REPUBLIC OF KENYA
IN THE HIGH COURT OF KENYA AT NAIROBI
COMMERCIAL AND TAX DIVISION
COMMERCIAL APPEAL NO. E021 OF 2023

AFAM CONCEPT INCORPORATION……APPELLANT

VERSUS

MUCHEMI JAMES KIHARA
T/A JAMPUR GENERAL AGENCIES…… RESPONDENT

(**Being an Appeal from the Ruling and decision of the Assistant Registrar of Trademarks (Eunice Njunga) at Nairobi dated 15th day of December 2022, in the Matter of the Trademark Application TMA No. 7152 "VITALE V" in the name of Muchemi James Kihara T/A Jampur General Agencies and Expungement proceedings thereto by Afam Concept Incorporated**)

BETWEEN

AFAM CONCEPT INCORPORATED……APPLICANT

VERSUS

MUCHEMI JAMES KIHARA

T/A JAMPUR GENERAL AGENCIES……

RESPONDENT

J U D G M E N T

A. Introduction

1. This Appeal has been filed pursuant to provisions of ***Sections 37, 51, 52 of the Trade Marks Act and Rule 117 of the Trade Marks Rules***, arising from the ruling delivered by Assistant Registrar of Trademarks (Eunice Njunga) dated 15th day of December, 2022 regarding Trademark Application TMA No. 7152 "VITALE V", where she held that the Appellant were not able to prove that they were aggrieved by the proprietor/respondent's trademark TMA No. KE/T/2011/71252 "VITALE V" remaining in the Register of Marks and therefore hand not succeeded in the expungement proceedings. Further, she held that the said trade mark had been entered in the Register of Trade Marks in Kenya in compliance with the law of trade marks in Kenya, thus should remained undisturbed.

2. Being aggrieved by the said decision the Appellant raised the following grounds of Appeal namely;

a) THAT the registrar erred in law and in fact by failing to consider the undisputed express written and binding provisions of the Distributorship Assignment Agreement dated

21st May 2010 applicable to the relationship between the Appellant and the Respondent.

b) ***THAT the registrar erred in law and in fact by failing to note that the respondent had no right as at 10th May 2011 to register the mark "VITALE V" in his favour.***
c) ***THAT the registrar misdirected herself by proceeding to consider parole evidence when the Distribution Assignment Agreement dated 21st May 2010 was expressly clear with regards to the contractual rights of the Appellant and the Respondent.***
d) ***THAT the registrar erred in law and in fact by failing to consider who was the true owner of the mark "VITALE V" on or before 10th May 2011 thereby coming to an erroneous conclusion under Section 14 and 20 of the Trade Mark Act.***
e) ***THAT the registrar erred in law and in fact by failing to take note of the undisputed fact and admission by the respondent that the Appellant is the manufacturer of products that contain the mark "VITALE V".***

f) ***THAT the registrar erred in law and in fact by failing to hold that the registration of the mark***

"VITALE V" by the respondent was indeed fraudulent and not in good faith taking into consideration the express provisions of the Distributorship Assignment Agreement dated 21st May 2010.

g) THAT the registrar erred in law and in fact by failing to identify the evidence before it, the express consent by the Appellant waiving the express provisions of the distributorship Assignment Agreement dated 21st May 2010 and permitting the Respondent in registering the mark " VITALE V" in his name.

h) THAT the registrar erred in law and in fact by holding that the Appellant acquiesced to a registration that was obtained through misrepresentation, dishonesty, fraudulently and without good faith.

i) THAT the registrar failed to consider entirely that the registration of the mark "VITALE V" in favour of the respondent is contrary to public policy.

j) THAT the registrar erred in law and fact by holding that the Appellant is not an aggrieved

person within the provisons of Section 35(1) of the Trade Mark Act.

3. The Appellant thus urged the court to set aside the said ruling and proceed to cancel, remove, expunge and/or struck off the said registration of trademark Application ***TMA No. 7152 "VITALE V***", made in favour of the respondent and to have the said trademark be registered in their favour. They also prayed to be awarded costs of this Appeal and the costs of the proceedings held before the registrar of Trade Marks.

