REPUBLIC OF KENYA

IN THE HIGH COURT OF KENYA AT NAIROBI

CIVIL CASE NO. 1447 OF 1999

UNILEVER PLC ..... PLAINTIFFS

VERSUS

BIDCO OIL INDUSTRIES ..... DEFENDANT

JUDGMENT

In a plaint dated 12th October, 1999 and filed into the Court on the same day the plaintiff, Unilever PLC claims that at all material times it was the registered proprietor of three trade marks namely trade mark Number 3477, Blue Band in class 42 (Schedule 11), trade mark No 16231 Blue Band in class 29 (Schedule 111), and Trade Mark Number 16589 Blue Band in class 29 (schedule 11). The registered marks have been so registered since 20th March, 1947, 19th November, 1968 and 22nd April, 1990 respectively and it has been manufacturing margarine under its trade marks since 1947. The same registered marks, according to the plaint have been used to distinguish the margarine manufactured by the plaintiff and its licenses for similar goods of other manufacturers and traders. It thus claims in the same pleading that the registered marks “Blue Band” has acquired substantial reputation as its trade mark such that the registered marks and device depicting a Band around its packaging are and have been known at all times by the trade and the public to denote the goods of the plaintiff and the plaintiff has acquired a substantial goodwill in the name and the device. He contends that the defendant has since August 1999 or thereabout infringed the Blue Band registered mark by using in the course of trade in Kenya in relation to margarine a brand under the name Gold Band and the device of a Band on the packaging bearing its product. It maintains that the use of the name and colour followed thereafter by the word Band which has been associated with the plaintiff’s margarine coupled with the use of the device of a Band on its packaging has caused or is likely to cause confusion in the minds of the public into thinking that the defendant’s product is associated with the plaintiff’s product or that the defendant’s product is manufactured by the plaintiff. It is thus claiming in that plaint that the defendant has infringed, threatens, and intends to continue to infringe its registered marks “Blue Band” and further it is also contending that the defendant has wrongfully sold and passed off margarine not of the plaintiff’s manufacture or merchandise in a name that has an integral part of the plaintiff’s registered trade mark. In the result, the plaintiff is seeking judgment against the defendant for a declaration that it is the registered proprietor of the trade mark “Blue Band” in the three classes mentioned hereinabove; a declaration that the defendant has infringed the plaintiff’s “Blue Band” trade mark by manufacturing, selling, promoting and generally dealing with margarine named Gold Band; and injunction restraining the defendant from infringing in anyway its registered marks “Blue Band”; an injunction restraining the defendant from passing off its goods as the goods of the plaintiff by using any deceptive by similar shape, colour, configuration, overall design and general appearance and also from using a deceptively similar marks namely Gold Band or otherwise causing such goods to be passed off as plaintiff’s goods; an injunction restraining defendant from manufacturing, importing, distributing, selling or offering for sale any margarine or other products

bearing the name Gold Band or any other brand, mark or designation bearing a close resemblance thereto. The plaintiff is also seeking other orders and these are, first, an order for the delivery to the plaintiff, or destruction on oath, of all infringing "Gold Band" brand margarine within the defendants's possession, custody or power, which would otherwise offend the provisions of the injunction sought hereinabove; an order for the delivery of all documents relating to the manufacture, importation, purchase, sale, distribution or offering for sale of the Gold Band margarine which infringe the plaintiff's trade mark, and an order that the defendant discloses the names and addresses of all those who have supplied it with the same goods and all those to whom it has supplied the offending goods together with the sales and details of quantities so supplied and given thereof, and lastly, it is praying for judgment that an inquiry as to damages or alternatively at the plaintiff's option, an account of profits made by the defendant as a result of the infringement of the defendant's trade mark and an order of payment of any sums found due together with interest thereon at court rates. It is also praying for costs of the suit.

