



REPUBLIC OF KENYA



Sime Darby Oils Professionals SDN BHD v Nairobi Beauty World Limited (Civil Suit E604 of 2023) [2025] KEHC 4970 (KLR) (Commercial and Tax) (24 April 2025) (Ruling)

Neutral citation: [2025] KEHC 4970 (KLR)

**REPUBLIC OF KENYA
IN THE HIGH COURT AT NAIROBI (MILIMANI COMMERCIAL COURTS)
COMMERCIAL AND TAX
CIVIL SUIT E604 OF 2023**

PM MULWA, J

APRIL 24, 2025

BETWEEN

SIME DARBY OILS PROFESSIONALS SDN BHD PLAINTIFF

AND

NAIROBI BEAUTY WORLD LIMITED DEFENDANT

RULING

1. The Plaintiff has approached this Court by way of Notice of Motion dated 7th December 2023 seeking, inter alia, temporary injunctive relief to restrain the Defendant from infringing on its registered trade mark "CBC Brand" (Words and Devices) in classes 3 and 29. It also seeks an order of seizure of the offending merchandise, directing the Defendant to seal and keep the goods bearing the allegedly infringing trade mark. The Plaintiff invokes the Court's jurisdiction under Order 40 of the *Civil Procedure Rules* and Sections 1A, 1B and 3A of the *Civil Procedure Act*. The orders are sought pending inter partes hearing and determination of the application and the main suit.
2. The crux of the Plaintiff's case is that it is the registered proprietor of Trade Mark No. 11XX60 "CBC Brand" (Words and Devices) in Class 29 and, as of 8th August 2023, also in Class 3, with registration of coconut oil-based beauty products having been regularized. The Plaintiff avers that, despite the Registrar's expungement of the Defendant's mark and ruling dated 9th April 2021, the Defendant has continued infringing activities by distributing, selling and/or manufacturing products bearing an identical or deceptively similar mark.
3. In opposition to the application, the Defendant, through its director, Mr. Abdirahman Abukar Hassan, filed a relying affidavit sworn on 19th December 2023. It is averred that the Defendant was the duly registered owner of the trade mark number 11XX60 "CBC Brand" (Words and Devices) until 9th April 2021, when the Assistant Registrar of Trademarks, in her ruling, ordered the expungement



of the Defendant's trade mark registration. The Defendant contends that the Registrar's decision has been appealed to the Court of Appeal, and therefore the instant application is premature and has the potential to render any decision made herein nugatory.

4. The Defendant further avers that the Applicant has failed to establish a prima facie case and has not demonstrated the irreparable loss it stands to suffer if the injunction is not granted, suggesting that any pecuniary loss could be adequately remedied by an award of damages, as the Defendant is a person of sufficient financial means.
5. The application was canvassed by way of written submissions filed by the respective counsel, who also made oral highlights. Having duly considered the application, the response thereto, and the submissions by both parties, the sole issue for determination is whether a temporary injunction should issue against the Defendant.
6. The Applicant seeks a temporary injunction on Trade Mark No. 11XX60 "CBC Brand" (Words and Devices) in Classes 3 and 29, which is an equitable and discretionary remedy. The guiding principles for the grant of interlocutory injunctions were set out in the seminal case of *Giella v Cassman Brown & Co. Ltd* [1973] EA 358, where the Court held that:

“First, an applicant must show a prima facie case with a probability of success. Secondly, an injunction will not normally be granted unless the applicant might otherwise suffer irreparable injury. Thirdly, if the Court is in doubt, it will decide the application on a balance of convenience.”

7. At this interlocutory stage, Section 46 of the [Trade Marks Act](#) (Cap. 506 Laws of Kenya) becomes relevant. It provides:

“In all legal proceedings relating to a registered trade mark (including applications under section 35), the fact that a person is registered as proprietor of the trade mark shall be prima facie evidence of the validity of the original registration of the trade mark and of all subsequent assignments and transmissions thereof.”

8. It is trite law that at the interlocutory stage, the Court is enjoined from making definitive findings on contested issues where the evidence remains untested.
9. As reiterated in the *Giella case* (supra), the first threshold for an applicant seeking an interlocutory injunction is the demonstration of a prima facie case with a likelihood of success.
10. The Applicant has placed before this Court documentary evidence of its registration as proprietor of Trade Mark No. 11XX60 "CBC Brand" (Words and Devices) in Class 29 since 1994, and in Class 3 relating to coconut oil-based beauty products. The Applicant further relies on the expungement of the Respondent's competing mark, Trade Mark No. KE/T/2011/72138, and a ruling by the Registrar of Trade Marks dated 9th April 2021 affirming the Applicant's exclusive rights.
11. From the material on record, this Court is persuaded that the Applicant has established a prima facie case with a probability of success, that it is the registered proprietor of the trade mark in question and is entitled to the statutory protection under the [Trade Marks Act](#), specifically Section 7, which confers:

“...the exclusive right to the use of the trade mark in relation to the goods or in connection with the provision of any services...that right is infringed by any person who not being the



proprietor...uses a mark identical with or so nearly resembling it as to be likely to deceive or cause confusion in the cause of trade...”

