



**1**  
**REPUBLIC OF KENYA**  
**IN THE HIGH COURT OF KENYA**  
**AT NAIROBI (NAIROBI LAW COURTS)**

**Civil Case 218 of 2006**

**GROUP FOUR SECURITY LIMITED.....PLAINTIFF/APPLICANT**

**VERSUS**

**G4S SECURITY SERVICES (K) LIMITED.....DEFENDANT/RESPONDENT**

**R U L I N G**

This is an application dated 24.4.2006 brought under Order XXXIX Rules 2 and 3 of the Civil Procedure Rules, Section 3A of the Civil Procedure Act and all enabling provisions of the Law. The application is seeking three principal orders as follows:-

- 1) That the defendant by itself its agents servants officers and or employees be restrained from infringing the plaintiff's trade marks Numbers TM 30034 and 30035 pending the hearing and determination of this suit.
- 2) That the defendant by itself, servants, agents, employees and/or by any other person be restrained from advertising using marketing, promoting, sourcing for business or any other way trading in the name of Group 4 Securicor or any other name closely resembling the plaintiffs mark Group 4 Security and to cease all and any other activities being carried out under the said name and a name similar to the same pending the hearing and the determination of the suit herein.
- 3) That the defendant do forthwith cease printing letter heads, contracts, waybills, promotional materials, brochures and/or any other trade documents of any nature with the said mark Group 4 Securicor pending the hearing and determination of the suit herein.

The application which is supported by an affidavit of one Niklas Brian Rogers the plaintiff's General Manager is based on the following principal grounds:

- 1) That the plaintiff is the registered proprietor of the trade mark No.TM 30034 in class 12 Schedule 111 as of 24.5.1982 in respect of vehicles.
- 2) That the plaintiff is also the owner of the Trade mark No.30035 in Class 16 Schedule 111 in respect of the Letter heads and stationery.
- 3) That the said mark in addition to Logo has the words Group 4 Security which is the name of the plaintiff.
- 4) That over the years since the plaintiff was incorporated in 1982 it has marketed the said mark,

created goodwill and reputation thereof and its security services have come to be associated with the mark.

5) That the respondent since towards the end of the year 2005 and actually from February, 2006 has started using a mark that is so similar and closely resembles that of the plaintiff's mark in the words: Group 4 Securicor which is so confusing and is likely to pass off the services of the defendant as those of the plaintiff.

6) That the defendant has started using the said mark in all its adverts, brochures, contract documents, letter heads and all its waybills and all its promotional materials together with its motor vehicles thereby infringing on the marks of the plaintiff.

7) That the defendant's use of the said resembling mark is not only infringing on the trade mark of the plaintiff but has also created confusion on the plaintiff's name by itself.

8) That the defendant usurpation of the mark is wrongful illegal without good faith and made with singular purpose of deceiving the public.

The said affidavit of Niklas Brian Rogers substantiates grounds for the application. To the affidavits are annexed 8 exhibits. The same Rogers swore a supplementary affidavit on 10.5.006 in further support of the application.

The defendant opposed the application on the basis of Grounds of Opposition filed by its advocates on 3.5.2006, a replying affidavit and a supplementary affidavit sworn by one Joseph Dowd the defendant's Regional Transport consultant. There are 19 exhibits annexed to those affidavits.

The application was ably canvassed before me at length on 25.7.2006, 13.9.2006, 22.9.2006 and 9.10.2006 by Mr. Mbaabu Learned counsel for the plaintiff and Mr. Kimani Learned counsel for the defendant. Both counsels elaborated on the positions taken by their respective clients in their affidavits and relied on several authorities.

