



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

Civil Case 377 of 2007

MATHEW ASHERS OCHIENGPLAINTIFF

VERSUS

KENYA OIL COMPANY LIMITED.....1ST DEFENDANT

KOBIL PETROLEUM LIMITED2ND DEFENDANT

RULING

This is an application dated 26th day of July 2007 under Order 39 Rule 2 of the Civil Procedure Rules and Section 3A of the Civil Procedure Act Cap 21 laws of Kenya. The application has one major prayer namely;

(1) That the defendants by themselves, their agents, servants or otherwise be restrained from producing, using, circulating or otherwise dealing with the mark “*proudly Kenyan*” in the cause of trade, business or otherwise by advertisement sales promotion, issue, circulation or otherwise pending the hearing and determination of this suit”.

The grounds in support of the application are;

(1) That the applicant is the registered proprietor of the trademark “*proudly Kenyan*” for use in advertising business management, business administration and office functions under class 35.

(2) That the defendants have by themselves, their agents, servants or otherwise **produced, used and circulated stickers with the mark “*proudly Kenyan*” in the course of their business or trade for purposes of advertisement, sales promotion or otherwise without the authority of the plaintiff.**

(3) That the use of the mark “*proudly Kenyan*” by the defendants in the course of their business by advertisement, sales promotion issue, circulation or otherwise infringes the plaintiff’s exclusive right to use the trademark in connection with the provision of the services in respect of which the trademark was granted.

(4) The continued use by the defendants of the mark erroneously indicates a connection in the course of trade or business between the plaintiff as proprietor of the trademark and the goods and/or services which the defendants offer and is likely to deceive or cause confusion in the course of trade and business for the following reasons;

- 1) **The mark is likely to be taken as being used as a trademark**
- 2) **The mark is likely to import a reference to the defendants having the right to use the trademark either as proprietor or registered user in relation to the goods or services with which the defendants deal in the course of business or trade.**
- (5) **The use of the mark by the defendants will cause injury or prejudice to the plaintiff as registered proprietor of the trade mark to the extent that the value of the plaintiff's trademark in trade and business will be eroded or otherwise diluted.**
- (6) **The defendants have given no indication that they intend to lease the production, use or circulation of the mark in the course of their trade or business.**

The application is further supported by the affidavit of the plaintiff who avers that he is the registered proprietor of the trademark "**proudly Kenyan**" having registered as No.59872 under class 35 in part A of the register. The certificate of registration of the said trade mark is exhibited and marked "MAO". The deponent also states that he is the proprietor of a firm by the names "**proudly Kenyan**", which he allowed a society by the same name, which he is the co-founder and chairman to use the said names.

The plaintiff complains that the defendants have produced, used and circulated stickers with the mark "**proudly Kenyan**" in the cause of their business or trade for purposes of advertisement, sales promotion or otherwise without his authority. The plaintiff alleges that the use of the stickers with the mark "**proudly Kenyan**" infringes his trademark and is likely to deceive or cause confusion because;

- 1) **The mark is likely to be taken as being used as a trade mark.**
- 2) **The defendants are likely to be taken as having the right to use the trademark either as proprietors or as registered users in relation to goods and services with which they deal.**
- 3) **Those who know the plaintiff as the proprietor of the trademark are likely to relate the goods and services of the defendants in relation to which the mark is used in the course of trade with the plaintiff.**

It is also the case of the plaintiff that he uses the trademark in the course of his business which involves branding, advertising, marketing and sales promotions for member companies, businesses, organizations and institutions at a fee. It is also the contention of the plaintiff that he had given the brand "**proudly Kenyan**" considerable public exposure through advertisement and marketing, hence he stands to suffer irreparable injury and prejudice since the value of the trademark in trade and business will be eroded or otherwise diluted.

Mr. Olonde learned counsel for the plaintiff/applicant submitted that the defendants not being registered owners of the trademark and without permission from the plaintiff has been using the said trademark to the prejudice of the plaintiff. He contended that the defendants are using the trademark for purposes of advertising, contrary to the interest of the plaintiff who runs a business in the name "**proudly Kenyan**".

