



REPUBLIC OF KENYA

IN THE HIGH COURT OF KENYA AT NAIROBI

MILIMANI COMMERCIAL & TAX DIVISION

CIVIL CASE NO. 296 OF 2018

DR. CATHERINE MASITSA1ST PLAINTIFF/APPLICANT

DR. ANDRAS ROZSA2ND PLAINTIFF/APPLICANT

VERSUS

SAMANTHA IRERIDEFENDANT/RESPONDENT

RULING

1. Catherine Masitsa and Andras Rozsa are the Plaintiffs in this matter. They have filed this case alleging infringement of the Trademark No. 76185 SAMANTHA in 12 classes and Samantha Logo in class 45 registered on 21st September 2012 and 13th May 2011 respectively. They have alleged the Defendant, namely Samantha Ireri has infringed their aforesated trademark "SAMANTHA" registered as Number 76185. The Plaintiff, therefore, by this action seek to injunct the Defendant from using, promoting, advertising, marketing or carrying on business or any other trade documents with the said trademark Samantha.

2. The Plaintiff by Notice of Motion dated 25th July 2018 seek interlocutory injunction to restrain the Defendant from infringing the Plaintiff's intellectual property right in the name of Samantha.

3. In the support of that application Catherine Masitsa deponed that the Plaintiffs registered a Trademark SAMANTHA in various classes but specifically, in respect to this suit, in class 3 that is in relation to soaps, perfumery, essential oils, cosmetics, hair lotion and dentifrices. That prior to that registration the Plaintiffs had traded in the name SAMANTHA since 2004. That is Plaintiff published, in 2004, a Magazine known as SAMANTHA Bridal Weddings, and continued to so publish upto 2005 when the Plaintiff entered into Wedding Expo Branded **SAMANTHA WEDDING FAIR**. Plaintiffs proceeded to outline the other various industries the Brand Samantha has been used. Further that the Plaintiffs have a make-up line know as SAMANTHA with a tagline **COLOUR ME BEAUTIFUL**.

4. Catherine Masitsta was informed by her client of an instagram page by the Defendant known as color-by Samantha which shows that Defendant is a make-up artist. That the client thought that color by Samantha was part of the Plaintiff's brand.

5. Plaintiffs' contention is that the Defendant's use of the name color-by Samantha can cause confusion with Plaintiffs' trademark. That the Defendant's use of that mark infringes the Plaintiffs' trademark SAMANTHA which is well known. That if the Defendant is not restrained it could cause irreparable damage to Plaintiffs brand which they have invested heavily since the year 2004. That the Defendant is likely to dilute the Defendant's brand.

6. The Defendant by replying affidavit opposed the application. The Defendant deponed that the Plaintiffs' application is premised on conjecture, misapprehension of facts and therefore a non starter. That the Defendant began trading as a make-up artist under the name and style COLOR BY SAMANTHA in November 2006, which was before the Plaintiffs registered their trademark. That the Defendant chose to trade in that name because Samantha is her name which name she was given by her parents from birth. That it is by that name that that clients, colleagues, peers, former school mates, relatives, friends and professionals in the beauty industry identify the Defendant. That the Defendant's trade name COLOR BY SAMANTHA is not visually or phonetically similar to the applicants trademark SAMANTHA. That the Defendant only offers make up services, a service that wholly relies on her skills as a make-up artist. That the Defendant does not sell nor manufacture soap, perfumery, essential oils, cosmetics, hair lotions, dentifrices which are the class the Plaintiffs registered their trademark.

DISCUSSION

7. I have considered the parties submissions and affidavit evidence.

8. The parties have presented very divergent arguments in this matter. On Plaintiffs' part the contention is that they are the registered owners

of the Trademark SAMANTHA which they allege the Defendant has infringed.

9. The Defendant on her part has stated that there is no likelihood of confusion in her use of the trade name color-by Samantha because her trade is different from that of Plaintiffs, because Samantha is her name and the name her clients, colleagues, and classmates know her by.

10. What is before me is an interlocutory injunction application. I am not expected to make final determination of the dispute, at this stage. This is what the Court of Appeal stated in the case:

MBUTHIA VS. JIMBA CREDIT FINANCE CORPORATION & ANOTHER. [1988] KLR. The Court of Appeal had this to say:-

“The correct approach in dealing with an application for an interlocutory injunction is not to decide the issues of fact, but rather weigh up the relevant strength of each side’s propositions. The lower court judge in this case had gone for beyond his proper duties and made final findings of fact on disputed affidavit.”

11. Bearing the above in mind I begin by saying that the Plaintiffs’ learned advocate, by his submissions, wrongly interpreted the provision or import the Section 11 of the Trade Mark Act, Cap 506. That Section provides:

No registration of a trade mark shall interfere with –

(a) Any bona fide use by a person of his own name or of the name of his place of business, or of the name, or of the name of the place of business, of any of his predecessors in business.

12. My understanding of that section is that a registration of trade mark would not interfere with bona fide use of a person’s name.

13. The Defendant stated that she uses her name, in her business as make-up artist, a name she was given from birth. If that be so the court, before granting any orders of restraint would need to receive evidence on whether or not the Defendants use of the words Color-by Samantha is bona fide. That can only be at full hearing.

14. Further the Plaintiffs’ Certificates of Registration of the Trade Mark SAMANTHA bears the words “This Certificate is not for use in Legal proceedings or for obtaining registration abroad.”

15. Those certificates have been relied upon in these proceedings. What then would be the import of those words in relation to the interlocutory application. That too can only be determined at a full hearing.

16. It is because of the above that I find that Plaintiffs have failed to show a prima facie case with probability of success. It is also my view that the damage the Plaintiff may suffer, if any, can be compensated by an award of damages.

DETERMINATION

17. In the end I find that the Plaintiffs’ application is lacking in merit and the same is dismissed.

18. However, on costs I shall order that they be in the cause because this is matter which can possibly end either way when the Court receives evidence.

19. In conclusion the Plaintiffs’ Notice of Motion dated 25th July 2018 is dismissed but the costs thereof shall be in the cause.

DATED, SIGNED and DELIVERED at NAIROBI this 5TH day of MARCH, 2019.

MARY KASANGO

JUDGE

Ruling Read and Delivered in Open Court in the presence of:

Sophie..... COURT ASSISTANT

..... COUNSEL FOR THE 1ST PLAINTIFF

.....COUNSEL FOR THE 2ND PLAINTIFF

.....COUNSEL FOR THE RESPONDENT