



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

Civil Suit 314 of 2006

**MATCH MASTERS LIMITED.....
.....PLAINTIFF**

VERSUS

**RHINO MATCHES LIMITED.....
DEFENDANT**

R U L I N G

Plaintiffs chamber summon is brought under Order XXXIX Rules 1,2,3 and 9 of Civil Procedure Rules, Section 3A of the Civil Procedure Act and the Trade Marks Act Cap 506. The same seeks an injunction, pending the determination of the suit, **“restraining the defendant either by themselves, their servants, agents and/or in any other matter howsoever from using the word “RHINO” and or the devise of a Rhino on its matches or any brand name identical or similar to the plaintiff’s brand name on box packaging or using any other brand name confusingly similar to the word “RHINO” and or the device of a Rhino and or selling, distributing and/or otherwise dealing in matches under the Trade mark “Rhino”.**

The application is based on the ground that: -

- The plaintiff is a Limited Liability Company engaged in manufacturing and dealership in among others match boxes under the brand name **“RHINO”** and is the proprietor of the Trade Mark consisting of **“RHINO”** word and a device of a Rhino duly registered by the Registrar of Trade marks in class 34 schedule (III), on 22nd July 1998, under Registration No. 47738;
- That the defendant has wrongly started using the word **“RHINO”** bolding printed on the packaging of their NDOVU matches and in yellow and orange colour to imitate the colours and style of the plaintiff’s matches, thereby passing off their matches as those of the plaintiff when they are not.
- That the infringement and passing off of the plaintiff’s trade mark is on going and is grossly misleading and confusing to the wholesalers, retailers and the general public, and the plaintiff stands to suffer loss and damage such as would not be compensated in monetary terms.

The plaintiff presented the following evidence by affidavit and in submissions. That the plaintiff company’s principal objective in the memorandum and articles of association in the manufacturing and dealing in all kinds of matches within the Republic of Kenya. It is the lawful proprietor of Trade Mark No. 47738, class 34 (schedule III) consisting of RHINO (word) and a logo depicting the devise of a Rhino in yellow and orange colours. The plaintiff since incorporation, on 6th August 1998, has been engaged in

manufacture, distribution and dealing in different types of matches under the brand name “**RHINO**”, which is widely sold in Kenya. That as a consequence of the exclusive distribution of the plaintiff’s matches, through out Kenya the Rhino brand has acquired a substantial good will and has become a household name in respect of matches and consequently the aforesaid logo and the name “**RHINO**” has become known in the match industry to wholesalers, retailers and to the general public as signifying and representing the plaintiff’s business. That the plaintiff has acquired a substantial reputation by the use of the mark and logo of “**RHINO**”. That in May 2006 the defendant infringed plaintiff’s trade mark and brand name and also did pass off its goods as those of the plaintiff, by importing matches from Tanzania under the brand name “**NDOVU**” but with the words “**RHINO**” boldly emboldened and emblazoned on the packaging of the match boxes and using similar colours to those of the plaintiff and thereby passing off their matches as those of the plaintiff.

Plaintiff then exhibited conversations between match distributor and the retailer which conversation showed the confusion made by those retailers in relation to the two matchboxes of the plaintiff and the defendant. In addition the plaintiff exhibited cash sale receipts where the match being purchased was indicated as Rhino Ndovu.

Plaintiff therefore concluded that the defendant’s action is calculated to mislead the wholesalers, retailers and the general public into believing that the defendant’s matches are the same as the plaintiff’s matches. That the defendant matches were introduced into Kenya market at the end of May 2006, which has caused considerable confusing to customers and that the defendant’s action is an unscrupulous attempt to cash in on the plaintiff’s good will in its brand and name built over many years.