Mr. Olonde Advocate further submitted that the purpose of registering a trademark is to give the registered owner the exclusive rights of ownership. He referred me to section 7(1) of Act No.4/94 (trade marks Act) Cap 506 Laws of Kenya. According to **Mr. Olonde** Advocate there is an infringement if a person who is not the owner uses the trademark of another for purposes of advertisement or otherwise without the authority of the owner. The defendants by using the names "**proudly Kenyan**" gives the false impression that they have connection with the registered owner of the trademark. And since it is not denied by the defendants that they are using the registered trademark and since the defendants have no licence or permission to do so, then the plaintiff is entitled to the orders sought in the application.

The two defendants filed joint grounds of opposition which was argued by **Mr. Oyatsi** Advocate, who

termed the plaintiff's application as completely misconceived and unmeritorious. He stated that the object of having a trade mark is to protect the identity of goods and services of the proprietor against deception by other parties who want to use the same identification. There are classifications of goods and services. And where a trade mark is registered, the rights of the owner is limited to that class of goods and services.

Mr. Oyatsi Advocate stated that there is a clear admission by the plaintiff that the mark used by the defendants is in relation to goods and services which are not similar to the ones of the plaintiff. The trademark is being used for carrying out the sales of fuels and other related products of the defendants. He contended that none of the defendants is engaged in similar business like that of the plaintiff. The defendants carry business under the class of National oils.

According to **Mr. Oyatsi** Advocate the goods sold by the defendants belong to a class whose category is far apart from the class which is protected by the plaintiff. And there can be no question of the public being deceived by the defendants' use of the words similar to the ones of the plaintiff. **Mr. Oyatsi** further submitted that upon perusal of exhibit No.3 attached to the application, it is clear that the words "**proudly Kenyan**" is used in the context of the defendants. The words "**proudly Kenyan**" is used in connection with the defendants as proud Kenyan companies or Kenyan based companies, hence there is no connection at all between the defendants and the plaintiff.

It is also the case of the defendants that they have not rendered any services of advertisement or business Management under the name "**proudly Kenyan**". And nowhere in the plaint has the plaintiff stated that he is carrying out any business of any description where he is offering any business or service to the public. And since the defendants deal in entirely different goods, it is in no way affected by the registration of the trademark.

It was the submission of **Mr. Oyatsi** Advocate that the plaintiff has not alleged that any of its customers or clients would mistake the goods of the defendants as those of the plaintiff. The court cannot therefore grant an injunction in futility. There must be a wrong the continuation of which has to be restrained. And it has to be demonstrated that an award of damages would not be sufficient alone.

On my part I have considered the nature of this unique application, the supporting affidavit of the plaintiff and grounds of opposition filed by the defendants. I have also taken into consideration the able and persuasive submissions of both Advocates. The plaintiff's position is that at all material times was the registered owner of the trademark "**proudly Kenyan**" as No.59872 in class 35 in respect of advertising, business management, business administration and office functions. The defendants are alleged to have infringed the registered trade mark by the use in the cause of trade of a mark which is identical or similar in relation to goods and services similar to those for which the trademark is registered, where such use being without due cause takes unfair advantage of or is detrimental to the distinctive character or requisite of the trademark of the plaintiff.

The defendants are alleged to have produced, used and circulated stickers bearing the mark "**proudly Kenyan**" to its customers, members of the public and clients.

First and foremost, it is pertinent to note that the goods and services provided by the plaintiff and defendants are so essentially different that fairly regarded they are sufficient to avoid any possibility of confusion and misrepresentation. The whole question in this matter is whether the thing "**(proudly Kenyan)**" as appearing in the defendants' stickers taken in its entirety, looking at the whole thing is such that in the ordinary course of things, a person with reasonable apprehension and with proper eye sight would be deceived.

In my understanding the law looks at the perception of a careful customer and whether the customers/clients of the plaintiff would be jeopardized by the course of events adopted by the defendants.

