



**Raburu v Airtel Network Kenya Limited (Civil Suit 198 of 2023)
[2024] KEMC 1 (KLR) (11 March 2024) (Judgment)**

Neutral citation: [2024] KEMC 1 (KLR)

**REPUBLIC OF KENYA
IN THE MILIMANI COMMERCIAL CHIEF MAGISTRATE'S COURTS
CIVIL SUIT 198 OF 2023
RL MUSIEGA, SRM
MARCH 11, 2024**

BETWEEN

WILLIS WAYNE RABURU PLAINTIFF

AND

AIRTEL NETWORK KENYA LIMITED DEFENDANT

JUDGMENT

1. The Plaintiff herein, from the evidence before me, is a media personality who works with Royal Media Services. He stated that he is the registered owner of the trademark No. 116744 'BAZU' in class 25, 35 and 38 effective 13th April 2021 therefore granting him exclusive rights to the use of the trade mark in relation to those goods and services classified under 'advertising and telecommunication service' in accordance with the International Classification of Goods and Services. The Defendant on the other hand is a telecommunication company incorporated under the Companies Act Chapter 486 of the Laws of Kenya.
2. The Plaintiff commenced this suit by the Plaint dated 12th June 2022 at the High Court under case number HCC 114 of 2022 seeking the following;
 - a. A permanent injunction to restrain the Defendant whether by itself, its directors, officers, employees or agents from infringing on the Plaintiff's registered Trademark No. 116744.
 - b. A permanent injunction to restrain the Defendant from publishing any material in the print and broadcast media in respect of the Plaintiff's Registered Trademark No. 116744 in respect to the mark 'BAZU' and/or any confusing or deceptive mark that directly or substantially is similar to that of the Plaintiff's.
 - c. Special damages amounting to Kenya shillings five million [Ksh. 5,000,000] attributed to the loss of any potential license fee that the Defendant may have paid to the Plaintiff in lieu of the Defendant's infringing activities.



- d. An order that profits earned by the Defendant by wrongful and/or unauthorized use of the mark alike to that of the Plaintiff be awarded to the Plaintiff as may be found due on calculating the accounts.
 - e. General damages.
 - f. Interest on (c), (d) and (e) above at Court's rate until payment in full.
 - g. Costs of this suit.
3. The Defendant proceeded entered appearance on the 6th August 2022 and further filed a statement of Defence dated 18th August 2022 in response to the Plaintiff's Plaint.
 4. On the 6th July 2023, the high court directed that the dispute fell within the jurisdiction of the Subordinate Court. Therefore, the suit was transferred to the Chief Magistrates' court at Milimani and allocated to myself for hearing and determination

The Plaintiff's case

5. During hearing of the suit, the plaintiff submitted that he was the registered owner of the Trademark No. 116744 'BAZU in class 25, 35 and 38 effective 13th April 2021.
6. He introduced himself and stated that had filed a witness statement dated 17th July 2022 which he relied on as his evidence in chief.
7. He stated that he was a media personality had that he had been working with Royal Media Services until recently. He stated that he does marketing across different platforms.
8. Further, he stated that he was the owner of the trademark 'BAZU' as it was registered and he was granted rights to the same trademark. He proceeded to add that the word 'BAZU' originated from him during his engagement with the public and he thereafter has been using the same in all his business activities especially in advertising, branding and management of other activities.
9. He proceeded to add that the people assumed that he had endorsed Airtel since they had used the name BAZU within there dealings which was not the case. Therefore, it had affected his business as it has caused confusion among the consumers and the general public.
10. During cross examination, he stated that under his National Identification Card, he had been identified as Willis Wayne Raburu but the public refereed to him as Willis Bazu Raburu but failed to call any witness to confirm the same. He stated that the word 'BAZU' first appeared in the public domain courtesy of his musical costs and promotional activities, the song bearing the name BAZU was produced in 2020. Following the same, the word BAZU was registered to him as a Trademark.
11. He stated that he had a trademark certificate confirming that he was the registered proprietor and that he had exclusive rights to the same. He stated that he had seen the Defendant advertise the trademark in their promotional advertisements without his consent. Following the above, he was therefore claiming for Kshs 5,000,000/= for use of the trademark for over 1 year without his consent.
12. During re-examination, he stated he identified to the public as Willis Bazu Ruburu. In the song 'Kalale' produced and released on 26th August 2022 being his first song he released under the trademark. The aforementioned song was released on YouTube and garnered millions of views.



The Defendant's case

13. The DW1 introduced himself as a digital marketer within the Defendant's company. He stated that he had filed a witness statement dated 30th January 2023 which he urged the court to adopt as his evidence in chief. He added that he had also filed other documents in support of his case.
14. During cross examination, he submitted that his documents as filed as exhibits. He did not submit a certificate of electronic evidence.
15. During re- examination, he stated that he had submitted screenshots of the word Bazu, there was also a link to confirm the same.

