



REPUBLIC OF KENYA

HIGH COURT AT NAIROBI (MILIMANI LAW COURTS)

CIVIL SUIT 323 OF 2004

PAUL KUKUBO1ST PLAINTIFF

FATIMA ALI MOHAMED2ND PLAINTIFF

PARMAIN OLE NARIKAE 3RD PLAINTIFF

MARKETING SOCIETY OF KENYA 4TH PLAINTIFF

VERSUS

REOLLOUT PUBLISHING LIMITED..... DEFENDANT

RULING

By its application for the 2/4/2004 the Applicant seeks the following interlocutory orders pending the determination of this suit. In order to succeed the Plaintiff must demonstrate that it had right to an injunction in accordance with the principles laid down in *Giella v. Cassman Brown*. The Plaintiff is a Marketing Society, which has been distributing its magazine called "Sokoni" to its members. The Respondent is a printer and publisher, which undertook to print the magazine "Sokoni" for the Plaintiff.

There is a divergence of opinion between the Plaintiff and Defendant as to what the basis was for the publishing and printing by the Defendant of the magazine for the Plaintiff, this appears in the statement contained on the Affidavits of William Kalombo of the 14/4/2004 and Jane Njeru of the 19/4/2004. Which version of the facts is correct will have it be ascertained at the hearing of the suit. The Respondent raised by way of objection to the application the fact that the Plaintiff has not registered the Magazine under the provisions of the Books and Newspapers Act (The Act) this it was not required to do so as long as the magazine is restricted to distribution amongst its members. The Plaintiff now says it intends to circulate the magazine to members of the Public, which would require registration.

The Respondent has commenced to publish a magazine called "Sokoni africa" the word "Africa" is in smaller print below the word "Sokoni". The Plaintiff's claim is for the alleged unlawful "passing off" by the Defendant of the magazine "Sokoni africa" as that of the Plaintiff Magazine "Sokoni" In connection with the onus on the Plaintiff to show that it had a good cause of action with a probability of success Mr. Oseko for the Respondent submitted that the Plaintiff had failed to show that the essential ingredients in a passing off action existed. These ingredients were summarized in the case of *Reckit & Colman Properties Ltd v Borden In . (1990) 1 WLR page 491*. They were referred to by Mbaluto J in the case of *Beiersdorf AG. v Emirchem Products Ltd HCCC No. 559 of 2002* as follows as page 18

"First, (the Plaintiff) must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with identifying "get up". Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intention) leading or likely

to lead the public to believe that goods or services offered by him are the goods or services of the Plaintiff. Thirdly, he must demonstrate that he suffers or, in a quia timet action, that he is likely to suffer damages by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the Plaintiff" If the Plaintiff as it now says intends to distribute its magazine for payment to members of the public it must, register the magazine under the Act. However even if it now commits an offence as the Respondent alleges does this destroy its right to bring this suit. Contravention of a statute destroying a right brings a passing of suit was dealt with by Danckwerts J in the case of J. Bollinger & Others Costa Brava Wine Co., Ltd (1959) 1 Ch D page 262 where at page 286 he said " But 'where an Act' (1 cite now from the Judgment of Lord Tenterden) C.J. in Doe v Bridge) creates an obligation, and enforces the performance in a specified manner, we take it to be a general rule that performance cannot be enforced in any other manner"

I am of the view that even if the Plaintiff breached the provisions of the Act this does not disentitle it to its remedy in passing off, if one exists. Turning to the matters in issue in this case. It is clear that the names of the magazine are identical in all respects save that the word "africa " has been added to the Respondent's magazine. Prima facie there is a passing off. Does the Plaintiff have any goodwill or reputation attached to the name? This is a matter for the trial Judge but it is not in dispute that the Plaintiff has been publishing its magazine under the name "Sokoni " for some considerable time and it is not unreasonable to assume that some good will attaches to the name. Indeed if I did not it is difficult to see why the Respondent has adopted the same name.

Why did it not use some other name for its magazine? So far as damages is concerned leaving aside the question, in future of the Plaintiff selling its magazine to the Public, if as a result of the Respondent publishing its magazine with the name "Sokoni" which is likely to deceive anyone who has received the Plaintiff's Sokoni Magazine in the past this would be sufficient damage to support a claim for passing off. I would refer to the first holding in the Bollinger case referred to above which in my view adamantly states the matters pertaining to an action for passing off. Holding:-

"That the law of passing off was not so limited in scope as to allow a person competing in trade to attach to his product a name or description with which it had no natural association, so as to make use of the reputation and goodwill gained by a product genuinely indicated by that name and description, and that it made no difference if the persons truly entitled to describe their goods by that name were a class producing goods in a certain locality and not merely one individual, for the description was part of their goodwill and a right to property. The law would fail if, as a general rule, it could offer no remedy for the deliberate act of one person causing damage to the property of the another and it should, and did, provide a remedy for the type of unfair competition alleged in the statement of claim"

I have to consider whether damages would be an adequate remedy and the balance of convenience. If the Respondents are allowed to continue with their publication it is likely to damage the distribution of the Applicant's publication that in my view damages would not be an adequate remedy. The balance of convenience falls in favour of the Applicant. I therefore grant the orders sought pending the hearing of the suit subject to the Plaintiff giving an undertaking as to damages in the event that the Respondent succeeds. Costs will be in the cause

Dated and delivered at Nairobi this 24th day of June 2004

P.J. RANSLEY

JUDGE