REPUBLIC OF KENYA

HIGH COURT AT NAIROBI (MILIMANI LAW COURTS

Civil Suit 435 of 2011

ANN NJERI MUNGAI KIHIU t/a

CREATIVE FORCE EVENTS ……...……..……...PLAINTIFF

VERSUS

THE STANDARD GROUP LIMITED ……....……..1st DEFENDANT

NJOKI KARUOYA ……..……2nd DEFENDANT

RULING

By a Notice of Motion dated 30th September 2011, the plaintiff prays for orders against both defendants:

1. THAT pending the hearing and determination of this suit, the Defendants be and are hereby restrained by way of an injunction whether by themselves, their officers, servants or agents or any of them or otherwise howsoever from doing the following acts or any or them that is to say:

a) Infringing and/or passing off the Plaintiff's ? Sista 2 Sista' mark together with its get up, concept and design; and

b) Advertising, distributing or marketing or in any manner whatsoever offering for public consumption any events, performances, programs or sessions bearing the name and style of ? Eve Sisters?.

2.THAT the Defendants be and are hereby compelled to deliver up to this Honourable Court or to the Plaintiff for purposes of inspection and/or destruction all infringing goods and articles at the Defendants possession as at a time to be determined by this Honourable Court.

3.THAT this Honourable court do issue any further orders that it may deem just and equitable in the circumstances.

The plaintiff also prays for costs. The motion is expressed to be brought under Order 40 rules 2,3,4 and 8 among other provisions of the Civil Procedure Act and Rules.

The primary grounds of the application, as I understood them, is that the plaintiff is the owner of a mark known as ? Sista 2 Sista ? together with the attendant design and concept since the year 2009. In an affidavit sworn on 30th September 2011 in support, the Plaintiff, who trades as Creative Force Events,

avers that she has lodged an application with Kenya Industrial Property Institute for registration of the mark as particularized by the annexture marked ? AM2?. The mark or concept is a platform where women gather together to share personal experiences, training and so forth or what the plaintiff calls "experiential programmes". The plaintiff avers that she has expended colossal sums of money in advertising, marketing or distributing the program.

She is aggrieved that the defendants have since introduced a similar product/service program under the name ? Eve Sisters? which they have misrepresented to the public by way of (1) a deceptively similar get-up and concept (2) use of the Plaintiff's database of contacts to publicise the event and (3) fraudulently misleading the Plaintiff to believe that the event scheduled for the 1st of October 2011 was for her ? Sist 2 Sista program only to be surprised with the advertisement placed by the Defendants in the Standard Newspaper of the 27th of September 2011) to be of the same quality and source as the programme/service provided by and belonging to the Plaintiff.

The plaintiff thus prays for injunctive relief because she claims she will suffer loss of reputation, sales, goodwill and other irreparable damage through the confusion generated by the defendants and which will mislead or misrepresent to the public that the services of the defendant known as ? Eve Sisters ? are the same as the plaintiff's ? Sista 2 Sista ?.

The motion is contested by the Defendants in grounds of opposition dated 4th October 2011. The defendants also sought to rely on a replying affidavit sworn by Njoki Karuoya, the 2nd defendant, on 10th October 2011 and filed in court on even date. The admission of the affidavit was contested by the plaintiff on the grounds that the defendants having been served with the motion on 30th September 2011, the replying affidavit was filed out of time contrary to Order 51 rule 14 of the Civil Procedure Rules, 2010 which require that such affidavit be filed at least 3 clear days before the hearing.

Of interest, learned counsel for the defendants did not apply to expand the time within which to file the affidavit at the commencement of the hearing. He did so in the course of his reply to the application when the plaintiff sought to lock him out of the cover of the affidavit.

In my considered opinion, Article 159 of the constitution as read together with sections 1A and 1B of the Civil Procedure Act enjoin this court to do justice to the parties. The overriding objective is to do substantial justice without undue regard to technicalities. The upshot is that in the interests of justice I have exercised my discretion to allow the defendants to rely on the replying affidavit of the 2nd defendant sworn and filed on 10th October 2011.

