



Primedia Limited (Superbrands East Africa) v Topscorebrands Global Limited (Commercial Case E578 of 2023) [2024] KEHC 15608 (KLR) (Commercial and Tax) (5 December 2024) (Ruling)

Neutral citation: [2024] KEHC 15608 (KLR)

**REPUBLIC OF KENYA
IN THE HIGH COURT AT NAIROBI (MILIMANI COMMERCIAL COURTS)
COMMERCIAL AND TAX
COMMERCIAL CASE E578 OF 2023
PM MULWA, J
DECEMBER 5, 2024**

BETWEEN

PRIMEDIA LIMITED (SUPERBRANDS EAST AFRICA) PLAINTIFF

AND

TOPSCOREBRANDS GLOBAL LIMITED DEFENDANT

RULING

Introduction

1. Before the court for determination is the Plaintiff's Notice of Motion dated 24th November 2023 brought under Order 40 Rules 2(1) & (2) of the Civil Procedure Rules and Sections 1A, 1B, 3A & 3B of the *Civil Procedure Act* seeking an injunction to restrain the Defendant whether by itself, its servants or agents and/or otherwise whomsoever from offering for sale their trademark, products, services, certification, awards and/or branding bearing the names "Topscorebrands", "Topscorebrands Kenya", "Topscorebrands Global" and/or any similar variation or image thereof and using its infringing marks in relation to their services pending the hearing and determination of this suit.
2. The application is supported by the grounds set out on its face together with the supporting affidavit of Juma Abdulrahman, the Plaintiff's Brand Liaison Officer sworn on 28th February 2023. It is opposed by the Defendant through the replying affidavit of Harun Muthomi Kiriba sworn on 13th March 2024. The application was canvassed by way of written submissions which are on record.
3. The Plaintiff's case is that it runs a business whose core functions are inter-alia, public relations consultants, advertising contractors and agents, acquiring and disposing of advertising space, time or opportunities in any media, undertaking advertising and promotional campaigns of every nature. That it is the registered owner of the trademark/certification trademark "SUPERBRANDS", Trade Mark No. 62290 under the *Trade Marks Act* (Chapter 506 of the Laws of Kenya), class 1, 2, 3, 4, 5, 6, 7, 8,



9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 33, 34, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44 and 45 and that it holds a valid certificate of renewal of the trademark issued on 27th August 2018 (the Trademark).

4. The Plaintiff avers that the Defendant is not an affiliate of the Plaintiff and has never at any point in time been given authority to use the Plaintiff's Trademark in any manner whatsoever or to use variations of the Trademark and/or to modify it in any way. The Plaintiff claims that it has suffered and continues to suffer huge losses in business as a result of the Defendant's use of the name "Topscorebrands", "Topscorebrands Kenya", "Topscorebrands Global" and its infringing marks which are identical to that of the Plaintiff thus confusing the Plaintiff's clients that the services offered by the Defendant are indeed those of and/or affiliated with those of the Plaintiff.
5. The Plaintiff further avers that the Defendant continues to place adverts and run its social media platforms under the name and/or branding bearing the names of these marks and/or such similar variation thereof so similar to those of those of the Plaintiff as to cause confusion to the general public.
6. The Plaintiff contends that these acts reek of unfair business practices, informed by malice and are meant to ride on the Plaintiff's goodwill and drive it out of business without due regard to the sacrifice both economically and socially invested by the Plaintiff over the years to build its clientele base. That the Plaintiff's business flourishes on the trust of its clientele, the quality and integrity of its products and the Plaintiff has been injured in its reputation and has suffered and will continue to suffer loss and damage unless the Court intervenes.
7. The Plaintiff accuses the Defendant of threatening to repeat its actions unless restrained by the Court and that in fact, the Defendant recently held an award ceremony issuing certification bearing the infringing marks to various companies and/or businesses which are strikingly similar to those of the Plaintiff despite the Plaintiff having previously issued a demand to the Defendant to desist from using the similar marks which continually infringe the Plaintiff's rights and undermines its reputation. For these reasons, the Plaintiff urges that the orders sought be granted.
8. In response, the Defendant states that the present application lacks merit, is vexatious, desperate and an abuse of court process and it is made with the sole intention and aim of misleading the court and as such should be dismissed at the first instance. The Defendant first raises the preliminary issue that the Plaintiff's deponent has no authority to institute the suit on behalf of the Plaintiff. On the substance of the application, the Defendant depones that the Plaintiff has not disclosed any legal ownership of the Trademark and that the registered ownership has not been distinguished before the court by the Plaintiff.
9. The Defendant claims that the Plaintiff is not and has never been the registered owner of the Trademark as the said name is not registered and that there was no resemblance between the two marks and the same is not deceptive. That the name "SUPERBRANDS" is a generic name which can be used by anybody as long as the name is not used as a Business Name or for Trading.
10. The Defendant avers that it was registered on the 17th July 2021 but has never advertised on the Plaintiff's website and social media platforms to offer services as those of the Plaintiff and has never copied the Plaintiff's Trademark Logo and Mark images in a bid to ride on the Plaintiff's market goodwill that it has built over a decade in order to gain an unfair market advantage. That the Defendant has never used plagiarized/pirated images and/or imitations of the Plaintiff's registered trademark logo and mark images which are strikingly similar so as to gain an unfair competitive advantage.
11. The Defendant admits that it held an award towards the end of the month of October 2023 and in early November 2023 but denies that it has ever issued out, distributed and offered reproductions,



