



REPUBLIC OF KENYA



**KENYA LAW**  
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**City Eye Advertising Agency v Safaricom Limited (PLC) (Commercial Case E391 of 2023)  
[2024] KEHC 14513 (KLR) (Commercial and Tax) (19 November 2024) (Ruling)**

Neutral citation: [2024] KEHC 14513 (KLR)

**REPUBLIC OF KENYA  
IN THE HIGH COURT AT NAIROBI (MILIMANI COMMERCIAL COURTS)  
COMMERCIAL AND TAX  
COMMERCIAL CASE E391 OF 2023  
PM MULWA, J  
NOVEMBER 19, 2024**

**BETWEEN**

**CITY EYE ADVERTISING AGENCY ..... PLAINTIFF**

**AND**

**SAFARICOM LIMITED (PLC) ..... DEFENDANT**

**RULING**

1. The Plaintiff filed the Notice of Motion dated 10<sup>th</sup> July 2023, under Order 40 Rules 1 and 2 of the Civil Procedure Rules seeking a temporary injunction to restrain the Defendant or its agents from infringing its intellectual property rights as the lawful proprietor of T.M. No. 99870 Commuter Train Advert.
2. The application is based on the grounds on its face, the supporting and supplementary affidavit sworn by the Plaintiff's registered proprietor, Zakayo Muchai Wainaina on 10<sup>th</sup> July 2023 and 3<sup>rd</sup> July 2024. The Plaintiff also filed written submissions dated 24<sup>th</sup> April 2024.
3. The Plaintiff's basis for seeking the injunction is that it has a Trademark certificate which is prima facie evidence and has the exclusive right for advertising for third parties under the commuter train advert and that the Defendant violated its rights under Trademark law by advertising its M-pesa product on the Standard Gauge Railway.
4. The Plaintiff submitted that a registered Trademark is prima facie evidence of the validity of registration of the trademark and relied on the decisions in Puma Se v John Githenduku Macharia Mburu [2021] eKLR and Thermos Holdings Limited & another v Doshi Iron Mongers Limited [2020] eKLR.



## Response

5. The Defendant opposed the application through a replying affidavit sworn by its Senior Legal Counsel, Daniel Mwenja Ndaba on 3<sup>rd</sup> July 2024 and written submissions of the same date. It was deposed that prior to this suit, the Plaintiff had written to the Defendant offering to provide advertising services including to advertise its products on a commuter train. However, the Defendant declined its offer. In 2021, Kenya Railways Corporation has announced that it had entered into partnership with Digital Mara as its exclusive advertising partner. The Defendant subsequently contracted the services of Digital Mara to advertise its product on the Standard Gauge Railway.
6. The Defendant argued that the application is bad in law and an abuse of the court process because there is no cause of action against it as it does not offer advertising services and it is a consumer of advertising services offered by a duly registered advertising company. It also argued that the Plaintiff is guilty of material non-disclosure for failure to mention Digital Mara in its claim. It contended that this suit is an attempt by the Plaintiff to retaliate against it for failing to take up its offer for advertising services. The Defendant further submitted that the Plaintiff has not met the conditions for the grant of injunctive orders.

## Analysis and Determination

7. I have considered the application, the parties' respective affidavits, evidence, submissions and authorities cited. The issues for determination is whether the Plaintiff has met the threshold for the grant of the interlocutory injunction sought.
8. At the outset, I find no merit in the argument that the application is bad in law because the Defendant is not an advertising company. The contracting of another party by the Defendant to advertise may constitute infringement if it interferes with the Plaintiff's exclusive rights.
9. The Plaintiff's application is brought under Order 40 Rules 1 and 2 of the Civil Procedure Rules, which provides as follows:

Order 40. rule 1] Cases in which temporary injunction may be granted.

1. Where in any suit it is proved by affidavit or otherwise—
  - (a) that any property in dispute in a suit is in danger of being wasted, damaged, or alienated by any party to the suit, or wrongfully sold in execution of a decree; or
  - (b) that the defendant threatens or intends to remove or dispose of his property in circumstances affording reasonable probability that the plaintiff will or may be obstructed or delayed in the execution of any decree that may be passed against the defendant in the suit, the court may by order grant a temporary injunction to restrain such act, or make such other order for the purpose of staying and preventing the wasting, damaging, alienation, sale, removal, or disposition of the property as the court thinks fit until the disposal of the suit or until further orders.

