also seeks to put forward an argument on passing off when he says that he has created and established in the mind of the populace goodwill and a distinct connection between the subject design and himself. Paragraph 53 states the "Defendant has applied his design for commercial gain in bad faith and without his authority. The Authority then relied upon, **ENG Kenya Ltd versus Magnate Ventures Ltd (2009)** eklr relates to protection prior to registration under **Section 86(3)**.

22. The Plaintiff repeatedly asserts that "*the Defendant has applied his design*" and that is an illegal and unlawful act.

23. The Defendant's Submissions are made from a starting point the Application is premised upon a misplaced ground that the Defendant has infringed the Plaintiffs industrial Design No. 752. The Defendants opposition to the Application are contained in the Replying Affidavit as set out above. At paragraph 2 the Defendant calls attention to the fact that the colour of the Defendant's advertisement has nothing to do with the Plaintiff's designs.

24. Paragraph 3 lists the points of opposition

(i) The advertisements made by the Defendant are done upon approval and authority of the County Government and the Government department in charge of Roads.

(ii) The footbridge in question was constructed and owned by the Government of Kenya.

(iii) The Plaintiff does not own the design or shape of the footbridge, and if he did, the correct party to sue would be the Government.

(iv) There is no known intellectual property in the design or shape of the bridge which is an engineering event the Plaintiff cannot lay claim to.

(v) The branding and coloring of the bridge has followed the shape of the bridge and not the Plaintiff's Industrial Design.

(vi) The Plaintiff's Industrial Design is in respect of an advertising panel and neither the bridge nor the Defendant's colors is an advertising panel

(vii) The Plaintiff's claim is geared towards achieving a technical result which is beyond the scope of protection granted to him by virtue of registration of his Industrial Design.

(viii) The footbridge the subject of the suit was constructed long time ago well before the Plaintiff's

application for and registration of the Industrial Design.

25. The Defendant argues that the Design which is protected by Registered Industrial Design 752 is a panel bearing the shape indicated. Use of such a panel without authority would amount to infringement. The Defendant asserts it has not produced such a panel. Further the footbridge is not a panel.

26. The Defendant bases its defence on the shape of the bridge which belongs to the Government of Kenya and predates the registration by a number of years.

27. The Defendant sets out Section 84 and 92 of the Industrial Property Act and states that the Plaintiff has misapprehended both the definition and protection given to his Industrial Design under the Act. It is said the Plaintiff is trying to obtain a technical result that is not permitted.

28. At paragraph 5 the Defendant states categorically that it has not created an advertising panel in the shape, configuration and appearance of the Plaintiffs Industrial Design. Further it is said that the Defendant has not breached Section 92 of the Act and that the Plaintiff is making wild allegations with no bearing on the statutory provisions and therefore the “*claim is bizarre*”.

20. The Defendant states that the facts alleged by the Plaintiff are seriously disputed and the Replying Affidavit has not been controverted. It is argued by the Defendant that “*it would be very unsafe for the Court to issue an injunction on the basis of disputed facts and unchallenged evidence by the Defendant. The Court will have to take evidence to establish, on a balance of probability, which of the two sides has an upper hand*”.

### **Analysis and Decision**

33. The Court has before it an application for Interim Injunctions one prohibitory and the other mandatory. The statutory point therefore must be the Court’s jurisdiction and power to make such orders.

Order 40 of the Civil Procedure Rules 2010.

34. **Order 40 Rule 1 and 2** provides

*1. In any suit for restraining the defendant from committing a breach of contract or other injury of any kind, whether competition is claimed in the suit or not, the Plaintiff may, at any time after the commencement of this suit, and either before or after judgment, apply to the Court for a temporary injunction to restrain the defendant from committing the breach of contract or injury complained of, or any injury of a like kind arising out of the same contract or relating to the same property or right.*

*2. The court may by order grant such injunction on such terms as to an inquiry as to damages, the duration of the injunction, keeping an account, giving security or otherwise, as the Court deems fit.*

35. The Right that the Plaintiff seeks to protect arises from the Registration of an Industrial Design. The Design was Registered pursuant to the Registration Certificate dated 13<sup>th</sup> May 2014 and is known as Industrial Design 752 under Section 92 (1) of the Industrial Property Act 2001 provides as follows:

*“(3) The Registered owner of an industrial design shall in addition to any other rights remedies or actions available to him, have the right to institute court proceedings against any person who infringes the industrial design by performing, without his consent, any of the acts referred to in subsection (1) on who performs acts which make it likely that infringement will occur”.*

35. The Plaintiff’s claim is that the Defendant has infringed his Industrial Design and unless restrained loss and damage will emanate. What constitutes infringement? **Section 92 (1) of the Act** provides;

*“92.(1) Registration of an industrial design shall confer upon its registered owner the right to*

*preclude third parties from performing any of the following acts in Kenya:-*

*(a) reproducing the industrial design in the manufacture of a product;*

*(b) importing, offering for sale and selling a product reproducing the protected industrial design;  
or*

*(c) stocking of such a product for the purposes of offering it for sale or selling it.”*

The Defendant in its Replying Affidavit states that it has done none of those things or in the words of the submissions the allegations are “*Seriously disputed*”.