B. <u>Pleadings</u>

4. The Appellant in their statement of case and statutory declaration filed before the registrar of trademarks averred that since 1978, they had been in the business of production, manufacturing and sale of health, beauty and cosmetic products, under various trademarks such as Hawailan silky, Vitale, leisure curl, wonder grow and ossat naturals. Specifically, under "***Vitale V brand***", they manufactured the following products;

i. Vitale Classic;
ii. Vitale Olive oil;
iii. Vitale Princess by nature;
iv. Vitale 3 in 1hair Therapy;
v. Vitale sensitive scalp;
vi. Vitale Elentee;

vii. Vitale Elentee soy organics; and

viii. Vitale Mo' Body;

Which they distributed worldwide registered under ***"Vitale"*** and/or ***"Vitale V"*** trademark, which they had registered with European union intellectual property office, the African intellectual property organization, the Registrar of trade marks Ghana and in the USA.

5. In order to sell these product's in Kenya they did enter into a distributorship assignment agreement with the respondent vide an agreement dated 21st May 2010 appointing him as their exclusive distributor and sales representative for the sale and distribution of Vitale olive oil natural in Kenya, and under clause 6 of the said agreement expressly provided that the respondent would not use, authorize or permit the use of the name of ***"Vitale olive naturals or Vitale"*** or any other trademark owned by them as part of its corporate or business name nor would he contest their right to exclusive use of the said trade mark .

6. On signing the said agreement, the parties herein commenced doing business and in January 2011, the respondent did propose that he be allowed to register "**Vitale V**" products with Kenya Bureau of Standards (KBS) in favour of the appellant as there were counterfeit product's, in the market, which would damage their reputation. To this end they did allow the respondent to register "***Vitale V***" in their favour with the registrar of

trademarks or to register himself as their licensee under ***Section 31 of the Trade Marks Act***, but unknown to them and without their express approval and/or consent the respondent failed to do so and instead registered himself as the proprietor of the said trade mark.

7. The Appellant emphasized that they were the sole manufacturer, true owners and original creators of the ***" Vitale V"*** products, having used the said words since their existence in 1978 and subsequent registration in 1983 in the USA and globally as a trade mark of and in connection with the goods and products it manufactured and therefore it was unlawful and irregular for the trademark registrar to have approved the respondent as the registered proprietor of the said mark, yet he was merely a licensed distributor under the agreement dated 21st May 2010. There was also no doubt that at the time of making the Application, the respondent knew and/or ought to have known that he had no actual, legal or valid claim to the said trade mark but had intentionally misrepresented these facts to the registrar, and had the trademark illegally registered in his favour.

8. The appellant further averred that on several instances, in their cause of their business, the respondent failed to meet his business obligations, and specifically failed to pay for "***Vitale v***" products supplied to him and this resulted in issuance of a termination letter on 28th October 2014, which they reconsidered after the respondent's plea, but later for the same

aforementioned reasons, finally terminated the said distribution partnership through their letter dated 8th August 2018, by which time the respondent owed them a sum of ***US$ 58,807.15*** in respect of ***"Vitale V"*** products supplied and not paid for.

9. As a result, they did instruct their advocate to issue a demand letter and check on the status of their trademark, wherein it was established that the respondent had improperly and fraudulently registered their mark in his favour, yet he did not have any proprietary interest allowing him to do so. The said registration was thus calculated to cause deception and confusion for products sold under the said mark, and would mislead members of the public as to the origin and source of their products and/or was calculated to frustrate their efforts to register a related or similar trade mark.

10. In view of the foregoing the Appellant urged the registrar to find that the registration of the trade mark ***TMA No 71252*** "***Vitale V***" made in favour of the respondent was irregular and unlawful as it was registered contrary to provisions of ***Article 6 of the Convention for the protection of industrial property of 1883***, which Kenya had ratified on 14th June 1965 and ***section 31, 35(1),(2) & (5) of the Trade Marks Act and rule 82 (1) of the trademarks rules*** and thus ought to be expunged, cancelled and be removed off the register of trade marks.