- plagiarized, modified and/or imitated logo and mark images of the Plaintiff to various business owners as awards. That the Defendant awards business and companies that subscribes to them for test performance in their respective fields of operation and that the businesses are awarded with certificates of good/best performance under the umbrella of the Defendant's Topscorebrands which is a generic name.
12. The Defendant asserts that it has never used the infringing copied/imitated logo and mark images of the Plaintiff and cannot cause any confusion among consumers as it has not engaged in business/trade. That the Plaintiff has not given particulars to be proved that the name of TopscorebrandS by the Defendant amounts to an infringement and that the Defendant has never calculated to dupe and mislead the general public into the belief that the Defendant's services are the Plaintiff's and into securing the Defendant's services as though they were the Plaintiff's services.
 13. The Defendant states that no particulars of loss nor damage have been given by the Plaintiff and that no loss or harm shall befall the Plaintiff since the Defendant is not using his name nor trading or selling the Plaintiff's products. The Defendant is a registered company in Kenya and continues to award the best performing businesses/companies who subscribe to them.

Analysis and determination

14. I have gone through the application, the Defendant's response and the parties' submissions. Before determining the substance of the application, I note that the Defendant raised a preliminary issue that the Plaintiff has not annexed a resolution from the Plaintiff granting it authority to institute this suit. However, from the record, I note that the Plaintiff's deponent has filed a verifying affidavit deponing that he has authority from the Plaintiff to act for it in this suit and that it has annexed a Letter of Authority presumably from the Plaintiff to this effect. Whereas the Plaintiff can argue that this is not necessarily a board resolution, I find that this Letter of Authority is prima facie proof that the deponent has authority to institute and continue this suit and the Defendant has not produced evidence stating otherwise. In any event, such a defect is not fatal and can be cured by providing the relevant resolution as there is no requirement in the Civil Procedure Rules that an authority to file suit must be filed or that it cannot be produced at a subsequent date (see [*First Community Bank Limited v Cecil G. Miller t/a Miller and Company Advocates \[2021\] KEHC 284 \(KLR\)*](#) and [*Leo Investments Limited v Trident Insurance Company Limited \[2014\] KEHC 8664 \(KLR\)*](#)).
15. Turning to the substance of the application, the main issue for determination is whether the court ought to grant the injunctive orders sought by the Plaintiff. The parties agree that the three requirements the Plaintiff has to satisfy in order to obtain an injunction were settled in *Giella v Cassman Brown & Co. Ltd [1973] E.A. 358* where the predecessor of the Court of Appeal held that a plaintiff must demonstrate that it has a prima facie case with a probability of success, demonstrate irreparable injury which cannot be compensated by an award of damages if a temporary injunction is not granted, and if the court is in doubt show that the balance of convenience is in its favour.
16. In [*Nguruman Limited v Jan Bonde Nielsen & 2 others \[2013\] KECA 347 \(KLR\)*](#) the Court of Appeal reiterated these conditions and further clarified that they are to 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.
17. As to what constitutes a prima facie case, the Court of Appeal in [*Mrao Ltd v First American Bank of Kenya Ltd & 2 others \[2003\] KECA 175 \(KLR\)*](#) explained that 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 to call for an explanation or rebuttal from the latter.” Thus, in order to succeed in getting an injunction, the Plaintiff is expected to demonstrate that it has a registered trademark which the Defendants have been copying, plagiarizing, pirating and/or imitating to the Plaintiff’s detriment.

