



**Interconsumer Products Limited v Lordix General Supplies Limited (Civil Suit 377 of 2009) [2009] KEHC 2097 (KLR) (Commercial and Tax) (10 July 2009) (Ruling)**

*[2009] eKLR*

Neutral citation: [2009] KEHC 2097 (KLR)

**REPUBLIC OF KENYA  
IN THE HIGH COURT AT NAIROBI (MILIMANI COMMERCIAL COURTS)  
COMMERCIAL AND TAX  
CIVIL SUIT 377 OF 2009**

**MK KOOME, J**

**JULY 10, 2009**

**BETWEEN**

**INTERCONSUMER PRODUCTS LIMITED ..... PLAINTIFF**

**AND**

**LORDIX GENERAL SUPPLIES LIMITED ..... DEFENDANT**

**RULING**

1. The plaintiff/applicant instituted this suit against the defendant/ respondent, on a claim based on the tort of infringing or passing off the plaintiffs 'Bouncy' mark together with its get up as used on 'Bouncy baby diapers', by the defendants in their product called 'Lordix baby diapers'. Simultaneously with the filing of the suit, the applicant filed a chamber summons under order XXXIX r 1,2,3,7 and 9 of the Civil Procedure Rules and section 5 of the Trade Marks Act and other enabling provisions of the law.

The applicant sought inter alia for the following orders that:-

- (a) The infringing and/or passing off the Plaintiffs 'Bouncy' mark together with its get up as used on 'Bouncy baby diapers'.
- (b) Packaging, selling, offering for sale, distributing or marketing or in any manner disposing of baby diapers bearing the 'Lordix' mark or any other name, mark, device or designation bearing a close resemblance thereto and bearing a get-up similar to the Plaintiff's 'Bouncy' diapers;
- (c) Parting with possession, power, custody (other than to the Plaintiff or its agents) of any or in any way altering, defacing or destroying all stock in hand of its 'Lordix baby diapers' or any diapers bearing a get-up similar to the Plaintiff's Bouncy baby diapers the following articles or any of them.



- (d) Parting with possession, power, custody (other than to the plaintiff or its agents) of any or in any way altering, defacing or destroying all documents, files, packaging materials, cartons, printing blocks, bromides, prints, invoices, receipts, articles or equipment relating to the importation, purchase, manufacture, sale, distribution or supply of products particularly but not limited to baby diapers which are distributed, sold or marketed by the defendant under the name 'Lordix' or related in any way to the passing off of the plaintiff's mark.
2. The application is premised on the grounds stipulated on the body thereto, and it is supported by the affidavit of Nick Nyaga the Managing Director of the applicant sworn on 26<sup>th</sup> May 2009, and an affidavit of Lydia Wambui Ndirangu a consumer of the plaintiff's goods, sworn on 26<sup>th</sup> May 2009. According to the applicant, they are engaged in manufacture, sale and distribution of sanitary, cosmetic and baby care products including but not limited to the Bouncy baby diapers'. The applicant is the owner of the mark Bouncy together with the device being the get up of the aforesaid diapers.
  3. The plaintiff commenced trading in the bouncy baby diapers' on or about June 2007. In the course of their business, the applicants also generally deal in cosmetic products and baby care products, from which they have gained reputation in terms of quality and reliability as they manufacture brands including Nice and Lovely, Gold Touch, 'All-time' sanitary pads and bouncy baby diapers'. From June 2007, the applicant started manufacturing and trading in bouncy baby diapers'. In that respect they have expended considerable resources in developing the concepts art works and packaging materials for the bouncy baby diapers' in advertising, promotion, publicity and marketing. Consequently they have acquired substantial reputation and good will in the get-up of the package.
  4. The get up is distinctively recognized by the public and identified with the applicant. It consists of the brand name Bouncy and the labeling and the packing of the goods thus the use of the mark bouncy is understood by the traders and the public to be of the highest quality. The applicants claim that the respondent introduced into the market similar goods with the same get up as that of the plaintiff, retailing under the name 'Lordix baby diapers. The get up of the product is confusingly similar to that of the applicant and therefore likely to deceive the general public. The similarity in the get up of the products are noted as follows:-
    - (i) The products have similar colours throughout the packages save for a minor use of colour blue instead of green in one part of the package.
    - (ii) The font used for the terms 'Lordix' and 'Bouncy' and the terms 'Dry & Soothing'. 'Baby Diapers', 'unisex baby diapers' is the same
    - (iii) The Colours used in the terms 'Lordix' and "Bouncy" are the same.
    - (iv) The diagram on the face of the package of a baby is the same, and
    - (v) The illustrations on the packages are identical in terms of content, format and font style used.
  5. It was argued for the applicant that the respondent has misrepresented to the general public and misled the public to believe that the goods offered by the respondent are those of the applicant. The respondent, if allowed to continue will unjustly profit from the investment of the applicants' concepts development of art work and packaging of the goods, advertising, marketing and promotions of the product. The applicant claims to have spent over Kshs 20 million in that respect.
  6. The respondent's products are of inferior and poorer quality in terms of utility packaging and usage. And due to the confusion caused to the purchasing public, the respondent's goods are likely to injure the reputation of the applicant in the market. The applicant has already received numerous



