



REPUBLIC OF KENYA
IN THE HIGH COURT OF KENYA
AT NAIROBI
COMMERCIAL & TAX DIVISION – MILIMANI
CIVIL SUIT NO. 823 OF 2010

**PATSTIFICO LUGI GAROFALO S.P.A.....PLAINTIFF/
APPLICANT**

VERSUS

**DEBENHAM & FEAR LIMITED.....DEFENDANT/
RESPONDENT**

RULING

The application before the court is brought by a chamber summons dated 2nd December, 2010, and taken out under Section 7 of the Trade Mark Act; Sections 3A and 63 (b), (c) and (e) of the Civil Procedure Act; and Order XXXIX Rules 1, 2A (1), 3, 7 and 9 of the Civil Procedure Rules, and all other enabling provisions of the law. The applicant thereby prays for orders that –

(1) The defendant/respondent whether by itself, its employees, servants or agents or by any other person appearing to be in charge or in control of the respondent's premises located along Baba Dogo road, Nairobi, Kenya, be restrained from importing, making, selling, offering for sale, exporting, removing from jurisdiction, distributing or otherwise parting with possession, power, custody or control or destroying or defacing or hiding in any other manner whatsoever dealing with pasta emblazoned with and bearing the mark "SANTA MARIA" herein after "SANTA MARIA" any material used or intended for the preparation of "SANTA MARIA" pasta.

(2) The defendant/respondent be similarly restrained from doing any of the above acts pending the hearing and determination of this suit.

(3) The defendant/respondent do permit the applicants licensee, servants, and or agents or the person serving the orders granted herein together with such other persons being not more than four as may be duly authorized by the applicant's Advocates to enter forthwith upon the respondents premises at Baba Dogo road and any of its ware houses at any time between 0800 hrs and 1700 hrs for the purpose of looking for, inspecting, photographing recording or otherwise and removing in to the custody of the plaintiff applicant's Advocates or in to the custody of the

court or Kenya Revenue Authority or Kenya Anti counterfeit Agency or such other body as the court may appoint –

- (a) Goods infringing the applicants in “SANTA LUCIA” trade mark and passing of “as belonging to the applicant and more particularly pasta products bearing the marks “SANTA MARIA” herein after referred to as “the infringing goods”**
- (b) All labels, sachets, packs, covering and distinguishing guises used on the infringing goods.**
- (c) Written and printed documents or items that have been emblazoned in the way that confusingly resembles the “SANTA LUCIA” trade mark.**
- (d) All inventories, correspondences with supplies and retailers, receipts and invoices showing orders and payments for and any other documentation relating to the respondents transactions with the infringing goods.**
- (4) The respondent do permit the applicant’s servants or the person serving the orders granted herein together with such other persons not being more than four from Kenya Revenue Authority or Kenya Anti Counterfeit Agency or such other body as may be authorized by the applicants Advocates to carry out such search and on request to open for such purposes any gates, doors, cupboards etc. or other storage facilities as requested.**
- (5) The respondent do forthwith disclose to the applicants licensee or servants or Kenya Revenue Authority or Kenya Anti counterfeit Agency the identity of all premises and their addresses in which any of the infringing goods are or have been stored.**
- (6) The respondents through its Directors do within 24 hours from the time the respondent is served with the orders herein swear an affidavit stating the whereabouts of the infringing goods or what has happened to the same and forthwith served such affidavit upon the applicant’s Advocate before expiry of the said 24 hours.**
- (7) The respondent do forthwith disclose to the applicant’s licensee or Kenya Revenue Authority or Kenya Anti counterfeit Agency the names and addresses of all persons, companies or firms responsible for supplying or offering to supply to them or to whom within their knowledge have supplied or offered to supply infringing goods with the dates and quantities of each supply or offer of supply and all documents relating to such supply or offer of supply and the names and addresses of all person, firms and companies who are parties of or associated with the respondent or any of them in relations to such supply.**
- (8) The respondent be restrained an injunction be granted restraining them whether directly or indirectly from informing any person, company or firm of the existence of these proceedings otherwise than for the purpose of seeking legal advice from duly appointed Advocates.**
- (9) The respondent do afford to the persons enforcing the orders granted herein all reasonable sanitary services.**

(10) The police station close to the respondent's premises render to the applicant all the necessary assistance to ensure that in effecting the orders herein there will be no threat that will lead to a breach of peace.

(11) The respondents to pay the cost of this application in any event.

The application is supported by the annexed affidavit of Emile Viola and Mohammed Ali and is based on the grounds that –

(a) The applicant is the registered proprietor of the trademark NO. KE/T/1993/040409 (also referred to as trademark No. 040409) consisting of the mark "SANTA LUCIA" and a logo registered in class 30 Schedule III of which is valid and subsisting until the year 2023 (the "SANTA LUCIA" trademark)

(b) The applicant is the registered proprietor of the "SANTA LUCIA" trademark since 18th of March 1993 which trademark has been used on the plaintiff's pasta products (herein also referred to as "SANTA LUCIA" pasta) to differentiate its goods.

