

**REPUBLIC OF KENYA**

**IN THE HIGH COURT OF KENYA**

**COMMERCIAL & TAX DIVISION**

**CIVIL CASE NO. 191 OF 2018**

**JOHARI SCHOOL LIMITED..... PLAINTIFF**

**-VERSUS-**

**ROSEMARY WAMBUGU T/A JOHARI SCHOOL.....**

**DEFENDANT**

**JUDGMENT**

1. The Plaintiff, **Johari School Limited**, set out its case in a plaint dated 15th May 2018. It stated that it is a limited liability company incorporated on or about 15<sup>th</sup> July 2011 for the purpose of operating a school and subsequently registered Johari School with the Ministry of Education, receiving provisional registration in August 2011 and full registration on 4/1/2012.
2. The Plaintiff asserted that it had, since September 2011, operated a kindergarten and primary school and had established goodwill and reputation in the name Johari School.
3. The Plaintiff alleged that the Defendant, who operated a school along Kiambu Road, had unlawfully carried on a similar business using the same name, thereby passing off its business as that of the Plaintiff and misleading the public into believing that the two entities were associated.

4. It contended that it held prior registration over the name and that parents and business associates had been confused and misled. The Plaintiff further averred that the Defendant's conduct was opportunistic, intended to derive financial benefit at the Plaintiff's expense, and had caused continued confusion in the market.
5. The Plaintiff further contended that despite issuance of a demand and notice of intention to sue, the Defendant had failed to cease using the name Johari School, prompting the suit.
6. The Plaintiff sought declarations on its exclusive right and priority over the name, permanent injunctive relief restraining the Defendant from using the name or any confusingly similar designation, an inquiry into damages or an account of profits, general damages for passing off, costs, interest, and any other appropriate relief.
7. In support of its case, the Plaintiff relied on the witness statement of **Salome M. Beacco** dated 15<sup>th</sup> May 2018 and a list of documents dated the same date.
8. Ms.Beacco, the Plaintiff's director, testified as PW1 and stated that the Plaintiff was incorporated on or about 15<sup>th</sup> July 2011 under the Companies Act to operate a school. The Plaintiff registered the name "**Johari School**" in compliance with the Ministry of Education requirements, obtaining a provisional certificate in 2011 and a full registration certificate on 4<sup>th</sup> January 2012. From September 2011, the Plaintiff operated a kindergarten and primary school and established goodwill and reputation in the education sector.

9. The witness testified that the Plaintiff later discovered that the Defendant, operating along Kiambu Road, was unlawfully carrying on a similar business and using the name Johari School without the Plaintiff's consent. This, according to the Plaintiff, caused confusion among business associates and prospective parents, who were misled into believing the Defendant was the Plaintiff, resulting in financial loss.
10. The Plaintiff therefore sought a permanent injunction restraining the Defendant from using the name Johari School on the basis of the Plaintiff's prior registration and priority.

### **Defendant's case**

11. The Defendant, **Rosemary Wambugu t/a Johari School**, filed a Statement of Defence and Counterclaim dated 14th July 2023. She denied liability for passing off and asserted that she lawfully registered her institution's name after conducting due diligence with the Registrar of Business Names.
12. The Defendant maintained that she was the sole proprietor of **Johari Daycare and Kindergarten**, registered on 3<sup>rd</sup> January 2014 under the Registration of Business Names Act, following an approved name search by the registrar, who did not exercise discretion to decline the name on grounds of possible confusion.
13. The Defendant denied that the Plaintiff had established goodwill or reputation and denied any illegal or unlawful use of the name or engagement in the same business. She stated that she was unaware of the Plaintiff's school until 2014;; that she operated within Kiambu County, and was duly registered by the Ministry

of Education on 28<sup>th</sup> December 2016 to offer the 8-4-4 curriculum without any objection.

14. The Defendant asserted that the trading name of her School differed from that of the Plaintiff's and that there was no passing off or intention to deceive the public.
15. The Defendant further asserted that "**Johari**" was a common Kiswahili word meaning "**jewel**" and could not be exclusively owned, and that the Plaintiff had not trademarked the name. She maintained that prior registration did not confer exclusive rights and that the Plaintiff had not satisfied the threshold for a permanent injunction. She denied receipt of any demand or notice to sue and contended that the suit had been overtaken by events and ought to be dismissed with costs.
16. In the counterclaim, the Defendant pleaded that the suit was instituted maliciously, citing false allegations, failure to conduct due diligence, and conduct intended to embarrass and portray the Defendant in bad light.
17. The Defendant reiterated that there was no infringement as the name was not trademarked and that company registration did not confer exclusivity over a general word. She stated that although she had ceased operating under the name Johari School in compliance with court orders, she had suffered financial loss and emotional distress.
18. Consequently, the Defendant sought dismissal of the suit, declarations that the Plaintiff had no exclusive rights over the name "Johari," orders directing the Plaintiff to pursue proper registration procedures at KIPi, general and special damages for malice, and costs and interest.

