



REPUBLIC OF KENYA
IN THE HIGH COURT OF KENYA AT NAIROBI
COMMERCIAL AND TAX DIVISION - MILIMANI
CIVIL CASE NO. 284 of 2011 “fast track”

FILMAFRICA (KENYA) LIMITEDPLAINTFF

VERSUS

**DEUTSCHE WELLE
DW AKAMEMIE
ONE FINE DAY FILMS
GINGER INK FILM & TELEVISION EPZ LTDDEFENDANTS**

RULING

This application is brought by a Notice of Motion dated 4th July, 2011 and taken out under Sections 1A, 2B, 3, 3A and 63 of the Civil Procedure Act, and Order 40 Rules 1 and 2 of the Civil Procedure Rules. The Plaintiff/ Applicant thereby seeks from this court the following orders-

1. ***THAT this application be certified as urgent.***
2. ***THAT the service of this application be dispensed with in the first instance.***
3. ***THAT pending the hearing and final determination of this application, a temporary injunction do issue to restrain the 1st, 2nd, 3rd and 4th defendants whether acting by themselves, their directors, their officers, their servants, their agents or any of them or otherwise howsoever from passing off or causing, enabling or assisting any other party to pass off the film training and the film workshop planned for 4th July, 2011 to 15th July, 2011 as and for a film training and a film workshop, respectively, of the plaintiff by the use of the name ‘FILMAFRICA’ or any other colourable imitation of the name ‘FILMAFRICA’ in Kenya or otherwise howsoever.***
4. ***THAT pending the hearing and final determination of this application, a temporary injunction do issue to restrain the 1st, 2nd, 3rd and 4th defendants whether acting by themselves, their directors, their officers, their servants, their agents or any of them or otherwise howsoever from passing off or causing, enabling or assisting any other party to pass off any film trainings and film workshops as and for film trainings and film workshops of the plaintiff by the use of the name ‘FILMAFRICA’ or any other colourable imitation of the name ‘FILMAFRICA’ in Kenya or otherwise howsoever.***
5. ***THAT the costs of this application be provided for.***

The application is supported by the Annexed Affidavit of Charles Peter Asiba, the Director and the Chief Executive Officer of the Plaintiff Company, and is based on the grounds that -

- (a) ***The plaintiff and the defendants are offering competing services in the film industry in Kenya.***
- (b) ***The plaintiff has acquired goodwill in Kenya’s film sector and trade with the usage of the name***

FILMAFRICA in its business undertakings which involve, inter alia, conducting trainings and workshops for practitioners in the film industry.

(c) The defendants have passed off a film training and a film workshop that they have planned for 4th July 2011 to 15th July, 2011 in Nairobi as and for film training and a film workshop, respectively, of the plaintiff by the use of the name 'FILMAFRICA', a name that is the same as the plaintiff's registered name of FILMAFRICA (KENYA) LIMITED.

(d) The similarity in the plaintiff's trade name of FILMAFRICA (KENYA) LIMITED to the name FILMAFRICA that the Defendants are using is apparent on the face of it, and there is therefore a real probability of confusion in the film industry, necessitating an injunction against the defendants.

(e) The defendants' actions are a deliberate misrepresentation by the defendants of a connection between the defendant' and plaintiff's businesses, resulting in consumer deception or confusion within the Kenyan film industry and its practitioners.

(f) The defendants are also offering to the film industry practitioners the services complained of free-of-charge, an act that the plaintiff cannot compete with, nor replicate now or after the defendants leave the country on or after the 15th of July, 2011

(g) The 1st, 2nd and 3rd defendants are foreign entities whose agents, servants or employees are in Kenya for the said training and workshop, but whose presence in Kenya after 15th July, 2011 is not guaranteed as they are likely to leave shortly thereafter.

(h) The plaintiff has written to the defendants demanding that they cease their passing off, and also for their admission of liability for passing off, but they have recklessly or negligently refused to heed the plaintiff's requests.

(i) The defendants have instead now changed the name of their project to FILMAFRICA, and the website has now been changed and renamed <http://www.filmafrica.org>. This amounts to a colourable imitation of the plaintiff's trade name.

(j) Therefore, unless the orders sought herein are granted, the plaintiff's business, goodwill and reputation will suffer irreparable loss and damage within the film industry in Kenya, hence the urgency of this application.

(k) Unless this Honourable Court intervenes and grants the orders sought, the plaintiff will suffer, and continue to suffer great injustice, and substantial loss will result to the applicant.

(l) The application ought to be granted in the interests of equity and justice.

Opposing to the application, the defendant's filed two replying affidavits. The first one was sworn by Sarika Hemi Lakhani, the managing director of the third defendant, and the second one was sworn by Siobhain Sarah Wilson, a director of the 4th defendant. The two affidavits are quite similar in form and content, and I intend to discuss them together. Their substance is that while the defendants accept having used the word "FilmAfrica", they claim to have been justified since the plaintiff is a registered company which has not exhibited any evidence of its registration of a trade mark "FilmAfrica" or at all. They also contend that the plaintiff's claim to ownership of any intellectual property in the name FilmAfrica or any derivative is not supported by any evidence. They further state that the mere registration of the company name "FILMAFRICA (KENYA) LIMITED" is not sufficient to provide proof of ownership of intellectual property rights in the name "FILMAFRICA" or otherwise. Furthermore, they maintain that the plaintiff has not exhibited any detailed market survey in Kenya or elsewhere, to establish or demonstrate to this court that indeed it has acquired any reputation or goodwill in the name FILMAFRICA in Kenya or otherwise.

