



**TRADE MARK ACT**

injunction to restrain alleged  
infringement of a **TRADE MARK**.

**REPUBLIC OF KENYA**

**IN THE HIGH COURT OF KENYA**

**AT MOMBASA (COMMERCIAL REGISTRY)**

**CIVIL CASE NO. 25 OF 2010**

**SOLLATEK ELECTRONIC (K) LTD.....PLAINTIFF**

**=VERSUS=**

**LIFTING EQUIPMENT COMPANY LTD.....DEFENDANT**

**RULING**

The plaintiff is the registered proprietor of Trade Mark No. 44388 which was registered on **4<sup>th</sup> June, 1996** in class 9 (schedule III) in respect of Electrical Equipment, Apparatus, regulators, instrument accessories and parts for such equipment, apparatus, regulators and instruments.

That registration was renewed for a period of 10 years from **4<sup>th</sup> June 2003**. The plaintiff has sold and distributed goods under that trade mark for the last 14 years. Those were electrical components, specifically Automatic Voltage Switchers. The plaintiff has sold or distributed those voltage switchers in boxes and packages bearing a label comprising distinctive get-up and general layout of the name **SOLLATEK** in blue and white outline.

The plaintiff in this suit alleges that the defendant has while the registered trade mark has been subsisting put on Kenyan market Automatic Voltage Switchers in boxes and packages of the same size as those used by the plaintiff. Those merchandize however have not been the plaintiff's merchandize. The packaging of the voltage switchers as pleaded by the plaintiff are identical and coloured identically to the label of the plaintiff's name SOLLATEK.

The plaintiff alleges that the said packaging amounts to infringement of its registered trade mark and it is likely to lead to deception that the defendant's Automatic Voltage Switchers are the plaintiff's Automatic Voltage Switchers. The plaintiff has pleaded further that the said sale of that merchandize by the defendant must have caused the voltage switchers to pass off as the plaintiff's Automatic Voltage Switchers.

The plaintiff prays in its plaint for orders of injunction to restrain the defendant from infringing or passing off and for an order of delivery up for destruction of all marks or labels or colourable imitation. They also

seek for an inquiry as to damages. The plaintiff by its chamber summons dated **26<sup>th</sup> July 2010** seeks interlocutory injunction pending the determination of this suit to restrain the defendant from infringing the plaintiff's registered trade mark or passing off in Kenya Automatic Voltage Switchers and other electrical components not the plaintiff's merchandize as and for Automatic Voltage Switchers and other electrical components of the plaintiff's merchandize by use of the mark label which is identical and colourable of the plaintiffs inform and get-up of the said trade mark.

The parties have relied on their affidavits and authority cited. As I begin to consider the application, I caution myself as per the holding of the case **MBUTHIA -V- JIMBA CREDIT FINANCE CORPORATION & ANOTHER KLR (1988) PAGE 1** where the court of appeal stated thus:

***“The correct approach in dealing with an application for an interlocutory injunction is not to decide the issues fact, but rather to weigh up the relevant strength of each side’s proposition. The lower court judge in this case had gone far beyond his proper duties and made final findings on facts on disputed affidavits.”***

I will begin by saying that the plaintiff deponed in its affidavit in support of its application that it sells and distributes Automatic Voltage Switchers and that the defendant has put into the Kenyan market such voltage switchers packaged in the same size as the plaintiff's and labeled like the packages of the plaintiff's switchers. I have examined the exhibited switchers and their packages of the plaintiff's products and of the defendant's products.

I find that the switchers of the defendant look exactly the same as those sold by the plaintiff under its trade mark. Similarly, the packaging is the same in colour and in words. The exception is only one symbol where on the case of the plaintiff's packaging it is square in white background whilst, the defendant's packaging is round in a white background. Apart from that exception when one looks at the plaintiff's and defendant's switchers and packaging, on a ***prima facie*** basis there is no distinguishable difference that I can see.

The defendant has denied the plaintiff's claim and deponed that the trade mark of **SOLLATEK** is owned by **Wen Zhou Tao Electrical Company Limited**. That company is registered in China. The defendant deponed that when Zhou Tao Electrical Company authorized the defendant's supplier to trade in that trade mark **SOLLATEK**. As correctly argued by the plaintiff if indeed that trade mark is registered in China, it does not oust the plaintiff's trade mark in this country.

Further, the plaintiff submitted that the defendant failed to prove that when Zhou Tao Electrical Company is the registered owner of the trade mark **SOLLATEK**. The argument raised by the defendant was defeated by a ruling annexed to the plaintiff's further affidavit being a ruling of the **Trade Mark Review and Adjudication Board** of the people of the Republic of China dated **26<sup>th</sup> April, 2010**. That ruling ordered the registration in China of the Trade Mark **SOLLATEK** in the name of Zhou Tao to be cancelled.

In my view, on a ***prima facie*** basis, I cannot find anything brought forward by the defendant which can defeat the plaintiff's right given by its registration of the trade mark **SOLLATEK** as provided under section 7 of the Trade Marks Act. In the case; **BEIERSDORF AG -V- EMI RCHEM PRODUCTS LTD HCC MILIMANI NO. 559 OF 2002** with regard to that section it was stated thus:

***“that section means and implies that a proprietor of a trade mark has the exclusive user of the mark and any person who wishes to use it has to do so with the licence from the proprietor”.***

Bearing in mind what is stated in regards to that section, does the plaintiff satisfy the principles of granting an injunction in the case of **Geilla Vs. Cassman Brown & Co. Ltd (1973) E.A.** which principles are:

- ***An applicant must show a prima facie case with a probability of success;***

· *An injunction will not normally be granted unless the applicant might otherwise suffer irreparable injury;*

· *When the court is in doubt it will decide the application on the balance of convenience.*

In my view, considering that on a *prima facie* basis, I have found that the plaintiff has a registered trademark **SOLLATEK** and that the defendant has used similar trade mark of the plaintiff, similar in position and get-up as the plaintiff's products. I find that the injunction application is merited. In my view the damage that the plaintiff will suffer cannot be compensated by an order of payment of money. It may be far too difficult to quantify such damage. Having found that the plaintiff has shown a *prima facie* case with probability of success I entertain no doubt which would prompt me to consider this matter on a balance of convenience.

For the above reason I grant the following orders:

1. *The defendant is hereby restrained by an order of injunction whether acting by itself, its directors, officers, servants, agents or any other persons howsoever; from infringing the plaintiffs' registered TRADE MARK NO. 44388 and/or passing off in Kenya Automatic Voltage Switchers and other electrical components not of the plaintiffs' merchandize as and for Automatic Voltage Switchers and other electrical components of the plaintiffs' merchandize by the use of the mark or label which is identical with and colourable and deceptive imitation of the label of the plaintiff in substantially the form and get-up of the said trade mark comprising the name SOLLATEK in blue and white outline or any other colourable imitation of the plaintiff's mark or label described in t his order.*

2. *The costs of the chamber summons dated 26<sup>th</sup> July, 2010 are awarded to the plaintiff.*

**DATED and DELIVERED at MOMBASA on this 10<sup>th</sup> day of November, 2011.**

**MARY KASANGO**  
**JUDGE**