



**Anti-Counterfeit Authority v Abass & another (Civil Appeal
56 of 2023) [2025] KEHC 6840 (KLR) (15 May 2025) (Judgment)**

Neutral citation: [2025] KEHC 6840 (KLR)

**REPUBLIC OF KENYA
IN THE HIGH COURT AT NYERI
CIVIL APPEAL 56 OF 2023
DKN MAGARE, J
MAY 15, 2025**

BETWEEN

ANTI-COUNTERFEIT AUTHORITY APPELLANT

AND

ADAN NURA ABASS 1ST RESPONDENT

FCA US LLC 2ND RESPONDENT

(Being an appeal from the ruling and orders of the Chief Magistrates Court at Nyeri by the Hon. Alfred Kiburu delivered on 26.07.2023 in Chief Magistrate's Civil Suit 390 of 2016)

JUDGMENT

1. This is an appeal from the ruling and orders of the Chief Magistrates Court at Nyeri (Hon. Alfred Kiburu) delivered on 26.07.2023 in Chief Magistrates Civil Suit 390 of 2016. The appellant was the 1st Defendant in the lower court, while the second respondent was the 2nd Defendant in the suit filed by the 1st Respondent herein.
2. The matter is relatively straightforward. The second Respondent laid a complaint in form ACA 8 dated 8.10.2016. This was over counterfeit goods pursuant to section 33 of the *Anti-Counterfeit Act*, 2008. This act was assented on 24.12.2008 and commenced on 7.7.2009. The long title is an Act of Parliament to prohibit trade in counterfeit goods, to establish the Anti-Counterfeit Authority, and for connected purposes. the said section 33 of the act provides as hereunder:
 33. Any holder of an intellectual property right, his successor in title, licensee or agent may, in respect of any protected goods, where he has reasonable cause to suspect that an offence under section 32 has been or is being committed, or is likely to be committed, by any person, lay a complaint with the Executive Director.



- (2) The complainant shall furnish, to the satisfaction of the Executive Director, such information and particulars, as may be prescribed, to the effect that the goods with reference to which that offence has allegedly been, or is being, or is likely to be, committed, prima facie are counterfeit goods.
 - (3) Where the Executive Director is reasonably satisfied-
 - (a) that the complainant is a person entitled to lay a complaint under subsection (1); and
 - (b) that
 - (i) the goods claimed to be protected goods, prima facie are protected goods; and
 - (ii) the intellectual property right, the subject matter of which is alleged to have been applied to the offending goods, prima facie subsists; and
 - (c) that the suspicion on which the complaint is based appears to be reasonable in the circumstances, the Executive Director shall cause appropriate steps to be taken in accordance with section 23(1).
 - (4) The preceding provisions of this section shall not preclude an inspector from taking any appropriate steps on his own initiative including receiving and acting on consumer complaints in relation to any act or conduct believed or suspected to be an act of dealing in counterfeit goods, provided the provisions of this Act are complied with.
 - (5) Nothing in this section shall preclude the Executive Director from causing appropriate steps to be taken in accordance with section 23(1) in the event of an infringement of an intellectual property right for which no complaint has been lodged by the holder thereof in accordance with subsection (1) of this section.
 - (6) Notwithstanding the provision of subsections (1) and (2) of this section, a consumer or purchaser of goods may, where he has reasonable cause to suspect that an offence under this Act has been committed, is being committed or is likely to be committed by any person, lay a complaint with the Executive Director who shall cause appropriate steps to be taken in accordance with the provisions of this Act.
3. The goods in question were fabrics branded under the Jeep brand, specifically JEEP trousers and shirts. This brand is a registered trademark of the 2nd respondent, a company incorporated under the laws of the State of Delaware, United States of America. The 2nd respondent also filed an affidavit in compliance with Regulation 13(2) of the Anti-Counterfeit Regulations, 2010. the procedure for laying a complaint as seizure of goods is set out in regulations 13 and 14 of the as follows:
13.
 - (1) An intellectual property right owner or his agent who wishes to lay a complaint to the Executive Director under section 33(2) of the Act shall lay a complaint in Form ACA 8 set out in the First Schedule.
 - (2) The complaint under paragraph (1) of this regulation shall be accompanied by-
 - (a) the fee specified in the Second Schedule;



- (b) an affidavit sworn by the complainant or his agent attaching the registration certificate and or any other relevant document in support of the complaint; and
- (c) an indemnity in Form ACA 9 set out in the First Schedule, signed by the complainant indemnifying the Authority from any claim for wrongful seizure, removal or detention of alleged counterfeit goods.