The defendant filed a statement of defence in which it denied the plaintiff's allegations and maintained that the margarine known as Bidco Gold Band is entirely dissimilar and different from the plaintiff's Blue Band and denied that the use of such words amounted to passing off or attempting to pass off. It also denied that its Bidco Gold Band infringes the plaintiff's registered marks "Blue Band" and lastly it denied that its use of the name Bidco Gold Band in connection with its margarine is calculated to lead or has in fact led to any deception or to the belief that its margarine is that of the plaintiff.

The plaintiff called five witnesses in support of its case. I will give a brief summary of the evidence of each of the same witness as I feel this may be important for the decision of the entire case before me.

PW 1, Rosemary Wandie was a seventeen year old school girl. She had been sent to the shop to buy Blue Band margarine but as she was in a hurry, she bought Gold Band margarine thinking it was a new margarine East Africa Industries had decided to make. She later wrote a letter to the company (East Africa Industries) seeking to know why the company had changed the name of their margarine and also why they had changed even the container. She wanted the company to let all know of the change so as to avoid any confusion. The letter to E A Industries was written on 12th June, 2000. In cross-examination, she stated that she bought the same Gold Band margarine thinking it was new margarine East African Industries had decided to make. She later wrote a letter to the company (East Africa Industries) seeking to know why the company had changed the name of their margarine and also why the company had changed even the container. She wanted the company to let all know of the change so as to avoid any confusion. The letter to E A Industries was written on 12th June, 2000. In cross-examination, she stated that she bought the same Gold Band from a shop at Kula Mawe in Isiolo. She bought *unga*, eggs, *Muchuzi* mix, a packet of Omo and the Gold Band. She asked for Blue Band but was given Gold Band which she could read. She checked the label of he Gold Band and she was not confused as the label and colours were different. She described the colours of Blue Band and that of Gold Band as well as the labels of the tins. She admitted that the names of the two were also different. Although she did not know who the manufacturers of Gold Band were, she thought it was manufactured by EA Industries. She confirmed on seeing the photograph of Gold Band that it was the photograph of what was similar to what she bought and that it had the word Bidco on top of Gold Band. She did not check the name of the manufacturer and used the name on the Blue Band containers to write to EA industries. She however did not have the same container of Gold Band in court as her mother threw it away. She also did not have the receipt for the things she bought that day and she admitted that in her letter she said she did not check the name on the container which prompted her to write the same letter. In re-examination she said that the shop from where she bought Gold Band does not normally issue receipts for goods bought from there.

Miriam Mohamed was the second plaintiff's witness. She lives at Kibera Olympic in Nairobi. She does small scale business and is a house wife. She knows product called Blue Band and has used it since she was born. She also knows product called Gold Band which she used once when she went to the shop and got confused. She saw it was Gold Band but she bought it on grounds that she wanted to see to what extent Blue Band had been improved as earlier on East Africa Industries had said they would improve Blue Band and so thought Gold Band was the improved Blue Band. She observed the difference between the two products when they were spreading Gold Band on bread. She noted Gold Band was chilly, hard and too much salty. She did nothing about it, but later researchers approached her and took her way.

When shown picture of Blue Band and Gold Band containers (part of exhibit 1), she stated that the two pictures do not look the same. The words Gold Band confused her because she thought that that word "Gold " had been used in place of "Blue" as part of the improvement E A Industries had promised to carry out. In crossexamination she said that prior to her buying Gold Band, she had heard the name of Bidco Oil Refineries and she know what they were manufacturing for sale in the market particularly Chipsy which she had seen at the time she bought Gold Band she did not check the name of the manufacturer as she bought many things but later she checked and found that it was manufactured by Bidco and not by Unilever. According to her, the researchers approached her in the month of March, 2000, about the same time this case was filed. At that time when she bought Gold Band in February, 2000, Blue Band had not changed its colours as it had done at the time of hearing the case. The name Bidco Oil Refineries Ltd is written on the Gold Band container although the writings of the same are not pronounced. She also stated that the colours of Blue Band were changed in the year 2002 and that is when she saw advertisements about change. Shown the new Blue Band and its colours, and the Gold Band and its colours, she accepted that the two colours are not the same.

