



REPUBLIC OF KENYA
IN THE HIGH COURT
AT NAIROBI
MILIMANI LAW COURTS
HCCC 365 OF 2007

SAFEPAK LIMITED PLAINTIFF

VERSUS

MALPLAST INDUSTRIES LIMITED DEFENDANT

R U L I N G

The plaintiff herein Safepak Limited (hereinafter “Safepark”) seeks by its Chamber Summons dated 13.7.2007 the following primary orders:-

That the defendant be restrained pending the hearing and

Determination of this suit from:

- (a) infringing the Industrial Design registered as No.385.**
- (b) manufacturing, importing or exporting, selling, offering for sale, distributing, marketing bottles or other products manufactured from the reproduction, imitation or infringement of the Industrial Design registered as No.388.**
- (c) parting with possession power custody (other than to the plaintiff or its agents) of all moulds, documents, files, invoices, receipts, articles or equipment relating to the importation, purchase, manufacture, sale or supply of the infringing bottles, moulds and other products.**

The application is expressed to be brought under Order XXXIX Rules 1, 2, 3 and 7 of the Civil Procedure Rules and Section 3A of the Civil Procedure Act. The grounds for the application as set out on the face of the application are as follows:-

- 1. That the plaintiff is the registered owner of Industrial Design No.385 and has been the owner of the design since 26.9.2003.**
- 2. That in or about May 2007, the defendant infringed the plaintiff’s design and continues to do so by reproducing the design to manufacture bottles that are similar and virtually indistinguishable from the plaintiff’s bottles in direct competition with the plaintiff.**

3. That the defendant has deliberately reproduced or copied the plaintiff's design and only altered the pupils of the clown's eyes to a round shape as opposed to the plaintiff's star shaped pupils. The defendant has also introduced a two arm device instead of a frill in the area below the "waist" of the bottle and the divisions below the "waist" of the defendant are in wavy lines as opposed to the plaintiff's straight lined divisions.

4. That the plaintiff has expended, intellectual and monetary effort in coming up with the unique design.

5. That unless the defendant is restrained the plaintiff will suffer irreparable harm, loss and damage.

There is an affidavit sworn by one Tishar Shah, the plaintiff's Managing Director. There is a further affidavit sworn by the same Managing Director and filed on 2.8.2007 in response to the replying affidavit sworn on 23.7.2007. The plaintiff has also supported the application by an affidavit of Nazima Saeed Malik, its advocate.

The defendant has in opposition to the application filed a replying affidavit of one Bijesh Shah, a director of the defendant who has also sworn a supplementary affidavit.

On 13.7.2007, the plaintiff filed this suit by way of plaint in which besides the prohibitory injunctions four other orders are sought in the following terms:-

1. **The delivery to the plaintiff of or destruction on oath of all the moulds and infringing products and of all bottles or other products within the defendant's possession, custody or power, which are manufactured as a result of an infringement of the plaintiff's design No.385 and would otherwise offend against the provisions of the injunctions.**

2. **The delivery of all documents relating to the manufacture, importation, purchase, distribution, selling or offering for sale of all the products falling within the provisions of the paragraph relating injunctions.**

3. **An order that the defendant discloses the names and addresses of all those by whom it has been supplied and to whom it has supplied products falling within the provisions relating to injunctions together with sales and details of quantities so supplied and the prices thereof.**

4. **An enquiry as to damages, or alternatively at the plaintiff's option an account of profits made by the defendant as a result of the aforesaid infringement by the defendant and an order for payment of any sums found due together with interest.**

I have perused the plaint. I have also perused the affidavits sworn in support of and in opposition to the application. Learned Counsel submitted at length and cited several authorities. I have carefully considered the said submissions. I caution myself that I am not trying this case and I should not therefore make definitive findings of fact and law as that is the province of the trial Judge. At this interlocutory stage, the application should be considered on the basis of the well known principles set in **Giella vs. Cassman Brown [1973] 358** – They are that an applicant will not get an interlocutory injunction unless he can show firstly that he has a prima facie case with a probability of success and secondly, that he stands to suffer irreparable loss and damage, that is loss, or damage that cannot be made good by an award of damages. Thirdly, if the court is in doubt the application should be considered on the balance of convenience.

Has the plaintiff shown a prima facie case with a probability of success at the trial? In its plaint the plaintiff has pleaded infringement of its registered design. The particulars of infringement have been given. The plaintiff in its affidavits repeats the allegations of infringement. It has exhibited a Certificate of Registration of its industrial design No.385 dated 9.11.2005. The duration of protection for the design is stated to be 5 years w.e.f. 26.9.2003 and can be renewed for two further terms of five years.

