



REPUBLIC OF KENYA

IN THE HIGH COURT OF KENYA

AT NAIROBI

MILIMANI COMMERCIAL & TAX DIVISION

CIVIL CASE NO. 144 OF 2008

STRATEGIC INDUSTRIES LIMITED.....PLAINTIFF

-VERSUS-

BEIERSDORF EAST AFRICA LIMITED.....DEFENDANT

J U D G M E N T

1. Strategic Industries Limited, the Plaintiff herein is an incorporated Company under the companies act. It is the registered owner of the Trade Mark No. 52749 known as “SENSATIONS” registered in Class 3 under the Trade Marks Act Cap 506. That Trade Mark is in respect of nail polish, perfumes, hand and body lotions, creams, lipsticks, hair creams and gels, curl activator gel, crème relaxers, neutralizing shampoo, perm relaxers, hairfoods, normal shampoos, pre softening gel, soaps, toiletries and skin lightening crèmes.
2. Beiersdorf East Africa Limited is incorporated under the Companies Act. It deals with various beauty products under the name of Nivea.
3. The Plaintiff, according to its Complaint, manufactures, distributes and sells a range of cosmetics products under its aforesaid Trade Mark “SENSATIONS”. That the Defendant in disregard of the Plaintiff’s proprietary right, granted by the Trade Mark “SENSATIONS” manufactures, distributes and/or sells body lotion under the name “NIVEA BODY SMOOTH SENSATION” and thereby uses without the Plaintiff’s authority, the Plaintiff’s Registered Mark “SENSATIONS”.
4. The Plaintiff’s case is that registration of its mark gives it the right to exclusively use that mark in respect of the goods that Trade Mark applies. That the Plaintiff accordingly manufactures and sells in the African region a wide range of cosmetic products over their Registered Mark. That over the years, the Plaintiff has established a wide market niche, reputation and goodwill for its goods. That through intensive marketing and advertisement, the Plaintiff has established its market base and has fondly been referred to, in the market as “SENSATIONS”.
5. In the year 2008 the Plaintiff stated it realized its sales volume, of its products, under the Registered Mark, had gone down. On conducting a market survey, it realized that the Defendant had introduced into the market a product “NIVEA BODY SMOOTH SENSATION”.
6. According to the Plaintiff, the use of the word “SENSATION” by the Defendant was causing confusion in the consumer market because the use of that word was visually and phonetically similar to the Plaintiff’s Registered Mark. That the confusion is even more because the Defendant’s product using the word sensation is in the same character, nature and description as those under the Plaintiff’s mark of “SENSATIONS”. The Plaintiff claims that the Defendant had infringed and continues to infringe the Plaintiff’s Registered Mark.
7. The Plaintiff’s claim is denied by the Defendant.
8. The defence case is that the words ‘Nivea Body Smooth Sensation’ is distinct and adapted to distinguish the Defendant’s goods from the goods of other traders in the market. That the colour regime, the graphics and the labeling are so distinct that no reasonable person would consider the Plaintiff’s and Defendant’s to be similar. That they are no close similarities.
9. The Plaintiff, by this claim, seeks orders for declaration that its Trade Mark has been infringed; an injunction restraining the Defendant from manufacturing, selling the body lotion bearing the words or name “SENSATION”; an order that the Defendant ceases and desists from manufacturing, distributing and selling the body lotion bearing the word ‘SENSATION’ and to give an unconditional written undertaking that it will not in the future sell, market, promote, advertise, distribute or import goods bearing the word ‘SENSATION’; an order that the Defendant submits its statements of account detailing the sales records of the infringing goods and an award of damages based on such sales be made; and an order that the Defendant discloses names, places and addresses of the persons or entities to whom it has supplied the

infringing goods and that the Defendant recalls the said goods for purpose of destroying them and in default the Plaintiff be allowed to go into any premises where the infringing goods are manufactured, distributed, stored and/or sold for purpose of confiscating the same for destruction.

ISSUES

10. I have considered the parties issues filed herein but having considered the pleadings and evidence, I am of the view that there are three issues that will determine the controversies between the parties. Those issues are:

a) *Has the Defendant infringed the Plaintiff's registered Trade Mark 'SENSATIONS'?*

b) *If yes, what orders should Court make?*

c) *Who bears the costs?*

ISSUE (a)

11. The Plaintiff obtained registration of the Trade Mark 'SENSATIONS' with effect to 18th March 2002. Although the Plaintiff's witness, Gradus Oluoch Adis, stated that it manufactures and sells its products with that mark in the African region, no evidence was produced before Court to prove such manufacture and sale in the African Region.

12. Again, the Plaintiff failed to prove, before Court, what its witness stated that it had established through intensive market goodwill. The Plaintiff did however call a witness by the name of Rose Karuo Ngumbau who stated that she began to use the Plaintiff's products, which she said were fondly referred to as 'SENSATIONS' when she was in High School. When she recorded her statement in March 2012, she was 25 years old. She stated that she was by then a student at Beauty School of Hair Dressing in Mlolongo Area, which she mistakenly said was in Nairobi. She then stated:

"I went to buy the products at a beauty shop at Mlolongo and I found a product named 'smooth sensation'. I thought it was an improved version of the 'sensations' products. I bought it. However when I used it, I found the texture was different."