The third plaintiff's witness was Veronica Nyabera Osama. She was shown two Blue Band containers (one old type and one new) and Gold Band containers and she stated that she had seen all of them before but she had seen the old type container of Blue Band longest since she was born. She first saw Gold Band container in the year 2000. She went to Uchumi supermarket on Ngong Road to buy assorted things. She also wanted to buy Blue Band but she found the supermarket had brought Gold Band. She then bought two tins of Gold Band but when she went home and made tea, her husband was not happy with Gold Band Margarine, and her husband forced her to go and buy Blue Band margarine as he said Gold Band margarine was salty. She then wrote a letter of complaint to East Africa Industries as she knew that any product with the word "Band" was from East Africa Industries. On cross-examination she stated that she did not retain any copy of the letter she wrote to E A Industries. She wrote it in the month of March, 2000. She said the colours of Blue Band margarine container and that of Gold Band margarine container are not the same. She saw people from E A Industries on this matter in the year 2001 as she had explained in her letter to East Africa Industries on how to trace her. She recorded a statement with E A Industries in early 2001. At the end of her evidence she confirmed on seeing the pictures of Blue Band container and Gold Band container that the two pictures were different.

Margaret Mwaura, the forth plaintiff's witness is the change manager with the plaintiff. She was earlier on before January, 2002, the marketing manager with the plaintiff's company. She was mainly responsible for all food products. She was also in that capacity, responsible for marketing of Blue Band and *Roiko*. She was shown a number of exhibits which were promotional items and after describing each of them, she stated that in all of them the words, "Blue Band" is common. She also stated that "Blue Band" was registered and the label is also registered. The words "Blue Band" had been registered as a trade mark. She stated that the defendant had produced product called Gold Band since 1999, but the defendant does not have a registered trade mark in that name. She then referred to the advertisement of Gold Band and maintained in her evidence that the advertisement of Gold Band does not contain the words "Blue Band" in them, nonetheless when she looks at the advertisement she sees colours of Blue Band in it. Blue Band was registered in 1947 and was launched in 1955, so that by the time Gold Band was launched in 1999, Blue Band had been in the market for 44 years. Although the packet of Blue Band and the packet of Gold Band do not look alike, when she sees the advertisement for the same, she realizes that the association of Band with colour is an association done by the plaintiff. The names Blue and Bandare Unilever creations and consumers may be led to believe that there is an association between whoever uses the names with Unilever. She added that the plaintiff was not objecting to the way the product looks, but was objecting to the use of the word Gold Band in association with Blue Band. The plaintiff, according to this witness feels the use of the word "Gold Band" can mislead consumers into thinking that it is associated with Blue Band. The word Band has no association with margarine, the product which the two litigants are selling. She referred to radio advertisement which says "Go, Go, Go for Gold" which does not refer to Bidco.

In cross-examination, she was shown Blue Band margarine container and Gold Band container and she confirmed that on the Blue Band margarine container, what is written is "Energy to Grow" whereas in the Gold band what is written is "Nature's Best is only Better" and these were not similar. She also stated that

colours were quite different. However, they were of the same weight, but shapes of the two containers were also different. Names were distinct, but they shares common name of “Band”. “Band” can be a colour. The name Gold Band is surrounded by a circle on top of it whereas the name Blue Band is surrounded with colour blue. The packaging yellowish and blue was changed in July 2001 and the plaintiff now has moved to new type – which is a light yellow and distinct blue colour which are not similar to Gold Band. Blue Band has now a blue top which Gold Band does not have. The plaintiff, according to this witness, lost some shares to Gold Band because of Gold Bands’s entry into the market using the word Band similar to the plaintiff’s word Band. She however, stated further that there is no proprietory right on the word “Band”. The plaintiff lost about 2% to 3% of the market. Loss at 2% translates to Ksh 40,000,000/=. She argued that after the plaintiff changed its colour, it was the plaintiff that got closer to the defendants colours. The plaintiff changed the colour because, it is an international company and its colours have to look alike internationally.

