



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

Civil Case 272 of 2007

PROCTOR & ALLAN (E.A.) LTD.PLAINTIFF

VERSUS

BEST FEED (E.A.) LTD.DEFENDANT

RULING

Before me is the plaintiffs' application expressed to be brought under the provisions of Sections 3A, 63 E of the Civil Procedure Act, Order XXXIX Rules 2 and 9, Order L. Rule 4 of the Civil Procedure Rules and all other enabling provisions of the law. The applicants seek declaratory orders and injunctive reliefs plus costs. The application is premised upon 16 grounds expressed on the face of the application.

The main grounds are that the plaintiffs have a registered Trademark "Besbix Hound meal" and manufacture all types of dog food branded with the trademark and they have been doing so for more than 8 years to the extent that they are now market leaders in the field. In that regard the 2nd plaintiff has invested heavily in the product and has established firm goodwill in the product itself, the trademark and the packaging device. The plaintiff contends that the defendant, since April 2007 has been producing a product not only identically packaged but also bears the plaintiff's registered Trade Mark or a corruption thereof. In the premises, the defendant is, infringing the plaintiff's said trademark and creating confusion among members of the public leading customers to believe that the offending product is indeed a product of the 2nd plaintiff, a fact which is not true and is detrimental to the plaintiff's business. As a consequence, the 2nd plaintiff's sales have dropped significantly since April 2007 resulting in substantial financial losses which continue to increase with every passing day.

The application is supported by an affidavit sworn by one Victoria Muthusi, the General Manager of the plaintiffs. In the affidavit the grounds for the application are substantiated. Annexed to the affidavit is a copy of the Registration Certificate which confirms that the plaintiff's Trademark "Besbix has been registered since 1954 and was renewed in the name of the 1st plaintiff on 3.7.1996 for a further period of 14 years. The plaintiffs have also exhibited copies of the respective get ups. It is clear that the device, and packaging of the respondent's products so closely resembles the device and packaging of the plaintiff's product that the public may be led to believe that the respondent's product is associated with the plaintiff's product.

The plaintiffs have also exhibited a letter from the respondent's advocate dated 20.5.2007. That letter was in response to the plaintiff's letter dated 17.5.2007 to the respondent demanding that the respondent removes its product from the market. The respondent's letter was an implied admission of the infringement of the plaintiff's trademark. The respondent indicated that its product would be withdrawn from the market. Notwithstanding that promise, the plaintiffs contend that the respondent continues to supply the offending product into the market, suggesting that the respondent has no desire to stop the

infringement aforesaid and continues passing off its product as the 2nd plaintiffs.

The plaintiffs swear that the respondent's product is different in quality and its continued sell will immensely erode the 2nd plaintiff's goodwill and thereby cause irreparable loss and damage to the plaintiffs.

The application and the plaint were served upon the defendant but no grounds of opposition or replying affidavit have been filed and when the application came before me for hearing on 30.7.2007, there was no appearance for the defendant. The application therefore proceeded ex parte. Counsel for the plaintiff took me through the supporting affidavit and submitted that on the material availed to the court, the plaintiffs were entitled to the orders sought.

I have perused and considered the application together with the supporting affidavit and its annexures. I have further given due consideration to the submissions of counsel. Given the uncontroverted affidavit evidence of the plaintiffs, I am of the view that conditions for the grant of the orders sought have been established. The plaintiffs have shown that its goods have acquired a representation in the market and are well know by distinctive features. There is also affidavit evidence that the respondent has committed acts of misrepresentation which have deceived or are likely to deceive consumers of the plaintiff's products. The plaintiffs swear that the 2nd plaintiff is likely to suffer damage by the deception of the respondent and that the misrepresentation and deception are calculated to injure the business and goodwill acquired by the plaintiffs. Indeed, the respondent in its advocate's letter dated 20.5.2007 undertook to withdraw its offending products from the market.

I have myself observed the respondents mark and compared it with that of the plaintiff's mark, the similarities are striking and to ordinary customers the difference would not be easily noticed. There has therefore been clear misrepresentation by the defendant to the public which misrepresentation leads the public to believe that the goods marketed by the defendant are those of the 2nd plaintiff.

In the premises, I have no hesitation in holding that the plaintiff has established all the conditions set in Giella vs. Cassman Brown & Co. Ltd. [1973] E.A. 358. Having done so, it is my view that they are entitled to the protection given by Section 7 of the Trade Marks Act which gives the proprietor of a Trade Mark statutory rights. The Section is in the following terms:-

“... Without prejudice to the generality of the foregoing, that right is infringed by any person who not being the proprietor of the trademark uses a mark identical with or so nearly resembling it as to be likely to deceive or cause confusion in the course of trade or in connection with the provision of any services in respect of which it is registered.”

The respondent has clearly contravened the provisions of the above Section and the plaintiffs are entitled to the protection given therein.

The plaintiffs have further prayed for mandatory orders of injunction. With respect to those prayers, the plaintiff had in addition to establishing the parameters set in the Giella vs. Cassman Brown & Co. Case (supra) show that this case is of exceptional character and is clear-cut. See the case of Locabail International Finance Ltd. vs. Agroexport and others [1986] 1 ALL ER 901. In view of the uncontroverted evidence given by the plaintiffs, including the defendant's own admitted intention to withdraw the offending products from the market, I have come to the conclusion that special circumstances have been established in this case to warrant the issuance of the interlocutory mandatory injunction sought.

The upshot is that I allow the plaintiffs' application dated 31.5.2007 in terms of prayers 4, 5, 6, 7 and 8 thereof. I do so on terms that the plaintiffs shall file written undertakings as to damages within seven (7) days of today. The said undertaking shall be under the company seals of the plaintiffs. The undertakings shall be fortified by the personal undertaking of the plaintiffs' General Manager to the same effect and which undertaking should also be filed within seven (7) days of today.

Costs shall be in the Cause.

Orders accordingly.

DATED and **DELIVERED** at **NAIROBI** this 7th day of December 2007.

F. AZANGALALA

JUDGE

Read in the presence of:- Mwangi Ms. holding brief for Marete for the applicants.

F. AZANGALALA

JUDGE

7/12/07