The question is whether what the respondents are doing constitutes or amounts to a misrepresentation. Let me say that misrepresentation constitutes an invasion of proprietary rights vested in the owner of the

registered trademark. However invasion of property is not in the mark, name or set up improperly used. The essence of intellectual property is that it protects applications of ideas and information that are of commercial value. Where the expression of an idea is inseparable from its function, it forms part of the idea, the rights thus infringed are enforced in similar ways. The law protects exploitable idea, name or new knowledge so that the rights of the owner is firmly and decisively asserted and/or strengthened.

Trade marks are protected as symbols needed by consumers to distinguish between competing products and services in market economy. Let me add that marks do not by itself have the capacity to prevent a competitor from entering any market with his own products or services, it merely prevents him from annexing the protected mark. In essence a mark may be built into an asset of prime value to a business. However they are not allowed to become barriers in the way of marketing products or services themselves. The right owner does not need the right in order to exploit a market for his goods and services. Ideally and essentially, trademarks are rights to stop others doing certain things (rights or obligations), in other words to stop pirates, counterfeiters, imitators and misrepresentators from exploiting them without the licence of the right owner. By way of corollary, the right gives no liberty to ignore the rights of other individuals or to override public liabilities.

This case, in my view brings into play some of the fundamental assumptions about the role and purpose of intellectual property which to an ordinary bystander may look very hard to predict. It also raises an awkward questions of the decision of the registering authority, in the course of his duty. The case of the plaintiff, one may be tempted to say it brings into play numerous, complex genetic manipulation of ideas by individuals with the aim of obtaining exclusive right to use a particular mark. I also think it alters or wears down the current and accepted notions on property rights, by putting considerable strains on traditional concepts of intellectual property rights.

The innovative desire of the plaintiff to preserve and register the words “**proudly Kenyan**” is the heralding of revolutionary ideas. However it puts the courts in a position of reluctance to give protection to the absolute character of property rights. I am conscious that as judges, we must appear as objective administrators of established law, rather than as wholesale markers of new principles. The idea may sound or look novel. However, it must be done within the confines of the law. In my view an amorphous idea or trademark cannot be used as an impediment in the marketing of products and services. Nevertheless I am aware that all intellectual property consists in the exclusive right to perform some defined activity in the main productive or commercial sector, with a view to give adequate protection the originality of an idea.

In order to give protection to the alleged trademark of the plaintiff, it is I think essential to establish that;

- (1) The idea or mark must be novel
- (2) It should not be one already known
- (3) It must not be meant to encumber the rights of others to enjoy the use of the same.
- (4) It must involve an inventive step.
- (5) It must escape the trait of obviousness
- (6) It must be one produced or designed by a skilled worker with original functions.
- (7) Must have been created with distinctive artwork.
- (8) It must not be meant to pre-empt the use of a common word or art. (It must not be a common word).
- (9) It must have the effect of deceiving a perspicacious shopper if somebody decides to create or uses it differently or in another form.

(10) It must have been created or crafted with imagination i.e. clearly expressed and easily understood.

(The list is not exhaustive)

The issue is whether a skilled worker, by observation or analysis could discover and reproduce the invention claimed by the plaintiff. In essence whether the defendants would have anticipated the restriction on the words “**proudly Kenyan**” and whether such a restriction can interfere with the rights of the defendants to use the words “**proudly Kenyan**” in the way they used or employed.

I think it incumbent upon the plaintiff to demonstrate a misrepresentation by the defendants by use of the words “**proudly Kenyan**” to the public to believe that the names offered are that of the plaintiff. The plaintiff must also show that he suffers or is likely to suffer damages by reason of the erroneous belief engendered by the defendants’ misrepresentation that the source of the name is the plaintiff which is calculated to injure the business or goodwill of the plaintiff, that the acts of the defendants are reasonably foreseeable consequences to the business which causes actual damages. In my view the plaintiff must have some badge of recognition on the trademark upon which to found his reputation as the exclusive owner of the said trademark. However as a matter of good practice, the court cannot allow a party to behave in a deliberate and obstinate way in order to obstruct the right of the public to use or employ common words attributable to a group of people or cause.

