



REPUBLIC OF KENYA



Ndegwa t/a Steame Max Peanuts v Muthoni t/a Super Max Peanuts (Civil Case E004 of 2024) [2024] KEHC 8165 (KLR) (4 July 2024) (Ruling)

Neutral citation: [2024] KEHC 8165 (KLR)

**REPUBLIC OF KENYA
IN THE HIGH COURT AT THIKA
CIVIL CASE E004 OF 2024
FN MUCHEMI, J
JULY 4, 2024**

BETWEEN

ROSEMARY WANJIRU NDEGWA T/A STEAME MAX PEANUTS ... PLAINTIFF

AND

FRANSICA MUTHONI T/A SUPER MAX PEANUTS DEFENDANT

RULING

1. The application for determination dated 15th March 2024 seeks for orders for a temporary injunction do issue restraining the respondent whether by itself, its directors, officers, employees, servants, agents, licensees, franchises or anyone claiming under them from infringing and/o passing off the applicant's intellectual property rights over the applicant's rightful acquired legal commercial reputation in the market through trading, promoting, advertising, marketing, carrying on business or continuing with the use of its particular trademark associated with Super max Peanuts and further an Anton Pillar to issue allowing the superintendent seizure of all documents, publicity material and any other thing in the respondent's possession marked Super Max Peanuts purported to be used in the market by the respondent which creates confusion and infringes on the applicant's trade mark.
2. In opposition to the application, the respondent filed a Replying Affidavit dated 29th April 2024.

The Applicant's case

3. The applicant states she has been in the business of distribution and sale of peanuts in the region which has earned a considerable repute and trust of the general public in the market and that she has registered her business under a business name incorporated under the laws of Kenya on 17th July 2018. The applicant further states that she holds an exclusive license and permit to trade in the peanut wrappings issued from the National Environment Management Authority (NEMA) and the Kenya Bureau of Standards (KEBS) on clear terms.



4. The applicant states that she has been specifically trading in and utilizing a unique trademark for the distribution of Steame Max Peanuts wrappings within the republic and has acquired a remarkable reputation and immense goodwill.
5. The applicant argues that she purchased a bale of wrappings the respondent was selling at her shop in Thika for a price of KShs. 8,000/- which is an imitation of her trademark and upon reviewing it, the applicant found that it was an exact copy of her trademark peanut wrappings 'Steame Max Peanuts' save for some minor alteration.
6. The applicant argues that the respondent has been involved in a deliberate move calculated towards bypassing her trademark creating confusion to her customers and the general public and for the purposes of leveraging on her acquired commercial reputation and good will attributed to its unique products and thereby passing off. As a result, the respondent's unlawful actions are causing serious business damage to the applicant's business in unlawful business poaching and predatory tactics being employed by the respondent targeting the applicant's customers and unsuspecting members of the general public.
7. The applicant further argues that the respondent's continued violation of her trademark and intellectual property rights puts at risk the applicant's market reputation and exposes it to unquantifiable risk and loss. The applicant further states that the trade design of using the names 'Super Max Peanuts', utilizing and/or disguising her location and copying her mode of trade is not only deceptive but also calculated to cause confusion among the public and the applicant's customers by misrepresenting that the respondent's peanut wrappings products are alike to and related to those of the applicant.
8. The applicant states that she has not licenced and neither has the respondent sought to be granted permission or license to utilize, copy or modify her trademarks and unless the court restrains the respondent's illegal actions, she is likely to continue passing off the applicant's trade name and mark resulting to further misrepresentation and confusion in the market between the applicant's and the respondent's peanut wrappings products which would cause irreparable damage to the applicant.
9. The applicant avers that the respondent has in her possession incriminating documents and things, and the applicant is fearful that there is a real possibility that she may remove and destroy such material before the suit can be determined by the court, materials which are necessary for the applicant to prove its action in passing off and it is crucial for an Anton Pillar Order to issue on the respondent's outlets and the applicant's distribution retail outlets.
10. The applicant states that the respondent will suffer no prejudice if the offending actions and practices are restrained.

The Respondent's Case

11. The respondent opposes the application on the premise that it is frivolous, vexatious and a blatant use of the honourable court's process for being premised on suppositions, guesswork, misinformation, distortions and outright falsehoods.
12. The respondent states that she has never traded, advertised, promoted and or carried on a business in the name and style of Super Max Peanuts. She further states that she is a regular retailer who trades under the name and style of Juskam Stores.



