



**REPUBLIC OF KENYA**  
**IN THE HIGH COURT OF KENYA AT NAIROBI**  
**COMMERCIAL AND TAX DIVISION**  
**CORAM: F. MUGAMBI, J**  
**CIVIL SUIT NO. E263 OF 2020**

**BETWEEN**

**THERMOS HONG KONG LIMITED ..... 1<sup>ST</sup>**  
**PLAINTIFF**

**NABICO ENTERPRISES LIMITED ..... 2<sup>ND</sup>**  
**PLAINTIFF**

**VERSUS**

**DOSHI IRONMONGERS LIMITED .....**  
**DEFENDANT**

**JUDGMENT**

**Introduction and Background**

**1.** The dispute herein arises from a contest over the ownership and alleged infringement of the trade mark (TM) “THERMOS” in various classes. The suit was commenced by a plaint dated 28<sup>th</sup> July 2020, precipitated by an advertisement published by the defendant, Doshi Ironmongers Limited (Doshi), in the Daily Nation on 17<sup>th</sup> June 2020. In that notice, Doshi

claimed to be the sole proprietor of TM No. 59464 “THERMOS” in Class 21, asserting exclusive rights to its use in Kenya.

2. In response, the 1<sup>st</sup> plaintiff, Thermos Hong Kong Limited (THK), placed its own advertisement in the same newspaper on 22<sup>nd</sup> June 2020, declaring that it remained the registered proprietor of the “THERMOS” trademark under TM Nos. 567, 568, 569, 570, 571, and 22376.
3. On 23<sup>rd</sup> July 2020, Doshi published another notice in the Standard Newspaper stating that THK was not the registered owner of TM 22376, that the registration of TM “THERMOS” in Class 21 in Doshi’s name had been quashed by the High Court in ***Mombasa Civil Appeal No. 251 of 2017***, and that TM 22376 covered only a “sun and snowflake” device.
4. THK contends that this publication was false, malicious, and intended to damage its business reputation, asserting that TM 22376 is a composite word-and-device mark, not merely a device. THK alleges that Doshi’s publications, coupled with a

letter from Doshi's advocates dated 23<sup>rd</sup> July 2020 demanding that the 2<sup>nd</sup> plaintiff, Nabico Enterprises Limited (Nabico), cease importing and selling "THERMOS"-branded goods, led to customer cancellations of their goods and loss of sales. The plaintiffs seek, among other reliefs, a permanent injunction restraining Doshi from infringing THK's trademarks and declarations that Doshi's threats and publications contravene **Sections 7 and 10 of the Trade Marks Act**.

5. Doshi's amended defence denies malice or falsity, asserting that THK is not the lawful owner of TM 22376, which it claims is registered as "THERMOS SUN AND SNOWFLAKE" and was never assigned to THK. Doshi maintains that its public notices were truthful and that its actions followed lawful registration of TM No. 59464 after a High Court order in **Mombasa Civil Appeal No. 251 of 2017**.
6. Doshi also filed a Counterclaim, against THK and Nabico, the gist of which is the illegal assignment of the TM THERMOS to THK. As far as Doshi is concerned, TM No. 22376 was never assigned to THK; what was assigned was TM No. 22356 through a

Deed of Assignment dated 21<sup>st</sup> November 2011. Doshi therefore claims that the Certificate of Registration of Assignment of TM 22376 was fraudulent. Further that the said TM expired on 16<sup>th</sup> November 2010, was never renewed, yet THK purported to assign it to Thermos KK (TKK).

7. By a statement of agreed issues dated 24<sup>th</sup> November 2021, the parties filed a list of the agreed issues which I would summarize to be as follows:
- i. Whether the current suit is barred under the doctrine of sub judice;*
  - ii. Whether the defendant's challenge to the validity of the plaintiffs' trademarks is barred by the limitation period under Section 16(1) of the Trade Marks Act and Rule 117 of the Trade Marks Rules;*
  - iii. Whether TM 22376 is registered as a "word and device" (composite) mark or merely a "device" mark;*
  - iv. Whether the registration and ownership of TM 22376 by THK is valid, lawful, and not subject to nullification or fraud;*
  - v. Whether the statements made by Doshi in its notices published on June 17, 2020, and*

*July 23, 2020, were false, damaging and made in bad faith;*

vi. *Whether the defendant is guilty of infringing on the plaintiffs' trademark.*