14.

- (1) An intellectual property right owner (or his agent) who wishes, to have suspected counterfeit goods seized by the Commissioner, under section 34(1) shall apply in Form ACA 10 set out in the First Schedule.
- (2) The application under paragraph (1) shall be accompanied by
 - (a) the fee specified in the Second Schedule;
 - (b) an affidavit sworn by the complainant attaching the registration certificate or any other relevant document in support of the application; and
 - (c) an indemnity in the Form ACA 11 set out in the First Schedule signed by the complainant indemnifying the Customs Authority from any claim made for any wrongful seizure, removal or detention of alleged counterfeit goods.

4. Had the parties taken some time to peruse the [Anti-Counterfeit Act](#) and exercised a reasonable degree of diligence, this matter would not have ended up in court. The 2nd Respondent was joined to the proceedings as the trademark holder. Subsequently, the Appellant filed an application dated 16th November 2016 and filed on 17th November 2016, seeking the following orders.

- a. The plaint herein dated 13.10.2016, together with the consequent amended plaint herein dated 17.7.2017, be struck out.
- b. costs to the 1st defendant.

5. The grounds for the application were that the court lacked jurisdiction to adjudicate the subject matter, and that the suit was frivolous. It was contended that the subject matter fell within the exclusive jurisdiction of the High Court. Furthermore, it was argued that the suit was premised on criminal activities and failed to meet the mandatory legal prerequisites, given that the goods in question were alleged to be counterfeit and therefore illegal. The application was supported by a 33-paragraph affidavit sworn by Weldone Sigei, a Chief Inspector with the Appellant.

6. The affidavit provided a general background regarding the seizure of the impugned goods. It stated that the said goods had been registered as counterfeit, infringing upon the trademark rights of the second Respondent. After several other applications had been dealt with, the court held as follows:

- a. The application dated is without merit
- b. The claim for damages for slander is hereby struck out.
- c. Each party to bear their own costs

7. The court had to search within the application to find the findings of the court. It could be advisable that the court crystallizes its decision in the final determination or disposition. Had the court done



this, it would have realized that the application was not dismissed but partly allowed. It is tautological to dismiss a partly allowed application.

8. The Appellant was aggrieved and filed the following grounds of appeal:
 - a. That the learned Chief Magistrate erred in law and in fact in failing to find and hold that the court lacked the requisite jurisdiction to entertain, hear and determine the suit by express provisions of the law.
 - b. The learned Chief Magistrate erred in law and in fact by failing to find and hold that the jurisdiction of the court was never invoked at all, and consequently, the court lacked the requisite jurisdiction to entertain, hear, and determine the suit by express provisions of the law.
 - c. That the learned Chief Magistrate erred in law and in fact by failing to find and hold that there is no cause of action established to sustain the prayers in the suit.
 - d. That the learned Chief Magistrate erred in law and in fact by failing to find and hold that there was no pleading to support the prayers sought in the suit and consequently the suit was for dismissal.
 - e. That the learned Chief Magistrate erred in law and in fact by failing to find and hold that the suit offends known and settled principles and provisions of law.
9. The Appellant submitted on the first ground that the *Anti-Counterfeit Act*, under Section 2, defines counterfeit goods to mean ‘goods that are the result of counterfeiting any item that bears an intellectual property right, and includes any means used for purposes of counterfeiting.
10. It was stated that the Appellant seized the 1st Respondent’s goods on the suspicion that they were counterfeit and infringed upon intellectual property rights. This action was said to be in compliance with Section 23(1) of the *Anti-Counterfeit Act*. Further, it was contended that Section 2 of the *Trade Marks Act* vests the jurisdiction to determine whether an infringement has occurred exclusively in the High Court.
11. It was submitted that under the *Anti-Counterfeit Act*, a statutory cause of action arises upon seizing suspected counterfeit goods under Section 23. Any party aggrieved by such seizure must seek relief under Section 25(3) of the Act, which provides access to a court of competent jurisdiction. It was further argued that the jurisdiction of any court for remedies other than those expressly provided under the statute is ousted. Reliance was placed on Section 3(1) of the *Judicature Act*, which sets out the hierarchy of legal norms, beginning with *the Constitution*, followed by written laws, including Acts of Parliament. In support of this position, the case of *David Sironga Ole Tukai v Francis Arap Muge & 2 Others* [2014] eKLR was cited.
12. They submitted that a competent court can only order the release of seized goods after deciding, upon a full trial, that the goods are not counterfeit. Reliance was placed on the decision in *Beyond Opinion Business Solutions v Anti-Counterfeit Authority & 2 Others*, Nairobi Commercial Civil Suit No. E175 of 2023.
13. It was their further submission that the 1st Respondent is bound by his pleadings as was held by the *Communications Authority of Kenya v Okiya Omtata Okoiti & 8 others* [2020] eKLR,
14. It was the Appellant’s submissions that there was no prayer seeking a determination as to whether the seized goods were counterfeit. Consequently, the court lacked jurisdiction to order the release of the goods without first making such a determination. They further contended that counterfeiting is a criminal offence, attracting penalties under Section 32 as read with Section 35 of the *Anti-Counterfeit*