11. The respondent filed his counter statement dated 14th July 2021 together with his statutory declaration dated 14th October 2021,

where he confirmed that the Appellant is the manufacturer of ***"VITALE V"*** range of products and had in 2010 purposed to establish their presence within the Kenyan market. Given that he had cultivated, established and created a good reputation, in depth market penetration, versatility and knowledge in the beauty, cosmetics and soap industry in Kenya and abroad, the appellant did approach and persuade him to enter into a distributorship contract which request he acceded to.

12. In order to facilitate, popularize, promote and market its products, and prevent similar counterfeits, the appellant representative Mr Korkor Akoto did come to Kenya, appointed and advocate known as Mr Maurice Kaikai (deceased), provided instructions and facilitated the registration of ***" VITALE V"*** trademark after due process under the Trade marks Act, including an application for registration, examination, approval and advertisement on the Industrial property Journal No 2011/08 dated 31st August 2011, for notice of objection within 60 days and eventually registration. It was thus his contention that the registration of the trade mark ***TMA No 71252 "VITALE V"*** under class 3 was effected in accordance with ***Section 2, 12, 14, 15, 20, 21 and 22 of the Trade mark Act***, with the full knowledge, consent approval and participation of the Appellant and/or their representative, and were thus precluded from alleging otherwise.

13. Arising from the above, he was the exclusive owner of the aforementioned trademark in class 3 in respect of cosmetics

and soap products in Kenya and had been dutifully paying all requisite taxes and statutory fees to all relevant government agencies. Further as a result of his intense marketing he had created immeasurable goodwill within the Kenyan market for goods registered under the said trade mark as they were on the shelves of all major supermarkets, and wholesale beauty shops in all regions within Kenya.

14. With regard to the appellants allegations that he had procured registration of the trade mark through fraud and misrepresentation of facts to the trade mark registrar, the respondent averred that from the emails exchanged during the registration process, it was clear that the appellant had been kept informed of the entire process, consented to the same and facilitated the said process and thus could not be heard to alleged fraud and/or misrepresentation. Further had they intended to have him registered as their agent or licensee under ***Section 31 of the Trade mark Act***, they would have indicated so and/or initiated opposition proceedings to the advertisement or filed an objection to the entire registration process under ***Section 21 of the Trade Marks Act*** but had not do so for over seven years and thus did not have locus to institute the expungement proceedings in accordance with provisions of ***Section 35 of the trade mark Act***.

15. Without prejudice to the foregoing and in accordance with provisions of ***Section 36(b) of the Trademarks Ac***t, it was the respondent further contention that the appellant was

precluded and estopped from initiating the expungement proceedings with respect to ***trademark No 71252 "VITALE V***" under his name for the reason that they had acquiesced to the his use and registration of the trade mark in the Kenyan market from 2011 todate, which was a period of over 10 years, during which time he had invested his time, finances and emotions in marketing the goods bearing the said trade mark and thus harbored a legitimate expectation that his investment would bear fruits and he would eventually recoup his investment, without interruption.

16. The respondent thus prayed that the application for expungement be dismissed with costs.

17. The suit was determined based on the pleading filed and parties submissions, which were considered by the Assistant registrar of trademarks and in her ruling dated 15th December 2022, held that the appellants did not prove that they were aggrieved by trade mark ***TMA No KE/T/2011/71252 "VITALE V"*** remaining in the register of trade marks in Kenya in compliance with provision of ***Section 35 of the Trade marks Act*** and thus could not succeed in the expungement proceedings. Secondly the said trade mark had been entered into the register of trade marks in Kenya in compliance with the law and would remain undisturbed. She also awarded the costs of the said proceedings to the respondent.

C. <u>The Appeal</u>

(i) **Appellants submissions**.

