REPUBLIC OF KENYA

IN THE HIGH COURT OF KENYA AT NAIROBI

MILIMANI COMMERCIAL & ADMIRALTY DIVISION

CIVIL CASE NO. 46 OF 2011

STRATEGIC INDUSTRIES LTD. ……..……..…..……. PLAINTIFF

VERSUS

REBECCA FASHION (KENYA) LTD. …….... DEFENDANT

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R U L I N G

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1. On the 13 September 2012, the firm of Henia Anzala & Associates, advocates, filed a Notice of Change coming on record as acting for the Defendant herein. On the same day, the said firm filed an Application before court by way of Notice of Motion in which it detailed that counsel for the Plaintiff/Applicant would move the court to strike out the Plaint dated 14th February 2011 and to dismiss the suit. I presume that this was a genuine error and that the said firm of advocates is acting for the Defendant. In any event, the Application was grounded firstly because the Plaintiff's Application for a temporary injunction in this matter was dismissed on 1 September 2011 and secondly because the Defendant is neither infringing the Plaintiff's trademark nor passing it off as claimed in the Plaint. The Defendant maintained that in the court's Ruling dismissing the injunction application, it had held that the two trademarks used severally by the Plaintiff and the Defendant were not similar and could be distinguished. It was noted that the said Notice of Motion was brought under the general provisions being **sections 3 and 3A** of the *Civil Procedure Act* as well as **Order 2 rule 15 (1) (a)** of the *Civil Procedure Rules, 2010*.

2. The Plaintiff responded to the Application by filing a Replying Affidavit sworn by the director and General Manager of the Plaintiff Company one **Mahmoud Saffideen** dated 4th October 2012. In his said affidavit, the deponent stated that the Plaintiff is a manufacturer of hair pieces and related products and has been the registered proprietor of the **"Afro Kinky"** brand of goods. The Trademark is in respect of hair additions and attachment hair pieces and braids, eye pins, needles and artificial fichers registered under trademark numbers 52 and 32. The deponent maintained that the Defendant, in total disregard of the Plaintiff's proprietary rights granted by virtue of the trademark registration, was importing, manufacturing, distributing and/or selling hair additions, hair pieces, weaves and wigs bearing the names **"Afro B"** which he said was phonetically and deceptively similar to the Plaintiff's goods covered by the trademark **"Afro Kinky"**. The remainder of the Replying Affidavit concentrated on bringing to the attention of the court the similarity between the Plaintiff's products and those of the Defendant's. The Plaintiff accused the Defendant of attempting to create unnecessary competition in the market through any means, with the express intention of driving the Plaintiff out of business by the selling, importing, offering for sale etcetera, products similar to those of the Plaintiff.

3. Mr. Anzala, learned counsel for the Defendant, submitted before court on 27th November 2012, that the main basis of the prayer in the Application was the Ruling of this court delivered on 1st September 2011. It was the Defendant's contention that the issues raised in the Plaint were and have been fully determined by the findings made in that Ruling. Counsel was of the opinion that to take the matter to full hearing would be a waste of the court's time. The issues that have been raised in the Replying Affidavit had been fully covered in the said Ruling of the court. In turn, counsel for the Plaintiff noted that it was the proprietor of the Trade Mark in question being Nos. 52 and 32. It was the Plaintiff's suit that the Defendant infringed and continues to infringe the Plaintiff's registered trademark. The court in its said Ruling of 1st September 2011 had addressed an application for a temporary injunction not a permanent one and it was for that reason that it was the Plaintiff's contention that this matter should come for full hearing.

4. The heading to the said Notice of Motion details that it is brought under **sections 3 and 3A** of the *Civil Procedure Act* as well as **Order 2 Rule 15 (1) (a)** of the *Civil Procedure Rules, 2010*. Those sections of the Civil Procedure Act give the court power to make orders under its inherent jurisdiction. However, **Order 2 rule 15 (1)** reads:

"At any stage of the proceedings the court may order to be struck out or amended any pleadings on the ground that –

(a) it discloses no reasonable cause of action or defence in law;"

From what I gather from the Defendant's submissions, what this court is being called upon to decide is whether Lady Justice Mugo (as she then was), in her Ruling dated 1 September 2011 in respect of the Plaintiff's Application dated 14 February 2011, made findings on all the points raised in the Plaint herein so that there is nothing further to be tried. If I find that to be the case then the provisions of **Order 2 rule 15 (1)** would come into play to the extent that the pleadings of the Plaintiff, the Plaint may be ordered to be struck out on the grounds that it discloses no reasonable cause of action as against the Defendant.