The last plaintiff’s witness was Frederick Onyango. He works with Steadman and Associates, which is a monitoring company. They listen to radio stations in Kenya and record all the advertisements. He is an advertisement recorder. The plaintiff and the defendant are their clients. In 1998, he recorded advertisement in relation to Blue Band and Gold Band products and took the Gold Band recording to the plaintiff and the defendant. He produced as exhibit the tapes that he made. When crossexamined, he said he made the recording in 1999 but he could not remember the date he made the same recording.

The defendant called one witness. Subra Manian Raman who was the Team leader in charge of administration at Bidco Oil Refineries Ltd (the defendant). They manufacture Bidco Gold Band amongst several other products. Bidco Gold is a margarine. On being shown different containers, he said Blue Band is manufactured by the plaintiff while Gold Band is manufactured by the defendant. He said these two, Blue Band and Gold Band, are not the only products with the word margarine on them. He showed the court another container with the word “Yellow Band Margarine” which he said was being manufactured by KAPA oil Refineries. He was not certain whether “Yellow Band Margarine” was still in the market but the trade mark was registered by KAPA Refineries as No 26018. He said that since the defendant started manufacturing “Gold Band” it had not received any complaint about the quality of their product. It has not received any complaint about the “get up”. The colours of the two products, Blue Band and Gold Band are different according to this witness. The defendant has not received any complaint on infringement of the trade mark.

On cross-examination, he said an application for registration of the defendant’s Gold Band trade mark was made. The plaintiff objected and the mater is still pending before the Registrar of Trade marks, so that “Gold Band” has not been registered as a trade mark. The word “Band” is common to both Blue Band and Gold Band. The word “Band” is a ring. Itcan also mean music word. Mixing products for margarine is called banding, but the word banding is not confined to mixing ingredients of margarine only. The defendant launched its product in 1999, but he did not know when Blue Band was first launched in the country, but from 1947 when the plaintiff claims to have launched its product to 1999 when the defendant launched its product, is 52 years and he was not certain whether any margarine had been around during the period of 52 years.

The above is a summary of the evidence that was adduced in this case.

There were several exhibits that were produced by the witnesses and I have considered them as well as they were indeed part of the evidence adduced in the case.

I have thoroughly perused the entire file and whereas I note that there is summons of directions filed in the file and that at one time a date was fixed for directions, there is nothing in the file to indicate that directions were given in the case and in particular , there is no evidence that issues were framed by the litigants nor that the parties agreed on the same issues. I will in the circumstances consider the case upon the issues that have arisen from the pleadings before me, the evidence adduced at the trial, the submissions by the learned counsel and the law applicable.

Although the defendant in its defence at paragraph 2 says it makes no admission of the plaintiff’s

allegations that the plaintiff is and was at all material times the registered proprietor of the trade mark "Blue Band" in different classes as stated at paragraph 3 of the plaint filed by the plaintiff, during the hearing of the case it was not disputed that the plaintiff is indeed the registered proprietor of trade marks "Blue Band". It is also not in dispute that these registered trade marks were at all material times valid. Even if this was in dispute, the evidence provided backed by exhibits availed would and do satisfy me that the plaintiff does hold the trade mark of "Blue Band" as no evidence has been adduced by the defendant to challenge the same.