reports from its loyal customers and distributors regarding the confusion created by the sale of Lordix baby diapers which have been mistaken for the 'bouncy baby diaper'. When the applicant received information regarding the actions of the respondent in passing off its goods, they immediately wrote a complaint to the Kenya Bureau of Standards and other authorities.

7. The applicant had lodged an application for the registration of the trade mark bouncy together with the get up on 8<sup>th</sup> January 2007. They subsequently applied to amend the application and when the matter was published in the journal of Kenya Industrial Property Institute in December 2008, the respondent lodged an opposition which is pending determination by the Registrar of Trade marks. The plaintiff is already registered proprietor of the mark 'bouncy' with the device baby diapers in various jurisdictions in particular the Republic of Uganda and Republic of Malawi. This registration in other countries gives the applicant priority for registration over other applicants in Kenya. Despite notifying the respondent of the infringement of passing off, they have refused to take any action to correct the misrepresentation.
8. This application is also supported by a customer Lydia Wambui Ndirangu who has deponed that she has been a consumer of the applicants' goods in general and in particular bouncy baby diapers having seen them advertised on television and other promotions materials like flyers and calendars. In this regard, sometimes in November 2008, she visited a super market to restock her baby diapers and found that Lordix baby diapers were retailing for approximately Ksh.80/- per pack of 8 while a similar pack of bouncy baby diapers were retailing for Ksh.160/-. After buying the diapers, she realized that she had bought the one with the mark Lordix but since they looked so similar to the bouncy diapers, she assumed Lordix diapers were manufactured and distributed by the same company. It is after the use that she realized the baby was uncomfortable unsettled and on checking the diapers further, she realized it did not retain waste as well as the bouncy diapers and as a result her baby obtained a bad rash on his bottom.
9. Counsel for the applicant further argued that under section 5 of the *Trade Marks Act* the applicant is entitled to file an action against the respondent for passing off goods. He contended that the applicant met the conditions for granting an interim order or injunction. The respondents applied to register the mark but the application was rejected by a letter dated 26<sup>th</sup> March 2009 because the registrar said there existed a similar mark by the applicant. The applicant has applied for the registration of the mark and they have been registered in other jurisdictions. He made reference to the case of Match Master Limited v Rhino Matches Limited [2006] eKLR. In that case the Learned Judge, Kasango J. while relying on the case of Supa Brite Limited VS Pakad Enterprises (2001) 2 EA 563 restated the principles to bring to bear when considering the claim of passing off.
10. The prerequisite to be established by the applicant are; the plaintiff must prove reputation or good will connected with the goods which are known by buyers by distinctive get up or feature. Secondly the defendant either intentionally or not, misrepresented to the public leading them to believe that the defendants' goods are the plaintiffs'. The plaintiff has also suffered damages because of the erroneous believe caused by the defendant's misrepresentation.
11. This application was opposed by the respondent. Counsel for the respondent relied on the replying affidavit of Mary Kihara sworn on 11<sup>th</sup> June. 2009. He submitted that the applicant is not the registered owner of the mark "Bouncy baby diapers'. Therefore, no action for infringement can arise by virtue of section 5 of the Trade Mark Act. The plaintiff made an application on 7<sup>th</sup> January 2007 for the mark 'bouncy'. This application was made under class 5 which does not apply to packaging of diapers but to pharmaceutical, medical, baby foods and other similar items. The applicant also applied to the Kenya Industrial Property Institute (KIPI) for the amendment of the specification. Prior to the making of the