13. This witness proceeded to testify how she later found out that the product, that is the packaging, showed that it was manufactured by the Defendant. She said further:

"I had bought the product because of the name 'Sensation' and I thought it was in the family of sensations perfumes and hair relaxers that I had used for my hair for a long time."

14. The Defendant, through its witness Afulani Francis Anyebase, the Defendant's Marketing Manager, denied the Plaintiff's claim of infringement.

15. He stated that the Defendant had registered a Trade Mark under the Nivea Brand. That under that brand, the Defendant had about 8 different product categories including body lotions. He further stated:

"Smooth Sensation is the franchise name of one of our many Nivea Body Lotions. The franchise name is a consumer-friendly description of the benefit that the product delivers when used over time."

16. The witness proceeded to state that other franchises in the Defendant's range of Nivea Body Lotions include Nourishing Lotion, Express Hydration Lotion, Repair & Care Lotion and Cocoa Butter Lotion. That therefore 'Nivea Body Smooth Sensation' is one of the lotions which define Nivea. That the Defendant has sold the said product over the years in East Africa and in many other parts of the world and has obtained recognition and goodwill.

17. It is clear from the evidence before me that although the Plaintiff has registered, the mark 'SENSATIONS' under Class 3, and some of the products under its Certificate of Trade Mark registration is hand and body lotion, there was no such product produced before Court. It does indeed seem as though the Plaintiff does not manufacture hand and body lotion under that mark. The only products, produced before Court, that the Plaintiff produces, is 'SENSATIONS PERFUME FOR WOMEN', 'SENSATIONS PERMANENT CRÈME RELAXER' and 'SENSATIONS STYLING GEL'.

18. Since those are the only products that the Plaintiff produced in evidence, it begs the question what product its witness Rose Kavuo was going to buy when she said she mistakenly purchased the Defendant's product.

19. The said witness, Rose Kavuo stated that she began to use the Plaintiff's products when she was in high school. She did not tell us what year that was but since she was 25 years in 2012, when she recorded her statement, I will speculate that the year she was last in high school was in the late 1990 perhaps 1996. Was the Plaintiff producing products with the mark of 'SENSATIONS' registration in March 2002? I guess what I am getting at is having had the opportunity to see this witness Rose Kavuo testify; I did not find her to be a truthful witness. I did not believe her testimony.

20. But even if her testimony was true, was she the only person who was 'confused', as she alleged, by the Defendant's lotion to lead her to mistake it for the Plaintiff's lotion. The Plaintiff did not call any other witness. In any event, though it was stated that a market research was

carried out by the Plaintiff which found the Defendant's lotion had reduced the Plaintiff's market share no such research was produced in Court.

21. It needs to be restated that he who alleges must prove. The burden of proof of course of any confusion was on the Plaintiff. On this score, the Plaintiff did not shift that burden.

22. But more importantly, it is the judge who bears the responsibility to determine whether indeed there is infringement.

23. I have looked at the Plaintiff's 'SENSATIONS' perfume, hair relaxer and the styling gel alongside the Defendant's Nivea Smooth Sensations Body Lotion' the get up cannot deceive or mislead. Not at all. The Defendant's lotion is not substantially identical to the Plaintiff's product. There is no likelihood, in my view, of confusion as to the source of the product. The Plaintiff's products are under the name 'SENSATIONS'. That is, different products such as permanent crème, perfume and styling gel are all under the brand 'SENSATIONS'. The Defendant's products are under the brand name of Nivea. So products such as body lotion, nourishing lotions and express hydration are under the name Nivea. The Plaintiff failed to prove that its mark 'SENSATIONS' is visually or phonetically similar to the Defendant's lotion 'Smooth Sensation'.

24. Further, the Plaintiff's mark does not include the word smooth which is in the Defendant's lotion.

25. The Plaintiff's claim of infringement has failed and accordingly I will not proceed to consider issue (b), that is what orders should be made if there was infringement. The Plaintiff's claim having failed, it will bear the costs of the suit.

26. Before concluding this matter, I wish to state that the decision/Ruling made by the Assistant Registrar of Trade Marks on 15th October 2011 is not binding on this Court. The Assistant Registrar made a Ruling, on that date, and amended the mark 'Nivea Visage Aqua Sensation' by deleting the word SENSATION in accordance to Section 35 of the Trade Marks Act. That decision/Ruling was following the hearing of the proceedings filed by the Plaintiff seeking to expunge the Defendant's mark 'Aqua Sensation' from the register.

27. In the end, the Plaintiff's case is hereby dismissed and the costs of this suit are awarded to the Defendant.

DATED, SIGNED and DELIVERED at NAIROBI this 22ND day of MAY, 2019.

MARY KASANGO

JUDGE

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

Sophie.....**COURT ASSISTANT**

.....**FOR THE PLAINTIFF**

.....**FOR THE DEFENDANT**