I have perused and considered the application, the affidavits both in support of the application and in opposition thereto together with the annexures. I have also carefully considered the able submissions of the Learned counsels appearing and all the cases to which I was referred as well as the relevant Law. Having done so, I take the following view of this matter: The plaintiff's action is founded on two complaints. The first one is that the defendant is infringing its trade marks Numbers TM 30034 and 30035. The second complaint is that the defendant is passing off its services as those of the plaintiff. The complaints have been made because the defendant has since end of 2005 started using the mark in the words "*Group 4 Securicor*" which is so similar and closely resembles that of the plaintiff which is "*Group 4 Security*." In support of the complaints, the plaintiff has exhibited a copy of its Certificate of Incorporation dated 24.5.1982 which shows that the plaintiff was incorporated under the name "*Group Four Security Limited*". Also exhibited are copies of Certificates of Registration of Trade Mark Nos.30034 and 30035. The marks are the same; rectangular in shape with the inscriptions "*Group 4 Security*". The certificates were renewed in May, 2003 for a further period of 14 years.

The plaintiff has also exhibited the defendant's notice published on 10.4.2006 notifying the public that the defendant had changed from Securicor Security Services Kenya Limited to G4S Security Services (Kenya) Limited with effect from 14.2.2006. Also exhibited are copies of published warnings by the defendant that "*Securicor is now Group 4 Securicor*". Those publications appeared in the Daily Nation of Wednesday 5<sup>th</sup> April, 2006 and Friday 7<sup>th</sup> April 2006. There are also Letter heads of the defendant with the words "*Group 4 Securicor*." There are then letters of enquiry from some of the plaintiff's clients seeking clarification on whether or not the plaintiff had merged with Securicor. Finally the plaintiff has exhibited correspondence exchanged between it and Securicor Security Services Kenya Limited in its former name and in the current name regarding infringement of the subject trademarks.

The defendant's response to the plaintiff's said complaints as can be gleaned from the replying

affidavit, the supplementary affidavit and the submissions of counsel is multi pronged. It contends that the plaintiff has not shown by affidavit evidence of its customers that any passing off has occurred. Indeed according to the defendant there has been no confusion and there is no likelihood of confusion by the defendant's use of the mark "Group 4 Securicor". In its view both the plaintiff and the defendant's clientele is sophisticated and cannot be confused by the use of the said mark. There is further the contention that the name securicor has been used by the defendant since 1964 before the plaintiff entered the market and the property in that name therefore belongs to the defendant which has acquired goodwill in the same. Its use is therefore not intended to pass off its services as those of the plaintiff or infringe the plaintiff's trade mark. With respect to the Change to "Group 4 Securicor" it is the defendant's contention that the same was necessitated by a change at its parent company abroad. Several annexures have been exhibited to show that change and in the event in the defendant's view there can be no question of a deliberate design on the defendant's part to get the plaintiff's customers. It is further contended that the intention to change has been known to the plaintiff since July, 2005 and yet the plaintiff did not complain earlier with the consequence that the defendant has incurred substantial expense in completing the change. In the premises the plaintiff is not only guilty of inordinate delay but it has acquiesced in the use of the mark "Group 4 Securicor". It is also contended by the defendant that the plaintiff has not used the mark "Group 4 Security" since the year 2000 and is therefore deemed to have abandoned the mark. It is also the defendant's contention with respect to the registered Trade Marks that the plaintiff was not given exclusive right to the use of the figure "4" and the word "Security." Consequently the said figure and word were available for use by any other person inclusive of the defendant.

For the plaintiff to succeed, in this application, it had to establish the conditions for the grant of an interlocutory injunction as set out in the case of Giella –vs- Cassman Brown [1973] E.A. 358. These are: First an applicant must show a prima facie case with a probability of success at the trial. Secondly, an interlocutory injunction will not normally be granted unless the applicant might otherwise suffer irreparable injury which would not adequately be compensated by an award of damages. Thirdly, if the court is in doubt it will decide an application on a balance of convenience.

In a passing off action an applicant has to establish the prerequisites summarized in the case of Reckitt Colman Products Limited –vs- Borden Inc. and Others [1990] 1 All ER 873. The prerequisites are: The applicant has to show that its goods or services have acquired a reputation in the market and are well known by some distinguishing feature. He should also establish that there has been misrepresentation which has deceived or is likely to deceive and that the plaintiff is likely to suffer damage by such deception of the respondent. He should also show that the misrepresentation was calculated to injure the business or goodwill or will probably do so.