In law, a proprietor of trade mark enjoys certain protection and section 7 of the Trade Marks Act chapter 506 Laws of Kenya states clearly what these protections are. It states as follows:

"7. Subject to the provisions of this section and section 10 and 22, the registration (whether before or after 1st January 1957) of a person in part A of the register as proprietor of a trade mark if valid gives to that person the exclusive right to the use of the trade mark in relation to the goods or in connection with the provision of any service and without prejudice to the generality of the foregoing that right is infringed by any person who, not being the proprietor of the trade mark or a registered user thereof using by way of permitted use, uses a mark identical with or so nearly resembling it as to be likely to deceive or cause confusion in the cause of trade or in connection with the provision of any services in respect of which it is registered, and in such manner as to render the use of the mark likely to:

(a) be taken either as being used as a trade mark;

(b) be taken in a case in which the use is upon the goods or in physical relation thereto or in an advertising circular or other advertisement issued to the public, as importing a reference to some person having the right either as proprietor or as registered user to use the trade mark or goods with which such person is connected in the course of trade".

Thus, as the plaintiff is the registered proprietor of the trade mark "Blue Band", the same registration gives it the exclusive right to use the same trade mark in relation to margarine and anybody else who uses a mark identical with or so nearly resembling the same trade marks "Blue Band" as to likely to deceive or cause confusion in the cause of trade or in connection with the provision of any services in respect of which it is registered, and in such manner as to render the use of the mark likely to:

(a) be taken either as being used as a trade mark;

(b) be taken in a case in which the use is upon the goods or in physical relation thereto or in an advertising circular or other advertisement issued to the public, as importing a reference to some person having the right either as proprietor or as registered user to use the trade mark or goods with which such person is connected in the course of trade.".

Thus, as the plaintiff is the registered proprietor of the trade mark "Blue Band", the same registration gives it the exclusive right to use the same trade mark in relation to margarine and anybody else who uses a mark identical with or so nearly resembling the same trade marks "Blue Band" as to be likely to deceive or cause confusion in the cause of trade in margarine would be stopped by law from doing so.

In this case the defendant also manufactures margarine and the plaintiff alleges that the defendant's use of the words "Gold Band" in its margarine containers infringes its trade mark of "Blue Band" in that the word "Band" has been used by the plaintiff for many years (to be precise for over 50 years) and is a fancy word unconnected with the product margarine and so the defendant in using the word "Band" in its containers of margarine is creating confusion or is likely to create confusion in the trade. The defendant on the other hand maintains that its get-up on its containers is different and the words used in its containers are "Bidco Gold Band" which are not the same as the words "Blue Band" and in any case there can be no property in colour or in name. In short the defendant's stand is that none can be confused by its use of the words "Bidco Gold Band" in its products and so there is no confusion or likely confusion to be caused by either the get-up or the words on the defendant's products.

It does not appear to me that there is any dispute on the question of passing off. Mr Ochieng, the then learned counsel for the plaintiff did in his submission before Hon Justice Hewitt on the application for injunction state as follows:

“Get – up is not in issue by which I mean “get-up” is not confusing”.

This was a remark made and recorded in the file and is part of the record. I cannot ignore it as I believe in a final judgment, the entire file must be considered. Even if I were minded to ignore it, it is still clear from the evidence before me that the plaintiff does not dispute the get-up on the containers of Gold Band margarine. PW 1 in her evidence said in crossexaminationthat she bought Gold Band although she had gone to the shop to buy Blue Band. She said further that she checked label and saw Gold Band, and that:

“I know the colour of Blue Band. Lid is yellow, container is white with blue stamp at the middle. Gold Band had a cream colour with a Goldish ring on the side of it. When I was given the tin, I saw immediately that the colours were different. I checked the label which was written “Gold Band”. I was not confused and did not think of anything else.”

and when shown a photograph of Gold Band margarine she said:

“This is what I bought. It has words “Bidco” on top of “Gold Band.”

PW 2 also stated when shown pictures of Blue Band and Gold Band in her evidence in chief:

“I am familiar with the picture. It is Blue Band. I now see the product pictured here at page 3 – Document No

3. It is Gold Band. The two pictures do not look the same.”

And in cross examination she said *inter alia*;

“The names are different. One is Gold Band and the other Blue Band Margarine.”

And stated further:

“The colours of the new Blue Band are not the same as the Gold Band colours.”