19. The Defendant filed a witness statement dated 15<sup>th</sup> July 2021 by **Ms. Rosemary Wambugu**, who testified that she was the sole proprietor of Johari Daycare and Kindergarten, registered on 3<sup>rd</sup> January 2014 under the **Business Registration of Names Act, Cap. 499**, and that she became aware of the Plaintiff only after their schools met at a spelling bee competition. She denied any intention to deceive the public or pass off her school as the Plaintiff's and contended that any allegations of malice or misrepresentation were unfounded.
20. The Defendant averred that she lawfully registered her business name following an approved name search by the registrar, who did not exercise discretion to decline the name on grounds of likely confusion. She maintained that had the name been considered strikingly similar, it would not have been approved. She denied any illegal or unlawful conduct and stated that she was unaware of the Plaintiff's existence at the time of registration.
21. She further stated that she operated within Kiambu County and was duly registered by the Ministry of Education on 28<sup>th</sup> December 2016 to offer the 8-4-4 curriculum without objection. She asserted that her trading name differed from the Plaintiff's and that there was no passing off, association, or financial benefit derived from any alleged confusion. She maintained that the Plaintiff had not proved any damage to goodwill or reputation.
22. The Defendant reiterated that "Johari" was a common Kiswahili word meaning "jewel" and could not be exclusively owned, and that the Plaintiff had not trademarked the name or pursued protection through KIPI. She asserted that prior company registration did not confer exclusive rights over a general word

and that the Plaintiff had not met the threshold for a permanent injunction. She further stated that the suit had been overtaken by events and ought to be dismissed with costs and judgment entered on the counterclaim.

23. The Defendant alleged that the suit was instituted maliciously, citing false allegations, lack of due diligence, and conduct intended to embarrass and portray her school in bad light. She stated that although she had ceased operating under the name Johari School in compliance with court orders, she had suffered financial, emotional, and psychological distress. She sought dismissal of the suit, declarations that the Plaintiff had no exclusive rights over the name "Johari," general damages for malice, and costs and interest.

### **Reply to the defence and Defence to Counterclaim**

24. The Plaintiff filed a reply to the defence and defence to counterclaim dated 14<sup>th</sup> November 2022 and reiterated that it was incorporated on 15<sup>th</sup> July 2011 to operate a school and was registered with the Ministry of Education in August 2011, obtaining a provisional certificate which was confirmed on 4<sup>th</sup> January 2012.

25. The Plaintiff denied that the Defendant complied with the mandatory procedures for business registration and maintained that it had operated continuously since 2011, building goodwill and attracting substantial enrollment.

26. The Plaintiff rejected the Defendant's claim of lack of knowledge of the Plaintiff's existence, stating that a company registry search would have revealed the Plaintiff's school.

27. The Plaintiff asserted that the Defendant's use of the name "Johari School" amounted to passing off, as third parties were likely to be confused into believing the Defendant was a sister or subsidiary of the Plaintiff. The Plaintiff maintained that the name Johari had acquired notoriety and was closely associated with the Plaintiff, and that the Defendant's conduct was intentional and aimed at misleading the public. It further stated that the Defendant's misrepresentation was likely to damage the Plaintiff's goodwill and that damages had accrued as a result.

28. The Plaintiff denied that the suit was time-barred, stating that it was filed within the six-year statutory limitation period, and maintained that a demand notice had been served but ignored. The Plaintiff reiterated its entitlement to the reliefs sought.

29. In defence of the counterclaim, the Plaintiff contended that the counterclaim was misconceived and overtaken by events, denied all allegations of malice and negligence, and maintained that goodwill was capable of infringement and that the name Johari had become distinctive and associated with the Plaintiff.

30. The Plaintiff therefore sought dismissal of the counterclaim with costs and grant of the prayers in the plaint.

### **Analysis and determination**

31. The Plaintiff and Defendant filed written submissions dated 15<sup>th</sup> October 2024 and 23<sup>rd</sup> April 2025, respectively.

32. I have considered the same together with the pleadings filed by both parties. It is my view that the core issue for determination is whether the Defendant's actions amount to passing off its business as that of the Plaintiff.

33. Passing off is defined in **Black's Law Dictionary, 8th edition**, as:

"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."