The plaintiff has also exhibited coloured photographs of both its design and the bottle manufactured by the defendant. The design of the plaintiff is in my view unique with distinctive and novel features. On two sides of the bottle is an impression of a smiling clown leading to a frill collar. There are two distinct parts. The upper part comprising the "head" and the lower part which I will refer to as the body. Between the head and the body the bottle narrows and the narrow part can easily be described as the neck or waist. The body is round with straight lines indented thereon at equal intervals. It can be held comfortably in one hand. Its width is about 5 cm and height is about 14.5 cm. The bottle was produced at the hearing of the application. I have no doubt in my mind that the plaintiff expended considerable intellectual effort in formulating the design and must have expended money in creating the mould for the bottle based on the design.

The defendant's bottle is the same size as that of the plaintiff. On two sides is the smiling clown's face of the same size as the face on the plaintiff's design. At close scrutiny the pupils of the clown's eyes on the defendant's bottle are rounded in shape instead of the starry shape of the plaintiff's. Again at close range, the defendant has introduced a two arms device below the neck instead of the frill which appears in the plaintiff's design. The lines on the body of the bottle are wavy at equal intervals. As I have said the differences can only be observed by close scrutiny. Otherwise at a distance visually there is no difference. Indeed when counsel held them from the bar I was not able to notice the differences. It is only when I held them that the differences slowly started to emerge. I agree with counsel for the plaintiff that the differences are not substantial enough to distinguish the overall features and the shape embodied in the defendant's bottle from features in the plaintiff's design.

There is, no dispute that the plaintiff's design is registered. A Certificate of Registration by the Industrial Property Institute has been of existed as "TSI".

Section 92(1) of the Industrial Property Act reads as follows:-

92(1) Registration of an Industrial design shall confer upon

its registered owner the right to preclude third parties

from performing any of the following acts in Kenya-

- (a) reproducing the industrial design in the manufacture of a product.**
- (b) Importing, offering for sale and selling a product reproducing the protected industrial design or**
- (c) Stocking of such a product for the purpose of offering it for sale or selling it,**

AND

92(3) reads:-

"The registered owner of an industrial design shall in addition to any other rights, remedies or actions available to him, have the right to institute court proceedings against any person who infringes the industrial design by performing without his consent, any of the acts referred to in sub-section (1) or who performs acts which make it

likely that infringement will occur.”

It is plain that under the above provisions of the Industrial Property Act, the plaintiff has a Statutory protection. The plaintiff has stated that it has been the registered owner of the Industrial Design No. 385 since 26.9.2003 and the protection given by the Act is valid for a period of 5 years since.

Having found that the defendant's bottle has features, patterns and shape similar to those of the plaintiffs' design, I am persuaded on a prima facie basis that the defendant is infringing the plaintiff's design. It is illustrative that the defendant admits that with respect to the design in question, it has been manufacturing, selling and offering for sale to its customers within the country for the last three months. The defendant is therefore a late entrant. The defendant further admits that its design is not registered. In the affidavit of Bijesh Shah sworn on 23.7.2007, at paragraph 13, it is deponed that prior to the receipt of a complaint from the plaintiff on 26.6.2007, the defendant had put arrangements in place to redesign its bottle with a view of improving the same in order to satisfy its customers' demands and the plans were still in place.

In my view as the letter was in response to the plaintiff's complaint that the defendant was infringing the plaintiff's design, the same contains an implied admission of the infringement.

In the premises, I am satisfied that the plaintiff has shown a prima facie case with a probability of success at the trial. The plaintiffs protection is Statutory and damages are not a paramount consideration. However even if I were to consider the same, I am of the view that the plaintiff stands to suffer irreparable harm and damage which cannot be compensated by damages. It is not easy to quantify intellectual property.

In the end I allow the plaintiff's application in terms of prayers 2(a) (b) (c) and (d) thereof. The injunction will be conditional on the plaintiff filing an undertaking under seal to pay damages, if any, to the defendant in the event that it is found at the trial that the injunction ought not to have been issued. The said undertaking to be fortified by a similar undertaking by the plaintiff's Managing Director. The said undertakings to be filed within the next 7 days.

Orders accordingly.

DATED and DELIVERED at NAIROBI this 30th day of November 2007.

F. AZANGALALA

JUDGE

Read in the presence of: Malik for the plaintiff.

F. AZANGALALA

JUDGE

30/11/07