The gist of the grounds of opposition and as buttressed by the said replying affidavit are that the plaintiffs claim is unfounded as the mark she claims is unregistered and what is before the court is a mere "Mentorship Programme". Furthermore, the defendants submitted that the trademark legal regime does not protect ? concepts ?. It was further submitted that the ? get up ? of "Eve Sisters ? and "Sista 2 Sista" is so different that there can be no element of passing off. The defendants also averred that there is no evidence of the monies expended by the plaintiff and that the whole concept of ? Sista 2 Sista ? was a collaborative effort between the plaintiff and the defendants to which the plaintiff can not claim full ownership.

The historical relationship between the parties and why it has gone sour are captured at paragraphs 3 to 15 of the replying affidavit.

Finally, the defendants submitted that the plaintiff's motion does not disclose a *prima facie* case with a probability of success and accordingly should be dismissed with costs.

I have heard the rival arguments and considered the pleadings on record. The matter before the court revolves around whether the defendants have infringed upon the mark of the plaintiff or whether the defendants have been passing off their ? Eve Sisters ? concept or trade name as that of the plaintiff's ? Sista 2 Sista" and whether such infringement has caused and continues to cause damage to the plaintiff

and should be restrained.

Intertwined with those questions would be a consideration of whether the defendants get up is so close to that of the plaintiff as to mislead the public and amount to passing off.

I must observe that at this point of the suit and in interlocutory application, I am not called upon (indeed I am advised against it) to make a finding on those matters which are matters of evidence before the trial court. I must not prejudice the trial court. What I am called upon to do is to establish, from the affidavit evidence, whether the plaintiff has established a *prima facie* case for grant of interlocutory injunction.

The principles for grant of injunctive relief in East Africa were well settled in the decision of **GIELLA VS CASSMAN BROWN & COMPANY** [1973] E.A. 358. Those principles are, first, that the applicant must show a prima facie case with a probability of success; secondly that he stands to suffer irreparable harm not compensable in damages; and thirdly, if in doubt, the court must assess the balance of convenience.

In addition, there is ample authority that an injunction, which is a discretionary remedy, may be denied despite fulfilling some of the conditions above, if the applicant has committed acts or misconducted himself in a manner that would not meet approval of equity.

But even before applying those principles to the present case, it is important to set out the legal parameters of an action in passing off. The plaintiff/applicant concedes that the ? Sista 2 Sista ? mark or trade name has not been registered as a mark though she claims priority to register it and has made an application as per exhibit ? AM2 ?. The true action in this case is one of infringement of a trade name or passing off. Both learned counsel did not cite any legal authorities to court. The general law on actions in passing off may be found in the decision of **RECKITT & COLMAN PRODUCTS LIMITED Vs BORDEN INC AND OTHERS** (1990) 1 WLR 59.

Those principles have been well summarized in the decision of AG RINGERA J (as he then was) in **SUPA BRITE LIMTIED Vs PAKAD ENTERPRISES LIMITED** Nairobi HCCC No 287 of 2001 (unreported) where the learned Judge stated, and I agree entirely;

? As regards the precise rights which are entitled to be protected by a passing off action, it is settled law that it is the goodwill ?.

It is relevant to set out the views on goodwill and get up pronounced in the RECKITT & COLMAN case (Supra).

? The fact that the proprietary right which is protected by the action is the good will rather than in the get up distinguishes the protection afforded by the common law to a trader from that afforded by statute to the registered holder of a trade mark who enjoys a permanent monopoly therein. Good will was defined by Lord Macnaughten in Inland Revenue Commissioners Vs. Muller & Co. ? s Margarine Ltd. (1901) A. C. 217, 223 – 224, as ? the benefit and advantage of the good name, reputation and connection of a business ?. Get-up is the badge of the plaintiff's goodwill, that which associates the goods with the plaintiff in the mind of the public. Any monopoly which a plaintiff may enjoy in get-up will only extend to those parts which are capricious and will not embrace ordinary matters which are in common use.?