application for amendment, the only application pending was for the registration of the mark 'bouncy' without the get up. The amendments sought to alter this device mark.

12. According to counsel for the respondent, the applicant cannot claim for a device which they only applied for by mere words. Further the documents annexed by the applicant to support the application for registration of the mark is a forgery and therefore the applicant cannot be granted an interim order or injunction. On the other hand, the respondent made an application in November 2008 at the Kenya Industrial Property Institute for a preliminary search for the Lordix baby diapers which was initially approved by a letter dated 19<sup>th</sup> December 2008, the KIPI indicated that the trade mark was available. Under class 16 which includes books binding materials, plastic materials and packaging baby diapers also fall under that category.
13. In the property journal of 31<sup>st</sup> December 2008, the applicant's application for amendment was advertised and it is clear they did not seek the registration of the mark on priority basis although it is registered in Uganda and Malawi. In the applicant's application for registration there was no color specification as provided for under section 19 of the Trade Mark Act. Counsel made reference to the case of Cut Tobacco v BAT where the court of appeal held that there can be no property right in a particular color and there can be no property in general words and description of the goods. Thus one would need evidence to show if the get up in Lordix baby diapers' is likely to deceive diapers' buying public into believing they are buying bouncy baby diapers.
14. The respondent has also opposed the registration of the applicants mark at KIPI, on the grounds that the mark is not distinctive. The applicant should allow due process at KIPI, to determine who should be registered. The respondent further contends that their products are of high quality they were imported from China and certified, after undergoing quality and standard check by Intertreck Testing Services Limited. The respondent is involved in legitimate business that is why they also applied for the registration of the trade mark at KIPI. The respondent submitted that the applicant has no legal rights for exclusive use of the get up in either bouncy or Lordix.
15. The applicant has merely been harassing and intimidating the respondent who has suffered damage, thus the applicant is not entitled to an equitable relief by way of an injunction. The affidavit sworn by the alleged consumer was also faulted by the respondent for lacking in credibility because she was able to recognize the difference between the two items especially because of their costs. Moreover, diapers are used by educated people who can differentiate the words bouncy and Lordix. Although the plaintiff claim to have been selling baby diapers from June 2007 they have not proved to this court whether the get up being used in bouncy, is the one they were using. According to the respondent, the plaintiff has not established a prima facie case with a probability of success as set out in the often cited case of Giella v Cassman Brown Co. Limited.
16. Having set out albeit in summary, the background information and the rival submissions, the issue to determine is whether the applicant is entitled to an interim order of injunction based on this claim of tort of passing off. It is not in dispute that the plaintiff is not the registered owner of the trade mark 'bouncy' with the get up baby diapers. This application is brought under section 5 of the [Trade Marks Act](#) which provides as follows:-

