



REPUBLIC OF KENYA



**Chez Sonia Limited v Sonia Mansioui t/a Chez Sonia & 2 others (Civil Case 432 of 2020)
[2021] KEHC 91 (KLR) (Commercial and Tax) (16 September 2021) (Ruling)**

Neutral citation: [2021] KEHC 91 (KLR)

**REPUBLIC OF KENYA
IN THE HIGH COURT AT NAIROBI (MILIMANI COMMERCIAL COURTS)
COMMERCIAL AND TAX
CIVIL CASE 432 OF 2020
WA OKWANY, J
SEPTEMBER 16, 2021**

BETWEEN

CHEZ SONIA LIMITED PLAINTIFF

AND

SONIA MANSIOUI T/A CHEZ SONIA 1ST DEFENDANT

ERNESTO ESTRADA GONZALEZ 2ND DEFENDANT

ESTHER MUTHONI MURIITHI 3RD DEFENDANT

RULING

1. The applicant herein, Chez Sonia Limited, filed the application dated 27th October 2020 seeking orders of temporary injunction to restrain the respondents by themselves, agents or otherwise restraining them from trading using the name ‘Chez Sonia’ which is confusingly similar in get up to the Applicants trade name ‘Chez Sonia Limited’.
2. The application is supported by the affidavit of the applicant’s Director MsSalome Kiende Ibeere and is based on the following grounds: -
 1. THAT the plaintiff/Applicant Company was registered and incorporated in Kenya on about January 2019 in the name of Chez Sonia Limited with one director Salome Kiende IBeere
 2. That the plaintiff’s Company director Salome Kiende Ibeere had acquiesced with the 1st defendant/ respondent herein to run and operate a wine bar business which did not go for long as the two parties disagreed and parted ways.



3. THAT following the disintegration and consequential parting of ways between the parties the 1st defendant/respondent colluded with the 2nd and 3rd defendants and they moved into a wine bar trade christened as Chez Sonia inscribed and painted the name in bold letters in their trade building and social media platforms without the license of the Plaintiff Company.
 4. THAT the defendants without disclosure of the prior existence of the Plaintiff, unlawfully caused a trademark to be registered by the 2nd defendant on 17th May 2019 in the name of chez Sonia thereby jeopardizing the Plaintiffs registration of the trademark.
 5. THAT this trade, use and publication was done well after the plaintiff's Chex Sonia Limited had been registered and was operational and the time the 1st defendant registered its name if any registration, it already had knowledge of the existence of the names Chez Sonia Limited and therefore the use of the plaintiff's name is opportunistic and geared at taking advantage of the global reputation and goodwill of the plaintiff Company in light of its well-publicized impending trade in the Kenyan International Market.
 6. THAT the registration of the 1st defendants Trade mark and the use of the Name Chez Sonia is also calculated to pass off the Defendant as part of or an affiliate of the plaintiff's business and that is why the defendants acquired a name which differed from the plaintiff by mere addition of the word Limited.
 7. THAT this act has caused confusion on the plaintiff's clients and public in general as to who is the true owner of the name and caused loss of business to the plaintiff company as the defendant/respondents jointly and severally went on to tarnish the name of the only director of the applicant/company and the plaintiff.
 8. THAT the respondents unless the temporary injunction is issued continues to trade, use the business name Chez Sonia to the detriment of the plaintiff Company thus causing confusion to the Plaintiff's clients and loss of business and clients to the plaintiff.
 9. THAT the respondents unless the temporary injunction is issued continue to earn income from the use of the plaintiff's trade name causing loss to the plaintiff Company.
 10. THAT the plaintiff will suffer irreparable loss if the respondents are not restrained by this honorable court.
 11. That the defendants will not suffer any harm as they already have a Company registered by the 2nd and 3rd defendants as directors through which they can trade.
3. The respondents opposed the application through the replying affidavit of Mr. Earnasto Estrada Gonzalez, the 2nd respondent herein, who states that he is the registered proprietor of the trademark Chez Sonia under the Trademarks Act and the same was published in the industrial Property Journal No 2019/08. He states that the plaintiff concealed the fact that the name Chez Sonia is derived from the 1st defendant's name. He avers that the applicant's name has never been publicized anywhere in



- Kenya prior to filing the suit and did not enjoy any good will. He further states that the application does not meet the necessary elements of passing off as the name Chez Sonia is only associated with the respondents who have gained its goodwill.
4. The application was canvassed by way of written submissions which I have considered. The main issue for determination is whether the applicant has made out a case for the granting of the equitable remedy of injunction.
 5. The principles governing the granting of orders of injunction were stated in the celebrated case of *Giella vs. Cassman Brown & Co. Ltd* (1973) E.A 385, where at page 360 thereof Spry J. held that: -

“The conditions for the grant of an interlocutory injunction are ...well settled in East Africa. 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.”
 6. *In Mrao Ltd vs First American Bank of Kenya Ltd & 2 Others* [2003] KLR 125, the court provided the definition of what amounts to a prima facie case as follows: -