18. The appellant relied on their submissions dated 7th February 2025,and supplementary submissions dated 10th July 2025, where they rehashed the facts as pleaded and emphasized that the parties relationship were guided by the distributorship Assignment Agreement, which at clause 6 it specified that the respondent would not use, authorize or permit the use of the name ***" Vitale Olive Naturals or Vitale"*** or any other trademark or trade name owned by the Appellant nor would he contest their right to exclusive use of the same. The only exception to this restriction was where they had expressly allowed the respondent to utilized the said trademark for marketing subject to their polices.

19. Due to a surge of counterfeits products in the market, they had allowed the respondent to register "***VITALE V"*** as thier trademark so at to prevent the penetration of counterfeit products passing off as their product but at no point was it intended that the said trade mark would be passed off or traded in the appellant's name for him to hold out as the manufacturer and/or owner of the said brand.

20. It was therefore their contention that registration mark ***"VITALE V"*** had been obtained through fraud and misrepresentation of facts, as the respondent did not have any proprietary right, and/or a valid/legal claim to the said mark, which could be substantiated or which could act as a badge of origin for the products sold. That said, it was also to be noted that the

respondent had made a clear assertion on the application form that he was the owner of the offending mark, when such assertion was clearly false as the appellant was the true owner/manufacturer of ***"VITALE V"*** brand and had previously registered the said mark with European Union Intellectual property office, African intellectual property organization and registrar of trademark in Ghana , United states of America and in the United Arab Emirates. Reliance was placed in; ***Vitamins Trademarks Case (1956)RPC, Trademark number KE/T/2008/63532 MISTRESS in class 5 in the name of East Africa Limited and expungement proceedings thereto by Osho Chemicals Industries Limited , Casabella Associates limited and expungement thereto by Corning Incorporated, Kerly's law of Trademarks and Trade Names,*** all of which clarified who could lay a genuine claim as a proprietor of a trademark.

21. Secondly, the appellant faulted the registrar for admitting parole evidence rather than putting emphasis on the parties' written contract instrument which clearly defined their roles and duties. Specifically, clause 6 of the said contract provided that the trademark was not assigned to the respondent, and thus the court did not require any extrinsic evidence to discern the intention of the parties. Therefore, no amount of correspondences or communication could override this intention, but unfortunately, the registrar of trade mark had completely overlooked and/or failed to consider the impact of

this clause and thus fell in error to hold that the respondent was rightful owner of the said mark. Reliance was placed in ***National Bank of Kenya Ltd Vrs Pipeplastic Samkolit (K) Ltd and Another (2001) Eklr, Lesaffre at Compagnie Vrs Mahra Industries Ltd (Civil Appeal E593 of 2022),{2023} KEHC 21294 (KLR) & Savings and loan Kenya Ltd Vrs Mayfair Holding ltd (2012) eklr, where the case of Shore Vs Wilson (1842) CL & Fin 355,565*** was cited with approval.

22. As to whether the respondent had a right over the trademark ***"VITALE V"*** as at 10th May 2011, it was submitted that the main purpose of registration was to designate the source of goods and services, and in effect, a trademark was a commercial substitute for one's signature. ***Section 46 of the Trademark Act*** provided that even though registration as a proprietor of a trademark was prima facie evidence of validity of the original registration, this position was rebuttable and a party could challenge the same by establishing prior ownership and use of the disputed mark.

23. It was not in dispute that the appellant was the inventor of "***VITALE"*** mark and also the manufacturer of its line of products since 1986.They had also registered the said mark and used it for a long time worldwide, which facts, were ignored by the registrar in her evaluation of the evidence presented before her and thus had arrived at the wrong decision.

24. They re-emphasized that the distribution agreement had specifically curtailed the respondent right over any of their

established trademark and therefore, it could not be said that they had acquiesced to the respondent's registration and use of the said mark. Reliance was placed in the case of ***Sengoku Works Ltd Vrs RMC International Ltd (1996)***, Where it was held that courts ought to first consider the agreement creating the relationship and recognize trademark rights clauses in order to determine the party's intentions.