Act. Therefore, the 1st Respondent is not entitled to any positive remedies until the suspicion of counterfeiting is dispelled by a competent court. It was argued that no cause of action can arise from an illegality, and no legal remedy can be granted where such illegality is admitted. they relied on *Match Masters Limited v Kenafric Matches Limited & Another* [2021] eKLR and *D. Njogu & Co. Advocates v National Bank of Kenya Ltd* [2009] eKLR, where the courts held that suits based on illegality are contrary to public policy.

15. Based on the foregoing submissions, the Appellant prayed that the appeal be allowed with costs, and that the Appellant's application dated 16.11.2016 be granted in its entirety.

Analysis

16. This being a first appeal, this court is under a duty to re-evaluate and assess the evidence and make its own conclusions. It must, however, keep at the back of its mind that a trial court, unlike the appellate court, had the advantage of observing the demeanour of the witnesses and hearing their evidence first hand. In the case of *Mbogo and Another vs. Shah* [1968] EA 93 where the Court stated:

“...that this Court will not interfere with the exercise of judicial discretion by an inferior court unless it is satisfied that its decision is clearly wrong, because it has misdirected itself or because it has acted on matters on which it should not have acted or because it failed to take into consideration matters which it should have taken into consideration and in doing so arrived at a wrong conclusion.”

17. The duty of the first appellate Court was settled long ago by *Clement De Lestang, VP, Duffus and Law JJA*, in the locus classicus case of *Selle and another Vs Associated Motor Board Company and Others* [1968]EA 123, where the law looks in their usual gusto, held by as follows:-

“.. this court is not bound necessarily to accept the findings of fact by the court below. An appeal to this court ... is by way of re-trial and the Court of Appeal is not bound to follow the trial Court's finding of fact if it appears either that he failed to take account of particular circumstances or probabilities or if the impression of demeanour of a witness is inconsistent with the evidence generally.”

18. The Court is to bear in mind that it had neither seen nor heard the witnesses. It is the trial court that has observed the demeanor and truthfulness of those witnesses. However, documents still speak for themselves. The observation of documents is the same as the lower court as parties cannot read into those documents matters extrinsic to them.

19. In the case of *Peters vs Sunday Post Limited* [1958] EA 424, court therein rendered itself as follows:-

“It is a strong thing for an appellate court to differ from the findings on a question of fact, of the judge who had the advantage of seeing and hearing the witnesses...But the jurisdiction to review the evidence should be exercised with caution: it is not enough that the appellate court might have come to a different conclusion...”

20. The grounds raised are humongous and state the same thing. Order 42 Rule 1 of the Civil Procedure Rules provides that: -

“Every appeal to the High Court shall be in the form of a memorandum of appeal signed in the same manner as a pleading. (2) The memorandum of appeal shall set forth concisely



and under distinct heads the grounds of objection to the decree or order appealed against, without any argument or narrative, and such grounds shall be numbered consecutively.