34. Passing off is a tort claim, and one need not have a registered trademark before instituting such a claim. This is stated under **Section 5 of the Trade Marks Act**, which states:

"No person shall be entitled to institute any proceeding to prevent, or to recover damages for, the infringement of an unregistered trade mark, but nothing in this act shall be deemed to affect rights of action against any person for passing off goods."

35. To succeed in a passing off action, a plaintiff must establish: (i) goodwill or reputation, (ii) misrepresentation by the defendant leading to public confusion, and (iii) damage or likelihood of damage.

36. In **Reckitt and Colman Products Ltd vs. Borden Inc and others [1990] 1 All ER 873**, the House of Lords listed the ingredients of a passing off action, that is:

"that the Plaintiff must establish a goodwill or reputation attached to the goods or services; 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 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."

37. In the case of **Strategic Industries Limited v Solpia Kenya Limited [2019] eKLR** it was held that:

"... the Courts are not hesitant to find the tort of passing-off in cases where similar trade names are used for the same products or products of the same nature and which are intended for the same market. The instant case is a classic example as there is similarity in pronunciation both visually, phonetically and rhythmically, and an average customer would most likely not be able to tell the difference ..." And the court went on to conclude that in this case, where the names were deceptively similar, the Plaintiff had demonstrated that the Defendant was depicting its goods as those of the Plaintiff and that the Defendant's product were not distinguishable when viewed as a whole and there would be likelihood of confusion."

38. In this case, the Plaintiff demonstrated through its evidence that it registered and operated as a school since the year 2011. The Plaintiff's school was registered as 'Johari School'.

39. The Defendant also registered a business name 'Johari Daycare and Kindergarten' in 2014 and later on proceeded to request for its registration at the Ministry of Education as 'Johari School 'and then 'C.I Johari School'.

40. It is clear to see that the names of the two schools are strikingly similar and that the ordinary person may conclude that the two entities are related or the same. Both businesses operate as schools and are intended for the same market. I am of the view that the Defendant's service is not distinguishable when viewed as a whole, and there would be a likelihood of confusion.

41. Further, the Plaintiff has established that it had goodwill and reputation as it had registered a company and operated a school under the title 'Johari School' since 2011. It also illustrated that the Defendant later on established a school with a similar name and thereby passed off as if it were the Plaintiff school. It is plausible that the Plaintiff suffered damages and or losses as a result of the Defendant's actions of passing off.

42. In the case of **Strategic Industries Limited v Solpia Kenya Limited [2019] eKLR**, the court relied on the English Court of Appeal case of Draper vs Trist [1934] 3 All ER 513, wherein it was stated;

"In passing off cases, however, the true basis of the action is that the passing off by the Defendant of his goods as the goods of the Plaintiff injures the right of property in the Plaintiff, that right of property being his right to the goodwill of his business. The law assumes, or presumes, that, if the goodwill of a man's

business has been interfered with by the passing off of goods, damages results therefrom.”

43. From the evidence, it is clear that the Plaintiff has proved that the Defendant passed off its services as those of the Plaintiff. Guided by the authority above, the law assumes that if the goodwill of a person’s business is interfered with by passing off, then it is clear that damages would emanate. It is therefore just to grant the prayer for damages caused by the infringement as sought by the Plaintiff.

44. As for quantum of damages, Some of the factors to be considered by the Court in assessing damages payable include: the strength and duration of the claimant’s goodwill; degree of similarity and likelihood of confusion; duration of the passing off; conduct of the Defendant (including persistence after notice); market overlap between the parties. In **Romageco Kenya Ltd v Automobile Parts Centre Ltd [2015] eKLR**, the court noted the difficulty of precise computation.

45. In the present case, considering the Plaintiff’s established goodwill and the Defendant’s contempt of prior court orders, I assess general damages at Kshs. 2,500,000.

46. As for the counterclaim, the Defendant pleaded that the Plaintiff was driven by malice in instituting this suit. The particulars of the malice were inter alia that the Plaintiff made false allegations that the Defendant illegally used the same name as that of the Plaintiff.

47. Having found that the Defendant passed off its school as that of the Plaintiff, I find that the counterclaim is baseless and lacks merit.

48. In the end, I find that the Plaintiff has proved its case and I grant the orders as sought in the plaint. The counterclaim is dismissed with costs.

49. It is so ordered.

**DATED, SIGNED AND DELIVERED AT NAIROBI THIS 20<sup>TH</sup> JANUARY 2026.**

A handwritten signature in blue ink, appearing to read 'Moses Ado', with a large, stylized flourish extending to the right.

**HON. JUSTICE MOSES ADO**

JUDGE

**In the presence of: -**

*C/A – Moses*

*Small h/b for Wanyonyi.....for the Plaintiff*

*N/A..... for the Defendant*