36. Guidance on how the Court should deal with applications for interim injunctions starts with the celebrated case of **Giella vs. Cassman Brown 1973 EACA 358, and the speech of Spry VC at 360 D-E**. These well accepted principles were set out by the Court of Appeal established that the Court has to consider the following questions before granting injunctive relief: (i) is there a prima facie case with a probability of success? (ii) does the applicant stand to suffer irreparable harm, if relief is denied? (iii) on which side does the balance of convenience lie? The Court of Appeal also referred to earlier cases as follows:

1. “I will begin by stating briefly the law as I understand it. First, the granting of an interim injunction is an exercise of judicial discretion and an appellate Court will not interfere unless it be shown that the discretion has not been exercised Judicially (**Sargent V. Patel, 16 E.A.C.A.63**).

2. The conditions for the grant of an interlocutory injunction are now, I think, well settled in East Africa. First, an applicant must show a prima facie case with a probability of success. Secondly, an interlocutory injunction will not normally be granted unless the applicant might otherwise suffer irreparable injury, which would not adequately be compensated by an award of damages. Thirdly, if the Court is in doubt, it will decide an application on the balance of convenience (**E.A. Industries v. Trufoods, (1972) E.A. 420**).

37. The question then arises, has the Plaintiff demonstrated a prima facie case that the Defendant has breached its Industrial Design. Analysing the Plaintiff’s allegations against the Act would be a necessary step. The Plaintiff alleges that the “*sometime in September 2014, the Defendant/Respondent pointed or caused to be painted in red, the footbridge. Red is a distinctive colour for the Defendant’s corporate identity. Although the Defendant does not expressly deny that statement, it admits that It does advertise on the footbridge. The Plaintiff goes on to assert that*” those acts constitute an advertisement which assumes the shape and configuration of the Plaintiff’s design.

38. The Exhibits attached to the Notice of Motion and Supporting Affidavit relate to Virgin Airlines there is no evidence that there is a connection between that entity and the Defendant which seems to be a supplier of various beauty products.

39. It is clear from the Certificate of Registration that the Plaintiff is the Registered owner of Industrial Design No. 752. That question is not within the preview of the Court and therefore raising it as an issue for determination is wrong in law and inappropriate. In any event the Defendant does not deny registration. The Registration relates to outdoor advertising. Again that is recorded on the Certificate. Once that position is clear the Act sets out again clearly the acts that third parties are prohibited from performing.

These are:

(a) Reproducing the industrial design in the manufacture of a product.(emphasis added).

(b) Importing, offering for sale and selling a product reproducing the design and a

(c) Stocking a product

The Defendant is adamant that it has done none of those acts. There is no evidence before the court that the Defendant has done any of those acts.

40. The Defendant has adduced evidence, which has not been challenged either in affidavit or submission that its use of the footbridge predates the application for registration on 5<sup>th</sup> November 2013.

The Court takes judicial notice of the fact that Mbagathi way was reconstructed between 2005 and 2007 including the footbridges. Therefore it is including the footbridges. Therefore it is highly probable that the footbridge and its shape and design predates the Plaintiffs design and its Registration by several years.

40. Further the footbridge belongs to either central Government and/or the County of Nairobi and those entities and their predecessors have not only authorized the use of the footbridge for advertising but also raise revenue for such use. It is noteworthy that the Plaintiff has not joined those two entities nor the Agent as a party to these proceedings.

41. The Plaintiff also refers to **Section 84** of the Act but quotes it selectively. What **Section 84** actually says is;

*“84(1) for the purposes of this Part, “an industrial design” means any composition of lines or colours or any three dimensional form whether or not associated with lines or colours”.*

And more importantly

*“Provided that such composition or form gives a special appearance to a product of industry or handicraft and can serve as a pattern for a product of industry or handicraft”*

42. The Plaintiff’s application has failed to produce any evidence or even description of a product of industry or handicraft produced by the Defendant. It is clear that the Defendant, from its own evidence used something called “*a flexi*” to cover the footbridge with an advertisement. That does not fall within the description of manufacture of a product. Therefore the Plaintiff has failed to demonstrate a prima facie case that there has been or will be infringement of the Plaintiffs design.

43. Notwithstanding, the weaknesses in the Plaintiffs evidence at this stage, I go on to consider whether there is irreparable loss that has been or could be occasioned to the Plaintiff has not pointed to any irreparable loss that will occur he says that the infringement is deliberate and male fides and will damage the Plaintiff’s goodwill. It is also said it will encourage infringement by others.

Firstly there is no evidence of the Plaintiff’s goodwill or other infringement before the Court. Secondly the Plaintiff describes himself as a businessman. The intended use of his design is for advertising. Further the Plaintiff himself has quantified his alleged loss at Kshs.1,000,000/- per month. Thirdly Andrews Investment has provided a quantum for hiring the Advertising spots that already exist. Therefore it is clear that the plaintiff wishes to exploit a business opportunity and damages are an adequate remedy.

44. As to the merits of the design and registration and the merits of the Defence, those are not appropriate enquiries at this stage and are matters for trial when the parties have had an opportunity to put their cases more fully.

45. For the reasons set out above the Plaintiffs Application is dismissed with costs to the Defendant. That order is justified because costs follow the event.

**Order accordingly.**

**FARAH S. AMIN**

**JUDGE**

Dated 30<sup>th</sup> day of March 2016.

Signed and Delivered on 28<sup>th</sup> day of April **2016**.

Coram

Hon. Lady Justice F. Amin J

In the presence of:

Phoebe Suda Court Clerk