21. The Court of Appeal had this to say about compliance with Rule 86 of the Court of Appeal Rules (which is *pari materia* with Order 42 Rule 1 of the Civil Procedure Rules) in the case of *Robinson Kiplagat Tuwei v Felix Kipchoge Limo Langat* [2020] eKLR: -

“We are yet again confronted with an appeal founded on a memorandum of appeal that is drawn in total disregard of rule 86 of the Court of Appeal Rules. That rule demands that a memorandum of appeal must set forth concisely, without argument or narrative, the grounds upon which a judgment is impugned. What we have before us are some 18 grounds of appeal that lack focus and are repetitively tedious. It is certainly not edifying for counsel to present two dozen grounds of appeal, and end up arguing only two or three issues, on the myth that he has condensed the grounds of appeal. This Court has repeatedly stated that counsel must take time to draw the memoranda of appeal in strict compliance with the rules of the Court. (See *Abdi Ali Dere v. Firoz Hussein Tundal & 2 Others* [2013] eKLR) and *Nasri Ibrahim v. IEBC & 2 Others* [2018] eKLR. In the latter case, this Court lamented:

“We must reiterate that counsel must strive to make drafting of grounds of appeal an art, not an exercise in verbosity, repetition, or empty rhetoric...A surfeit of prolixious grounds of appeal do not in anyway enhance the chances of success of an appeal. If they achieve anything, it is only to obfuscate the real issues in dispute, vex and irritate the opposite parties, waste valuable judicial time, and increase costs.” The 18 grounds of appeal presented by the appellant, *Robinson Kiplagat Tuwei* against the judgment of the Environment and Land Court at Eldoret (Odeny, J.) dated 19th September 2018 raise only two issues...”

22. The court abhors repetitiveness of grounds of appeal which tend to cloud the key issue in dispute for determination by the court. In the case of *Kenya Ports Authority v Threeways Shipping Services (K) Limited* [2019] eKLR, the court of appeal observed that: -

“Our first observation is that the memorandum of appeal in this matter sets out repetitive grounds of appeal. The singular issue in this appeal is whether Section 62 of the *Kenya Ports Authority Act* ousts the jurisdiction of the High Court. We abhor repetitiveness of grounds of appeal which tend to cloud the key issue in dispute for determination by the Court. In *William Koross V. Hezekiah Kiptoo Kimue & 4 others*, Civil Appeal No. 223 of 2013, this Court stated:

“The memorandum of appeal contains some thirty-two grounds of appeal, too many by any measure and serving only to repeat and obscure. We have said it before and will repeat that memoranda of appeal need to be more carefully and efficiently crafted by counsel. In this regard, precise, concise and brief is wiser and better.”

23. The remaining issues are ancillary, repetitive, prolixious, and a waste of judicial time. This court will have to decide whether the magistrate’s court had jurisdiction to hear and determine this dispute.
24. The goods were seized pursuant to purported powers under the *anti-counterfeit act*, which was a statutory function. The goods were declared counterfeit. Whether or not they were is a question for determination once the court is moved. This can be done under the Act, or if the appellant acted in excess of their powers, then the court is moved to quash the decision. Without challenging the decision to declare them counterfeit, they remain counterfeit.



25. What then is the utility of a suit claiming for detinue of counterfeit goods? The court acted in excess of its jurisdiction in purporting to link the decision to charge to the declaration of goods to be counterfeit. The declaration as counterfeit was complete on the laying of the charge.

26. The decision to charge lay elsewhere. As held by the Supreme Court in the case of *Waswa v Republic (Petition 23 of 2019)* [2020] KESC 23 (KLR) (4 September 2020) (Judgment) Joseph Lendrix Waswa v Republic [2020] eKLR Neutral citation: [2020] KESC 23 (KLR), the Supreme Court stated as follows:

We agree with this view and adopt it as the correct position in law. We are of the view that the victim has no active role in the decision to prosecute or the determination of the charge upon which the accused will finally be tried. This is the sole duty of the DPP. While the victim of a crime can participate at the stage of the proceedings as deemed appropriate by the trial Judge, a victim or his legal representative does not have the mandate to prosecute crimes on behalf of the DPP. The DPP must at times retain control of, and supervision over, the prosecution of the case. As such, the constitutional and statutory powers of the DPP to conduct the prosecution is not affected by the intervention of the victim in the process.