8. At the hearing, each party called a single witness. Their oral testimonies were consistent with their respective witness statements and pleadings. Accordingly, I will not reproduce the evidence in full but shall refer to the relevant portions in the course of my analysis. I will first deal with the two preliminary issues that arise.

i. ***Whether this suit is barred by the doctrine of sub judice:***

9. Doshi invokes the doctrine of *sub judice* under ***Section 6 of the Civil Procedure Act***, contending that the parties have previously litigated over TM No. 17003 in ***Mombasa High Court Civil Appeal No. 251 of 2017: Doshi Ironmongers Limited V Thermos Hong Kong Limited***. In that matter, the Court overturned a decision of the Assistant Registrar, quashed the refusal to register TM 17003,

and directed that the application be considered on its merits.

- 10.** Following the Court's judgment of 11<sup>th</sup> December 2019, the Assistant Registrar considered and approved the application, which led to the issuance of a certificate for TM No. 59464 to Doshi. Doshi states that the impugned public notices arose from this registration.
- 11.** THK disputes the applicability of the *sub judice* rule. It maintains that the judgments in ***Mombasa High Court Civil Appeal No. 251 of 2017*** and ***Mombasa Civil Appeal No. E013 of 2021*** concerned TM 17003 alone. According to THK, the ownership, validity, or infringement of TM 22376 has never been in issue in those proceedings, and the present cause of action, alleged infringement and injurious falsehood, arises from a wholly different factual and legal context.
- 12. *Section 6 of the Civil Procedure Act*** essentially prohibits a court from hearing a matter if the issues in dispute are directly and substantially the same as those in a previously instituted suit between the

same parties or their privies, and if that earlier matter is still pending before a court with jurisdiction to grant the relief sought.

- 13.** For the bar to apply, it must be shown that there are two suits or proceedings; the matter in issue in the subsequent suit is directly and substantially the same as in the previous suit; the parties are the same or claiming under the same title; and the previous suit is pending before a court of competent jurisdiction.
- 14.** Upon reviewing the record, particularly **pages 177 to 230** of the consolidated trial bundle, it is clear that the earlier Mombasa proceedings were confined exclusively to TM 17003, described and pleaded as the “THERMOS” word mark. The central question in those proceedings was whether the Assistant Registrar erred in rejecting Doshi’s application for registration of TM 17003 and whether THK’s opposition to that application had been properly sustained. The High Court’s intervention was therefore limited to setting aside the Assistant Registrar’s decision and directing a fresh consideration of TM 17003.

**15.** Critically, TM 22376 was neither a pleaded issue nor an adjudicated matter in those proceedings. It was not the subject of the pleadings, or reliefs sought in the Mombasa litigation. In contrast, the present suit pivots on TM 22376, whose nature and character is in issue. Accordingly, it is my finding that the dispute over TM 22376 is not directly and substantially the same as the prior proceedings over TM 17003, and the bar under **Section 6** does not apply.

**ii. Whether Doshi's challenge to THK's trademarks is statute-barred?**

**16.** The plaintiffs contend that this Court is divested of jurisdiction to entertain Doshi's counterclaim in so far as it relates to TMs 567-571 and TM 22376. They rely on the holding in **Alex Njunge V Annie Munini Muasya, [2024] KEELRC 265 (KLR)**, where the Court observed:

***"An allegation that a claim is statute barred goes to the jurisdiction of the court and, if found to be true, the court cannot proceed further... Further, no***

***amount of innovation can confer jurisdiction on a court where it does not plainly have one.”***

**17.** It is the plaintiffs’ case that **Section 16(1) of the Trade Marks Act** read together with **Rule 117 of the Trade Marks Rules** sets clear time limits for challenging the registration or assignment of a trade mark. **Section 16(1)** provides that:

***“Any person aggrieved by a decision of the Registrar may, within the prescribed time and in the prescribed manner, appeal to the court.”***

**18.** Under **Rule 117 of the Trade Marks Rules**, such an appeal must be lodged within sixty (60) days from the date of the Registrar’s decision.

**19.** THK submits that TMs 567-571 were registered on 16<sup>th</sup> August 1920 and TM 22376 was registered on 8<sup>th</sup> November 1975. The assignments in favour of THK were registered in 2011, as confirmed by the Registrar’s letter of 14<sup>th</sup> January 2011. Yet, Doshi’s counterclaim challenging the ownership of these

marks was not filed until 2021, almost ten (10) years later.

