



REPUBLIC OF KENYA
IN THE HIGH COURT OF KENYA

AT NAIROBI

COMMERCIAL & TAX DIVISION – MILIMANI

CIVIL CASE NO. 576 OF 2010

OSHO CHEMICAL INDUSTRIES LTD.....APPLICANT

VERSUS

SILVERSTONE MASTERS (S.S.M) LTD.....DEFENDANT

RULING

The application before the court is brought by way of chamber summons dated 18th August, 2010, and taken out under Order XXXIX Rules 2 and 3 of the Civil Procedure Rules; Section 3A of the Civil Procedure Act and all enabling provisions of the law. By the application, the applicant seeks orders that –

1. ... (spent)
2. **The defendant by itself its agents, servants, officers and/or employees be restrained from infringing the plaintiff's trade mark No. 55438.**
3. **The defendant by itself, servants, agents, employees and/or by any other person be restrained from selling, advertising, using, marketing promotions or in any other way trading in the name Ferroxx-No. 1 or any other name resembling the plaintiff's mark Oshoferrox and to cease all and any other activities being carried out under the said name pending hearing and determination of the suit herein.**
4. **The costs of this application be borne by the defendant.**

It is supported by the annexed affidavit sworn on 18th August, 2010, by Kalpesh Parekh, the Operations Director of the plaintiff/applicant Company, and is based on the grounds that –

- (a) **The plaintiff is the registered proprietor of the trademark No. 55438.**

(b) That over the years since introducing its products bearing the mark Oshoferrox in Kenya in the year 2002 the Plaintiff has created goodwill and reputation thereof and its product has come to be associated with the mark.

(c) The respondent has “been introduced products” (sic) bearing the Mark Ferroxx-No.-1 which is so similar or closely resembles the plaintiff’s mark Oshoferrox which is so confusingly similar and is likely to pass off the defendant’s products as those of the plaintiff.

(d) The defendant’s use of the said resembling mark amounts to infringement of the plaintiff’s trademark.

(e) The defendant’s usurpation of the mark is wrongful, illegal, without good faith and made with the singular purpose of deceiving the public.

Oposing the application, the respondent filed a replying affidavit sworn on 23rd November, 2010, by Mahendra K L Shah, the defendant’s Managing Director. The thrust of his deposition in that affidavit is that whereas the registration of the applicant’s trademark refers to a product by the trade name “**Oshoferox**”, the applicant’s suitproduct goes by the name of “**Osho Ferroxx**” which product was neither envisaged nor covered by the registration certificate for trademark No. 55438. In sum, notwithstanding that the registration of the trademark referred to by the applicant in respect of Oshoferox which is one word and spelt with one “**r**”, nevertheless, the applicant’s product was packaged, labelled and marketed as two words “**Osho Ferroxx**” with (two words and double “**r**”) whereas the respondent’s subject product is “**Ferroxx No. 1**”.

With the leave of the court, the parties filed their respective skeleton submissions. After considering the pleadings and those submissions, I note that the plaintiff is truly the registered proprietor in Kenya of the trademark No. 55438. It was registered under Class 1 and consists of the word “**Oshoferox**”. The date of registration was 10th December, 2003, and the registration expires on 10th December, 2013. A copy of the certificate of registration is annexed to the supporting affidavit sworn by Kalpesh Parekh and marked as “MKS 2”.

It is also the applicant’s case that the respondent has copied the former’s registered mark and is selling products closely resembling those of the applicant. The applicant therefore contends that unless the respondent is restrained, it will continue infringing the applicant’s registered mark to the latter’s loss and detriment. For that reason, the applicant seeks in prayer 3 of its application an order that the respondent itself, servants, agents, employees and any other persons be restrained from selling, advertising, using marketing promotion or in any other way trading in the name “**Ferroxx No. 1**” or in any other name resembling the plaintiff’s mark “**Oshoferox**” and to cease all and any other activities being carried out under the said name pending the hearing and determination of this suit.