18. The Plaintiff has annexed a Certificate and Search indicating that it is the registered proprietor of the trademark “Superbrands” which includes both the name and logo devices indicated therein. I am in agreement with Plaintiff’s submission that under Section 7 of the [Trade Marks Act](#), 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 & Sana Industries Limited \[2015\] KEHC 8101 \(KLR\)](#)).
19. In order to succeed in an action for infringement or breach of a trademark, the Plaintiffs need 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. The Plaintiff has also annexed the images of its logo devices which it claims, the Defendant has copied. The Plaintiff has also annexed the Defendant’s logo which the Plaintiff argues bears a striking resemblance to its logo and is causing confusion to its customers. It should not be lost that at this stage, the court can only pronounce itself on a prima facie basis and that in the absence of oral and documentary evidence which can be tested by way of cross examination, it can prove to be difficult to conclusively state that a defendant has infringed on any intellectual property rights of a plaintiff (see [Webtribe Limited T/A Jambopay v Jambo Express Limited \[2014\] KEHC 1724 \(KLR\)](#)).
21. From the record, I find that the Plaintiff’s trademark name is ‘Superbrands’ whereas the Defendant’s registered company name is ‘Topscorebrands’. Clearly, these two names are distinct and are phonetically and rhythmically different and are unlikely to cause confusion or deceive members of the public.
22. In respect of the Plaintiff’s trademarked logo devices, I note that the same is circular and ringed with a zigzag shape all round with the name ‘Superbrands’ appearing in the middle. The dominant colours appear to be yellow/gold, black, white and grey. On its part, the Defendant’s logo device appears to also be circular with a ringed zigzag shape around it but with the name “Topscorebrands” appearing in the middle. The dominant colours therein appear to be blue, green and maroon with yellow/golden strips running through the circle.
23. In my view and on a prima facie basis I find that the two logos are visually different and are unlikely to confuse a rational citizen as to which logo belongs to which company. I further note that the search annexed by the Plaintiff from the Registrar (JA-3) indicates that trademark is disclaimed that the Trademark gives “No Right To The Exclusive Use Of The Words “award”, “east Africa” And The Indication Of The Year Each Separately And Apart From The Mark As A Whole”. This means that only the words “Superbrands” and the logo device therein are for the exclusive use of the Plaintiff.
24. With the Defendant using a logo device that does not have the name “Superbrands” or a logo device that does not resemble the one that has been trademarked by the Plaintiff, it is my finding the Plaintiff has failed to demonstrate a prima facie case with a probability of success and the odds are stacked against it from obtaining injunctive orders. In light of the dicta in the Nguruman Case (Supra), this marks the end of the Plaintiff’s inquiry.



Disposition

25. For the above reasons, I find that the Plaintiff's Notice of Motion dated 24th November 2023 is not merited and the same is dismissed with costs.

RULING DELIVERED VIRTUALLY, DATED AND SIGNED AT NAIROBI THIS 5TH DAY OF DECEMBER 2024.

P.M. MULWA

JUDGE

In the presence of:

Mr. Maina for Plaintiff

Mr. Oloo for Defendant

Court Assistant: Carlos