The defendant in opposition brought forward the following arguments. The defendant company was incorporated in September 1999 and the objects of that incorporation are to carry on business as dealer in matches and related products, export and importation of various goods including matches. That the defendants are importers, packagers and distributors of “**NDOVU** safety matches.” That the word “**NDOVU**” and the device of an elephant that appear on the defendant’s matches is a registered trademark, belonging to defendants. That the packaging of that match was in compliance with specification for matches provided for in Kenya Standard specification. The defendant denied that the plaintiff has title to the purported trademark that in any case the word Rhino was an ordinary English word, which can never be, on its own, subject of a trademark. That the matches of Rhino matches Limited have gained substantial goodwill and reputation in Kenyan market and that those matches were of a good quality and better “**get up**” and affordable to ordinary Kenya. Defendant denied infringement of the plaintiff’s trademark since the word “**Rhino**” is part of its registered name.

Defence then disputed the survey done by the plaintiff and stated that the conversations recorded by the plaintiff were ‘**stage managed**’ and that the cash sale receipt were written at the direction of the plaintiff’s agent. In this regard defence annexed to the replying affidavit, letters, written by the people interviewed by the plaintiff’s agent, whereby they retracted what conversation was recorded, to prove that there was confusion in the market over the matches of the plaintiff and the defendant. Defence in a rebuttal annexed receipt, which showed that the retailer indicated in the receipt, ‘**Ndovu**’ matches and not ‘**Rhino Ndovu**’.

Defence concluded by stating that the use of Rhino matches Ltd is legitimate since that is the registered name of the company and that balance of convenience was in favour of the defendant who would be put to great hardship, since it has distribution ship in certain towns and has invested immensely in market surveys, reach marketing and importation of huge stocks lard stocks of matches, ready made packaging materials and advertising materials which would to waste if an injunction is granted.

In case it has not come out clearly what is at stake in this mater, the court will describe the plaintiffs ‘**get up**’ of its Rhino matches and also the defendant’s, allegedly, offending match.

The plaintiff’s get up on its front has a yellow back ground with a bright orange in ball shape, with two horizontal bright orange lines. There is thereof the word Rhino and the device rhino. The back has a

while background with the word **RHINO** and devise rhino and in very small print appears the name of the plaintiff.

The defendant's get up, has at its front a yellow background with the word NDOVU and devise of an elephant. The back has a yellow background and very prominently and in boldly is the work "**RHINO**" and in smaller letter is "**matches Ltd.**"

The plaintiffs complaint relates to the defendant's use of the word Rhino prominently at the back of the match box.

For the court to grant an interlocutory injunction the plaintiff must show a prima facie case a probability of success; secondly, that such an injunction will not normally be granted unless the plaintiff might otherwise suffer irreparable injury; and thirdly, when court entertains doubt it will decide the plaintiff's application on a balance of convenience.

Plaintiff argued that it had proved a prima facie case with a probability of success. That the plaintiff's trademark of Rhino word and devise of rhino in July were registered 1998, that by the defendant amplifying its name on the package of the match a reasonable man would be deceived and may be led to purchase the defendant's matches thinking that they belonged to the plaintiff. That such confusing is exemplified by the confusion seen by the retailers.

Plaintiff relied on the case HARIA INDUSTRIES – V – P J PRODUCTS LTD [1970] E.A. 367 where the court of appeal held that "the test is whether an average customer acting with reasonable care would be likely to be confused by the article complained of;

Plaintiff also relied on the case SUPA BRITE LIMITED – V – PAKAD ENTERPRISES [2001] 2 EA 563. This high court case held that:

"To succeed in any action alleging passing off (which is an infringement of the legal principle that no man may sell his goods as those of another) a plaintiff must prove three things namely (a) that he has acquired a reputation or good will connected with the goods or services and that such goods or services are known to buyers by some distinctive get up or feature; (b) that the defendant, whether intentionally or not, made misrepresentation to the public leading them to believe that the defendant's goods are the plaintiff's; and (c) that the plaintiff hasdamage because of the erroneous belief engendered by the defendant's misrepresentation."

Plaintiff argued that if the defendant's object of prominently putting the word Rhino on its match box was to gain advantage over the plaintiff, that that constituted passing off.

Defence in opposition argued that the plaintiff cannot dictate how the defendants should write its name on the match box, in other words that the plaintiff, and indeed the court had no jurisdiction, or order the defendant to write its name in italic or bold.