“No person shall be entitled to institute any proceeding to prevent, or to recover damages for, the infringement of an unregistered trade mark, but nothing in this act shall be deemed to affect rights of action against any person for passing off goods”...
17. Based on the above provision of the law, the applicant can institute an action for passing off goods. The other issue to consider is whether the plaintiff has established a prima facie case with a probability



of success. The applicant claims to have a reputation for trading in the bouncy baby diapers since June 2007. The applicants are registered as the owners of the trade mark in Malawi and Uganda. They annexed the certificates of registration in the two jurisdictions where they have been trading with the same product. Here in Kenya, they claim to have expended considerable sums of money in developing the concepts, art works and packaging material for bouncy baby diapers and in advertisement promotion, publicity and marketing thereby acquiring a substantial reputation and good will in the get up of the package which is distinctively associated with the applicant's goods. They have annexed the documents in support of the advertisements and other costs the developing the packaging.

18. The applicants also applied for the registration of trade mark in Kenya way back in January 2007, the process has been going on and when their application was published in the Industrial Property Journal of 31<sup>st</sup> December 2008, the respondent filed a notice of opposition on 24<sup>th</sup> February 2009 on the grounds that the mark is not distinctive as required by section 12 (e) of the Trade Mark Act. The respondent also claims to have acquired a reputation for using the same mark.
19. It is evident from the material before this court that the applicant is the one who started trading with the bouncy baby diapers earlier than the respondent started trading with similar product Lordix baby diapers which is similar to the one of the applicant. This is evidenced by the applicant's registration certificate from Uganda and Malawi as well as various documents they have annexed on advertisements and developments of the product. This is also supported by the applicant's initial application for registration of the trade mark which was made on 2<sup>nd</sup> January 2007. On the part of the respondent it is clear that they came into the market a year later, on or about July 2008, according to the affidavit of Mary Kihara. The respondent started importing their products from China.
20. Are the respondents passing off their goods Lordix baby diapers for bouncy baby diapers? The applicant's application was supported by a customer who claims to have been deceived and actually purchased Lordix baby diapers because of the similarities in the 'color', the 'font' used for the term 'Lordix' and 'bouncy' and terms 'dry' and 'soothing baby diapers unisex baby diapers' are the same. The colors used and the diagram on the face of the baby on the package are the same. The illustration on the packages, are also identical in terms of contents format and fonts style used.
21. During the presentation of this application the applicant demonstrated the two packages. They are also exhibited in the application and I can also note the similarities on annexure NN3, the two products have very striking similarities. These similarities are also acknowledged by the respondent who has filed an objection against the registration of the applicant's mark with KIPi. These similarities are also acknowledged by the public who are the consumers of the bouncy baby diapers and it is confirmed by an affidavit of a customer that they get confused.
22. Going by the above evidence, I am satisfied that an ordinary person is more likely than not, likely to be confused by that striking resemblance and similarity of these two products. I am further persuaded that the applicants' products were in the market earlier; they also made attempts to register the mark in January 2007, whereas the respondent came into the market later, and made products that are strikingly and confusingly similar. Although the issue is for the trial court, on the face of it, I find the two products are more probably than not, causing confusion to the public and perhaps the respondents' products are passing off as those of the applicant.
23. On the issue of damages, the applicant has demonstrated the colossal sums of money they have used in the development and manufacture of the products. On the other hand, the respondent's claim that they have been importing their products from China. Thus the applicant will suffer substantial



loss unless the interim order is granted. It is easier to stop an importation of products than to stop manufacturing of a product.

24. On the balance of convenience, the applicant has demonstrated it has invested highly to develop and manufacture the product while the respondent has imported its products from China. When one has to stop production, it goes without saying that the costs are higher than when one has to order products from China. On this basis, I am satisfied that the applicant should be granted order No.3 as prayed in the Chamber Summons dated 26<sup>th</sup> May 2009.
25. The applicant is also ordered to issue an appropriate undertaking to compensate the respondent for damages and file it in court within 7 days of this order.

Costs of this application will be in the cause.

**RULING READ AND SIGNED AT NAIROBI THIS 10<sup>TH</sup> DAY OF JULY 2009.**

**M.K. KOOME**

**JUDGE**