In the same vein, when PW 3 was shown pictures 2 and 3 in exhibit 1 she readily said in cross-examination that picture 2 is that of Blue Band and picture 3 is of Gold Band and said:

“colours are not the same”.

The effect of this evidence adduced from the ordinary members of the society who were called by the plaintiff as witnesses is that the get-up of Gold Band containers was not in any way confusing as the colours were clearly different and the names were also different. I also had the opportunity to see the exhibits in Court and I do agree that there can be no dispute as to passing off as the two products are in my mind different in colour appearance and in the wording except that the word “Band” is used in both. I do find therefore that the defendant cannot be found liable in tort of passing off.

That leaves the main bone of contention between the parties to be one and that is whether or not the plaintiff’s trade mark Blue Band is infringed. As I have stated above, the plaintiff’s contention is that its trade mark “Blue Band” is infringed in that the word “Band” which forms 50 % of its trademark has been used by the defendant and that has caused confusion or is likely to cause confusion. It maintains, again as I have stated above, that that word “Band” has been used by it for so long that its business in margarine has been associated with it and that as the word “Band” is not descriptive of its product but is a fancy word, its use by the defendant could have only been motivated by the urge to pass its goods as that of the plaintiff and hence an infringement of the plaintiff’s trade mark.

The law on infringement of trade marks is now well settled. I will refer to two cases which in my mind set out the general proposition of law applicable to a case such as this case such as this case before me. First is the case of *Ektiebolaget Johnkoping – Vulcan Indstricksfabriksaktie Bolag v East Africa March Co Ltd (1964)* to which I was referred by both parties. It was a High Court decision and although of persuasive authority only, I do feel it sums up the law particularly as regards the case before me for it deals with a case where the words used, ie "The Ship" and "The Steamship", were words that were not in themselves, in ordinary language descriptive of the product which were matches, like in this case where the word complained of ie Band is not descriptive of the product which is margarine. In that case Udo Udome CJ stated at various places as follows:

"As a general proposition of law, I think I am right in stating that the burden of satisfying the court that there has been an infringement of its trade mark is on the plaintiff company. It is for the plaintiff company to prove that there is a resemblance between the two marks and that such resemblance is deceptive. It is also a well established principle of law that it is the duty of the judge to decide whether the trade mark complained of does so nearly resemble the registered trade mark as to be likely to deceive or cause confusion in the minds of the public. From that duty the judge cannot abdicate."

What the trial judge upon whose shoulder the decision as to whether or not a trade mark complained of does so nearly resemble the registered trademark as to be likely to deceive or cause confusion in the minds of the public is to look for in such a decision is stated in the same case by the same learned judge at page 69 of the report. He says:

"In case of this kind the principle upon which relief is given by the Court is that a man cannot offer his goods for sale representing them to be the goods or manufacture of a rival trader; and such representation might take the form of the use of the same or similar trade mark or brand, which is the substance of the complainant in that case. To constitute such a representation it is not necessary that the trademark complained of should be absolutely identical with or resemble too close the mark or brand sought to be represented in every material particular.

As we said by Lord Cranworth LC in *Seico v Prevezende* (5) (1 Ch App At P 196);

"What degree of resemblance is necessary from the nature of things, is a matter incapable of definition a *priori*. All that Courts of justice can do is to say that no trader can adopt a trade mark so resembling that of a rival, as that ordinary purchasers purchasing with ordinary caution, are likely to be misled. It would be a mistake, however, to suppose that the resemblance must be such as would deceive persons who should see the two marks placed side by side. If a purchaser looking at the article offered to him would naturally be led, from the mark impressed on it, to suppose it to be the product of the rival manufacturer, and purchase it in that belief, the Court considers the use of such a mark to be fraudulent."