(c) The applicant has been supplying and selling in Kenya, pasta products bearing the "SANTA LUCIA" trademark for more than 22 years.

(d) The applicant's goods bearing the "SANTA LUCIA" trademark have acquired immense goodwill and reputation throughout Kenya.

(e) The respondent's goods bearing the "SANTA MARIA" mark have a mark and/or a colour of package and/or configuration and/or general appearance that so nearly resembles the "SANTA LUCIA" trademark as to be likely to deceive or confuse the purchasing public to the extent that the source of the defendant/respondent's goods or services is the same as the source of those offered by the plaintiff/applicant resultantly the defendant/respondent is passing off its goods as those of the plaintiff/applicant.

(f) The respondent is importing, distributing, supplying and selling in Kenya pasta products bearing the mark "SANTA MARIA", the products which have no connection in the course of trade with the plaintiff's/applicant's goods but which bear a confusing similar mark and/or logo and/or colour of package and/or configuration and/or general appearance that so nearly resembles the "SANTA LUCIA" trademark and as a consequence constitute an infringement of the plaintiff's/applicant's "SANTA LUCIA" trademark.

(g) The applicant and its appointed sole licensee in Kenya continue to suffer losses due to reduced sales of "SANTA LUCIA" pasta caused by the trademark infringement and "passing off" which have been precipitated by the defendant/respondent.

(h) The applicant and its sole licensee in Kenya continue to lose customers due to confusion created in the minds of the purchasing public as a result of the trademark infringement and passing off as hereinabove enumerated and precipitated by the defendant/respondent.

- (i) **The applicant has extremely strong prima facie case with a strong probability of success against the defendant/respondent and is likely to succeed in the main action.**
- (j) **As a result of the above the applicant stands to suffer serious and irreparable damage to its brand, goods, trademark, goodwill and reputation that is not capable of any monetary compensation.**
- (k) **The respondent has in its possession incriminating documents and there is a possibility that it may destroy the material before the application is heard *inter partes*.**
- (l) **Further, there are grounds for believing that the defendant/respondent has in its possession infringing goods and that if put on notice of the suit herein it is likely to dispose of, hide, deface, remove from jurisdiction, destroy or obliterate any evidence which will permit the plaintiff to establish its claim in damages at the trial of the action making the present application for an immediate and effective measure extremely necessary.**
- (m) **The applicant immediately upon seizure of all the infringing goods shall file an affidavit with 14 days after such seizure wherein the plaintiff/applicant will give details of all the defendant/applicant's items it has taken into custody through its Advocate or sole licensee in Kenya and in that affidavit the plaintiff/applicant's duly authorized official shall give an undertaking that the items seized shall only be used for the proper conduct of this action.**
- (n) **The applicant is ready to give an undertaking as to costs and damages in this matter.**
- (o) **It is just and equitable and necessary that the court grants the applicant an interlocutory injunction in order to prevent any further infringement of the plaintiff/applicant's trademark and abuse of the goodwill or reputation by the defendant/respondent as the harm cannot be measured or compensated in damages.**

In opposition to the application, the respondents filed an affidavit sworn on 15th December, 2010, by Ratilal Dhanji Gudhka, the respondent's Managing Director. With leave of the court, the parties also filed skeleton submissions. When these came for highlighting, however, Mr Ondieki for the applicant did not wish to highlight his submissions. Instead, he replied to the highlighting of the respondent's submissions by Mr Wathuti.

After considering the application, the respective submissions of counsel and the authorities cited therein, I find that the main issue to be determined is whether the applicant is entitled to the injunctions and the Anton Pillar Orders which it had sought against the respondent. The conditions to be satisfied in determining whether an interlocutory injunction ought to issue were articulated by the then Court of Appeal for East Africa in **GIELLA v CASSMAN BROWN & CO. LTD** [1973] EA 358, in which the court said at page 360 –

“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 court, it will decide an application on the balance of convenience.”

For the applicant to succeed in this matter, it is imperative that it satisfies the court that it is the registered proprietor of a trademark; that the said trademark has been breached, either by imitation or otherwise, by

the party against whom the injunctive orders are sought; and that the said party has passed off its own goods as those of the registered proprietor of the trademark. Applying these principles to the facts of this case, the first issue is whether the applicant is the registered proprietor of a trademark in respect of "SANTA LUCIA" pasta. The applicant's case as built up in the plaint and repeated time and again in the application, is that it is the registered proprietor of Kenyan Trade Mark No. KE/T/1993/40409 consisting of the mark "SANTA LUCIA" registered in class 30 Schedule III to the trademark rules made under the Trade Marks Act ... This information is to be found especially in Paragraphs 3, 4,5 and 6 of the Plaint.