13. The respondent further states that she buys her commodities from different suppliers and distributors and sells the same in her shop and she does not follow up on the name the business uses since she stocks a variety of products from different suppliers.
14. The respondent states that the entire suit and application are an afterthought by the applicant who is well known to her and has been her supplier for a period of time. The respondent further states that she was buying from the applicant until July 2023 when she ceased. The respondent argues that the applicant is trying her luck at the respondent's commodities and the allegations that she copied her products are untrue.
15. The respondent avers that the applicant is mischievously and intentionally misleading the court on facts which would be detrimental to her case in not disclosing that she has also been the respondent's customer, bought her products in the past and sold her products in the respondent's retail shop. The respondent states that she does not distribute or supply products since she operates a retail shop.
16. The respondent argues that the applicant has not demonstrated what rights have been passed off and further the applicant is second guessing on what products the respondent sells and has no knowledge of the trade name she seeks to injunct.
17. The applicant filed a Further Affidavit dated 27th May 2024 and deposed that she wishes to amend her pleadings by substituting the respondent's name from Fransica Muthoni to Fraciah Muthoni.
18. The applicant argues that the respondent has failed to provide or substantiate grounds to warrant the none issuance of Anton Pillar Orders. The applicant further argues that the respondent has been using Juskam Stores as a disguise store to continue frustrating and infringing her trademark by selling Super Max Peanuts wrappings hence targeting her customers and unsuspecting members of the general public.
19. Parties disposed of the application by way of written submissions.

The Applicant's Submissions

20. The applicant relies on the cases of *Mrao Limited v First American Bank of Kenya Ltd & 2 Others* [2003] 1 KLR 125; *Paul Gitonga Wanjau v Gathuthi Tea Factory & 2 Others* [2016] eKLR and *Nguruman Limited vs Jan Bonde Nielsen & 2 Others* [2014] eKLR and submits that she has a *prima facie* case as she has rightfully acquired legal commercial reputation in the market through trading and carrying on business and continuing with the use of its particular trademark associated with Super Max Peanuts.
21. The applicant submits that she has been suffering irreparably as her business has undergone losses as shown in her statement of accounts. The applicant argues that unless the honourable court restrains the respondent's illegal actions regarding the infringement of the Steame Max Peanuts, she will continue suffering irreparably.
22. The applicant submits that the trade design of using the names 'Super Max Peanuts', utilizing or disguising the applicant's location and copying her mode of trade is deceptive and calculated to cause confusion among the public by misrepresenting that the respondent's peanut wrappings products are similar and related with those of the applicant. The applicant further submits that she has not licensed and neither has the respondent sought to be granted permission or license to utilize, copy or modify the applicant's trademark.
23. The applicant relies on the cases of *Anton Piller KG v Manufacturing Processes Ltd & Others* [1976] 1 All ER 779 and *Microsoft Corporation v Mitsumi Computer Garage Ltd* [2001] 1 EA 128 and submits



that she has established a strong prima facie case by presenting to the court evidence that the respondent is infringing on her trademark. Further, the respondent has in her possession incriminating documents and Super Max Peanuts wrappings which she may remove and destroy before the determination of the suit. The applicant further submits that the respondent will not be caused grave prejudice and injury that cannot be quantified in the event the application is allowed.

24. The applicant further relies on *Halsbury's Laws of England* 2012 Vol 22 para 52, Section 6 of the *Civil Procedure Act* and the case of *Peter Gachuki Mwangi & 2 Others v Copyright Board of Kenya & 3 Others* [2014] eKLR and submits that the suit does not constitute any abuse of the court process as there exists no other suit with the same parties in any other court.