- 20.** According to THK, any challenge to the registration or renewal of these marks, including the assignments to THK, ought to have been lodged within the statutory timelines. By operation of **Section 16(1)** and **Rule 117**, the claims are therefore statute-barred, and once the bar applies, the Court lacks jurisdiction to entertain the matter.
- 21.** To support this position, THK relies on the Supreme Court's pronouncements in **Nasra Ibrahim Ibren V Independent Electoral and Boundaries Commission & 2 Others, SC Petition No. 19 of 2018** and the Court of Appeal in **Anclat Musau V Attorney General & 2 Others, [2020] eKLR**, as well as the oft-cited principle from **Iga V Makerere University, (1972) EA 62**.
- 22.** Doshi counters this argument by stating that its challenge falls within the exception allowed under **Section 16**. It alleges that THK obtained registration of TM 22376 fraudulently, irregularly, and without lawful basis, arguing that the TM actually assigned to

THK by TTK under the Deed of Assignment dated 21<sup>st</sup> January 2011 was TM 22356, not TM 22376.

- 23.** According to Doshi, the purported certificate of registration for TM 22376 was issued without any lodged document evidencing its assignment, making the registration fundamentally defective. Doshi blames the fraud on THK and not the Registrar, hence no need to enjoin the Registrar.
- 24.** Fraud, being a grave allegation, must be specifically pleaded and strictly proved, as underscored in **Ardhi Highway Developers Ltd V West End Butchery Ltd & 6 Others, [2015] eKLR** and **Opiyo & Another V Olwenje, [2023] KECA 1539 (KLR)**. The burden lies squarely on the party alleging it.
- 25.** The documentary evidence placed before me, dating back to 2010, contains consistent references to TM 22376 under Class 21 in relation to THK's goods, including the applications for registration, assignment and renewal of the TM. Such a consistent pattern over many years indicates a clear and ongoing recognition of TM 22376 as the relevant mark associated with THK's goods.

- 26.** Doshi's attempt to support its case by citing two letters found on **pages 101-102** of the consolidated bundle, as well as the deed of assignment dated 21<sup>st</sup> January 2011, is unconvincing. Relying on these documents to argue a connection to TM 22376 overlooks the broader and more authoritative record that consistently refers to TM 22376. In fact, the cover page to the deed of assignment explicitly states that it refers to TM 22376, while the body mentions TM 22356, an observation that was made by PW1. This inconsistency supports the testimony of PW1 that the misdescription was a typographical error rather than an intentional misrepresentation.
- 27.** Furthermore, TM 22356 is mentioned only about three times throughout the entire record, whereas TM 22376 is referenced extensively and consistently in numerous documents and filings. I would therefore agree with THK that this disparity accentuates that TM 22376 is the correct and primary trademark in question, and the isolated mentions of TM 22356 are accidental or clerical inaccuracies rather than evidence of a different or conflicting trademark.

- 28.** Importantly, based on the description and context of the correspondence on record, as well as the classification of the goods involved, there is no evidence indicating that TM 22356 pertains to THK's product line. The argument is further corroborated by the Deed of Rectification dated 13<sup>th</sup> May 2021 which was registered on 25<sup>th</sup> June 2021, following an application by THK.
- 29.** The fact that Doshi did not raise any objections, complaints, or allegations of fraud at the time, despite being fully aware of the relevant documentation and having had direct dealings with THK, significantly undermines the credibility of the fraud allegations. The absence of any findings of fraud against THK further reinforces the notion that these accusations are merely an afterthought designed to inflate Doshi's case.
- 30.** This pattern of inaction by Doshi also extends to the issue of whether TM 22376 is associated with TM 17003 and the legal implications surrounding that association. All the relevant facts and circumstances concerning these matters were within Doshi's knowledge but were deliberately left unraised, which

further suggests a lack of genuine basis for their current claims.

- 31.** In the absence of proven fraud, the exception to limitation of time under **Section 16** does not apply. The counterclaim was therefore unjustifiably filed well outside the timelines under **Section 16(1)** and **Rule 117**. It is important to emphasize that such statutory time limits are not mere procedural formalities. In the context of the intellectual property framework, these periods serve the crucial policy purpose of promoting certainty, stability, and finality in transactions concerning proprietary rights recorded in the trademark register.
- 32.** The register is supposed to function as a reliable public record, which enables investors, and other market participants to base their decisions confidently on clearly established ownership and entitlement. Allowing previously settled registrations, particularly those that have remained uncontested for over a decade, to be re-opened without lawful cause would undermine this predictability. This could create insecurity around registered rights, discourage investment in branding,

and weaken the integrity of the register as a definitive source of intellectual property rights.