I will apply those principles to the matter under consideration. It is not disputed that the plaintiff is the registered proprietor of the trade mark "Group 4 Security" which was registered in the year 1992. There is also no dispute that the plaintiff's name is "Group Four Security Limited" – and was incorporated under that name on 28<sup>th</sup> May, 1982. It is obvious therefore that the plaintiff has in the said trade mark incorporated its name. The defendant has stated that it has been in existence worldwide since the 1930's and has been in existence in Kenya since 1964. There is no allegation that the defendant objected to the registration of the defendant under its name. No objection was also raised against the registration of the said trade mark by the plaintiff. The plaintiff states that it has established itself over the years in Kenya and East Africa as a serious provider of security services for both residential and commercial and all forms of security and has and continues to render high quality services in the security field where it has been a leader for over 24 years. It has also contended that for that period its trade mark "Group 4 Security" has been marketed, advertised and has received considerable repute and goodwill due to the high quality services the plaintiff renders that the name has become a household name which name is synonymous to security services offered and provided by the plaintiff. The defendant's response to those allegations is that the plaintiff has not furnished proof of the allegations and the same are not admitted. In the light of the conflicting affidavit evidence, the issue of goodwill or reputation is not clear cut.

I have however, observed the defendant's mark "Group 4 Securicor" and the plaintiff's mark Group 4 Security. The similarities at a casual glance are more than the differences. Indeed the only difference is

in the ending of the second word. In my view visually and phonetically the two marks are so strikingly similar that a casual observer would not easily notice the difference.

In Parke Davis & Company Limited – vs – Opa Pharmacy Limited [1961] EA 556 which was an action in passing off the Court of Appeal held that since the first two syllables in the trade name “Capsolin” and “Capsopa” were identical and there were resemblances in the containers there was a real probability of confusion and the appellant company was entitled to an injunction. The decision in that case was followed by Mbaluto J in Beierdorf AG – Vs – Emirchem Products Limited: HCCC No.559 of 2002 (UR) – who held that the trade mark “NIVELIN” was so strikingly similar to the trademark “NIVEA” that it would probably cause confusion to customers.

In Brooke Bond Kenya Ltd –vs- Chai Limited [1971] EA 10, the Court of Appeal held inter alia that the general impression of the average customer is the test of passing off. In that case the appellant sued the respondent for infringing its trade mark and for passing off its goods as the appellant’s. The infringement consisted of using the words “Green Label.” The packets used by the respondent had been changed to make them nearly resemble those of the appellant.

In the case at hand the defendant’s name was changed from Securicor Security Services Kenya Limited to G4S Security Services (Kenya) Limited in February 2006. The name “Group 4 Security” was neither in the earlier name nor in the new name. In the new name “Securicor” has been dropped. So the only reason why the defendant uses the make “Group 4 Securicor” is to enable it comply with the requirements of its parent company based outside Kenya. I do not find that a sufficient reason to deny the plaintiff, the protection given it by the statute particularly as the plaintiff’s name incorporates the trade mark. In a sense the plaintiff’s trade mark “Group 4 Security” is in reality its name: Group Four Security.

I am not persuaded that the plaintiff abandoned the use of the mark as alleged by the defendant. I have also not found any acquiescence by the plaintiff in view of correspondence exhibited by the plaintiff. There is for instance the plaintiff’s letter dated 14.2.2006 addressed to the defendant’s Managing Director over infringement of the said trademark. The opening paragraph is as follows:-

“We note with great concern that inspite of our several demands to yourselves that you refrain from using our trademark Group 4 Security; you have persisted in violating our exclusive statutory rights attaching to the said registered trademark.”

And when the defendant advertised themselves as “Group 4 Securicor” on 5.4.2006 the plaintiff immediately objected vide its letter of even date and threatened that it would file suit. That letter elicited a response from the defendant on 7.4.2006. The defendant noted the plaintiff’s concern and looked forward to amicable discussions to resolve the matter. In the premises it cannot be said that the plaintiff’s right to seek protection has been lost by acquiescence.

With respect to the contention that the registration of the said trademark did not give the plaintiff exclusive rights to the use of figure “4” and the words “Group” and “Security”, in principle that is correct. In my view however, the protection extends to the use of the words in the trade mark together viz “Group 4 Security” and not to the individual words or the figure. So whereas the individual words and figure were excluded from protection and were available for use by the defendant and indeed the entire world, the words and figure used as registered were exclusive to the plaintiff.