5. As set out in the said Ruling, the Plaintiff's Application dated 14 February 2011 sought orders from the court to restrain the

Defendant**:**

"either by itself, its directors, employees, agents and/or servants from: –

a. Infringing Trade Mark AFRO KINKY Nos. 52832 in class 26

b. Importing, manufacturing, distributing, supplying, stocking, offering for sale, selling or by way of trade exposing products bearing the name AFRO B or any other mark, name or designation bearing a close resemblance thereto.

c. Importing, manufacturing, distributing, supplying, stocking, offering for sale, selling or by way of trade exposing hair products bearing the name AFRO B or any other mark, name or destination bearing a close resemblance thereto.

d. Passing off any of its goods as the goods of the Plaintiff and particularly but not limited to any hair additions and attachments, hair pieces and braids, weaves and wigs."

In that regard, Lady Justice Mugo in her said Ruling at page 7 detailed the quite distinct and distinguishing features as between the Plaintiff's product and the Defendant's product which I have no need to repeat here. However the Judge noted that:

"other distinguishing features are that the Applicant's product is shown to be manufactured by Strategic Industries Ltd (the Applicant) of P. O. Box 30682, 00100 NBI (GPO) KENYA with own Email address and Website while the Respondent's package clearly shows that the product is made

in China and has the Style Icon Trade Mark (other than AFRO-B) printed all over the larger portion of the packaging. In the opinion of this court the two marks and names are quite distinctive and easily distinguishable. They are not in my considered opinion capable of causing or likely to cause confusion or to deceive customers that they are one and the same, from the same source or origin, or indeed that the product sold under STYLE ICON Trade Mark bearing the style "AFRO-B" is related to the Applicant's by Trade Mark or otherwise. I see no evidence of passing off in the circumstances." (Underlining mine).

6. The prayers as contained in the Plaint dated 14 February 2011 seek orders as follows:

"(a) A declaration that the Defendant has infringed and/or passed off the Plaintiff's trademark known as 'AFRO KINKY' No. 52832.

a. A permanent injunction restraining the Defendant whether by itself, its directors, employees, agents and/or servants, or anybody or entity whatsoever deriving authority under it, from importing, manufacturing, distributing, supplying, stocking and/or selling any product which is phonetically similar in pronunciation to the Plaintiff's trademark, 'AFRO KINKY'.

b. Same marks or word combination or other marks similar or closely similar to the Plaintiff's said products.

c. Damages for infringement and/or passing off.

d. Delivery up to the Plaintiff by the Defendant of all hair additions, her pieces and braids, weaves and wigs bearing the infringing marks with all their packets for destruction at the Defendant's cost.

e. Costs of this suit.

To my mind and as above, I am of the opinion that Lady Justice Mugo has covered all these points/prayers in her said Ruling dated 1st September 2011. The only prayer not dealt with was the question of the costs of the suit, although the Judge did award to the Defendant the costs of the said Application dated 14 February 2011. The **Giella versus Cassman Brown** principles apply equally to temporary or interlocutory injunctions as they do to permanent injunctions. Lady Justice Mugo found in her Ruling that no *prima facie* case had been made out by the Plaintiff as against the Defendant either as regards infringement of trademark or passing-off. I do not see what is left on the part of the Plaintiff to try. Consequently, I allow the Defendant's Notice of Motion dated 11 September 2012 and dismiss the Plaintiff's suit as against the Defendant by striking out the Plaint herein. The Defendant will have the costs of this Application as well as those of the dismissed suit. Order accordingly.

DATED and delivered at Nairobi this 23rd day of January 2013.

J. B. HAVELOCK
JUDGE