“...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 the applicant’s case upon trial. That is clearly a standard which is higher than an arguable case.”
 7. The question which arises is whether the applicant has established a prima facie case against the respondents. In answering this question, the court is called upon to examine whether the applicant’s rights have been infringed so as to warrant the granting of orders of injunction pending the hearing and determination of the main suit. The applicant’s case is that it was incorporated on or about January 2019 to carry out operations as a wine club with Salome Kiende Ibeere as the sole Director. The 1st defendant thereafter teamed up with the applicant as a business partner but that their relationship disintegrated due to a disagreement after which the defendants moved to trade with the name Chez Sonia which they caused to be registered as a trademark.
 8. The plaintiff’s case is that the move, by the defendants, to register ‘Chez Sonia’ as a trademark was aimed at taking advantage of the plaintiff’s global reputation and goodwill as the defendants are engaged in similar and identical business to that of the Plaintiff Company. The plaintiff contends that the defendants’ registration of the trademark has caused confusion amongst its customers.
 9. In a rejoinder, the defendants argued that the name ‘Chez Sonia’ was duly registered under the Trademarks Act in the name of the 2nd Defendant as the proprietor and that since the applicant had not published the said name, it did not enjoy goodwill in the market with respect to the same. The respondents submitted that the similarity of the names did not bar the defendant from registering the trademark and that no loss had been occasioned to the plaintiff as a result of the use of the trademark.
 10. Section 7 (1) of the *Trademarks Act* provides that the registration of a person as the proprietor of a trademark if valid gives that person the exclusive right to the use of the trademark in relation to the



goods or in connection with the provision of services and that such right is infringed by a person who not being a proprietor of the trademark or a registered user of the trademark 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 services in respect of which it is registered.

11. In the present case it is not disputed that the plaintiff registered the name “Chez Sonia” as a company under the *Companies Act* whereas the defendants registered the business mark under the Trademark Act.

12. When dealing with a similar matter in *Agility Logistics Limited & 2 Others V Agility Logistics Kenya Limited* [2012] eKLR the court observed that

“...My take on the two pieces of legislation is that whereas the *Companies Act* governs registration of company names, the fact of registration per se does not extend protection to the name of the company itself as does the protection provided by a trademark. The *Companies Act* only protects such names to the extent that no other company can be registered by a similar name but does not protect the intellectual property in the name itself as to confer exclusive use, as does a trademark. The upshot of the foregoing analysis is that in the present matter, the protection provided to the name “Agility” by the trademark registered in favour of the Plaintiffs by far overrides the protection of the name “Agility Logistics” secured through the mere registration of the name as a company. The exclusivity in the use of the name that is conferred upon the Plaintiff through the Kenyan registration of the mark and worldwide by virtue of the status of “well known mark” confers locus standi upon the Plaintiffs to sustain a claim for infringement of the mark that the Defendant cannot equally enjoy by virtue of registration of the company under the *Companies Act*.”

13. Taking a cue from the decision in the above cited case, I find that since it is not disputed that the defendants are the registered proprietors of the name Chez Sonia under the Trademarks Act and that they have been trading with the same name, such registration confers upon the defendants the exclusive right to the said name. While I appreciate the plaintiffs concerns over the similarity of the names and the intention of the defendants, I nevertheless find that the registration of the business name under the *Companies Act* does not bar the defendants from using their duly registered trademark.

14. In a nutshell, I find that the plaintiff has not demonstrated how its rights have been infringed and has thus failed to establish a prima facie case.

15. The Court of Appeal stated as follows over the second condition for the granting of orders of injunction in *Nguruman Limited vs. Jan Bonde Nielsen & 2 Others* [2014] eKLR: -

“On the second factor, that the applicant must establish that he “might otherwise” suffer irreparable injury which cannot be adequately remedied by damages in the absence of an injunction, is a threshold requirement and the burden is on the applicant to demonstrate, prima facie, the nature and extent of the injury...there must be more than an unfounded fear or apprehension on the part of the applicant. The equitable remedy of temporary injunction is issued solely to prevent grave and irreparable injury; that is injury that is actual, substantial and demonstrable; injury that cannot “adequately” be compensated by an award of damages. An injury is irreparable where there is no standard by which their amount can be measured with reasonable accuracy or the injury or harm is such a nature that monetary compensation, of whatever amount, will never be adequate remedy.”



16. With regard to irreparable harm, the plaintiff asserted that it suffered loss of business due to the deception and confusion in the names. The plaintiff argued that no amount of money that can compensate it for the loss of good will. I however not that the plaintiff did not place any material before the court to show that it suffered loss as a result of the use of the name “Chez Sonia” by the defendants. I therefore find that it would be premature to deal with the issue of loss at this interlocutory stage. I further find that the balance of convenience does not favor the plaintiffs herein but tilts in favour of allowing the parties to proceed with the main case on a more intrinsic test of evidence and the law.
17. In the upshot, I find that the application dated 27th October 2020 unmerited and therefore dismiss it with order that costs shall be in the cause.

DATED, SIGNED AND DELIVERED VIA MICROSOFT TEAMS AT NAIROBI THIS 16TH DAY OF SEPTEMBER 2021 IN VIEW OF THE DECLARATION OF MEASURES RESTRICTING COURT OPERATIONS DUE TO COVID-19 PANDEMIC AND IN LIGHT OF THE DIRECTIONS ISSUED BY HIS LORDSHIP, THE CHIEF JUSTICE ON THE 17TH APRIL 2020.

W. A. OKWANY

JUDGE

In the presence of: -

Ms Matheka for Plaintiff/Applicant.

Mr. Ndolo for Defendant/Respondent

Court Assistant: Sylvia.