The Respondent's Submissions

25. The respondent relies on the case of *Giella v Cassman Brown & Co. Limited* [1973] EA 358 and submits that the applicant has not satisfied the conditions to warrant her the orders sought. The respondent argues that the applicant allegedly purchased a bale of peanuts from her but on closer interrogation of the packaging, the peanuts are packaged and distributed by Gazebo Merchants. Despite that, the applicant failed to integrate or even include in the suit the real principal and owner of the peanuts and decided to pursue the respondent who is a trader who stocks different goods. Further, the respondent submits that the applicant has failed and/or neglected to adduce evidence that the respondent owns or trades as the purported infringer despite her raising the issue in her replying affidavit. Thus, the respondent submits that the main objective of the application is to stop a business rival from conducting her business after their relationship turned sour.
26. The respondent relies on the case of *Mrao Ltd vs First American Bank of Kenya Ltd & 2 Others* and submits that the applicant has not demonstrated the relationship between Juskam stores (where the peanuts were purchased), Super Max peanuts (the purported infringer) and Gazebo Merchants (the packager and distributor of Super Max peanuts) and therefore the applicant has failed to establish a *prima facie* case with any possibility of success.
27. The respondent submits that the applicant has not met the requirements for the grant of an Anton Piller order. Further, the respondent argues that she is guaranteed her right to privacy as enshrined in the *constitution* as she is a general merchant and in her possession is suppliers' data which she has to protect. The respondent argues that the applicant is on a fishing exercise and further she does not even know who she is supposed to sue.
28. Relying on *Bullet and Leake and Jacobs*, in *Precedents of Pleadings*, Order 2 Rule 15(b) of the *Civil Procedure Rules* and the case of *Kivanga Estates Limited vs National Bank of Kenya Limited* [2017] eKLR, the respondent argues that the present application is bad in law and the principles of justice, an abuse of the court process and is premised on suppositions, guesswork, misinformation, distortion and outright falsehoods.
29. The respondent relies on the case of *Party of Independent Candidate of Kenya v Mutula Kilonzo & Others* (no citation given) and submit that as the successful party, they are entitled to costs of the suit and application.
30. The main issues for determination are:-
- a. Whether the applicant has met the requisite conditions to warrant the granting of a temporary injunction.
 - b. Whether the applicant's prayer for Anton Piller orders has been established.



The Law

Whether the applicant has met the requisite conditions to warrant the granting of a temporary injunction.

31. The principles of interlocutory injunction are now well settled. Those principles were set out in *East African Industries v Trufoods* [1972]EA 420 and *Giella v Cassman Brown & Co. Ltd* [1973]EA 358. Restating the said principles, Ringera J, (as he then was) in *Airland Tours & Travel Limited v National Industrial Credit Bank* Nairobi (Milimani) HCCC No. 1234 of 2002 set them out as follows:-
- a. A prima facie case with a probability of success at trial;
 - b. The applicant is likely to suffer an injury, which cannot be adequately compensated in damages;
 - c. If the court is in doubt about the existence or otherwise of a prima facie case it should decide the application on a balance of convenience;
 - d. The conduct of the applicant meets the approval of the court of equity.
32. Similarly, in *Dr. Simon Waitharo Chege v Paramount Bank of Kenya Ltd* Nairobi (Milimani) HCCC No. 360 of 2001, Ringera J, (as he then was) held:-

“The remedy of injunction is one of the greatest equitable relief. It will issue in appropriate cases to protect the legal and equitable rights of a party to litigation, which have been, or are being or are likely to be violated by the adversary. To benefit from the remedy, at an interlocutory stage, the applicant must, in the first instance show that he has a prima facie case with a probability of success at the trial. If the court is in doubt as to the existence of such a case, it should decide the application on a balance of convenience. And because of its origin and foundation in the equity stream of the jurisdiction of the courts of judicature, the applicant is normally required to show that damages would not be an adequate remedy for the injury suffered or likely to be suffered if he is to obtain an interlocutory injunction. As the relief is equitable in origin, it is discretionary in application and will not issue to a party whose conduct as pertains to the subject matter of the suit does not meet the approval of the eye of equity.”

Prima facie case with a probability of success at trial

33. What then constitutes a *prima facie* case? In the case of *Mrao Ltd v First American Bank of Kenya Ltd & 2 Others* [2003] KLR 125,

“The principles which guide the court in deciding whether or not to grant an interlocutory injunction are, first, an applicant must show prima facie case with a probability of success. Secondly, an interlocutory injunction will not normally be granted unless an applicant might otherwise suffer irreparable injury, which would not adequately be compensated by an award of damages. Thirdly, if the court is in doubt, it will decide an application on the balance of convenience....A mere scintilla of evidence can never be enough; nor can any amount of worthless discredited evidence. It is true that the court is not required at that stage to decide finally whether the evidence is worthy of credit, or whether if believed it is weighty enough to prove the case conclusively: that final determination can only properly be made when the case for the defence has been heard. It may not be easy to define what is meant by “prima facie case” but at least it must mean one on which a reasonable tribunal,



properly directing its mind to the law and the evidence could convict if no explanation is offered by the defence...The terms “prima facie” case, and “genuine and arguable” case do not necessarily mean the same thing, for in using another term, namely a suitable cause of action, the words “*prima facie*” are frequently used to refer to a case which shifts the evidential burden of proof, rather than as giving rise to a legal burden of proof in the manner of considering, which was in relation to the pleadings that had been put forward in the case. It would be in the appellant’s interest to adopt a genuine and arguable case standard rather than one of prima facie case, the former being the lesser standard of the two...In civil cases a prima facie case is a case in which on the material presented to the court a tribunal properly directing itself will conclude that there exists a right which has apparently being infringed by the opposite party to call for an explanation or rebuttal from the latter. A prima facie case is more than an arguable case. It is not sufficient to raise issues but the evidence must show an infringement of a right, and the probability of success of the applicant’s case upon trial. That is clearly, a standard, which is higher than an arguable case.”

