



REPUBLIC OF KENYA
IN THE HIGH COURT OF KENYA AT MOMBASA
CIVIL CASE NO 66 OF 2000

SPA.....PLAINTIFF

VERSUS

JAMALE & ANOTHER.....DEFENDANT

RULING

The matter under consideration is the Chamber Summons dated 10.2.2000 which was taken out by the plaintiff in the main suit under section 7 of the Trade Marks Act cap 506, sections 3A, 63 (c) and (e) of the Civil Procedure Act and order 39 rules 1 & 2 of the Civil Procedure Rules:

Twelve prayers were sought in that application but only prayer 3 was argued before me as the others were reportedly dealt with. Prayer 3 seeks an order:

“That each of the defendants (whether by themselves or by any person appearing to be in charge of the premises hereinafter specified) be restrained from making, selling, offering for sale, exporting, smuggling, removing from jurisdiction, distributing or otherwise parting with possession, power, custody or control of or destroying or defacing or hiding or in any dealing with pasta marked Santa Lucia and Saint Lucie or any material used or intended for their preparations ,hereinafter called “the infringing goods” pending the hearing and determination of this suit”.

The plaintiff is a manufacturer of pasta and other foodstuffs in Italy under the Trade Mark “Santa Lucia” which products they say command a world - wide market and is sold in Kenya and East Africa. The said Trade Mark was registered in Kenya on 18.3.93 under the relevant provisions of the Trade Marks Act and Rules and a Certificate of Registration was issued accordingly. It was to last 7 years but is said to have been extended on 23.11.99 for a period of 14 years.

Whilst on a visit to Kenya in May 1999 the Sales Manager of the plaintiff saw more some labelled “Santa lucia” and trapped in cheap material without indicating where it was made unlike theirs which clearly showed it was made in Italy. He also noticed other pasta labelled “Saint Lucie” which had wrappings indicating that it originated in Dubai, UAE. None of the two types of pasta was being sold with the authority or knowledge of the plaintiffs. It was clear to the plaintiffs that the said goods were being peddled and passed-off as the plaintiffs’ goods and they were and deceptively similar to those marketed under their registered Trade Mark.

They took action immediately by drawing the attention of the public to such products in paid advertisements. Further investigations revealed that it was the defendants herein who were responsible for the distribution of the goods and indeed some 8 containers of them were being offloaded at the Port of

Mombasa in February 2000. They were taken to some fortified premises at Bondeni, Mombasa which are owned by the defendants.

Filled with fear and suspicion that the goods would imminently be released into the market the plaintiffs came to court on 11.2.2000 and filed suit seeking a permanent injunction to restrain the defendants from infringing on the registered Trade Mark amongst other prayers. The prayer sought in the application is interlocutory.

The defendants deny that they have infringed the plaintiff's Trade Mark, if any exists, and aver that the pasta marketed by them under the two trademarks was lawfully imported from the plaintiffs. The plaintiffs have merely brought the suit out of malice and business rivalry arising from complaints lodged by the defendants to the plaintiffs about the poor quality of their pasta supplied to them. They aver that the wrappings and trade marks complained of were in fact the plaintiff's own, which averment was denied by the plaintiffs on oath. There are claims and counterclaims of forgery.

The application was forcefully argued on both sides by counsel Mr Ojiambo and Mr. Omondi who cited several English and other authorities *in extenso*. If I do not refer to them in similar fashion it is not out of disrespect for counsel but because I am satisfied that I need only at this stage examine the Affidavit evidence on record without making conclusive findings of fact to satisfy myself whether the plaintiffs have made out a *prima facie* case with a probability of success, secondly whether even in such case, they are likely to suffer loss which is incapable of recompense in damages and if I am in doubt where the balance of convenience tilts.

Those are the principles set out in the locus classicus case of *Giella -vs- Cassman Brown & Co Ltd* [1973] EA 318.

On the face of it, the plaintiffs have indeed a registered trade mark in Kenya. The Certificate issued by the Registrar of Trade Marks under the Trade Marks Act is exhibited. Although it was pointed out by counsel for the defendants Mr Omondi that "the Certificate is not for use in legal proceedings", as it says so in a footnote thereon, I find such footnote as of no legal consequence in the face of the substantive provision in the Act under section 46 that Registration shall be *prima facie* evidence of validity in all legal proceedings. The Certificate is simply one of the forms under the Fourth Schedule of the Act (Form TM 10A) whose provision is made for under rule 4 of the Trade Marks Rules and are, subject to modification. Section 7(1) (a) (b) and (d) of the Act which it is submitted has been infringed states:

7. (1) Subject to the provisions of this section and of sections 10 and 11, the registration (whether before or after 1st January; 1957) of a person in Part A of the register as the 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 services 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 course of trade or in connection with 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 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 trademark or goods with which such a person is connected in the course of trade;

(d) cause injury or prejudice to the proprietor or registered user of the trade mark".

I have carefully examined the two trademarks complained at by the plaintiffs. There is little doubt that they are deceptively similar to the Registered Trade Mark of the plaintiffs. The two are admittedly not registered as Trade Marks anywhere. I doubt the seriousness of the contention by the defendants that the

two offending trade marks were indeed the creation of the plaintiffs themselves who were peddling substandard goods imported from them by the defendants. The truth will out when oral evidence is subjected to cross examination, At this stage I am persuaded that the plaintiffs have made out a *prima facie* case that there is an infringement at their trade mark under section 7 at the Act.

I am also persuaded that the product at the plaintiffs is marketed worldwide.

To allow the indiscriminate flouting of Registered Trade Marks would not only negate the purpose of the law on Registration of Trade Marks but would also make non-sense of commercial World order. Irreparable damage would ensue and in my view an injunction is the most efficacious remedy. Any damage that may ensue against the defendants may be atoned for by an order that the plaintiffs give security for damages for such damages in the event that their suit fails.

In the circumstances I grant prayer 3 of the application. In order to prevent abuse of the protection afforded by the order and to ensure that the plaintiffs take steps to prosecute their case expeditiously I limit the operation of the order to 8 months. The plaintiffs shall give an undertaking as to damages within 48 hours should their suit ultimately fail. In default the application will stand dismissed.

Costs in the cause.

Dated and Delivered at Mombasa this 4th day of May 2000.

P.N.WAKI

JUDGE