The second case I will refer to is the case of *Coca-Cola Company of Canada, Limited v Pepsi-Cola Company of Canada, Limited* [1942] KBD 615 where the Privy Council stated at page 616 as follows:

"The actual question for decision in the present case may, therefore, in the light of the above definition be stated thus; does the mark used by the defendant so resemble the plaintiff's registered mark or so clearly suggest the idea conveyed by it, that its use is likely to cause dealers in the users of non-alcoholic beverages to infer that the plaintiff assumed responsibility for the character or quality or place of origin of Pepsi-cola."

In the case before me, the product was margarine but from the submissions put forward by Mr Ochieng, the then learned counsel for the plaintiff, I got the feeling as I have stated above that having considered that the plaintiff had no complaint against the get-up, the plaintiff's problem was that the use of the word Band in its packages could mislead purchasers into believing that the plaintiff was the origin of the product Gold Band and to that extent, the plaintiff's trade mark was or would be infringed.

I have seen all the exhibits that were produced in this case, and I have considered them. I have also considered the evidence of the relevant witnesses on the question of whether or not they were confused by

the use of the word “Band” in the defendant’s package. PW 1 says in her first story that she was sent to buy Blue Band margarine, but she bought “Gold Band” because on that day she was in a hurry. Later in that same evidence in chief she said that when she went to the shop she asked for Blue Band Margarine but the shopkeeper gave her a container on which was written Gold Band and she though it was a new margarine the company had decided to make and she decided to buy it. In cross-examination, however, she gave a third version of her story and this time she said:

“On that day I bought *unga*, Eggs, *muchuzi* mix and a packet of *Omo*, and that Gold Band and Bread. I asked for Blue Band and he gave me Gold Band. I could read it. I checked label and saw Gold Band. I asked shopkeeper and he told me in Kiswahili. *“Hii ni Blue Band Mpya wamebadilisha Jina kama vile Omo.”*

And as if that was not enough, twelve days later in her letter to the sales manager EA Industries dated 12th June, 2000, she stated that when her mother asked her as to why she bought “the new brand of margarine” she told her mother:

“Mother, it wasn’t my choice, I only asked for Blue Band, Sorry I didn’t check the label in the container.

It is obvious to me that all these versions as to why she bought Gold Band instead of Blue Band cannot be true. I do agree with Mr Billing, learned counsel for the defendant, that this witness was not telling the Court the whole truth and much as I would not call her a liar as such, I do not think she was a reliable witness upon whose evidence one can rely for decisions. In any case she was not confused by the word “Band” on Gold Band container. At least she has not stated so. Her first version is that she bought Gold Band because on that day she was in a hurry and not because she was confused by the existence of the word Band on the container. Her second version is that she asked for Blue Band but when she was given Gold Band, she bought it because she thought it was a new margarine the company had decided to make. She knew only two well that it was a different container and she did not state as to why she thought it was a new product the plaintiff had decided to make. She had no reason to be confused. The third version is clearly a confusion brought about by the shopkeeper and not by the existence of the word “Band”. She says she saw the label, appreciated the difference and asked the shopkeeper and it was on the strength of the shopkeeper’s story that she bought the product. That is not confusion caused by the label or by package. In any event, I do agree again with Mr Billing, learned counsel for the defendant that that statement attributed to the shopkeeper was in itself hearsay evidence and was not admissible as the maker of it was not called to be crossexamined on its authenticity or otherwise. Thus, PW 1’s evidence as to whether the use of the word “Band” on the defendant’s package caused or was likely to cause confusion in the minds of the reasonable members of the public properly exercising their minds is not of any help to me first because, PW 1 is in my humble opinion not a reliable witness and secondly because even if I were to accept her evidence, still it does not reveal that she was confused by the words complained of and lastly, because in any event part of her evidence was hearsay and inadmissible in law. In any case, notwithstanding all the above, she stated in cross examination that she was not confused and I have reproduced the relevant parts of her evidence to that effect hereinabove, when I was considering whether or not passing off was in dispute.