It is thus for the plaintiff to prove the resemblance, deception, infringement and the attendant damage. See **AKTIEBOLAGET JONKOPING VS EAST AFRICA MATCH COMPANY LILMITED** [1964] E.A. 62. In a case like the present one it becomes important to adduce evidence of a member of the public to show the confusion in the get up and the passing off. The Honourable Justice Ringera delivered himself thus in the SUPABRITE case (Supra).

? *I am of the opinion that like in the case of personal reputation, evidence of goodwill must, whether at*

interlocutory stage or final hearing of a suit, be offered by members of the public and not the subject of the reputation himself or the trader and his consultant as the case may be ……?

In the present case, I have not seen sufficient evidence of the monies expended by the applicant on the trade name or persuasive evidence by affidavit or otherwise of a member of public on the confusion generated by the two trade names. I would venture to also add that on the face of it the names ? Sista 2 Sista ? and ? Eve Sisters ?, and even the get up seems quite different from a visual and phonetic basis.

What seems clear at this stage is that the plaintiff and defendants had collaborated upto some point in the concept or trade in the name of ? Sista 2 Sista ?. It might as well be that the defendants turn around to use the similar concept in ? Eve Sisters ? is not entirely in good faith but those will be matters of evidence at the trial.

The matter before the court is in a way similar to the contest for the true franchise owner for ? Miss India Worldwide Pageant for Kenya ? in **CONTRACT NETWORK LIMITED & ANOTHER VS DHARMATAN SARAM & 2 OTHERS** Nairobi HCCC 980 of 2000 (unreported) as consolidated with **SHEINA POPAT & 4 OTHERS VS PRETTY GHELANI & ANOTHER** Nairobi HCCC 979 of 2002 (unreported) wherein the learned Judge said;

?*The same franchise is also claimed by the plaintiffs. In those circumstances it is clear to me that the plaintiff's claim that the 2nd & 3rd defendants are passing off their trade name as their own can not be divorced from both parties' claim to the franchise. Now in light of those considerations and in the light of the fact that there is no affidavit evidence from any member of the public being confused by the two pageants …….. I do not think that the plaintiffs have established a prima facie case of passing off with a probability of success ……..?*

Another relevant decision was the contest over the use of the names ? Makini Herbs Clinic ? in **DINAH BHOKE MAKINI T/A MARY RIZIKI VS WILLS WANJALA & 4 OTHERS** Nairobi HCCC 608 of 2004 (unreported).

In all these cases, it was incumbent upon the plaintiff to prove the loss of goodwill or the deception in the get up to lay a *prima facie* case for passing off. In the instant case, and for the reasons given earlier, I am unable to say from the evidence that the plaintiff has established such a *prima facie* case. I also find that in all the circumstances of this case it would be impossible to say that damages would be unavailable or that they would not be an adequate remedy. Even the balance of convenience espoused in the **GIELLA** case (Supra) would tilt in favour of the defendants who have already commenced business (at least with respect to the event held on 1st October 2011 that the plaintiff had sought to injunct *ex-parte* and who would be prejudiced if it were to turn out that no passing off occurred. This is not to say that the plaintiff will not be prejudiced either. As stated earlier, many of those matters will be a question of evidence at the trial court and the less we say at this stage, the better.

In the result, and having found that the plaintiff has not met the threshold for grant of any interlocutory relief, I order that the Plaintiff's Notice of Motion dated 30th September 2011 be and is hereby dismissed with costs to the defendants.

Orders accordingly.

DATED and **DELIVERED** at **NAIROBI** this 14th day of October 2011.

G.K. KIMONDO
JUDGE

Read in open court in presence of

Mr. Nyaribo for Plaintiff

Mr. Echesa Welimo for Bwire for Defendants