The information is also repeated in Paragraphs 3, 4, 5 and 6 of the supporting affidavit sworn by Emile Viola. Paragraphs 4 and 5 of the said affidavit read as follows –

"(4) ...the said registration is and was at all material times valid and subsisting and I annex hereto a copy of the certificate of registration and mark the same as "EV 001".

(5) ... I am also aware of my own knowledge and from the advice and records of the plaintiff/applicant that the applicant is the registered proprietor of the trademark "SANTA LUCIA" under trademarks No. 40409 since the 18th March, 1993 which was later extended on 23rd November, 1999 for a further period of 14 years. I annex herewith the certificate of renewal of a registered trademark and mark it as "EV 002".

Whereas exhibit "EV 002" is annexed to the affidavit in terms of Paragraph 5, there is no exhibit "EV 1" attached to the said affidavit as alleged in Paragraph 4 thereof or at all. Section 22 (2) of the Trade Marks Act states that –

"On registration of a trade mark, the Registrar shall issue to the applicant a certificate in the prescribed form of the registration thereof under the hand and seal of the Registrar."

The effect of the failure by the applicant to exhibit a copy of the certificate of registration implies that the applicant has failed to demonstrate that it is the registered proprietor of the trademark. Regarding Exhibit "EV 002", it is noteworthy that this is a **Certificate of Renewal and not a certificate of registration**. It purports to have been issued on 9th March, 2010, and reads as follows –

"THIS IS TO CERTIFY that Trade Mark No. KE/T/1993/040409 in Class 30 in the name of PASTIFICIO LUCIO GAROFALO S.p.A. of Piazza Sannazzaro 199/c, 80100 Napoli, ITALY has been renewed for a further period of 10 years as from 23rd November, 2013."

If the applicant sought to prove that it owned the trademark "SANTA LUCIA" using this certificate of renewal of trademark, then it is noteworthy that the said certificate is faulty in several ways. In the first instance, it is not issued under the hand and seal of the Registrar as it is only rubber stamped. Secondly, it purports to certify renewal of the trademark "SANTA LUCIA" for a further period of 10 years as from 23rd November, 2013, which is more than 2 years to come. It also offends Rule 64 of the Trade Marks Rules which states that –

"64 (1) At any time not more than ninety days before the expiration of the last registration of a trade mark, any person may leave at the office a fee for the renewal of the registration of the mark in form TM 10, and, if he is not the registered proprietor, shall sign a statement on the form that he is directed by the registered proprietor to pay the fee (if such be the case) and shall give his address."

The law allows renewal of a trademark at least 3 months before expiration and not more than 90 days as demonstrated by the applicant's purported Certificate of Renewal. One would therefore be entitled to question the authenticity of this certificate of renewal, and the bottom line remains that the applicant has not exhibited a certificate of registration of its alleged trademark. For this reason alone, I am doubtful

whether applicant has satisfied the very first condition laid out in **GIELLA'S CASE** for the grant of an interlocutory injunction.

If the applicant had satisfied that condition, the second condition to satisfy would have been that if the interlocutory injunction is not granted as prayed, the applicant might suffer irreparable injury which would not adequately be compensated by an award of damages. The prayers sought in the plaint in this matter are self explanatory. The relevant paragraph reads –

“REASONS WHEREFORE the plaintiff is entitled, pursuant to the provisions of Section 7 of the Trade Marks Act and or under the equitable jurisdiction of this court to...

(g) General damages for “*passing off*” and/or trademark breaches and infringements committed by the defendant.

(h) Alternatively, at the option of the plaintiff, an account of profits made by the defendant as a result of the said “*passing off*” and/or trademark infringement by the defendant and an order for payment of any sums found due.”

The claim for general damages in Paragraph (g) herein above adequately demonstrates that the applicant itself is contented that it can be compensated by an award of damages. In that event, it is not necessary to grant an injunction as damages would suffice to compensate the applicant.

Finally, the third condition is that if the court is in doubt, it will decide an application on a balance of convenience. I have already expressed a doubt as to whether the applicant is truly the registered proprietor of a trademark and my *prima facie* reaction is that there is no evidence to that effect. In the circumstances, if I was in any doubt, I would find that the balance of convenience lies in maintaining the prevailing status quo pending the hearing and determination of the main suit. Where the application fails to qualify for the grant of an interlocutory injunction, it can hardly satisfy the more stringent conditions for the grant of an Anton Pillar Order. This is one such application. The applicant has not satisfied the conditions for the grant of an interlocutory injunction, nor for an Anton Pillar Order.

Being of the above persuasion, I decline to grant the injunctive orders or the Anton Pillar Order which had been sought pending the hearing of this case. The application is accordingly dismissed with costs to the respondent.

It is so ordered.

DATED and DELIVERED at NAIROBI this 14th day of June, 2011.

L NJAGI

JUDGE