34. In determining whether a prima facie case has been made it is instructive to revert to Section 7(1) of the [Trade Marks Act](#) to ascertain whether sufficient cause has been shown by the applicant. Section 7(1) of [the Act](#) provides:-

Subject to the provisions of this section, and of sections 10 and 11, the registration (whether before 1st January 1957) of a person in Part A of the register as the proprietor of a trademark if valid gives to that person the exclusive right to use of the trademark 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 trademark or a registered user thereof using by way of permitted use, uses a mark identical with or so nearly resembling it as to likely deceive or cause confusion in the course of the 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 trademark;
 - 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 licensee to use the trademark or goods with which such a person is connected in the course of trade;
 - c. Be taken in a case where the use is use at or near the place where the services are available for acceptance or performed or in an advertising circular or other advertisement issued to the public or any part thereof, as importing a reference to some person having the right either proprietor or as licensee to use the trademark or to services with the provision of which such a person as aforesaid is connected in the course of business;
 - d. Cause injury or prejudice to the proprietor or licensee of the trademark.
35. The applicant registered her business ‘Steame Max Peanuts’ on 17th August 2018 and she is the registered owner of the trade mark Steame Max Peanuts which was registered under the [Trade Marks Act](#) as Trade Mark No. 129465. The Certificate of Registration annexed to her supporting affidavit marked RW2 confirms that the trade mark was registered on 14th August 2023 and is set to expire on 14th August 2033. It further shows that the Trade Mark was registered under Class 16 in respect of



film and bags for wrapping and packaging. The registered proprietor according to the Certificate of Registration is Steame Max Peanuts

36. According to the applicant, she came to learn that the respondent had copied her entire work and was offering similar peanut wrappings as 'Super Max Peanuts' and when she purchased a bale of the wrappings the respondent was selling at her shop, she discovered that they were an imitation of her trademark save for some minor alterations.
37. The respondent denied ever trading or carrying business in the name and style of Super Max Peanuts and states that she is a regular retailer who trades under the name and style of Juskam Stores. She further stated that she buys commodities from different suppliers and distributors and sells them in her shop. Further the respondent states that the applicant is known to her and has been her supplier for a period of time and she bought from the applicant products until July 2023.
38. From the record, it is not in dispute that the applicant is the registered proprietor of the trademark Steame Max Peanuts. The applicant is obligated to demonstrate the business connection between her business and that of the respondent's which she claims trades under the name of Super Max Peanuts. Furthermore, the respondent denied trading under the name of Super Max Peanuts and yet the applicant did not deny this allegation or provide evidence to the contrary. The only evidence she provided in an attempt to link Super Max Peanuts to the respondent was an MPESA message marked RW3 which only showed that she sent money to the respondent in her personal capacity which receipt message did not show the impugned named of Super Max Peanuts.
39. A closer look at the annexures provided by the applicant, the print out marked RW3 of the Super Max Peanuts clearly indicates that the packaging was done by Gazebo Merchants. It is evident that the applicant has not shown the link between the respondent, Super Max Peanuts and Gazebo Merchants.
40. In my view, the applicant has not shown that there exists actual distinctive features of her trade mark which is protected from that of the respondent as the applicant merely annexed a print out of images. It would appear from the averments of the parties that the respondent was already in the business of trading in various goods before the cause of action arose. The respondent annexed receipts showing that she purchased some goods from the applicant on various dates until July 2023. Furthermore, the respondent was trading with the applicant before the applicant registered her trademark in August 2023.
41. It is my considered view that the applicant has not established a *prima facie* case with a probability of success to justify granting of an injunction. The applicant having failed to qualify for the grant of an interlocutory injunction, it is evident that it can hardly satisfy the more stringent conditions for the grant of an Anton Pillar Order.
42. The applicant in her Further Affidavit wishes to amend the respondent's name from Fransica Muthoni to Fraciah Muthoni. This prayer is not sustainable as the applicant has sought to amend her pleadings in an affidavit instead of filing a formal application to be heard inter parties.

Conclusion

43. I reach a conclusion that the application dated 15th March 2024 lacks merit and is hereby dismissed with costs to the respondent.
44. The costs shall abide in the suit.
45. It is hereby so ordered.

RULING DELIVERED, DATED AND SIGNED AT THIKA THIS 4TH DAY OF JULY 2024.



F. MUCHEMI
JUDGE