12. The use of a mark that so nearly resembles the registered mark, and which is likely to cause confusion or deceive, constitutes a clear case of infringement.
13. That said, I find that the applicant has made out a prima facie case with a chance of success that it is the registered owner of the trade mark No. 11XX60 "CBC Brand" (Words and Devices) in Classes 29 and 3, hence it is entitled to the protection afforded by Section 7 of the *Trade Marks Act*.
14. In *Pharmaceutical Manufacturing Company v Novelty Manufacturing Ltd* HCCC No. 746 of 1998 [referred to by Gikonyo, J. in *Solpia Kenya Limited v Style Industries Limited & Anor* (2015) eKLR] Ringera J. (as he then was) held that:

“Registration of a trademark confers the right of exclusive use of the mark. Infringement of the trade mark is a tort of strict liability. Intention and motive are irrelevant considerations... the right is a statutory one.”
15. The question before this Court is whether the Respondent’s use of the impugned mark is likely to deceive or cause confusion among the purchasing public.
16. A preliminary comparative analysis between the Respondent’s mark, as described in the pleadings, and the Applicant’s registered Trade Mark No. 11XX60 “CBC Brand” (Words and Devices) reveals a sufficient degree of similarity as to render it probable that members of the public, exercising ordinary caution, may be misled into purchasing the goods of one party under the mistaken belief that they originate from the other.
17. In the present case, it is evident that both the Applicant and the Respondent are engaged in the same or a closely related line of business, specifically concerning coconut oil-based products. The continued use of the same or a strikingly similar brand name by the Respondent for such products is highly likely to create confusion among consumers who have come to associate the "CBC Brand" with the Applicant.
18. On the critical question of irreparable harm, this Court is satisfied that it is the Applicant, and not the Respondent, who stands to suffer irreparable loss if the alleged infringement is allowed to persist pending the full hearing of the suit. The ongoing confusion in the market, the potential diversion of customers, and the erosion of the goodwill associated with the Applicant’s registered trade mark constitute harm that may not be adequately compensated by a mere award of monetary damages. The intangible value of a brand and its reputation are often difficult to quantify in monetary terms.
19. In view of the foregoing, I am persuaded that the Applicant has satisfied the threshold for the grant of an interlocutory injunction. The Applicant has established a prima facie case with a likelihood of success, and on the third limb of the *Giella v Cassman Brown* test, the balance of convenience clearly tilts in favour of granting the injunction to protect the Applicant’s established statutory rights and prevent further potential confusion and damage to its goodwill.
20. Accordingly, I find the application dated 7th December 2023 is meritorious and is hereby allowed as follows:
 - a. That pending the hearing and determination of the substantive infringement proceedings, a temporary order of injunction be and is hereby issued restraining the Defendant, [Nairobi Beauty World Limited], whether acting by its servants or agents or any of them or otherwise howsoever, from infringing on the Plaintiff’s registered trade mark No. 11XX60 CBC Brand (Words and Devices) and from interfering with the Plaintiff’s exclusive rights to importing and



exporting, marketing, selling, manufacturing and in any way whatsoever transacting with the trade name “CBC Brand” (Words and Devices) or any other mark confusingly similar thereto in relation to goods in Classes 3 and 29.

- b. That pending the hearing and determination of the substantive infringement proceedings, a temporary order of injunction be and is hereby issued directing the Defendant, [Nairobi Beauty World Limited], to seal and keep seizure of all offending merchandise bearing the trade mark “CBC Brand” (Words and Devices) or any other mark which is phonetically and visually similar to the Plaintiff’s registered trade mark “CBC Brand” (Words and Devices) or any other mark confusingly similar thereto, currently in their possession, custody or control.
- c. The costs of this application shall abide the outcome of the substantive suit.

RULING DELIVERED VIRTUALLY, DATED AND SIGNED AT NAIROBI THIS 24TH DAY OF APRIL 2025.

PETER M. MULWA

JUDGE

In the presence of:

Ms. Achieng h/b for Mr. Onyony for Plaintiff/applicant

Mr. Wamunyolo for Defendant/respondent

Court Assistant: Carlos