77. Additionally, a victim cannot and does not wear the hat of a secondary prosecutor. When victims present their views and concerns in accordance with section 9(2)(a) of the VPA, victims are assisting the trial Judge to obtain a clear picture of what happened (to them) and how they suffered, which the may decide to take into account. Victim participation should meaningfully contribute to the justice process. It must be noted, however, that this does not mean that the court's judgment will follow the wishes of the victim. The trial Judge will, of course, take into account the law, facts, all the different interests, and concerns, including the rights of the defence and the interests of a fair trial to arrive at a sagacious decision. 78. Conscious

27. This leaves the appellant as a complainant. They can only do seizure, and no more. Whether to charge the first respondent is not in the appellant's province. Ipso facto, the Appellant has no power to charge the first respondent. They cannot force the first respondent to charge. This does not remove the declaration of counterfeit goods.

28. The foregoing means that the plaint before the court seeking detinue and rerun of counterfeit goods in untenable. The court below was thus plainly wrong in dismissing the application. Consequently, the appeal is allowed. The order dismissing the notice of motion dated 16th November 2016 given on 26.07.2023 is set aside. In lieu thereof, the appellant's application dated 16.11.2016 is allowed. The plaintiff's suit is struck out.

29. The issue of costs is governed by Section 27 of the *Civil Procedure Act*, which provides as follows:

(1) Subject to such conditions and limitations as may be prescribed, and to the provisions of any law for the time being in force, the costs of and incidental to all suits shall be in the discretion of the court or judge, and the court or judge shall have full power to determine by whom and out of what property and to what extent such costs are to be paid, and to give all necessary directions for the purposes aforesaid; and the fact that the court or judge has no jurisdiction to try the suit shall be no bar to the exercise of those powers: Provided that the costs of any action, cause or other matter or issue shall follow the event unless the court or judge shall for good reason otherwise order.



- (2) The court or judge may give interest on costs at any rate not exceeding fourteen per cent per annum, and such interest shall be added to the costs and shall be recoverable as such.
30. The Court of Appeal in the case of Farah Awad Gullet v CMC Motors Group Limited [2018] KECA 158 (KLR) had this to say:
- “It is our finding that the position in law is that costs are at the discretion of the court seized up of the matter with the usual caveat being that such discretion should be exercised judiciously meaning without caprice or whim and on sound reasoning secondly that a court can only withhold costs either partially or wholly from a successful party for good cause to be shown.
31. The Supreme Court set forth guiding principles applicable in the exercise of that discretion in the case of Jasbir Singh Rai & 3 others v. Tarlochan Singh Rai & 4 others, SC Petition No. 4 of 2012; [2014] eKLR, as follows: -
- “(18) It emerges that the award of costs would normally be guided by the principle that “costs follow the event”: the effect being that the party who calls forth the event by instituting suit, will bear the costs if the suit fails; but if this party shows legitimate occasion, by successful suit, then the defendant or respondent will bear the costs. However, the vital factor in setting the preference is the judiciously-exercised discretion of the Court, accommodating the special circumstances of the case, while being guided by ends of justice. The claims of the public interest will be a relevant factor, in the exercise of such discretion, as will also be the motivations and conduct of the parties, before, during, and subsequent to the actual process of litigation.... Although there is eminent good sense in the basic rule of costs – that costs follow the event – it is not an invariable rule and, indeed, the ultimate factor on award or non-award of costs is the judicial discretion. It follows, therefore, that costs do not, in law, constitute an unchanging consequence of legal proceedings – a position well illustrated by the considered opinions of this Court in other cases.
32. The circumstances of this case are not edifying. The matter has taken from 2016 to date to conclude. The Applicant did not prosecute their application dated 16.11.2016 until 6 years later. The delay is unacceptable and an indictment to the parties. Advocates have a solemn duty to help in furthering the administration of justice. To bring this unfortunate matter to a close, each party will bear their own costs in this appeal. However, the Appellant is entitled to costs in the court below

Determination

33. The upshot of the foregoing is that I make the following orders: -
- a. The Appeal is allowed. The application dated 16.11.2016 is hereby allowed. The effect is that the 1st Respondent’s suit in the court below is hereby struck out
 - b. The Appellant shall have costs in the court below.
 - c. Each party is to bear its costs on the appeal.
 - d. The file is closed.

**DELIVERED, DATED, AND SIGNED AT NYERI ON THIS 15TH DAY OF MAY, 2025.
JUDGMENT DELIVERED THROUGH MICROSOFT TEAMS ONLINE PLATFORM.**



KIZITO MAGARE

JUDGE

In the presence of: -

Ms Nyawira for Adera for the Appellant

N/A for the first Respondent

Mr Omondi for the second Respondent

Court Assistant – Michael