In the context of the above submissions and observations, it is my considered view that Section 7 (1) of the Trade Marks Act (Cap 506, Laws of Kenya) gives the proprietor of a Trade Mark certain rights. It states that –

“Subject to the provisions of this section... the registration ... of a person in Part A of the register as a proprietor of a trade mark if valid gives to that person the exclusive right to the use of the trade mark in relation to the goods or in connection with the provision of any services and without prejudice to the generality of the foregoing that right is infringed by any person who, not being the proprietor of the Trade Mark or a registered user thereof using by way of permitted use, uses a mark identical with or so nearly resembling it as to be likely to deceive or cause confusion in the course of trade or in connection with the provisions of any services in respect of which it is registered, and in such manner as to render the use of the mark likely to –

(a) **be taken either as being used as a Trade Mark;**

(b) **be taken in a case in which the use is upon the goods or in physical relation thereto or in advertising circular or other advertisement issued to the public, as importing a reference to some person having the right either as proprietor or as registered user to use the trade mark or goods with which such a person is connected in the cause of trade...**

From this Section, it is patently clear that the registration of a Trade Mark confers on the registered proprietor the exclusive right to the use of that mark in connection with the goods in respect of which it is registered. The right to exclusive user is deemed to be infringed by any person who uses a mark which is either identical with or so nearly resembling the registered mark as to be likely to deceive or cause confusion in the cause of trade to the extent that unsuspecting members of the public might mistake the goods of one manufacturer for those of the other. In the instant case, the applicants registered trade mark bears the word **“Oshoferox”**. The respondent contends that its own mark is **“Ferrox No. 1”** and that the latter does not breach the applicant’s right to the use of the word **“Oshoferox”**. One of the reasons advanced for that view is that the applicant has tended to use **“Osho Ferrox”** which are two words instead of the word **“Oshoferox”** which is one word. Secondly, the applicant’s trade mark bears only one **“r”** whereas the respondent mark bears double **“r”**.

From these arguments, I find that the respondent’s contention amounts to nothing more than splitting hairs. Whether **“Oshoferox”** is spelt as one word, or split into two words as **“Osho Ferrox”**, and whether it is spelt with single **“r”** or double **“r”**, to all intents and purposes, it stands for one and the same thing. It is to be observed in Section 7 (1) (supra) that a trade mark is breached when another person uses a mark either identical with or so nearly resembling it as to be likely to deceive or cause confusion in the cause of trade (emphasis added). What we have here is not the use of a mark which is **“identical with”** the applicant’s registered mark. However, the use of the word **“Ferrox”** in the respondent’s mark introduces a business name which so nearly resembles the applicant’s mark as to be likely to deceive or cause confusion in the cause of trade. As stated by Fletcher Moulton, in Reports of patent, design, trade mark and other cases, Vol LXVIII at page 106 –

“The likelihood of confusion or deception in such cases is not disproved by placing the two marks side by side and demonstrating how small is the chance of error in any customer who places his order for goods with both the marks clearly before him, for orders are not placed, or are often not placed, under such conditions. It is more useful to observe that in most persons the eye is not an accurate recorder of visual detail, and that marks are remembered rather by general impressions or by some significant detail than by any photographic recollection of the whole.”

By reason of the foregoing, and seeing that there are some similarities between the applicant’s registered trade mark and the mark used by the respondent, I am satisfied that the applicant has established a *prima facie* case with regard to the infringement of its trade mark with the probability of success. Secondly, since the applicant may not know the extent to which it might have suffered because of the respondent’s user of a name substantially resembling its own, I find that damages may not be an adequate remedy for it. The main conditions for the grant of an interlocutory injunction as enunciated in **GIELLA v CASSMAN BROWN** [1973] EA 358 have been satisfied.

I accordingly grant an interim order of injunction in terms of prayer 3 of the application by chamber summons dated 18th August, 2010. The applicant will give an undertaking as to damages within 10 days from today.

Costs in the cause.

DATED and DELIVERED at NAIROBI this 28th day of July, 2011.

L. NJAGI
JUDGE