



**Masista & another v Ireru (Civil Suit 96 of 2018) [2024] KEHC 14375 (KLR)
(Commercial and Tax) (20 November 2024) (Judgment)**

Neutral citation: [2024] KEHC 14375 (KLR)

**REPUBLIC OF KENYA
IN THE HIGH COURT AT NAIROBI (MILIMANI COMMERCIAL COURTS)
COMMERCIAL AND TAX
CIVIL SUIT 96 OF 2018
A MABEYA, J
NOVEMBER 20, 2024**

BETWEEN

CATHERINE MASISTA 1ST PLAINTIFF

ANDRAS ROZSA 2ND PLAINTIFF

AND

SAMANTHA IRERU DEFENDANT

JUDGMENT

1. This suit was instituted by the plaintiffs vide a plaint dated 25/7/2018 wherein they sought a declaration against the defendant for infringement on the plaintiffs' trade mark 'Samantha' registered as number 76185. They also sought a permanent injunction to restrain the defendant from trading promoting, advertising marketing or carrying out business with the trademark Samantha. That the defendant be directed to deliver to the plaintiffs all branded materials used to advertise, market or package bearing the infringing name Samantha.
2. They pleaded that they were the registered proprietors of the trademark no 76185 Samantha in 12 classes and Samantha Logo in class 45 which were registered on the 21/9/2012 and 13/5/2011, respectively. That prior to the registration, they had been using the tradename since 2004 whereas the defendant had been trading under the tradename Color by Samantha in the makeup Industry.
3. According to the plaintiffs, the defendant had been marketing and advertising her make up in the name Color by Samantha which was identical to the plaintiffs' trademark Samantha. That the defendant's use of the word Samantha on her products infringed on the plaintiffs' right of use granted pursuant to their trademark. That the defendant's actions created the impression she was trading with the name Samantha with the consent of the plaintiffs. That she had taken advantage of the plaintiffs' goodwill over the trademark and thus had infringed on the plaintiffs' trademark.



4. On the particulars for infringement, the plaintiffs stated that the defendant advertised and used into the same market goods in the same class as those of the plaintiffs and bearing the same trademark or deceptively similar to those of the plaintiffs; riding on the plaintiffs' trademarks goodwill; causing confusion and brand dilution in the market, and having the defendant's trade name phonetically and visually similar to that of the plaintiffs.
5. The defendant opposed the suit vide her statement of defence dated 23/8/2018. She admitted that she was a makeup artist by profession and that she started running her business in the year 2006. That her trade Color by Samantha was neither identical nor similar to the plaintiffs' trademark and there was no likelihood of confusion of the two.
6. She averred that her name was Samantha Ireri and she was popularly known as Samantha by her clients, colleagues former school mates as well as professionals in the makeup industry. That she trades under her own name and she does not manufacture the products she uses in her make up business and therefore the plaintiffs' allegations were meant to deceive the Court.
7. Further, that her make up business is run on referrals and therefore there was no real likelihood of confusion as her trade name was not similar to the plaintiffs' trademark. She contended that the plaintiffs had not made out a case for infringement of trademark.
8. At the trial, the defendant did not turn up and the trial therefore proceeded ex-parte. Dr. Catherine Masisa testified as PW1. She adopted her witness statement dated 25/7/2018 as her evidence in chief and produced the bundle of documents as Pexh1. She testified that in 2004, the plaintiffs started publishing a magazine known as Samantha Bridal Weddings which highlighted everything to do with weddings. That the Brand Samantha had been used in various industries including a package for makeup services where brides are transformed through hair art, make up and wedding gown.
9. She told the Court that the company further offers training in makeup application and students are awarded certifications. That the plaintiffs' brand was known and was nominated in several awards whilst the defendant's brand was unknown since it was not nominated.
10. The plaintiffs filed submissions dated 11/9/2023. They submitted that the registration of the plaintiffs' trademark include class 3 which includes soaps, perfumery, essential oils, cosmetics, hair lotions, beneficiaries in class 44 hygienic and beauty care for human beings among other classes.
11. It was submitted that this registration remained valid as it had not been challenged and therefore, the plaintiffs have the exclusive rights to the use of mark in cosmetics and beauty care. That the trademark Samantha was phonetically similar with the defendant tradename Color by Samantha which was likely to cause confusion in the market.
12. It was submitted that the plaintiffs had made a prima facie case with probability of success and they were likely to suffer irreparable damage as the defendant continued to infringe their mark. That they had heavily invested in their brand and had won numerous awards both locally and internationally.
13. I have considered the pleadings before Court and the submissions on record. The case before Court is on infringement of trademark. The plaintiffs sought a declaration that by using the tradename Colour by Samantha, the defendant was infringing on their registered trademark no 76185 SAMANTHA. They therefore sought to restrain the defendant from carrying on business or dealing with the trademark Samantha.
14. It is not in dispute that the plaintiffs are the registered proprietors of the trademark 'SAMANTHA' which was registered as number 76185. Generally, registration of a Trade Mark confers on the person



registered as such the right of exclusive use of the Mark. Section 7 of the Trade Mark Act sets out the rights that accrues by registration in Part A and the 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, and in such manner as to render the use of the mark likely to—
- (a) be taken either as being used as a trade mark;
 - (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 trade mark 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 as proprietor or as licensee to use the trade mark 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 trade mark.”