PW 2 also stated in her evidence that she saw Gold Band but bought it on the strength that she thought it was an improved make of Blue Band because the plaintiff had said earlier that East Africa Industries would improve Blue Band, and so she thought it was an improved make and she wanted to know how far Blue Band had been improved. What created confusion in the mind of this witness is the fact that according to her, East Africa Industries had said earlier that they would improve Blue Band product and so when she saw Gold Band, she knew it was Gold Band but she thought it was an improved Blue Band but was a different product called Gold Band. It was until the researchers from the plaintiff’s company visited her house that she was taken to go and record a statement on the matter. Secondly, this witness said in evidence that she was approached by researchers in March 2000. That was not correct, but this witness was clearly in my mind a witness obtained by researchers after the case had been filed on 12th October, 199 and her evidence therefore requires careful scrutiny before I can rely on it. (See *Akt Jonk-Vulcan* case above at page 66). After careful scrutiny of her evidence however, she also does not testify that the word “Band” confused her. She in fact stated in her evidence that the names of the two products

are different and she admitted that the name of the manufacturer of Gold Band Margarine is there on the container but it is in small writing. She accepted that the name Bidco was written on top of the container and at the sides of the same tin of Gold Band margarine whereas on the Blue Band container no name was written. She also said that Blue Band colours had changed and the colours of the new Blue Band are not the same as the colours of Gold Band. I find it difficult to appreciate any confusion in the mind of this witness created by the use of the word "Band".

PW 3 identified different pictures shown to him during his crossexamination and said the picture of Blue Band was different from that of Gold band. When she went to Uchumi to buy Blue Band, she bought Gold Band knowing that it was different from Blue Band but she thought it was an improvement. The get-up did not confuse her and the use of the word "Band" also did not confuse him. The other two witnesses were an employee of the plaintiff company and an employee of a monitoring company who took tapes of advertisement. These were, for purposes of this case, not members of the public.

The three witnesses representing the public, ie PW 2 & PW 3 have not satisfied me that the use of the words "Gold Band" confused them and led them into buying the defendant's product believing it was the plaintiff's product.

I have also seen the exhibit – ie the packaging containers of old Blue Band, new Blue Band and Gold Band. I have considered the plaintiff's arguments that the word "Band" has been associated with plaintiff's product and that as it is a fancy name, not describing the product, the legal proposal that there is no property in a name or in colour cannot apply to it. I have also considered its further argument and evidence of PW 4 that 50% of the plaintiff's trade marks. The trade mark which is registered in the name of the plaintiff and which must be protected is "Blue Band" and not "Band". The word Band on its own is not protected and is not a trade mark. It is the combination of the words "Blue Band" that is a trade mark. That being so, can there be a property in the word "Band" capable of being protected. In my mind the answer must be no. The trade mark which can be infringed is "Blue Band" and not the word Band The learned counsel for the plaintiff argues that as part of the words "Blue Band" which is a registered trade mark has been infringed and as the word "Band" is a fancy word not descriptive of the product margarine there is infringement of the trade mark and there is a real probability of confusion. He has supported that argument with the decision of Crawshaw, JA in the case of *Parke Davies & Co Ltd V Opa Pharmacy Ltd* [1961] EA 556. However, for some reason, he did not in his submission refer me to the first holding in that case. That holding states as follows:

"(i) Since the first two syllables in the trade name used by each of the parties were identical and there were\resemblances in the containers there was a real possibility of confusion and the appellant company was entitled to an injunction."

It will be readily noted that in that case injunction was granted not only because the first two syllables in the trade names represented to the public that their goods are the goods of the plaintiff. I also hold that there is no satisfactory proof that the same words "Gold Band" or "Bidco Gold Band" so nearly resemble the registered trade mark of the plaintiff's products as to be likely to deceive or cause confusion in the minds of the public. The plaintiff's suit fails and is accordingly dismissed with costs to the defendant. Orders accordingly.

Dated and Delivered at Nairobi this 4th day of February 2004.

J.W.ONYANGO OTIENO

JUDGE