25. The Appellant further reiterated that it was essential to underscore that waiver could not be inferred where parties' rights were preserved in writing and there had not been any overt act demonstrating abandonment of the same. The respondent had actively concealed material information at the time of registration of the trademark, thereby vitiating any claim of inform consent or passive acceptance. Reliance was placed on ***Halbury's law of England 4th Edition, Volume 16 at page 994, Rajnikantkhetshi Shah Vs Habib Bank A.G. Zurich (2016) KEHC 6740 (Klr), & Serah Njeri Mwobi Vs John Kimani Njoroge (2013) eKL***R, which discussed this concept at length.

26. Finally, the appellant also faulted the registrar finding that they were not aggrieved persons within the provisions of ***Section 35(1) of the Trademark Act***, yet they had been in the production, manufacturing and sale of health and cosmetic products since 1986, and the respondent too had traded in similar goods for a period of time even before the parties had signed the distribution agreement. It therefore went without

saying that that both of them were trading in the same class of goods and the continued use of the mark "***VITALE V"*** by the respondent presented great damage to their business interest. Furthermore, the respondent would gain advantage from registration and use of the trademark, yet he did not own it, which would be wrong and certainly qualify the Appellant as an aggrieved person for purposes of Section 35 of the Act. Reliance was placed on ***Saudi Arabian Airlines Corporation Vs Saudi Kenya Enterprises Limited (1986) Eklr***, where the said principal was discussed.

27. In conclusion, the Appellant urged this court to find that this Appeal has merit and proceeds to set aside the Impugned ruling of the Assistant registrar of trademark dated 15th December 2022.

(ii) The Respondents Submissions

28. The respondent relied on their submissions dated 19th February 2025 stating that the appeal filed was wholly unmeritorious, lacked legal and factual basis as the Appellant had failed to demonstrate any plausible grounds upon which the registrar decision could be set aside and thus prayed that the said Appeal be dismissed. In particular, the Appellant had not demonstrated that the registration of his trademark was fraudulent or unlawful and mere allegations of fraud without tangible proof could not suffice. Reliance was placed in the case of **Vigilante Security Ltd Vs Vigilante group Kenya Ltd (2022) Eklr**, where it was held that fraud must be pleaded and proved.

29. Secondly, the doctrine of waiver and Acquiescence applied against the Appellant as they had previously accepted and recognized the validity of the registered trademark and failed to challenge the same for several years, thereby waiving their right to object to the same. Their conduct was thus inconsistent with any intention, other than to waive their right and the respondent urged this court to so hold. Reliance was placed on ***Banning Vs Wright (1972) 2 All ER 987 & Sita steel Rolling Mills Ltd Vs Jubilee Insurance Company ltd (2007) eKLR.***

30. The respondent emphasized that his trademark had been in existence for a period of over seven (7) years and pursuant to ***Section 16(1) of the Trade marks Act***, the same was statutorily insulated from any challenge unless obtained by fraud or in violation of Section 14 of the Act. In absence of any proven illegality, the doctrine of indefeasibility applied, thereby rendering the Appellants challenge to be legally untenable. Reliance was placed in the case of ***Cut tobacco Kenya limited Vs British American Tobacco (K) ltd (2001)eklr***, where validity of a registered trademark was upheld.

31. The doctrine of laches also barred the Appellants claim as they had taken an unreasonably long time in asserting their right, yet they had all along been aware of the registration of the ***"VITALE V"*** trademark in his favour, but had failed to challenge the same within the permitted window. Reliance was placed in the case of **Daniel Kibet Mutai & 9 others Vs Attorney General (2019) Eklr & Edward Akongo Oyugi & 2 others**

Vs Attorney General (2019*) eklr*, where it was held that a party that slept on its rights for an unreasonable long period cannot later revive their claim without justifiable cause.