Analysis and determination

16. Against the summary of the pleadings I have highlighted above, the parties' witnesses duly testified along the lines I set out in the pleadings. In addition to the extensive pleadings the parties produced documents and filed written submissions supported by copious authorities. I do not intend to reproduce the testimony and submissions but will refer to the relevant parts in determination of the following consolidated agreed issues settled by the parties for determination:
 - i. Whether the trademark registration and use of the work 'BAZU' in class 25,35 and 38 is lawful.
 - ii. Whether the Defendant is liable for infringement.
 - iii. Whether the Plaintiff is entitled to the relief sought.

Whether the trademark registration and use of the work 'BAZU' in class 25,35 and 38 is lawful.

17. Section 2 of the *Trade Marks Act* defines a Trade Mark as follows:-

“Trade mark” means, (except in relation to a certification trade mark) a mark used or proposed to be used-

- (a) in relation to goods for the purpose of indicating a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user to use the mark, whether with or without any indication of the identity of that person or distinguishing goods in relation to which the mark is used or proposed to be used from the same kind of goods connected in the course of trade with any person;
- (b) in relation to services for the purpose of indicating that a particular person is connected, in the course of business, with the provision of those services, whether with or without any indication of the identity of that person or distinguishing services in relation to which the mark is used or proposed to be used from the same kind of services connected in the course of business with any other person;

18. Section 2 of the Act also defines a 'mark' as follows:-

“mark” includes a distinguishing guise, slogan, device, brand, heading, label, ticket, name, signature, word, letter or numeral or any combination thereof whether rendered in two-dimensional or three-dimensional form;



19. A distinguishing guise, is defined in the Act thus:-

“Distinguishing guise”, in relation to goods, means the shape or configuration of containers of the goods.”

20. It is common ground that the Plaintiff is the registered proprietor of the trade mark ‘BAZU’ under registration no. 116744 in case 25,35 and 38. The Plaintiff claims to hold a trademark on;

Class 25 – apparels and clothing

Class 35- class for advertising and business services

Class 38- class for telecommunication services

21. I do not think it is in dispute that the proprietor of a trademark enjoys rights and protection granted by section 7 of the Trade Marks Act which provides in part as follows;

7. Right given by registration in part a, and 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

22. Therefore Section 7(1) of the Trademark Act provides that registration by a person as the proprietor of a trademark if valid gives to that person the exclusive right to use the said trademark. Any person who not being the proprietor or registered user of a Trademark, uses a mark which is identical to or so nearly similar as to be likely to deceive or cause confusion in the minds of consumers in the course of trade or in connection with the goods or services in question is said to have infringed that trademark.



In the case of *Pharmaceutical Manufacturing Company –vs- Novelty Manufacturing Ltd* HCCC No. 746 of 1998, Hon. Justice Aaron Ringera (as he then was) held as follows:-

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

“Since the right to a trademark is a statutory one, acquiescence cannot constitute an estoppel or any other defence which the statute itself does not recognize.” [emphasis mine]

23. Considering the above, the Plaintiff as the proprietor and owner of the trademark ‘BAZU’ under class 25, 35 and 38 is entitled under section 7 aforesaid, to the exclusive use of the mark in relation to goods for which it is registered. (See *Solpia Kenya Limited v Style Industries Limited & another* ML HCCC No 138 of 2014 [2015] eKLR).

24. The court in *Pharmaceutical Manufacturing Company – vs – Novelty Manufacturing Limited*: HCCC No.746 of 1998 (UR), Ringera J as he then, observed as follows at page 14 of his judgment:

“...Registration of a trademark confers the right to 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...”

- (8) In *Wilson Muriithi Kariuki T/A Wiskam Agencies V Surgipharm Limited*, Odunga J stated,

“...The position as of now is that the Applicant is the registered proprietor of the said Trade Mark and until that proprietorship is successfully challenged, has the right to enjoy the benefits that accrue therefrom. To allow the defendants to also distribute a product bearing the same name would amount to introducing not only unnecessary confusion in the mind of the consumers of the said product but may engender chaos in the market.”

25. I therefore find and hold that as the registered owner of the Trademark, the Plaintiff is entitled to its exclusive use.

Whether the Defendant is liable for infringement.

26. The Court of Appeal, in *Cut Tobacco Kenya Ltd v British American Tobacco (K) Ltd* NRB CA Civil Appeal No 126 of 2000 [2001] eKLR quoted with approval the passage below on the burden of proof from the High Court of Uganda in the case of *Aktiebolaget Jonkoping–Vulcan Industricksfabriksatebolag v East African Match Company* [1964] EA 62, 67:

As a general proposition of law, I think I am right in stating that the burden of satisfying the court that there has been an infringement of its trade mark is on the plaintiff company. It is for the plaintiff company to prove that there is a resemblance between the two marks, and that such resemblance is deceptive. It is also a well-established principle of law that it is the duty of the judge to decide whether the trade mark complained of so nearly resembles the registered trade mark as to be likely to deceive or cause confusion in the minds of the public. From that duty the judge cannot abdicate.