With regard to the contention that the services rendered by the plaintiff and the defendant are expensive and only utilized by sophisticated clientele thereby removing the possibility of confusion, I have found as follows:

The mark’s “Group 4 Securicor” and “Group 4 Security” are so similar that the possibility of confusion would not depend on the class, sophistication or economic worth of the clientele. Infact the enquiries made by M/s Monique Vaghters and Wallmart Limited in their letters dated 20.4.2006 and 19.4.2006 respectively addressed to the plaintiff put the issue beyond controversy.

In the premises, I am satisfied that the plaintiff has established a prima facie case with a probability of success that its trade mark “Group 4 Security” has been infringed by the defendant. With respect to the plaintiff’s application based on passing off by the defendant as stated above, the plaintiff had to establish the prerequisites summarized in the case of Reckitt Colman Products Limited – vs – Borden Inc and Others (Supra). In my view the plaintiff has not satisfactorily shown that its services have acquired a reputation in the market and are well known by some distinguishing feature as no independent customer vouched for the same in an affidavit in support of the application (See the decision of Ringera J as he then was in Supa Brite Limited –vs- Pakad Enterprises [2001] 2 EA 563. The plaintiff had also to show that there has been misrepresentation which deceived or is likely to deceive and that the plaintiff is likely to suffer damage by such deception of the respondent. The defendant has prima facie shown to my satisfaction that its decision to use the mark Group 4 Securicor is to enable it comply with the requirements of its parent company. In my view therefore the defendant is not guilty of deliberate misrepresentation or deceit even though the change in my view as already discussed above is likely to deceive. The defendant has not designed the change to injure the plaintiff’s business or good will. The probable injury to the plaintiff is clearly unintended. But should the defendant be permitted to continue using the mark notwithstanding that the plaintiff is the registered proprietor of a similar trade mark. I think not. I have already found that the similarities between the plaintiff’s mark “Group 4 Security” and the defendant’s “Group 4 Securicor” raise a real probability of confusion to customers. Such confusion in my view is likely to cause damage to the plaintiff. The plaintiff’s apprehension that it will suffer irreparable loss and damage unless the defendant is restrained is not altogether without basis. In my view actual loss need not be proved at this stage. In Pharmaceutical Manufacturing Company – vs – Novelty Manufacturing Limited: HCCC No.746 of 1998 (UR), Ringera J as he then was observed as follows at page 14 of his judgment:

“Registration of a trademark confers the right to exclusive use of the mark. Infringement of the trade mark is a tort of strict liability. Intention and motive are irrelevant considerations. And as the right is a statutory one acquiescence cannot constitute an estoppel or any other defence which the statute itself does not recognize.”

The Learned Judge was dealing with a dispute over the word “TRIHISTAMIN” a registered trade mark and “TRI-HISTINA” which was being used to compete with the registered trade mark.

In the result I have no hesitation in holding that the plaintiff has established the 1<sup>st</sup> and 2<sup>nd</sup> tests set out in the case of Giella –vs – Cassman Brown and Company Limited (Supra) 1973 to wit a prima facie case with a probability of success at the trial and that the injury complained of with regard to infringement of its trade mark would not adequately be compensated in damages.

In finding that the plaintiff has satisfied the conditions for the grant of interlocutory injunctive relief, I am alive to the fact that the plaintiff has inter alia sought the same prayers in the plaint. This finding does not amount to a determination of the plaintiff’s suit at this interlocutory stage. I will in the end allow prayers 2, 3 and 4 of the application. The orders of 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 one director of the plaintiff. The said undertakings to be filed within seven (7) days of today.

Costs shall be in the cause.

Orders accordingly.

DATED AND DELIVERED AT NAIROBI THIS 13<sup>TH</sup> DAY OF NOVEMBER, 2006.

F. AZANGALALA

JUDGE

13.11.2006

Read in the presence of:- Mbabu for the applicant and Kiragu for the defendant/respondent.

F. AZANGALALA

JUDGE

13.11.2006