



REPUBLIC OF KENYA
IN THE HIGH COURT OF KENYA
AT NAIROBI (COMMERCIAL DIVISION –MILIMANI)

CIVIL CASE NO. 608 OF 2004

DINAH BHOKE MAKINI T/A DR. MARY RIZIKI.....PLAINTIFF

VERSUS

WILLS WANJALA.....1ST DEFENDANT

MUSA AYUB alias MUSA GATI MAGIGE.....2ND DEFENDANT

ISAAK MAGIGE T/A MAKINI HERBS CLINIC.....3rd DEFENDANT

RULING

The Chamber Summons dated 3rd November, 2004 was brought under Order 39 Rules 2 and 3 of the Civil Procedure Rules and Section 3A of the Civil Procedure Act. It is by the Plaintiffs and it is seeking mainly three orders which are:-

(a) That the Defendants by themselves, their servants, agents or otherwise be restrained by a temporary injunction from selling or offering for sale their products and services under the name of MAKINI HERBS CLINIC pending the hearing and determination of this application inter partes;

(b) That the Defendants by themselves, their servants, agents or otherwise howsoever be restrained by a temporary injunction from selling or offering for sale their products and services by passing them off as being those of the Plaintiffs' MAKINI HERBAL CLINIC pending the hearing and determination of this application inter partes;

(c) That the Defendants by themselves, their servants, agents or otherwise howsoever be restrained by a temporary injunction from using the name

“MAKINI” in relation to their practice of herbal remedies services until the hearing and determination of this application inter partes.

The Plaintiffs further sought the above orders until the hearing and determination of the suit.

The main grounds for the application are as follows:-

(I) That the Plaintiffs run a natural remedies clinic in the name and style of MAKINI HERBAL CLINIC which clinic carries on continuous mobile clinics throughout the country;

*(ii) That the Defendants who until recently were in the employment of the Plaintiffs have since then been passing off their products and services as those of the Plaintiffs under the trade name **MAKINI HERBS CLINIC***

*(iii) That the Defendants have advertised their products and services using the name **MAKINI HERBS CLINIC** while disparaging the Plaintiff's clinic **MAKINI HERBAL CLINIC** vide radio transmission on occasions including:*

(a) Kenya Broadcasting Corporation's National Service on 2.10.2004 at approximately 19.21 Hrs.

(b) Kenya Broadcasting Corporation's National Service on 12.10.2004 at approximately 20.15 Hrs

(iv) That as the Plaintiff's business flourishes on the trust of their clientele, the quality and integrity of their products and members of staff the Plaintiffs have been greatly injured in their reputation and have suffered and will continue to suffer loss and damage.

*(v) That the Defendants threaten to and intend unless restrained by the Court to repeat their actions and conduct aforesaid and to continue selling their products and services under the name **MAKINI HERBS CLINIC** not in fact the Plaintiffs' products and services and to pass off the said products and services as those of the Plaintiffs;*

The Chamber Summons is supported by three affidavits sworn by the 1st Plaintiff, one Samuel Ngure Mungai and one Mary Nyambura Ngure. The 1st Plaintiff also swore a supplementary affidavit and a further supplementary affidavit. To these affidavits are several exhibits annexed.

The Respondents opposed the application and filed a Replying affidavit of the 1st Respondent who also swore a further affidavit. Grounds of Opposition have also been filed. To the said affidavits were annexed several exhibits.

The application came before me for hearing on 29th November, 2004 and 6th December, 2004. Mr. Ngaru Learned Counsel argued the application for the Plaintiff and Mr. Kwame Learned Counsel opposed the same for the Defendants.

In his oral submissions in Court, Counsel for the Plaintiffs recited the averments in the affidavits in support of this application. He emphasized that the Plaintiffs run their practice of natural remedies in the name and style of **MAKINI HERBAL CLINIC** which name has been widely publicized through all the known media of the trade and the general public in Kenya with the result that the said name in the trade and to the general public signifies the Plaintiffs' products and services. The Plaintiffs have thus acquired goodwill and substantial reputation in and by the use of the said name. Indeed the name **MAKINI** is derived from the surname of the Plaintiffs and emanates from the 1st Plaintiffs husband and 2nd Plaintiff's father one Dr. Morris Makini who carried on the same business in the name and style of **MAKINI UTAMADUNI HERBS**. Counsel further submitted that the Defendants who are the Plaintiffs' former employees have on many occasions wrongfully sold and passed off their products and services, as those of the Plaintiffs to the detriment of the Plaintiffs' established goodwill.