27. Passing off, according to Black’s Law Dictionary (8th edition.), is the act or an instance of falsely representing one’s own product as that of another in an attempt to deceive potential buyers. It is



actionable in tort under the law of unfair competition. It may also be actionable as a trademark infringement.

28. The Court of Appeal, in *Nairobi Map Services Limited v Airtel Networking Kenya Limited & 2 others* NRB CA Civil Appeal No 125 of 2016 [2019] eKLR expounded on this definition by holding as follows:
29. In *Reckitt and Colman Products Ltd vs. Borden Inc and others* [1990] 1 All ER 873, the House of LORDS summarized the ingredients of an action in passing off, namely:
 - i. that the plaintiff must establish a goodwill or reputation attached to the goods or services;
 - ii. secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff; and
 - iii. thirdly, he must demonstrate that he suffers or, in a quia timet action, that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff.
30. The Plaintiff proved that he attained registration of the Trademark 'BAZU' on the 13th April 2021 which was before the Defendant had started using the aforementioned mark to promote its internet products which was about 16th December 2022. The Defendant alleged that the trademark 'BAZU' was not similar to the products offered by the Plaintiff as there was a difference between Bazu and Bazu Bundles. Following the registration of the trademark, the Plaintiff states that he continued to provide promotional and advertising services to various organizations including 22Bet Kenya under the brand name Bazu. The Plaintiff further admitted that the general public had already created a perception that he had endorsed the Defendant following the use of the term 'Bazu' within their promotional internet bundle which was not the case. I therefore find that the Defendant continued to use the Plaintiff's trademark in a manner that might have led the public to believe that those the two parties had entered into an endorsement agreement.
31. I find and hold that the Plaintiff herein has proved that the Defendant is liable for infringement and passing off the brand name 'Bazu'

Disposition of relief

32. The Plaintiff has sought to be awarded general damages. In an action based on tort the Court has the discretion to determine the quantum of damages payable depending on the circumstances of each particular case. In *Gerber -vs- Lectra* [1995]R.P.C 385 the five (5) principles applicable in the assessment of damages were set out as follows:-
 - a. Damages are compensatory only, to put the Claimant in the same position he would have been in had the wrong not been sustained;
 - b. The burden of proof lies on the Claimant, but damages are to be assessed liberally;
 - c. Where the Claimant has licensed his right, the damages are the lost loyalty;
 - d. It is irrelevant that the Defendant could have competed lawfully; and
 - e. Where the Claimant has exploited his right by his own sales, he can claim lost profit on sales by the Defendant he would have made otherwise, and lost profit on his own sales to the extent that he was forced by the infringement to reduce his own price.



33. Having found that the Plaintiff is the duly registered owner of the trademark 'Bazu', that as the principal and owner of the mark; that the Defendant had been passing off their bundles in relation to the Plaintiff's right.
34. By prayer (d) of the Plaint, the Plaintiff has sought to be awarded the profits wrongfully earned by the Defendant through the wrongful use of the mark as may be found due on calculating accounts. The Plaintiff has not specified the amount being claimed under this head. The Plaintiff did not produce their audited accounts for the periods in question nor did they call an Accountant to testify on their behalf. I find that this claim has not been proved on a balance of probability and according I dismiss prayer (d) of the suit.
35. I have considered the authorities cited by the Plaintiff in support of his claim for damages. In my view it would be fair to assess general damages at Kshs. 1.5 million. Accordingly the present suit succeeds and I hereby make the following orders:-
- a. A permanent order of injunction be and is hereby made and directed at the Defendant restraining it, whether by its directors, officers, employees, servants, agents or any person whatsoever authorized by it from infringing on the Plaintiff's registered Trademark No. 116744
 - b. A permanent injunction is hereby issued restraining the Defendant from publishing any material in the print and broadcast media in respect of the Plaintiff's Registered Trademark No. 116744 in respect to the mark 'BAZU' and/or any confusing or deceptive mark that directly or substantially is similar to that of the Plaintiff's.
 - c. Special damages amounting to Kenya shillings five million Ksh. 5,000,000 attributed to the loss of any potential license fee that the Defendant may have paid to the Plaintiff in lieu of the Defendant's infringing activities.
 - d. The Defendant is hereby directed to pay to the Plaintiff General Damages in the amount of Kshs. 1,500,000/-.
 - e. Interest shall accrue on (c) and (d) above at court rates from the date of this judgement until payment in full.

SUBPARA f. Cost of this suit are awarded to the Plaintiff.

DELIVERED DATED AND SIGNED AT NAIROBI THIS 11TH DAY OF MARCH 2024

RAWLINGS LILUMA

SENIOR RESIDENT MAGISTRATE

In the presence of:

Samuel Court Assistant

..... For the plaintiff

..... for the defendant