- 33.** Additionally, I have considered the argument that the plaintiffs violated **Rule 64 of the Trade Marks Rules** concerning the renewal process of the subject trademarks. **Rule 64** authorizes the Registrar, upon the expiration of a trade mark registration, to remove it from the register after providing notice to the proprietor. The record does not show that the Registrar ever issued such a notice or took steps to cancel the registration of these marks.
- 34.** Even if it were assumed that the renewal applications were submitted after the registration had expired, in breach of procedural requirements, such procedural missteps alone do not constitute fraud. As established in judicial pronouncements such as **Ardhi Highway Developers Ltd V West End Butchery Ltd & Others, [2015] eKLR**, fraud involves a deliberate and willful act intended to deceive. Procedural omissions or late filings, especially when the Registrar has accepted and acted upon them, do not automatically satisfy the standard for establishing fraud.

**35.** Therefore, I find that Doshi's counterclaim concerning TMs 567-571 and TM 22376 is barred by the statutory time limits under **Section 16(1) of the Trade Marks Act** and **Rule 117 of the Trade Marks Rules**, given that no fraudulent conduct has been proven to the required standard. Consequently, this counterclaim is struck out with costs.

**36.** I will now proceed to analyze whether THK has proved its claim to the required threshold and whether it is deserving of the prayers sought.

**iii. The nature and character of TM 22376:**

**37.** There is contestation on the nature and characterization of TM 22376. This controversy was highlighted in Doshi's publication in the daily newspaper of 23<sup>rd</sup> July 2020 which read in part as follows:

***"According to documents filed in court by Kaplan & Stratton Advocates, Trade Mark No. 22376 which Thermos Hong Kong Limited purports to own IS NOT the word "THERMOS" but "SUN & SNOW FLAKE".***

- 38.** THK takes issue with this statement and maintains that the said TM is “word and device” and not merely a “device” TM. The question then arises; who between the parties is correct?
- 39.** In my view, the answer to this question is quite straight forward. The parties’ consolidated trial bundle contains a Certificate for use in legal proceedings issued on 26<sup>th</sup> April 2011 which supports the plaintiff’s position that indeed that TM 22376 is registered as a “word and device” mark, consisting of the word “THERMOS” combined with the sun and snowflake device, with registration dating back to 8<sup>th</sup> November 1975. The registration was renewed on 8<sup>th</sup> November 2010 for a further period of ten (10) years as evidenced by the Certificate of Renewal issued on 7<sup>th</sup> December 2010.
- 40.** Based on this evidence, I am compelled to conclude that TM 22376 is indeed registered as a composite mark, as the word “THERMOS” combined with the sun and snowflake device. The registration clearly protects this combined mark, including the distinctive word “THERMOS” as part of the overall

composite, in accordance with **Section 7 of the Act**. The plaintiffs' position is further reinforced by **Section 46 of the Act**, which presumes the validity of the original registration and all subsequent assignments or transmissions, solely on the basis of registration.

***iv. Whether the contents of Doshi's notices in the Daily Nation (17 June 2020) and Standard Newspaper (23 July 2020) were accurate, true and factual, and whether the plaintiffs suffered losses:***

- 41.** Doshi admits in its submissions that both parties hold registered rights in the TM THERMOS. However, it contends that the registration claimed by THK is invalid. Based on this premise, Doshi maintains that the notice issued on 17<sup>th</sup> June 2020, which stated that Doshi was the sole proprietor of TM No. 59464, "THERMOS," in Class 21, and held exclusive rights to its use, was correct and should be upheld.
- 42.** From the certificate of registration at **page 347** of the trial bundle, I agree that this statement is factually accurate only to the extent that TM 59464

(a word mark) was lawfully registered in Doshi's name. The deliberate omission of other relevant facts, particularly that THK remains the proprietor of TM 22376 (a combined word and device mark) in the same Class, raises serious concerns about malfeasance.