The Defendants have done so by the use of the name **MAKINI HERBS CLINIC** and by advertising the sale of their services and products under the said name on brochures which bear striking, resemblance to the Plaintiffs' brochures. Further that the get-up of the Defendants' brochure strikingly resembles the Plaintiffs' and the Logo is exactly the same as the one owned and used by the Plaintiffs. In Counsel's view the Defendants' actions are calculated to deceive and mislead and have in fact deceived and misled the trade and the general public into the belief that the Defendants' products, and services are the Plaintiffs'. The Defendants have therefore thrived, on the fact that the Plaintiffs' clients would not be able to tell the difference between the name **MAKINI HERBS CLINIC** and **MAKINI HERBAL CLINIC**.

In Counsel's view the consequence of the Defendants' actions is that the Plaintiffs have been greatly injured in their reputation and have suffered loss and damage hence the filing of this application. Counsel relied on the case of *Supa Brite Ltd –v- Pakad Enterprises Ltd* (2001) 2 E.A. 563 on the basis of which he submitted that the Plaintiffs had shown a prima facie case with a probability of success at the trial.

Anticipating submissions on behalf of the Defendants' counsel argued that whereas the Plaintiffs had filed NAIROBI CMCCC No. 3588 of 2004, the same is against the 1st Defendant only, the cause of action is different and the reliefs sought are different.

Regarding incorporation of Makini Herbs and Research Centre Limited, Counsel submitted that, the 1st Plaintiff did not know what she was signing when she placed her signature on the forms for incorporation of the said company and in any event the company is not trading and has not filed any returns at the Registrar of Companies offices.

Counsel for the Defendants in responding to the submissions made on behalf of the Plaintiffs argued that the alleged passing off action is a camouflage of a business partnership that has collapsed. This argument is made on the basis that there exists a company by name Makini Herbs and Research Centre limited trading and marketing its services as **MAKINI HERBS CLINIC** and whose directors are the 1st Plaintiff, the 1st Defendant and the 2nd Defendant and this company has been trading as **MAKINI HERBS CLINIC and MAKINI HERBAL CLINIC** interchangeably. In Counsel's view the Plaintiffs cannot claim exclusive entitlement to the use of the name MAKINI.

Counsel further submitted that the 1st Plaintiff is a former spouse of the 1st Defendant and before the incorporation aforesaid they carried on business as partners using the name **MAKINI** and any goodwill acquired is attached to both of them and not to any one of them individually. As the above facts had not been disclosed by the 1st Plaintiff when she obtained ex-parte orders, the 1st Plaintiff is in the circumstances guilty of material non-disclosure so Counsel submitted. Counsel also submitted that despite the registration of the business name **MAKINI HERBAL CLINIC** the 1st Plaintiff continued to do business with the Defendants until late December, 20003 when she started offering parallel services. In Counsel's view the question of passing off does not arise and the Plaintiffs are not entitled to any protection.

It was further argued for the Defendants that they were never employees of the Plaintiffs as alleged and no document had been exhibited to support this allegation. The above arguments notwithstanding, Counsel for the Defendants submitted that in fact there has been no misrepresentation, confusion, deception or passing off and in sum the Plaintiffs had not shown a prima facie case with a probability of success at the trial.

Counsel for the Defendants has also argued that this suit and application are *res judicata* as there is **NAIROBI CMCCC No.3588 of 2004** in which the matters in issue are also directly and substantially in issue between the same parties. Counsel submitted that an application for injunction in that suit was declined and the Plaintiffs are not entitled to the reliefs sought herein.

Reliance was placed upon several authorities. I do not have to cite them here but I will have the principles therein in mind in considering this application.

The above are the rival submissions for and against the application. I have considered the submissions. I have also perused the pleadings, the application the several affidavits, and the annexures thereto. Having done so I take the following view of the matter.

The gist of the Plaintiffs' application is that the Defendants who until recently were the Plaintiffs' employees have been passing off their products and services as those of the Plaintiffs under their trade name **MAKINI HERBS CLINIC** which is similar to the Plaintiffs trade name of **MAKINI HERBAL CLINIC** with the result that the Plaintiffs have been injured in their reputation and have suffered damage and loss by the Defendants' misrepresentation or deception.

The Defendants' answer to the Plaintiffs' case is that they have never been employees of the Plaintiffs at all. To the contrary the 1st Plaintiff, the 1st Defendant and the 2nd Defendant have been business partners and had been doing business under the name **MAKINI HERBAL CLINIC** which business was formerly registered as **MAKINI HERBS AND RESEARCH CENTRE** and later incorporated under the name **MAKINI HERBS AND RESEARCH CENTRE LIMITED**. There was then a fall out between the 1st Plaintiff and the 1st Defendant and the Plaintiffs commenced parallel clinics. The first Defendant was not only a business partner but also the 1st Plaintiff's spouse before the fall out.