In my understanding the law is perfectly clear that a party who has adopted or invented a particular mode of designating his particular trademark has a right to say that other persons or entities shall not use in furtherance of its trade or business such a designated name, looking exactly like it or that they shall not sell it in such a way as to steal or disadvantage the owner of the trademark. All the law will protect are such capricious additions or features as may be attached to the owner for purposes of indicating that he is the originator of the trademark.

The mark must be of particular shape or configuration which become specifically identified with a particular individual, the person may be entitled to protection against deceptive use for the creation or imagination he crafted into the trademark. The trademark must be originally designed or invented by the owner with distinctive imagination, hence a property is created because a particular shape or configuration of the very object was designed or originated by the owner. The question is whether what the respondents are doing constitutes or amounts a misrepresentation to accord the plaintiff the protection he is seeking.

In my view once it is established as a matter of fact that what they are doing constitutes a misrepresentation, which effectively deceives the public into an erroneous belief regarding the source of the name, then the applicant would automatically be entitled to an order of injunction. However it is my position that the mere fact that a party registers a common name cannot entitle him or her a legal protection of a right acquired through the inept and inattentive action of the registering authority. My humble view is that no property right can be acquired through the laxity and negligence of public officers failing to adhere to their legal mandate.

In **Reddaway vs Banham (1896) AC 199 at page 210** it was held;

“the name of a person or words forming part of the common stock of language may become so far associated with the goods of a particular maker that it is capable of proof that the use of them by themselves without explanation or qualification by another manufacturer would deceive a purchaser into the belief that he was getting the goods of A when he was really getting the goods of B. In a case of this description the mere proof by the plaintiff that the defendant was using a name word or device which he had adopted to distinguish his goods would not entitle him to any relief. He could only obtain it by proving further that the defendant was using it under such circumstances or in such manner as to put off his goods as the goods of the plaintiff. If he could succeed in proving this, I think he would on a well established principles be entitled to an injunction”.

Here in this case the defendants are alleged to have produced, used and circulated stickers bearing the mark “**proudly Kenyan**”. It is pertinent to note that of late many business firms are invoking their Kenyan roots to edge out their competitors. In my view “Kenyaness” is meant to boost sales and inspire customer loyalty, hence the idea is to inspire patriotism and loyalty in a particular product associated with a local business company or an individual Kenyan. In essence it means a particular service or product is homegrown and indigenous, therefore the words “**proudly Kenyan**” resonates with Kenyaness. One may be tempted to say that Kenya belongs to all of us, so we have a duty and/or obligation to be “**proudly Kenyan**” and be proud of our local products and services to show a sense of loyalty and nationhood for what we are.

Let me say trade marks and patents give temporary oxygen to technological inventions and design rights. As stated earlier the law would step in to protect against genetic manipulation of ideas but on the same breadth is reluctant to give absolute protection without the consideration of the character of the right allegedly infringed.

What I am saying is that the interest of an individual to secure a fair value for his intellectual effort or investment of capital or labour must be weighed against the interest of the public as a whole in its economic, cultural, religious, political and social development and identification. It is my position that an individual cannot be allowed to reap profits in a matter quasi public nature unless there is evidence that substantial part or portion of the profits earned would be diverted for public purpose, advantage and/or good. The question is whether the words “**proudly Kenyan**” is a novel product or service which can be equally and unilaterally be used by all Kenyans or whether the scope can be limited to the person who has the registration rights. It suffices to say that prima facie all intellectual property rights consists is the exclusive right to perform or restrict some defined activity in the main productive, commercial and service use of a particular item and its usage.

I have to assess the degree to which the applicant’s investment will be open to dissipation if he is not accorded the exclusive right to pressure and restrict the use of the words “proudly Kenyan”. The issue is whether a skilled worker by observation or analysis could discover and reproduce the invention which the plaintiff alleges to have invested and registered to his exclusive use. I think it is incumbent upon the plaintiff to show or establish a goodwill or reputation attached to the words “**proudly Kenyan**” has been unfairly and illegally used by the defendant in order to promote the sales of its goods and services. The plaintiff must also demonstrate that he suffers or is likely to suffer damage by reason of the erroneous or illegal misrepresentation of the defendant. And the source of the name is him with an intention to injure the business or goodwill of the plaintiff, that the acts of the defendant is a reasonable foreseeable consequence to the business, which causes actual damage.

