



Diageo Scotland Limited & another v London Distillers (Kenya) Limited (Civil Suit E192 of 2019) [2022] KEHC 94 (KLR) (Commercial and Tax) (11 February 2022) (Ruling)

Neutral citation: [2022] KEHC 94 (KLR)

**REPUBLIC OF KENYA
IN THE HIGH COURT AT NAIROBI (MILIMANI COMMERCIAL COURTS)
COMMERCIAL AND TAX
CIVIL SUIT E192 OF 2019
A MABEYA, J
FEBRUARY 11, 2022**

BETWEEN

DIAGEO SCOTLAND LIMITED 1ST PLAINTIFF

UDV (KENYA) LIMITED 2ND PLAINTIFF

AND

LONDON DISTILLERS (KENYA) LIMITED DEFENDANT

RULING

1. The defendant has moved the Court through an application dated 7/5/2021 under Order 2 Rule 15 of the [Civil Procedure Rules](#) to have the plaint dated 21/6/2019 struck out and the suit dismissed accordingly.
2. The application is premised on the grounds that the plaintiffs, instead prosecuting this suit, lodged a Notice of Opposition to the Application for Registration of a Trade Mark against the defendant with the Registrar of Trade Marks (hereinafter “Registrar”); that the suit has not been prosecuted and is stuck in the pre-trial stage; that the plaintiffs have caused two concurrent matters before this Court and the Registrar with both seeking the same result and being actively pursued.
3. Further, that the plaintiffs have filed an application seeking stay orders from the Registrar against their own opposition proceedings against Trade Mark Application No.107015 and that the defendant herein lodged the application for registration of trade mark without the knowledge of the filing of this suit.
4. The plaintiffs jointly opposed the application vide grounds of opposition dated 19/5/2021 and a replying affidavit sworn on 3/6/2021.



5. In the grounds of opposition, they contend that the suit is rightfully before this Court as the Registrar does not have the authority to grant the orders prayed for in the plaint dated 21/6/2019; that the opposition proceedings filed before the Registrar were rightfully instituted therein to challenge the registration of the impugned mark.
6. The plaintiffs further contend that there has been inordinate delay in filing the present application as the matter has been in Court severally for case management conference without protest from the defendant and that the defendant has been aware of the opposition proceedings since 22/7/2019.
7. The plaintiff argued that the present application was a mere delay tactic that would defer the hearing of the suit causing prejudice to the plaintiffs.
8. In his replying affidavit Eva Kagundu, the 2nd plaintiff's legal manager, state that while the issues raised in the opposition proceedings and this suit are similar, the reliefs sought are not and that it is incumbent upon the plaintiffs to ensure that they address their grievances in the appropriate forums in accordance with the reliefs sought. That if this Court were to find that the defendant had infringed the 1st plaintiff's trademark, the Registrar may be prevented from registering the contested trademark by the Court and therefore it is prudent that this suit is determined first.
9. The Court has considered the record. The plaintiffs' dispute with the defendant lies in the alleged violation of their trade mark by the defendant. They claim that the defendant's use of the product known as 'General Meakins' violates the 1st plaintiff's trademark in the product 'Captain Morgan'.
10. The defendant accused the plaintiffs of forum shopping and submitted that the plaintiffs filed the present suit and immediately after, filed opposition proceedings before the Registrar over the same subject matter; that the High Court should only deal with appeals from the Registrar under the [Trade Marks Act](#).
11. Conversely, the plaintiffs submitted that the reliefs sought before this Court relate to the defendant's infringement of the 1st plaintiff's Captain Morgan Trade Marks and the relief sought before the Registrar is the rejection of the defendant's application to register the contested trade mark.
12. The present suit was instituted vide a plaint dated 21/6/2019 and the application to register a trademark on 30/9/2019. While the objection proceedings opposing the said trademark application were lodged in September of 2019.
13. A perusal of the plaint shows that the plaintiffs primarily seek permanent injunctive relief to restrain the defendant from dealing in any manner with the product known as General Meakins which is alleged to infringe on the 1st plaintiff's trademarks.
14. The Court is of the opinion that the objection proceedings instituted by the plaintiffs was merely reactive to the defendant's application to register a trade mark on its product. Under Section 29 of the Trademarks Act, the plaintiffs may oppose an application for registration within the prescribed time from the time of the advertisement.
15. As such the Court finds that, despite the pendency of this suit, the opposition proceedings were a necessary measure for the plaintiffs to protect their interest in their registered trademarks.
16. The Court further notes that the present application that sought to have this suit dismissed was filed in May of 2021 while the objection proceedings were filed in September of 2019. An inordinate and unexplainable delay leads to a conclusion that the application might have been an afterthought on the part of the defendant.



17. The grounds to be considered before a court can strike out and dismiss a suit are set out under Order 2 Rule 15 of the Civil Procedure Rules 2010. These include where a pleading discloses no reasonable cause of action or defence in law, it is scandalous, frivolous or vexatious; where it may prejudice, embarrass or delay the fair trial of the action; or it is otherwise an abuse of process of the court.

18. In *Kivanga Estates Limited v National Bank of Kenya Limited* [2017] eKLR, the Court of Appeal cited with approval, the decision in *Trust Bank Limited v Amin Company Ltd & Another* (2000) KLR 164 wherein it was held that: -

“A pleading or an action is frivolous when it is without substance or groundless or fanciful and is vexatious when it lacks bona fides and is hopeless or offensive and tends to cause the opposite party unnecessary anxiety, trouble or expenses. A pleading which tends to embarrass or delay fair trial is a pleading which is ambiguous or unintelligible or which states immaterial matters and raises irrelevant issues which may involve expenses which will prejudice the fair trial of the action”.

19. The Court reiterates the foregoing and finds that the present suit does not fit the above description. The upshot is that I find the application dated 7/5/2021 to be without merit and dismiss the same with costs to the plaintiffs.

It is so ordered.

DATED AND DELIVERED AT NAIROBI THIS 11TH DAY OF FEBRUARY, 2022.

A. MABEYA, FCI Arb

JUDGE