[Order 40, rule 2.] Injunction to restrain breach of contract or other injury.
- 2.



- (1) In any suit for restraining the defendant from committing a breach of contract or other injury of any kind, whether compensation is claimed in the suit or not, the plaintiff may, at any time after the commencement of the suit, and either before or after judgment, apply to the court for a temporary injunction to restrain the defendant from committing the breach of contract or injury complained of, or any injury of a like kind arising out of the same contract or relating to the same property or right.
- (2) The court may by order grant such injunction on such terms as to an inquiry as to damages, the duration of the injunction, keeping an account, giving security or otherwise, as the court deems fit.”

10. In *Giella v Cassman Brown & Co Ltd*, (1973) E.A 385, at page 360 where Spry J. set out the conditions for the grant of an interlocutory injunction as follows:-

“First, an applicant must show a prima facie case with a probability of success. Secondly, an interlocutory injunction will not normally be granted unless the 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.”

11. As to what entails a prima facie case, the Court of Appeal in *Mrao Ltd v First American Bank of Kenya Ltd & 2 others* [2003] KLR pondered:

“So what is a prima facie case? I would say that in civil cases it 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 as 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. 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.”

12. In addition, in *Colour Planet Limited v Safaricom Ltd & 2 others* [2016] eKLR cited with approval in *Puma Se v John Githenduka Macharia Mburu* [2021] eKLR, the High Court observed as follows:

“It is evident from the fore stated cases that in order for the Court to consider an application for injunction, the principles as enunciated in *Giella v Cassman Brown & Co. Ltd* (1972) EA 358 are considered, as well as the provisions of the law under the *Trade Marks Act*. If it is shown and proven that the trade mark was registered for the exclusive use of the proprietor, then the Court would have to allow for an injunction to dissipate confusion in the minds of consumers and further, the eminent chaos that may arise.”

13. In this case, the Defendant further submitted that the Plaintiff has not met the conditions for the grant of injunctive orders. However, the Plaintiff asserted that it has a Trademark certificate which is prima facie evidence that it has the exclusive right for advertising for third parties under the commuter train advert and that the Defendant violated its rights under Trademark law by advertising its M-pesa product on the Standard Gauge Railway.



14. The Plaintiff exhibited its certificate of registration of trademark No. 99870. Under class 35 Advertising by branding commuter train with advertising material inside and outside of the train.
15. The Plaintiff relied on Section 7 (1) of the Trademark Act which provides as follows:

“7. Right given by registration in Part A, and infringement thereof

(1) Subject to the provisions of this section, and of sections 10 and 11, the registration (whether before or after 1st January, 1957) of a person in Part A of the register as the proprietor of a trade mark if valid gives to that person the exclusive right to the use of the trade mark in relation to those 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 trade mark or a registered user thereof using by way of permitted use, uses a mark identical with or so nearly resembling it as to be likely to deceive or cause confusion in the course of trade or in connection with the provision of any services in respect of which it is registered...”

16. Similarly, Section 46 of the Trademark Act provides:

“Registration to be prima facie evidence of validity

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.”

17. Therefore, I am satisfied that the Plaintiff has demonstrated a prima facie case, that it shall suffer irreparable harm that cannot be compensated by damages and that the balance of convenience tilts in favour of granting the interlocutory injunction.
18. In conclusion, the Plaintiff’s application dated 10<sup>th</sup> July 2023 is merited. It is allowed with costs to the Plaintiff.
- Orders accordingly.

**RULING DELIVERED VIRTUALLY, DATED AND SIGNED AT NAIROBI THIS 19<sup>TH</sup> DAY OF NOVEMBER 2024.**

.....

**P. MULWA**

**JUDGE**

**In the presence of:**

(Plaintiff/applicant - in person) – Mr. Zakayo present

Mr. Bett h/b for Mr Opiyo for defendant/respondent

Court Assistant: Carlos