In order for the plaintiff to seek protection he must establish the words “**proudly Kenyan**” has been associated with him and he became associated with it because he is the originator of the words, therefore has exclusive rights to restrict its usage to parties like the defendants. The plaintiff must be the source or must be associated with the source of the words “**proudly Kenyan**”. However he cannot legitimately do so when the words are so common that it can be rightly and legally identified with all proud Kenyan. Of course you cannot any more than the public claim a monopoly of what belongs to or can be identified with all Kenyans, because of having acquired a registration. The registration cannot override the rights to own the usage of common words that belongs to the citizens of this great nation.

It is not legitimate to equiparate a common word which is unique in the public usage to make it a word not ordinarily in public use. It is I think material to say that the words “**proudly Kenyan**” certainly cannot possibly become distinctive and exceptional to the direction, permission, consent, and/or use of the applicant. What the applicant is seeking to protect is neither a trade or goodwill associated with him but a common name available to all Kenyans. In my humble opinion there is not and cannot be any proprietary right in an idea or can a person claim monopoly in a particular name in the absence of any artwork, invention, innovation, crafting and/or origination by the claimant like the plaintiff herein. I do not think a perspicacious shopper can say that by use of the words “**proudly Kenyan**” the defendant trespassed into the rights of the plaintiff. In essence the law cannot be used to pre-empt the use of a common word where no imagination was crafted into it by the claimant. To confer protection against a passing off is not the

same as restricting the use of common words where a person created no artwork or used no imagination in its present form. The plaintiff cannot have a better right than all other Kenyans because he has chosen to employ the word “**proudly Kenyan**” as his trademark. In my view an individual cannot be exclusively allowed to use a common word in furtherance of his trade or business and at the same time restrict such word from the others who are entitled to an equal use. I think the case of the plaintiff falls within that category.

Let me say that the use of descriptive expressions or slogans in general use like “**proudly Kenyan**” cannot entitle the plaintiff to a relief of injunction simply because he has in his possession a registration document issued by a sleeping public officer who is not conscious of the legal consequences of allowing such a registration. The words proudly Kenyan is widely used and is familiar within the public domain, therefore no party can restrict its use, whether for business or otherwise.

Now having taken into consideration guiding principles as set in **Giella vs Cassman Brown**, I am satisfied that the plaintiff’s application falls short of the requirement set out. There is no prima facie case with a probability of success. You cannot suffer damages for what does not exclusively belong to you at the first place. I am not in doubt therefore the application must fail and has failed for the reasons set out hereinabove.

In conclusion it is my determination all proud citizens of this great Nation are entitled to the use of the words “**proudly Kenyan**”. In particular the security officers working under difficult and deplorable condition, putting their life, security and safety in great risk and jeopardy in defending our borders, teachers working in remote areas trying to educate our young children, civil servants working for the good of this country and judicial officers working overtime and often sharing the same ready table with their children late into the night in order to deliver justice are proud citizens of this country and are entitled to use the words “**proudly Kenyan**”. As stated Kenya belongs to all of us and it cannot be **Mr. Mathew Ashers Ochieng’s** who can restrict us from using the words “**proudly Kenyan**”. If I accord that exclusive right to the plaintiff, I would be depriving the rest of Kenyans the obligatory right and duty to be proud of being Kenyan. I think that is not available and I refuse to accord the plaintiff that exclusive privilege. I must say to **Mr. Ochieng** that he cannot restrict what belongs to all the proud citizens of this country. He may use it for the betterment of his business but let him know that he has no better and/or greater right than the defendants herein.

In the premises the application dated 26th July, 2007 is dismissed with costs.

Dated and delivered at Nairobi this 31st day of October, 2007.

M. A. WARSAME

JUDGE