32. The respondent thus urged this court to uphold the registrar decision dismissing the expungement proceedings.

D. Analysis and Determination

33. I have considered this appeal, submissions filed, and the impugned ruling. I have also considered the decisions relied on and perused the trial court's record. This being a first appeal, it is by way of a retrial, and this court, as the first appellate court, must re-evaluate, re-analyze, and re-consider the evidence afresh and draw its conclusions on it. The court should, however, bear in mind that it did not see the witnesses as they testified and give due allowance for that. (see ***Selle v Associated Motor Boat Co Ltd & Others*** **[1968] EA 123) & Peters Vs Sunday Post Limited (1968) EA 123 .**

34. A first appellate court is also the final court of fact, and litigants are entitled to full, fair, independent consideration of the evidence. The parties have a right to be heard both on issues of fact and issues of law, and the court must address itself to all issues raised and give reasons thereof. While considering the entire scope of **Section 78 of the Civil Procedure Act**, a court of first appeal can appreciate the entire evidence and

come to a different conclusion. See ***Kurian Chacko Vs Varkey Ouseph AIR 1969 Kerala 316.***

35. The issues that arise for determination in this Appeal are as follows;

a) Whether the Appellant is an aggrieved person within the provisions of Section 35(1) of the Trademark Act.

b) Whether the registration of the mark "VITALE V" in favour of the respondent was procured in a fraudulent manner.

c) Whether the Appellant Acquiesced its rights over the "VITALE V" mark

d) Whether the trademark in question is statutorily protected under Section 16 of the Trademarks Act.

e) Who should bear the costs of this suit?

36. It is not in dispute that the Appellant has since 1986 been in the business of production, manufacture and sale of health beauty and cosmetic products, which are distributed worldwide under various trademarks and brand, including, ***VITALE***, which has several products like; Vitale Classic, Vitale Olive oil, Vitale prince by nature, Vitale 3-in-1 hair therapy, Vital sensitive scalp, Vitale Elentee, Vitale Elentee soy organics and Vitale Mo'body. It is also common ground that the appellant being desirous of selling its product's within Kenya, did enter into a

distribution assignment agreement dated 21st May 2010 appointing the respondent as their exclusive distributor and sales representative of Vitale oil brand.

37. The said contract was sustained for eight (8) years until the parties fell out in April 2018, when the Appellant terminated the said agreement and upon making an application to register the "***VITALE V"*** mark, they were informed that their application could not be accepted as it was similar to a previous mark already registered in favour of the respondent under T.M.A No 71252. Upon being served with a demand to relinquish the said mark, the respondent through his advocate refused to do so unless paid a sum of ***Kshs 20 million***, to recoup sums incurred in promoting the "***VITALE V"*** brand within Kenya and it is this intransigence that lead to the expungement proceedings.

(i)Whether the Appellant is an aggrieved person within the provisions of Section 35(1) of the Trademark Act .

38. On the first issue, **Section 35(1) of the Trademark Act** does provide that;

> " ***Any person aggrieved by the non-insertion in or omission from the register of an entry, or by any entry made in the register without sufficient***

cause, or by any entry wrongly remaining on the register, or by any error or defect in any entry in the register, may apply in the prescribed manner to the court, at the option of the applicant and subject to the provisions of Section 53, to the registrar, and the court or the registrar may make such order for making, expunging or varying the entry as the court or the registrar may think fit".

39. The registrar did hold that the appellant was not qualified to be termed as an aggrieved person for the reason's that; they had also acquiesced to the said registration and use of the "VITALE Mark, the same had not been fraudulently registered and had been used by the respondent for a period of over seven (7) years thus qualified for protection under the provisions of ***Section 16 of the Trademarks Act***.

