



REPUBLIC OF KENYA
IN THE HIGH COURT OF KENYA
AT NAIROBI (MILIMANI COMMERCIAL COURTS)

Civil Case 468 of 2005

TRIUMPH DEVELOPMENT LIMITED.....
.....PLAINTIFF

V E R S U S

GOLDEN BISCUITS (1985) LIMITED.....
DEFENDANT

JAMBO BISCUITS (K) LIMITED
.....APPLICANT

R U L I N G

There has been considerable delay in the preparation and delivery of this ruling. The same was occasioned by my serious illness in 2006 and the long attendant recuperation. The delay is regretted.

The Applicant herein, JAMBO BISCUITS (K) LIMITED, has applied by notice of motion dated 26th June, 2006 for leave to be joined in this suit as the 2nd Plaintiff. The application is based upon the grounds:-

- (1) That the Plaintiff is a wholly-owned subsidiary of the Applicant, and that the Applicant is the one that actually uses trade marks Nos. 54918 (“**BRITANIA DOT.COM**”) and 56832 (“**DOT.CREAM**”), the subject-matter of this suit.
- (2) That the infringement of the trade marks complained of affects the Applicant’s sales as the user of the trade marks, and the Applicant therefore suffers loss and damage.
- (3) That the Applicant is already registered as a licensee of the two trade marks, and is therefore legally entitled to fight any infringement of the trade marks.
- (4) That the Applicant has a cause of action against the Defendant in respect of the two trade marks with issues of fact and law similar to those raised by the Plaintiff.
- (5) That the order sought will not prejudice the Defendant in any way.

It is stated that the application is brought under Order I, rule 1 and Order 50, rule 1 of the Civil Procedure Rules (the Rules). Section 31 (3) of the Trade Marks Act is also cited. The application is supported by the affidavit of one NITIN P. DAWDA, the managing director of the Applicant. I have read the same.

The Defendant has opposed the application as set out in the grounds of opposition dated 19th July, 2006. Those grounds are:-

1. That Order I, rule 1 of the Rules does not confer any jurisdiction on the court to join an additional party to an existing suit, which jurisdiction is contained in rule 10 of the same Order.
2. That the said rule 10 does not permit an application by a person who is not already a party to the suit.
3. That no useful purpose will be served by joining the Applicant as a plaintiff in the suit unless the plaint is amended to disclose the Applicant's cause of action, yet no draft amended plaint has been annexed.
4. That in any case the Applicant's claimed cause of action appears to have accrued after the present suit had been filed.
5. That the registered user of a trademark has no right to sue unless the proprietor of the trademark has refused to do so.

There is no replying affidavit; the grounds of opposition raise points of law.

I have considered the submissions of the learned counsels appearing, including the text and the section of the Trade Marks Act cited. Indeed the power of the court to add a party to a suit is donated by rule 10, not by rule 1, of Order I; rule 1 merely prescribes who may be joined in one suit as plaintiffs. Rule 10 (1) and (2) on the other hand provide:-

“10. (1) Where the suit has been instituted in the name of the wrong person as plaintiff, or where it is doubtful whether it has been instituted in the name of the right plaintiff, the court may at any stage of the suit, if satisfied that the suit has been instituted through a bona fide mistake, and that it is necessary for the determination of the real matter in dispute to do so, order any other person to be substituted or added as plaintiff upon such terms as the court thinks fit.

(2) The court may at any stage of the proceedings, either upon or without the application of either party, and on such terms as may appear to the court to be just, order that the name of any party improperly joined, whether as plaintiff or defendant, be struck out, and that the name of any person who ought to have been joined, whether as plaintiff or defendant, or whose presence before the court may be necessary in order to enable the court effectually and completely to adjudicate upon and settle all questions involved in the suit, be added.”

The Applicant's learned counsel was thus wrong to insist that the application was brought under rule 1, and not under rule 10, of Order I. But in the interests of justice I shall proceed upon the basis that the application is brought under rule 10 of Order I.

It was submitted for the Defendant that an application such as the one now before the court can only be made by a person who is already a party in the suit. I do not, with respect, subscribe to that view. The wording of sub-rules (1) and (2) of rule 10 does not preclude any interested person from applying to be joined as a plaintiff. Regarding amendment of the plaint, in exercising its discretion under rule 10 of Order I, the court will impose such terms as it may think fit, including an order for amendment of the plaint.

Regarding the submission that the Applicant's claimed cause of action appears to have accrued after the suit had been filed, that is a defence that is available to the Defendant if the Applicant is joined as a plaintiff. It need not prevent it from being joined in the proceedings as no prejudice will have been occasioned to the Defendant.

The last point taken by the Defendant is that the registered user of a trade mark has no right to sue unless the proprietor of the trade mark has refused to do so. Section 31 (3) of the Trade Marks Act, Cap. 506 provides:-

“Subject to any agreement subsisting between the parties, a registered user of a trade mark shall be entitled to call upon the proprietor thereof to take proceedings to prevent infringement thereof, and, if the proprietor refuses or neglects to do so within two months after being so called upon, the registered user may institute proceedings for infringement in his own name, as if he were the proprietor, making the proprietor a defendant; and a proprietor so added as defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings.”

It appears from the language of this sub-section that the proprietor of the trade mark has exclusive right to bring legal proceedings for protection of the trade mark against infringement. A registered user acquires the right to sue only if the proprietor refuses or neglects to act within two months after being called upon by the registered user to do so. A registered user who thus institutes proceedings must then add the proprietor as a defendant in the proceedings.

In the present application the Applicant, who says it is a registered user, has not claimed that it has called upon the proprietor of the subject trade marks to sue and that the proprietor has refused or neglected to do so; indeed the Applicant cannot make such a claim as the present suit was instituted by the proprietor to protect the trade marks against infringement. So, the Applicant’s right, as a registered user, to sue has not accrued, and it is not entitled to sue. For this reason alone, I must decline its application to be joined in this suit as the 2nd Plaintiff.

In the event, the application by notice of motion dated 26th June, 2006 is hereby dismissed with costs to the Defendant. There will be an order accordingly.

DATED AT NAIROBI THIS 29TH DAY OF AUGUST, 2007

H. P. G. WAWERU

J U D G E

DELIVERED THIS 31st DAY OF AUGUST, 2007