



REPUBLIC OF KENYA

IN THE HIGH COURT OF KENYA

AT NAIROBI

COMMERCIAL & TAX DIVISION

CIVIL SUIT NO. 46 OF 2011

STRATEGIC INDUSTRIES LTD.....PLAINTIFF

VERSUS

REBECCA FASHIONS (K) LTD.....DEFENDANT

RULING

The Applicant in the Notice of Motion dated 14th February 2011, seeks orders of this court to restrain the Respondent either by itself, its directors, employees agents and/or servants from:-

- a. **Infringing the Applicant's 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 designation 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.

The Applicant prays also that the Applicant be ordered to allow the Applicant access the Respondent's business premises to take inventory of the offensive products bearing the name "AFRO B" and to take and preserve at its premises (until the hearing and determination of the suit) such samples as may be deemed necessary to be removed from the Respondent's premises.

The application is premised on the grounds that:

1. The Applicant is the proprietor of the Trade Mark "AFRO KINKY" 52832 registered in class 26 under the **Trade Marks Act** (Cap 506 of the Laws of Kenya).
2. The respondent, is importing, manufacturing in complete disregard of the Applicants rights under the said Trade Mark, and selling in the same market as the Applicant, products which are phonetically similar in pronunciation to the Applicant's goods covered by the Trade Mark "AFRO KINKY"
3. The Respondent is infringing the Applicant's Trade Mark with a very high likelihood of the Applicant's consumers buying the Respondent's products assuming the same to be those of the Applicant.
4. The Applicant's sales have declined severely as a result of the Respondent's activities.
5. That the Respondent's actions are a threat to the very fabric of the Applicant's business sanctity, creativity, inventions and innovations and that there is a real likelihood of the Applicant incurring irreparable loss as a consequence of losing its market niche, reputation and investment on the subject Trade Mark.

To support the application is the Applicant's Director and General Manager Mahmoud Saffideen's affidavit sworn on 14th February 2011. He depones inter alia, that the Respondent is not only passing off its goods as those of the Applicant but also that, by so doing, the Respondent is compromising and deceiving the Applicant's customers as to the origin of the goods. In addition to exhibiting copies of the Applicant's certificate of registration of the Trade Mark, samples of the respective packaging material used by the parties hereto have been annexed to the Supporting Affidavit for comparison purposes. It is further deponed in the Supporting Affidavit that, from surveys conducted by the Applicant's sales personnel, its sales of its – AFRO KINKY weaves have plummeted as a result of the influx of Respondent's products in the market. The Applicant has cited the following authorities to support its case.

1. **GLAXO GROUP LTD v SYNER-MED PHARMACEUTICALS LTD [2010] e KLR**
2. **PREMIER FOOD INDUSTRIES LIMITED v AL- MAHRA LIMITED [2006] e KLR**
3. **BELLE MAISON LTD v YAYA TOWERS LTD HCCC No. 2225 OF 1992.**

The Application is opposed on the strength of a Replying Affidavit sworn by the Respondent's director, Hongxia Li on 28th February 2011, to which the Applicant responded through a Supplementary Affidavit filed on 8th April 2011. The Respondent refutes the Applicant's claim on the basis that the Applicant does not have any exclusive right to the use of the words "AFRO" and/or AFRO B" stating that the latter is a phrase commonly used in the hair manufacturing industry to describe the afro look hairstyle. Annexed to the Replying Affidavit are 5 samples of packages from different companies bearing the said phrase.

To support the submissions that the Respondent has neither infringed the Applicant's Trade Mark nor passed off its goods as those of the Applicant, the Respondent has cited three authorities as follows:-

1. **UNILEVER PLC v BIDCO OIL INDUSTRIES** [2004] 1 KLR 57
2. **SANITAM SERVICES (E. A.) LTD v RENTOKIL (K) LTD & ANOTHER** [2002] e KLR
3. **SANITAM SERVICES (E. A.) LTD v RENTOKIL (K) LTD & ANOTHER** [2006] e KLR.

The Respondent argues that the suit and the application herein are intended to defeat competition and prays that the application be dismissed and the orders sought be refused.

There is no dispute that the Applicant holds a valid registered Trade Mark and therefore entitled to legal protection as provided under **Section 6** of the **Trade Marks Act**. What is in issue however, is whether, prima facie, the enjoyment of the Applicant's said rights is threatened by the Respondent's trade and/or dealings with the hair products going under the name "AFRO B" in a manner that entitles the Applicant to obtain injunctive orders as sought in the application before me. In other words, has the Applicant established a prima facie case against the Respondent as to the infringement of its said Trade Mark and the passing off of its goods by the Respondent and has she demonstrated irreparable loss (attributable to the Respondent's acts) not capable of compensation by an award in damages? If there is doubt as to the above, does the balance of convenience favour the granting of the restraining orders? Noting that prayer 3 of the application is in the nature of a mandatory injunction, are there special circumstances as would entitle the Applicant to such orders?

I have examined the samples of packaging material exhibited by the Applicant in regard to its manufacture, distribution and sale of its hair products under the Trade Make "AFRO KINKY" and the Respondent's product imported and sold under the name "AFRO B". I find the same to be quite distinct and bearing several distinguishing features as follows:-

APPLICANT'S PRODUCT RESPONDENTS PRODUCT

1. Name/style;	Afro Kinky Bulk	AFRO-B
2. Picture:	One African Face with braided or twisted hair	Two Faces, one African One Asian with straight hair
3. Main colours:	Pink, Yellow Dark Blue and white	Blue white and Black
4. Trade Mark:	Darling ®	Style icon T.M
Colour No.	1/350	2
Slogan:	Hair that lasts longer	The Finest Human Hair For
You	PURE WEAVE	

In addition to the above, 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.

The Applicant’s contention that its sales have dipped as a consequence of the presence of the Respondent’s hair product is not supported by a consumer questionnaire and I do not find the sales figures contained in annexures MS 5 useful in this regard. Even if the same were to be taken as indicators of loss, I am not satisfied that such losses can, prima facie, be attributed to the respondent’s as to support a prima facie case or irreparable loss within the requirements of **GIELLA v CASSMAN BROWN [1973] E. A. 359**.

In the premises I am not persuaded of the merits of the Application and do hereby dismiss the same with costs to the Respondents.

DATED, SIGNED and DELIVERED at NAIROBI this 1ST day of SEPTEMBER, 2011

M. G. MUGO

JUDGE

In the presence of:

Mr. Okelo holding brief for Mr. Onyony For the Applicant
Mr. Anzala For the Respondent