40. In ***Saudi Arabian Airlines Corporation Vs Saudia Kenya Enterprise Limited (1986) eKlr***, the learned judges relied on a passage by ***Daiguiri Rum Trade Mark, [1969] RPC 600, 615*** which dealt with the words "persons aggrieved". It was pointing out that the said words were first used in [English] *trade marks Act* in 1875 without further definition and added that [at page 615];

"***In my opinion, the words were intended by the Act to cover all trade rivals over whom an advantage was gained by a trader who was getting the benefit of a***

registered trade mark to which he was not entitled. If an erroneous entry "[in the register]" gives to his rival a statutory trade advantage which he was not intended to have, any trader whose business is, or will probably be affected thereby is "aggrieved" and entitled to ask that the error should be corrected."

41. Further relying on various decisions made in English Court of Appeal or by the Registrar of trade marks in ***Wright Crossley & Co's Trade Mark [1898], 15 RPC 131,, Ellis & Co'sTrade Mark, [1904] RPC 617, Lever Bros v Sunniwite Products, [1949] RPC 84 and Wells Fargo Trade Mark, [1977] RPC 503 and the OscarTrade Mark Case, [1979] RPC 173***, the learned judges held the following as the these guiding beacons to determined who an aggrieved person is –

(i)no exact exhaustive definition is possible;

(ii) for reasons of public policy make it undesirable to narrow unduly the definition because it is a public mischief that there should be on the register a mark that should not be there;

(iii)common informers and strangers proceeding want only (Lord Ashbourne in Powell's case) or officious interferers (Lord Herschell, L C in Powell's case) are excluded because they have no interest at all in the register being correct;

(iv)anyone in the same trade and dealing in the same articles as one who has wrongfully registered a trade mark is prima facie an aggrieved person;

(v)someone who lacks a trading interest in the goods covered by the registered mark is not one (The Quakers could not have rectified a registration of 'Quaker' for liquor Ellis & Co's Trade Mark and the Academy of motion picture Arts and Sciences could not have removed from the Register the mark 'Oscar' registered for gramaphone records, radio and sound equipment Oscar Trade Mark and Lever Bros could not have sunniwite's mark removed because Lever dealt in soapless detergent and sunniwite's mark was registered for its scents, cosmetics and hair lotions;

(vi)if the applicant's business is based abroad the case should be judged on its merits: In Re Riviere's Trade Mark but compare Wells Fargo Trade Mark where the applicant's business was based in Liechtenstein so it was held to have no locus standi;

(vii)anyone in the same trade who can show he wishes to trade in the same articles and would be hampered or impeded in his business or developing it by the existence of the registration of that mark is one;

(viii)any trader is an aggrieved person if the registration of the mark restrains what would otherwise have been his legal rights;

(ix)each case depends on its own facts; and
(x)the circumstances of a case may show that an applicant is not aggrieved.

42. From these English authorities, it is clear that if the trader deals in the same class of goods, could use the same or a similar mark and/or can show that the registered mark restrains what would otherwise have been his legal right***s*** he/she, would prima facie have proved that he is an aggrieved party. This can only be displaced by the person who registered the trade mark showing that there is no reasonable probability that the objector would have used the mark if free to do so.

43. Given the undisputed facts herein it is obvious that the appellant meets the criterion of being an aggrieved party and had the inherent right to challenge the registration of "***VITALE V***" mark in favour of the respondent. Unfortunately, the assistant registrar of trademarks failed to consider these parameters and thus arrived at a wrong determination that the Appellant was not an aggrieved party within the meaning of **Section 35(1) of the Trademark Act** .

(ii)Whether the registration of the mark "VITALE V" in favour of the respondent was procured in a fraudulent manner

44. It was the Appellants contention that they were the true owners of the ***VITALE*** mark before 10th May 2011 and were also the manufactures of products with the ***"VITALE V"*** mark having registered and been in use of the said trademark for a long period worldwide. Secondly it was also not in contention that vide the distributorship assignment agreement dated 21st May 2010 they had allowed the respondent to promote and distribute their product but at clause 6 thereof it was clear beyond peradventure that ownership of the trademark was not transferred nor did they handover their rights to the said trademark. Therefore, respondent's assertion on the application form that he was the owner of the offending mark, was clearly false and should be regarded as a deliberate attempt to deceive the registrar as to who was the rightful owner of the said mark.