- 43.** Such an omission could and did in fact deceive the public into believing that Doshi held exclusive rights over the entire "THERMOS" brand in Kenya, which is misleading and injurious to THK. The concern is reinforced by the publication of 23<sup>rd</sup> July 2020, which I have already examined. In that publication, Doshi stated:

***"The registration of Trade Mark 'THERMOS' in Class 21 in favor of Thermos Hong Kong Limited was quashed by the High Court in Mombasa in CIVIL APPEAL NO. 251 OF 2017. The Trade Mark is no longer registered in the name of Thermos Hong Kong Limited."***

- 44.** I have already stated that it was not true that TM 22376 was quashed by the Court neither is it true

that it relates to words only or that the same is not registered in the name of THK. Despite this, the publications in question misrepresented the status of TM 22376, falsely and inaccurately describing its character and ownership. In light of this, I find that the statements made were factually incorrect, misleading, and harmful to THK's reputation. Additionally, these false representations cast serious doubt on Doshi's good faith in issuing and publishing such information.

**v. *Infringement of THK's copyright:***

**45.** As previously stated, the TM held by THK was duly registered and under **Section 7 of the Act**, a registered mark enjoys protection against infringement. **Section 7** explicitly states that registration confers exclusive rights to the owner, but it also recognizes that the use of a mark that is substantially similar or nearly resembles another registered mark does not automatically constitute infringement.

**46.** THK asserts that its registered mark, which dates back to 1975, affords it the exclusive right to use the mark. Conversely, it is clear that Doshi registered TM

59464 in respect of the word “THERMOS” only in 2006. This timeline is significant in light of the sales invoices from **pages 150-176**, which date back to 2003, a time prior to Doshi’s registration. These invoices demonstrate that THK had been using its mark for a considerable period, through its supplier, Nabico. THK has also provided compelling evidence of its supply of “THERMOS” branded products to supermarkets across Kenya, further establishing its longstanding use of the mark.

- 47.** Under **Section 10 of the Act**, such prior use by THK confers rights that remain protected even against later registrations by another party, reinforcing THK’s ongoing claim to the mark’s ownership.
- 48.** In summary, Doshi's claim to exclusive rights as the registered proprietor of TM 59464 does not automatically negate THK’s established rights, which it acquired through long-term use and reputation in the market. This is especially true given the differences in the nature and characterization of their respective marks. I concur with THK's submission that Doshi was not justified in attempting to prevent THK from using its mark. Such action did

indeed cause tangible loss to the plaintiffs as evidenced by the email correspondence contained on **pages 289-290** of the consolidated bundle.

- 49.** The email was directed to branch managers, controllers, stock coordinators, back office staff, regional managers, and other personnel of Naivas Supermarket. It states, in part:

***“Urgently remove the above SKUs from the shelves pending a legal notice of the brand’s name as per today’s papers.”***

- 50.** Doshi’s conduct, in as far as it obviously caused confusion, misled the public, and unjustifiably restrained the lawful use of the mark by THK amounts to infringement under the Trade Marks Act.

### **Conclusion and Final Orders**

- 51.** Accordingly, and for the reasons that I have stated, I find the plaintiff’s claim to be merited. Judgment is entered in favour of the plaintiffs against the defendants as follows:

***a) A declaration is hereby issued that the defendant is not entitled to interfere***

***or restrain the use of the THERMOS mark by the first plaintiff by virtue of the first plaintiff having continuously used the mark in accordance with Sections 7 and 10 of the Trade Marks Act.***

- b) A permanent injunction is hereby issued to restrain the defendant, whether by itself, its directors, officers, employees, or agents from infringing on the first plaintiff's registered Trade Marks Nos. 567,568,569,570,571 and 22376.***
- c) A declaration is hereby issued that the threats made by the defendant in its letter dated 23<sup>rd</sup> July 2020 and the advertisement in the Standard of 23<sup>rd</sup> July 2020 contravene the first plaintiff's rights under Sections 7 and 10 of the Trademarks Act.***
- d) A permanent injunction is hereby issued to restrain the defendant from interfering with the first plaintiff's sale its goods to any retailers in respect of goods sold under TM 567,568,569,570***

**and 22376 in respect of the mark “THERMOS” under Section 10 of the Trademark Act.**

**e) A permanent injunction is hereby issued to restrain the defendant from publishing any material in the print and social media in respect of the first plaintiff’s TM 567,568,569,570 and 22376 in respect of the mark “THERMOS”.**

**f) The plaintiffs shall have the costs of this suit.**

**DATED, SIGNED AND DELIVERED AT NAIROBI  
THIS 23<sup>RD</sup> DAY OF OCTOBER 2025.**

**F. MUGAMBI  
JUDGE**