At the oral canvassing of the application, Mr. Gitonga appeared for the Plaintiff/Applicant and Mr. Murgor appeared with Mr. Owino for the 3rd and 4th Defendants. After considering the application and the submissions of counsel, I find that the main issue to determine is whether the Applicant has made out a case for the grant of an interlocutory injunction. The conditions to be satisfied for the grant of such an injunction are well laid down in the case of **GIELLA v. CASSMAN BROWN & CO. LTD** [1973] E.A. 358. In that case, **Justice Spry, V.P** of the then Court of Appeal for East Africa observed at page 360-

"The conditions for the grant of an interlocutory injunction are now ... well settled in East Africa. 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 doubt, it will decide an application on the balance of convenience”.

According to the affidavit sworn by Sarika Hemi Lakhani, a director of the third defendant, one Tom Tykwer, a world renowned film Director, together with a Director of the fourth Defendant, mentored and trained up-coming Kenyan film makers in film making resulting in the shooting and production of ‘**Soul Boy**’, a Kenyan film, in November, 2008, which was to become a major success in the international market. As a result, the idea of an initiative aimed at educating, training and mentoring up-coming Africans in the craft of film making was borne, hence, ‘**FilmAfrica**’.

No doubt the idea of an initiative aimed at educating, training and mentoring up-coming Africans in the craft of film making was a novel one. However, it was borne out of a film shot in 2008 which was 2 years after the incorporation of “**FILMAFRICA (KENYA) LIMITED**”. No matter how novel the idea might have been, it was improper to give the initiative a name which was identical with that of a company which was already registered in Kenya. If the Respondents had sought to register their undertaking in Kenya in the name of ‘**FilmAfrica**’ or ‘**FilmInAfrica**’, I don’t think that the Registrar-General would have sanctioned it. **Section 17(1)(d) of the Registration of Business Names Act (Cap. 499 of the Laws of Kenya)**, states in no uncertain terms -

“(I) The Registrar shall refuse to register ... any firm, individual or corporation carrying on, or proposing to carry on business under a business name-

(a) ...

(b) ...

(c) ...

(d) Which is identical with or is similar to that of a business or corporation existing, or is already registered under this Act or under the Companies Act, if in the opinion of the Registrar such registration would be likely to mislead the public;”

Whether the word used by the Respondents is “FilmAfrica” or “FilmInAfrica”, both names are visually and phonetically identical with “FilmAfrica” which is the key word in the business name registered and used by the Applicant. Therefore, “FilmAfrica” or “FilmInAfrica” would not qualify for registration as a business name as long as the Applicant Company subsists as it is likely to mislead the public. It is therefore idle for the Respondents to suggest that the Plaintiff’s name is not registered as a trade mark, and that there is no evidence in support in the Plaintiff’s claim of any intellectual property ownership in the name “FilmAfrica”. It is sufficient that the Applicant company is registered under the Companies Act in the name of “FilmAfrica”, and for any one else to use that name in any business transaction would be an affront to **S. 17(1)(d) of the Business Names Act**.

In the context of this matter, the emphasis here is not on trade marks, or intellectual property, but a business name which is identical with or similar to that of an existing business. I think that anyone who is aware of the existence of the Plaintiff Company would not hesitate to associate and identify the initiative “FilmAfrica” and “FilmInAfrica” with the Plaintiff Company. Although the Respondents denied it, there is bound to be deception and confusion caused by their joint usage of the names “FilmAfrica” and “FilmInAfrica”. For these reasons, I find that the first condition for the grant of an interlocutory injunction has been satisfied.

The second condition to be complied with is that 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. In its final prayer in the plaint, the Applicant prays for judgment against the 1st, 2nd 3rd and 4th Defendants jointly and severally for-

(a) ...

(b) ...

(c) *An account of profits and surpluses and an order for payment of all sums found due together with interest thereon.*

(d) *Damages together with interest thereon.*

These prayers imply that the loss which the Applicant might have suffered or might continue to suffer is not irreparable as it can be quantified and compensated by an award of damages. In other words, by these prayers, the Applicant itself suggests that it would be appeased if it is compensated for the wrong, if any, committed by the Respondent. The effect of the prayers sought by the Applicant in paragraphs (c) and (d) above is to neutralize all the ground which the applicant had made for the award of an injunction. The Applicant has therefore failed to satisfy the 2nd condition. For that reason, it becomes futile to consider the balance of convenience, as I am not in any doubt that by claiming damages, the applicant has forfeited the prospects it had for the grant of an injunction.

By reason and wholly on account of the foregoing, the application for the grant of an interlocutory injunction fails and it is hereby dismissed with costs. The interim injunction granted at the commencement of these proceedings is hereby discharged.

Orders accordingly.

DATED and DELIVERED at NAIROBI this 7th day of December, 2011

**L. NJAGI
JUDGE**