15. Under this provision, the conditions for trademark infringement include: (1) the unauthorized use of the mark by a party other than the proprietor, (2) the mark being used publicly or in advertising, and (3) the use being likely to result in harm or prejudice to the proprietor, such as confusion or damage to the brand.
16. The plaintiffs’ case is that they had been in business since the year 2004 and the trademark was registered in 2012. That the plaintiffs’ brand Samantha was well known and that they had received several awards with respect to the same brand. On the particulars for infringement, they faulted the defendant for advertising and using the same market goods in the same class as those for the plaintiffs and riding on the plaintiffs’ good will thereby causing confusion. At the trial, the plaintiffs appeared through Pw1 and testified in support of their case.
17. On her part, the defendant stated that Samantha was her name and her clients, friends and colleagues identified her as such. That her business was offering make up services and this was different from what the plaintiffs offered. She stated that she did not own the goods used to perform the services and that her business was run on referrals therefore there was no likelihood of confusion. However, she did not turn up at the trial to support her case.



18. In Halsbury's Laws of England, 4th Edition, Volume 48 at paragraph 85, it is stated that: -

“Subject to certain exceptions and to any conditions or limitations entered in the register, the registration of a trademark (other than a certification trade mark), if valid, gives the proprietor the exclusive right to the use of the trade mark upon or in relation to the goods in respect of which it is registered and any invasion of this right is an infringement of the trade mark. Without prejudice to the generality of the above provision, that right of exclusive user is deemed to be infringed by any person who uses a mark identical with or so nearly resembling the registered mark as to be likely to deceive or cause confusion, in the course of trade, in relation to goods in respect of which it is registered, and in such a manner as to render the use of the mark likely to be taken either (1) as being use of a trade mark; or (2) in certain cases of physical use or advertising, as importing a reference to some person having the right, either as proprietor or registered user, to use the mark, or to goods with which such a person is connected in the course of the trade.”

19. In *Pharmaceutical Manufacturing Company v Novelty Manufacturing Ltd* HCCC No 746 of 1998, referred to by Gikonyo, J in *Solpia Kenya Limited v Style Industries Limited & Another* (2015) eKLR, Ringera, J (as he then was) held that: -

“Registration of a trademark confers the right of exclusive use of the mark. Infringement of the trade mark is a tort of strict liability. Intention and motive are irrelevant considerations... the right is a statutory one”

20. In *Saudia Arabian Airlines Corporation v Saudia Kenya Enterprises Limited* [1986] eKLR, Lord Pearce in his speech in *Daigiri Rum Trade Mark*, [1969] RPC 600, 615 dealt with the words “persons aggrieved” by pointing out that they were used in the first [English] Trademarks Act in 1875 without further definition and added [at page 615] that: -

“In my opinion, the words were intended by the Act to cover all trade rivals over whom an advantage was gained by a trader who was getting the benefit of a registered trade mark to which he was not entitled. If an erroneous entry “[in the register]” gives to his rival a statutory trade advantage which he was not intended to have, any trader whose business is, or will probably be affected thereby is “aggrieved” and entitled to ask that the error should be corrected.

...

At common law, a trader could ask the courts to protect him from the improper use of his mark by others who would pass off their goods as his. But to do this he had to establish by cogent evidence from the purchasing public and the trade that the mark had come to denote his goods and his alone. To avoid the paraphernalia of proof and to help traders by enabling them to see more clearly where they stood in respect of particular trade marks the Trademarks Act were passed. It is, and was intended to be a great advantage to a trader to have his mark registered under the Acts. That advantage to him is to some extent a corresponding disadvantage to his rivals. He was only intended to have it if necessary qualifications are fulfilled. If they are not, the mark is not to be entered on the register. If it subsequently appears that it is wrongly entered on the register it is to be removed. For to permit it to remain would give him, at the expense of his rivals an advantage to which he is not entitled.”



21. In view of the foregoing, the burden of proof in trademark infringement lies with the proprietor who claim that his/her trademark has been infringed. It is not enough to state that a trademark has been infringed, there has to be evidence of the infringement and the likely prejudice to be suffered. The Court notes that, it is not uncommon for individuals to use their own name in commerce, especially where the name is part of the individual's identity or personal brand.
22. In this regard, the mere use of the name "Samantha" does not automatically constitute trademark infringement. The central issue in this case is whether the use of the name "Samantha" by the defendant creates a likelihood of confusion among consumers, especially in light of the plaintiffs' claim that their brand is well-known and widely recognized.
23. PW1 testified that "Samantha" is a well-known brand, and that it is featured across several television stations. The plaintiffs further claimed that they first became aware of the possible infringement when a customer asked about the defendant's Instagram page. Even though the plaintiffs did not produce the customer who allegedly got confused with the defendant's Instagram page, the plaintiffs' evidence to that fact remained unrebutted and neither was it challenged.
24. I have considered the defendant's defence that her name was Samantha and she was only trading in the name and style of Color by Samantha. However, the defendant failed to appear and offer evidence to support those assertions. In *AMK VS. Kenya Power & Lighting Company Limited* [2020] Eklr, it was held: -

“Where a party fails to call evidence in support of its pleading (be it a plaint or defence), the evidence of the opposing party is to be believed as having not been rebutted, unless effectively and displaced in cross-examination. In this case, the evidence was not displaced in cross-examination. Accordingly, the evidence of the plaintiff was uncontroverted. See *Edward Mariga vs. Nathaniel David Schulter & Another* [1997] Eklr.
25. In the present case, the defendant having failed to appear and controvert or challenge the testimony of Pw1, the latter's testimony remained uncontroverted is to be believed. There is nothing on record to show that the defendant was trading in ger name to warrant the invocation of section 11 of the [Trade Marks Act](#) in her favour.
26. In the premises, I find that the plaintiffs have proved their case to the required standard and I enter judgment against the defendant as prayed for in the plaint.

It is so decreed.

DATED AND DELIVERED AT NAIROBI THIS 20TH DAY OF NOVEMBER, 2020.

A. MABEYA, FCI Arb

JUDGE