45. To counter this contention, the respondent averred that the Appellants were in the loop and approved the registration process and thus could not turn around eight (8) years later to disown a process they had approved. This contention found favour and was upheld by the assistant registrar.

46. ***Clause 6 of the Distributorship Assignment agreement*** dated 21st May 2010 expressly provided that

> ***"Distributor will not use, authorize or permit th use of, the name "Vitale Olive Naturals or Vitale" or any other trademark or trade name owned by the manufacturer as part of its firm, corporate or***

business name in any way. Distributor shall not contest the right of the Manufacturer to exclusive use of any trademark or trade name used or claimed by the manufacturer.

Distributor may subject to the Manufacturer polices regarding reproduction of the same utilize manufacturer's name, trademarks or logs in advertising on stationeries and business cards."

47. It is now a longstanding principle of law, that parties to contract are bound by the terms and conditions thereof, and that it is not the business of courts to rewrite such contracts**.** ***In National Bank of Kenya Limited v Pipe Plastic Samkolit (K) Ltd [2002] 2 EA 503 [2011] eKLR at 507***, this Court stated:

> ***"A court of law cannot rewrite a contract between parties. The parties are bound by the terms of their contract, unless coercion, fraud or undue influence are pleaded or proved." See also Pius Kimaiyo Langat v Co-operative Bank of Kenya Limited [2017] eKLR.***

48. In the House of Lord's decision in **Brogden v Metropolitan Rly Co [1876-77] LR 2 APP CAS 66,** Lord Blackburn held as follows:

> "***I have always believed the law to be this, that when an offer is made to another party and in that offer,***

there is a request express or implied that he must signify his acceptance by doing some particular thing, then as soon as he does that thing, he is bound."

49. Also in **Danson Muriuki Kihara v Johnson Kabungo [2017] eKLR** the Court relied on the case of **National Bank *(supra)*** and **Ajay Indravadan Shah vs Guilders International Bank Ltd Civil Appeal No. 135/2001 [2002] 1 EA 269** stated that : -

"It is apparent from the authorities that a court of law will not interfere with contracts entered into by two consenting parties and the interest agreed upon unless the terms are on the face of it illegal, unconscionable, oppressive and fraudulent."

50. A review of the emails and correspondences exchanged, when the respondent registered the trademark in May 2011 or on any earlier date does not reveal that the Appellant waived their right of ownership of the disputed mark nor did they consent to transfer of the said mark in favour of the respondent. In absence of such evidence, it was clear that the respondent's assertion on the registration form, that he was the owner of the offending mark, was clearly false, misleading and was aimed at deceiving the registrar to approve the same.

51. The registrar in her ruling impugned ruling completely failed to consider this issue (parties' contractual obligations) and determined the question of fraud, solely based on parole evidence, which determination was clearly made error and is thus set aside Ex debito Justitiae. Having so determined, it is not necessary for this court to interrogate the other issues arising in this Appeal.

C. **<u>Disposition</u>**

52. The Upshot is that this Appeal has merit and is allowed. The decision of the Assistant registrar of trademark dated 15th December 2022 issued in the Matter of Trademark Application TMA No 71252 ***"VITALE V"*** in the name of Muchemi James Kihara T/A Jampur General Agencies and Expungement proceedings thereto by Afam Concepts Incorporated is hereby set aside in its entirety.

53. The said registration of the Trademark TMA No 71252 "VITALE V" under the respondent's name is hereby cancelled, removed, expunged and struck off the register of Trade marks.

54. The costs of the proceedings before the registrar of trademark and of this Appeal are awarded to the Appellant.

55. It is so ordered.

Dated, signed, and **delivered** online at **MARSABIT** this 7TH day of **JANAURY, 2026.**

FRANCIS RAYOLA OLEL
JUDGE

Delivered on the virtual platform, Team this 7TH day of

JANUARY,2026.

In the presence of: -

.....N/A.....Appellant

.....N/A..... Respondent

.....JARSO..... Court Assistant