Defence also drew the court's attention to the note on the plaintiff's certificate of registration of Trademark, which provided.

"This certificate is not for use in legal proceedings or for obtaining registration abroad."

Defence counsel submitted that this showed that the plaintiff could not rely on the certificate in these proceedings.

He further argued that the certificate also provided: -

"Registration is for seven years from the date first above mentioned."

And since the date of that certificate was 23rd July 1999, that by 22nd July 2005, the certificate's validity

had expired and that by virtue of section 5 of the trade mark, the plaintiff could not sustain this action.

Defence differentiated the both ‘**get ups**’ in that the defendants get up did not have orange device, that the word Rhino is the defendant’s name and by law, after incorporation, the defendant was entitled to use that name and since equity follows the law, an injunction ought not be granted.

I have considered counsel’s detailed arguments, the law cited to me and the affidavit evidence. The first issue perhaps to consider is whether or not the plaintiff can rely on the certificate of registration of Trademark, in view of the two issues raised by the plaintiff. On a prima facie basis I find that the note on the certificate states that, that certificate would not be used a broad in legal proceedings. That is clear from the words thereof. On the issue of expiry of validity, I find that Rule 67 and 68, The Trade Marks Rules, provides the regime to be followed for removing the mark from the register on expiry of the period stated in the certificate the defendant in presenting its argument did not show that that regime had been followed. The court, on prima facie basis find that there being no evidence that the plaintiff name had been removed from the register, the presumption is that there is no such removal.

On the defendant’s argument that it merely used its name on the matchbox, the reply thereof is found in the case MOHAMEDLAI ESMAILJI ESSAJI V KARACHIWALLA LIMITED, where it was held:

“.....A man is entitled to trade in his own name provided he does what is reasonable necessary to distinguish his business from that of another person of the same name.”

The issue for consideration is can the court find at this interlocutory stage that the use of the prominently word Rhino on defendant’s match, fails to distinguish the defendant’s match with the plaintiff’s match. On the basis of the interlocutory application the court find that there is little if any distinction.

On whether the plaintiff has brought evidence to show that the public can be confused by the packaging of the matchbox. Defence obtained letters written by person who had been interviewed by the plaintiff’s agent who retracted their statements to the plaintiffs agent. The court finds that for the court to accept the retraction it ought to be on oath and not just on letters. The plaintiff stated that the person interviewed could possibly have retracted their statements because of fear of the effect to the business. This was not controverted by the defendant the court is of the view that it is more probably correct rely on the first interview by plaintiff’s agent.

The court as result of what is stated herein before find that the defendant’s use of amplified word Rhino is on prima facie basis likely to be an infringement of plaintiffs trade mark. The prominent word Rhino is so resembles plaintiff’s trademark that the ordinary person is, more likely than not to be confused by that resemblance.

The court is also of the view that it is possible to be said that the defendant is guilty of passing off for indeed the plaintiff having registered their trade mark in July 1998, as stated by the deponent of the affidavit in support, can be said that by passage of time and by evidence of retailers it proved reputation of using the name “**Rhino**”. The defendants by prominently using the word Rhino, on the background of yellow colour, can be said on a prima facie basis said to be mis representation that the defendant’s matches are the produce of the plaintiff. It is arguable that it could lead to damage of the plaintiff’s good will in the word Rhino.

The plaintiff at this interlocutory stage has shown a prima facie case with a probability of success.

The court grants the following orders: -

1) That this court does hereby grant an interim injunction restraining the defendant either by themselves their servants, agent and/or in any other matter howsoever from using the word “RHINO” and/or the device of a rhino on its matches or any brand name identical or similar to the plaintiff’s brand name on match box packaging or using any other brand name confusingly similar

to the work “RHINO” and/or the device of a rhino and/or selling, distributing and/or otherwise dealing in matches under the Trade mark “RHINO” pending the hearing and determination of this suit.

2) The plaintiff is awarded costs of the chamber summons dated 13th June 2006.

MARY KASANGO

JUDGE

Dated and delivered this 24th July 2006

MARY KASANGO

JUDGE