In **RECKITT AND COLMAN PRODUCTS LTD –V- BORDEN INC. AND OTHERS (1990) 1 WLR 59**, it was held:

“(1) The principles of the Law of passing off were well established in that no man was to sell his goods as those of another; that the elements which a Plaintiff had to prove were:

(a) that he had acquired a reputation or goodwill connected with the goods or services he supplied in the mind of buyers and such goods or services were known to the buyers by some distinctive get-up or feature;

(b) that the Defendant had whether or not intentionally made misrepresentations to the public leading them to believe that the Defendant's goods or services were the Plaintiff's and

(c) that the Plaintiff had suffered, or in a quia timet action was likely to suffer damage because of the erroneous belief engendered by the Defendant's misrepresentation, and that all the three elements were questions of fact.”

At this stage of the proceedings my concern is whether or not in the light of the above principles the Plaintiffs have satisfied the conditions for the grant of a temporarily interlocutory injunction as set out in the rule setting case of GIELLA –V- CASSMAN BROWN & CO. LTD (1973) E.A. 358. The Plaintiffs therefore had to first show a prima facie case with a probability of success at the trial.

The main dispute revolves around the use of the word **MAKINI** in **MAKINI HERBS CLINIC** and **MAKINI HERBAL CLINIC**. The evidence I have perused has on a prima facie basis not shown that the Defendants were former employees of the Plaintiffs. The 1st Defendant has exhibited a certificate of Registration of **MAKINI HERBS AND RESEARCH CENTRE** which indicates the 1st Plaintiff, the 1st Defendant and the 2nd Defendant as business partners carrying on business at L.R. No. 209/6556/1 Trishul Towers Muranga Road/Ngara junction Nairobi. The Certificate was given on 1st February, 2000.

The 1st Defendant has also exhibited a Certificate of Incorporation of **MAKINI HERBS AND RESEARCH CENTRE LIMITED** which certificate was given on 6th June 2000. The subscribers were the 1st Plaintiff, the 1st Defendant and the 2nd Defendant. The subscriber's signatures were witnessed by an advocate called D.K. THUO of P.O. Box 62210 Nairobi.

The above documents on a *prima facie* basis show that the 1st and 2nd Defendants were not employees of the Plaintiffs as alleged by the Plaintiffs. There is no other material showing the contrary position.

The 1st Defendant has also deponed that for close to 10 years he cohabited with the 1st Plaintiff as husband and wife. This deposition has not been controverted by the 1st Plaintiff in her response to the affidavit containing this averment. This may suggest that the 1st Defendant was not only a business partner but also a family member of the Plaintiffs. On a prima facie basis I am persuaded that the 1st Defendant and the 2nd Defendant did business together with the 1st Plaintiff not as employees but on a level suggesting co-ownership of the business. This being my view of the relationship between the 1st Plaintiff and the 1st and 2nd Defendant I find also on a *prima facie* basis that any reputation or goodwill attached to the use of **MAKINI HERBAL CLINIC OR MAKINI HERBS CLINIC** is not exclusive to the Plaintiffs but to all the owners of the business.

From the above findings it is obvious that the Plaintiffs have not at this stage established the elements set out in the case of Reckitt & Colman Products Limited –v- Borden Inc. and Others (supra). It follows therefore that the Plaintiffs have not shown a prima facie case with a probability of success at the trial. It is therefore unnecessary to consider the other conditions set out in the case of Giella –v- Cassman Brown and Co. Ltd (supra).

Before leaving this matter I feel constrained to comment on the issue of res judicata canvassed before me by both Counsel. I have perused Nairobi CMCC No.3588 of 2004 and I have found that the plea of *res judicata* is not available for the reasons that the cause of action and the reliefs sought are not the same and the parties to that case are the Plaintiffs and the 1st Defendant excluding the 2nd and 3rd Defendants herein. My concern however is that no explanation has been given to the Court as to why the Plaintiff did not bring the present action earlier as they have alleged that they dismissed the Defendants way back in February, 2004 and the Defendants have since been passing off their products and services as those of the Plaintiff under their trade name **MAKINI HERBAL CLINIC**.

Another complaint raised by the Defendants and which I feel it is only fair to comment upon is the allegation of material non-disclosure on the part of the Plaintiffs at the time they obtained the ex parte interlocutory injunction. The 1st Plaintiff did not breath a word about the fact that she had been convinced by the 1st Defendant to register **MAKINI HERBS & RESEARCH CENTRE** first as a business name and later in September, 2000 as a company. She also did not disclose that they had agreed that **MAKINI HERBS & RESERCH CENTRE** would be used for research purposes only.

In my view these non-disclosures were material non-disclosures and if the facts had been disclosed at the time of obtaining the ex-parte interlocutory injunction it may very well have been declined. If this application hinged on the non-disclosures, I would have held for the Defendants and dismissed the application.

However, as I have found that the Plaintiffs have not shown a prima facie case with a probability of success, I order that the Plaintiff's application dated 3rd November, 2004 be and is hereby dismissed in its entirety with costs to the Defendants. Orders accordingly.

DATED AND DELIVERED AT NAIROBI THIS 18TH DAY OF FEBRUARY, 2005.

F. AZANGALALA

JUDGE

Read in the presence of: