



**Osho Chemical Industries Limited v Moiben Connections Limited & another (Commercial Case E010 of 2023) [2023] KEHC 2315 (KLR) (Commercial and Tax) (17 March 2023) (Ruling)**

Neutral citation: [2023] KEHC 2315 (KLR)

**REPUBLIC OF KENYA**  
**IN THE HIGH COURT AT NAIROBI (MILIMANI COMMERCIAL COURTS)**  
**COMMERCIAL AND TAX**  
**COMMERCIAL CASE E010 OF 2023**  
**DAS MAJANJA, J**  
**MARCH 17, 2023**

**BETWEEN**

**OSHO CHEMICAL INDUSTRIES LIMITED ..... PLAINTIFF**

**AND**

**MOIBEN CONNECTIONS LIMITED ..... 1<sup>ST</sup> DEFENDANT**

**JOJEMI EAST AFRICA LIMITED ..... 2<sup>ND</sup> DEFENDANT**

**RULING**

**Introduction and Background**

1. The plaintiff has filed the Notice of Motion dated October 11, 2022 made, inter alia, under Order 40 Rules 1, 2, 4 and 8 of the [Civil Procedure Rules](#) seeking the following orders:
  1. Spent\*
  2. Pending the hearing and determination of the suit, the defendants be restrained from doing the following acts:
    - a. Passing off, or attempting to pass off or causing, enabling or assisting others to pass off its products known as 'IMPRESS' or any similar name as that of the plaintiff's product.
    - b. Infringing on the plaintiff's trademark, 'MISTRESS' which is registered as Trademark No. 78539 in Class 1 (Chemicals used in agriculture, horticulture and forestry), and 5 (Insecticides, fungicides, herbicides).



- c. Manufacturing, importing or exporting, selling offering for sale, distributing, marketing, advertising and promoting products bearing the trade name 'IMPRESS' or any other name, mark or designation bearing a close resemblance thereto.
  - d. Passing off any of their products as the products of the plaintiff and particularly but not limited to any products under the brand name 'IMPRESS'.
  - e. Parting with possession, power, custody (other than to the plaintiff or its agents) of or in any way altering, defacing, or destroying the following articles or any of them:
    - i. Products which infringe the said trademark 'MISTRESS'.
    - ii. Goods which are being passed off as the goods of the plaintiff and particularly but not limited to any products manufactured and/or marketed by them under the unregistered mark 'IMPRESS'.
    - iii. All documents, files, packaging materials, cartons, printing blocks, prints, invoices, receipts, articles or equipment relating to the importation, purchase, manufacture, sale or supply of products particularly but not limited to any products manufactured and/or marketed by it under the unregistered mark 'IMPRESS' which are being passed off as the goods of the plaintiff and which are also being or have been passed off as the plaintiff's goods or relating in any other way to the aforesaid passing off and to infringement of the said plaintiff's trademarks.
3. The defendants be ordered to give under oath, all supporting documents not limited to invoices and receipts, an account of those profits made and arising out of the sale of the product, 'IMPRESS', down to the date when the defendants cease passing off 'IMPRESS' as the plaintiff's product, 'MISTRESS' or further orders of this court.
  4. The defendants do produce under oath supported by documentary evidence, of their monthly sales of 'IMPRESS' down to the date when the defendants cease passing off the plaintiff's product known as 'MISTRESS' or further orders of this court.
  5. Any further orders in the interest of justice.
  6. The costs of the application be the plaintiffs in any event.
2. The application is supported by the grounds set out on its face together with the supporting affidavit of Manoj K. Shah, the plaintiff's Chief Executive Officer, sworn on October 11, 2022. It is opposed by the 1<sup>st</sup> defendant through the replying affidavit of its Managing Director, Antonio David, sworn



on February 6, 2023 and by the 2<sup>nd</sup> defendant through the replying affidavit of its Executive Director, Esther Wamuyu Waithaka, sworn on January 30, 2023. The parties have also supplemented the arguments in their pleadings by filing written submissions.

3. From the parties' pleadings, it is not in dispute that the parties are all in the business of selling insecticides and other chemicals for use in agriculture. The plaintiff is and has at all material times since 2013 been the registered proprietor of the trademark, 'MISTRESS' under Trademark No. 78539 in Class 1 (Chemicals used in agriculture, horticulture and forestry), and 5 (Insecticides, fungicides, herbicides). The 2<sup>nd</sup> defendant is also the registered proprietor of the trademark "IMPRESS" under trade mark number 113851 in Class 5 (fungicides) of International Classification of Goods and Services.
4. On 16<sup>th</sup> January 2023 the plaintiff filed suit together with the instant application against the defendants accusing them of deceptive imitation and get up of their 'IMPRESS' product and passing off the same as that of the plaintiff's 'MISTRESS' product and now seeks the interim orders highlighted above.

### **The Application**

5. The plaintiff states that it has been selling, promoting and advertising the MISTRESS product in Kenya and selling the same in distinct packaging continuously since 2007. It contends that its trademark has a reputation in Kenya owing to its reputation as a leading manufacturer and distributor of agricultural products and as a result of the plaintiff's investment in growing the 'MISTRESS' product in the market.
6. The plaintiff accuses the defendants of using offending names and branding that is intended, targeted and calculated to deceive and confuse the average consumer of its products and the public in general. The plaintiff avers that 'IMPRESS' is a fungicide for the control of early and late blight in potatoes and tomatoes and downy mildew on roses, it is packaged in a shiny yellow packet, the name 'IMPRESS' is printed in black at the top of the package, below the label on the left is a picture of healthy-looking rose, tomatoes and potatoes, the middle part of the package has writing explaining the use of the product and the package contains 1kg of the product.
7. The plaintiff further contends that buyers would be misled into thinking that they are purchasing the plaintiff's product, especially given the fact that the offending product came to be sold and marketed under the name 'IMPRESS', long after the plaintiff had marketed, sold and distributed its product. That the use of substantially similar packaging and names is aimed at misrepresenting and intended and calculated to deceive the public and consumers that the offending product is the plaintiff's product or associated with it and the customers who have been accustomed to purchasing 'MISTRESS' on account of its distinctive name are now being deliberately deceived by the deceptively similar naming and packaging.
8. The plaintiff asserts that the copying of the plaintiff's packaging both singly and in combination was meant to pass off the defendants' product as that of the plaintiff and in particular deceive shopkeepers and consumers, both literate and illiterate into the belief that they were purchasing a product that was manufactured by the plaintiff. It reiterates that it holds a large market share for the 'MISTRESS' products, hence the real danger that the defendants are passing off the plaintiff's trademark to take advantage of the plaintiff's market penetration.
9. The plaintiff urges that the defendants should give an account of all profits they have made since they began passing off the plaintiff's 'MISTRESS' products and that an account should be given to show the defendants' sales from when they started dealing in the 'IMPRESS' products in Kenya. That



despite demand made to the defendants to cease and desist from passing off the plaintiff's products and Trademarks, the defendants have failed to comply.

### **The defendants' Replies**

10. The 1<sup>st</sup> and 2<sup>nd</sup> defendants deny the allegations against them. They assert that they have not passed off or attempted to pass off, caused, enabled or assisted others to pass off the plaintiff's MISTRESS product as the 2<sup>nd</sup> defendant's IMPRESS product and insist that the packaging and names of the two products are distinct and distinguishable. The 2<sup>nd</sup> defendant supports the position taken by the 1<sup>st</sup> defendant and urges that the plaintiff has not made out a case to warrant the grant of an injunction and ancillary orders.
11. The 1<sup>st</sup> defendant states that it granted authority to the 2<sup>nd</sup> defendant for purposes of parallel registration of its IMPRESS product by the Pest Control Product Board but that since the parallel registration of the 2<sup>nd</sup> defendant's IMPRESS trade mark, the 1<sup>st</sup> defendant has never had any dealing and/or joint business engagement with 2<sup>nd</sup> defendant and further the 1<sup>st</sup> defendant is not privy to the 2<sup>nd</sup> defendant's business engagement. The 1<sup>st</sup> defendant insists that it has never had any dealing and/or engagement with 2<sup>nd</sup> defendant with regard to the plaintiff's MISTRESS products and does not deny that on January 18, 2023, it received a demand notice from the plaintiff to the effect that the 1<sup>st</sup> defendant was allegedly passing off its "MISTRESS" product as "IMPRESS". It denies the allegation in the demand notice.
12. The 1<sup>st</sup> defendant does not deny that it has been buying the plaintiff's MISTRESS product from 2012-2021 for its business but avers that the same has never been passed off as alleged. It states that it is not privy to the validity of the plaintiff's MISTRESS promotion and advertising in Kenya and that it deals in agricultural products and is not privy to the 2<sup>nd</sup> defendant's business venture and /or transactions with regard to the IMPRESS product.
13. The 1<sup>st</sup> defendant states that it has not put in the market and/or sold the plaintiff's 'MISTRESS' product to the 2<sup>nd</sup> defendant and that it is a stranger to the offending name and packaging of the 'IMPRESS' products. It states that the IMPRESS products are not similar, deceptive or confusing to any average consumer of the plaintiff's product and public. That due consideration of conceptual, visual and phonetic features of the of both the plaintiff's MISTRESS and 2<sup>nd</sup> defendant's IMPRESS and their packaging discloses distinctions and distinguishable elements which cannot deceive and/or confuse ordinary consumers of the two products from the plaintiff and 2<sup>nd</sup> defendant.
14. The 1<sup>st</sup> defendant contends that the plaintiff has not provided any evidence of the alleged reputation and market of its products and that the alleged similarity elements are selective and not comprehensive for conceptual, visual and phonetic consideration. That the plaintiff's MISTRESS and the 2<sup>nd</sup> defendant 's IMPRESS together with their packaging are distinct and distinguishable as shown in its deposition and that the buyers would not be misled.
15. The 1<sup>st</sup> defendant states that the plaintiff is deliberately misleading by erroneously selecting portions of the trade mark name and packaging features instead of holistic conceptual, visual and phonetic considerations. That the holistic conceptual, visual and phonetic consideration of the trademarks and packaging thereof, disclose no passing off, infringement, deception or confusion in the use of the 2<sup>nd</sup> defendant's trade name and packaging of the IMPRESS product.



## Analysis and determination

16. From the pleadings, evidence and arguments by the parties, the main issue for resolution is whether the defendant should be restrained from the violating or otherwise breaching the plaintiff's trademark. If so, whether the plaintiff is entitled to consequential relief.
17. There is no dispute that the three requirements the plaintiff has to satisfy in order to obtain an injunction were settled in *Giella v Cassman Brown* [1973] EA 348. The first requirement is that an applicant must demonstrate that it has a *prima facie* case with a probability of success. Second, that it will suffer irreparable injury which cannot be compensated by an award of damages if a temporary injunction is not granted, and last, if the court is in doubt show that the balance of convenience is in its favour. In *Nguruman Limited v Jane Bonde Nielsen and 2 others* NRB CA Civil Appeal No. 77 of 2012 [2014] eKLR the Court of Appeal explained that each of the conditions or requirements must be applied as separate, distinct and logical hurdles which an applicant is expected to surmount sequentially. This means that if the applicant does not establish a *prima facie* case then irreparable injury and balance of convenience do not require consideration. On the other hand, if a *prima facie* case is established, then the court will consider the other conditions.
18. The Court of Appeal in *Mrao Ltd v First American Bank of Kenya Limited and 2 others* [2003] eKLR explained that 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 been infringed by the opposite party to call for an explanation or rebuttal from the latter." Thus, in order to succeed in getting an interlocutory injunction, the plaintiff is expected to demonstrate that the defendants have been passing off their products as those of the plaintiff and that they have been infringing on the plaintiff's trademark.
19. Under section 7 of the *Trade Marks Act* (Chapter 406 of the Laws of Kenya), the registration of a trademark confers on the owner the right of exclusive use of the mark (see *Solpia Kenya Limited v Style Industries Limited & another* ML HCCC No. 138 of 2014 [2015] eKLR). In order to succeed in an action for infringement or breach of a trademark, the plaintiff needs to prove that it is the registered proprietor of the mark, that the alleged infringement was a mark identical which, or so nearly, resembles that of the registered mark so as to be likely to deceive or cause confusion in the course of trade or in connection with the provision of services in respect of which it is registered, that the use of the mark is without consent or authority of the proprietor; and that the use of the mark is such that it is likely to cause injury or prejudice to the proprietor or licensee of the Trade Mark.
20. As stated, it is not in dispute that the plaintiff is the proprietor of the registered trademark 'MISTRESS' while the 2<sup>nd</sup> defendant is the proprietor of registered trademark 'IMPRESS'. The plaintiff contends that the name 'IMPRESS' is deceptively similar to the name 'MISTRESS' and so is the packaging of the parties' two products so as to cause confusion to members of the public. At this point, let me reiterate that the court is only being called to make a *prima facie* rather than a conclusive determination, as the latter can only be done after a full hearing. Thus, on a *prima facie* basis, can it be stated that the name 'IMPRESS' and 'MISTRESS' are deceptively similar so as to cause confusion to unsuspecting members of the consuming public? I think not. I agree with the defendants that the two names are quite distinct and distinguishable in light of their conceptual, visual and phonetic features that cannot ordinarily deceive and/or confuse consumers of those products. The two words contain visually and phonetically different first letters, that is, 'IMP' and 'MIST' with the only similarity being the letters 'RESS'. These letters put together give the words very different meanings and pronunciations and they do not on the face of ordinary circumstances phonetically sound similar or visually appear similar.



21. I can also say the same of the packaging of the two products. From the photographs annexed by the parties, the get ups of the two products' packaging indicate different designs, images and wordings which are not confusing at least to a rational naked eye. In as much as the packaging of both products contain a dominant yellow colour, the plaintiff's is clearly distinguishable as it has some blue and green strips whereas the 2<sup>nd</sup> defendant's has neither and only has what appears to be pink. The Court of Appeal, in *Cut Tobacco Kenya Ltd v British American Tobacco (K) Ltd*, Civil Appeal No. 126 of 2000 [2001] eKLR stated that there can be no propriety rights in a particular colour and there can be no property in general words descriptive of the goods. I therefore find that the defendants' 'IMPRESS' products are not deceptively similar to that of the plaintiff's 'MISTRESS' so as to confuse members of the public.
22. As to whether the defendants have been passing off the plaintiff's 'MISTRESS' products as those of the defendant's 'IMPRESS, I find that this is an issue that can be best determined at trial where the parties can adduce oral and documentary evidence whose veracity can be tested in cross examination. As was held in the unreported case of *Hoswell Mbugua Njuguna t/a Fischer & Fischer Marketing v Equity Bank Limited* HCCC No. 599 of 2010 [2015] eKLR, in the absence of oral evidence which can be tested by way of cross examination, it would be difficult to ascertain whether a defendant has infringed on any intellectual property rights of a plaintiff (see also *Webtribe Limited T/A Jambopay v Jambo Express Limited* HC COMM Misc. Appl. No. 159 of 2019 [2014] eKLR). In any case, the plaintiff has not adduced any *prima facie* evidence that demonstrates that the defendants have been passing off its products.
23. I therefore find that on a *prima facie* basis, the plaintiff has not demonstrated that the defendants have been passing off its 'MISTRESS' products. In sum, the plaintiff has failed to surmount the first hurdle for the grant of an injunction and its quest for the same stops at this point in line with the dicta in the *Nguruman Case* (*supra*).
24. The plaintiff also seeks an order for accounts and documents. This order is consequential upon the proof of a *prima facie* case. Having reached the conclusion that the defendants have not been passing off their products as those of the plaintiff and that the defendants' products are not deceptively similar to that of the plaintiff, I find no basis and relevance for ordering the defendants to produce their accounts or those documents requested for by the plaintiff.

### **Disposition**

25. For these reasons, I dismiss the plaintiff's application dated October 11, 2022 with costs to the defendants.

**DATED AND DELIVERED AT NAIROBI THIS 17<sup>TH</sup> DAY OF MARCH 2023.**

**D. S. MAJANJA**

**JUDGE**

Court of Assistant: Mr M. Onyango

Ms Muturi instructed by Rilani Advocates for the plaintiff.

Mr Marienga instructed by Marienga and Company Advocates for the defendants.

