



Rentokil Initial (K) Limited v Sanitam Services (EA) Limited & another (Civil Appeal 74 of 2019) [2023] KECA 997 (KLR) (28 July 2023) (Judgment)

Neutral citation: [2023] KECA 997 (KLR)

**REPUBLIC OF KENYA
IN THE COURT OF APPEAL AT NAIROBI
CIVIL APPEAL 74 OF 2019
HA OMONDI, KI LAIBUTA & GWN MACHARIA, JJA
JULY 28, 2023**

BETWEEN

RENTOKIL INITIAL (K) LIMITED APPELLANT

AND

SANITAM SERVICES (EA) LIMITED 1ST RESPONDENT

KENTAINERS (K) LIMITED 2ND RESPONDENT

(Being an appeal from the Ruling and Order of the High Court of Kenya at Nairobi (F. Ochieng, J.) dated 18th May 2017 in HCCC No. 58 of 1999)

JUDGMENT

1. The genesis of this appeal stems from an application dated February 26, 2016 filed by the respondents in which they prayed that the appellant be held in contempt of the orders of the Court of Appeal given on July 28, 2006; that, in consequence, the appellant's directors, Patrick Nyaga and Simon Mwago be held to be in contempt of the orders of the Court of Appeal given on July 28, 2006; that all the bins in the possession and/or control of the appellant be destroyed; and that costs of the application be provided for.
2. In the High Court, the 1st respondent was the plaintiff whilst the appellant was the 1st defendant, and the 2nd respondent was the 2nd defendant. The 1st respondent had complained that this court had granted orders as follows:
 - i. Permanent injunction to restrain the defendants from manufacturing and/or using the foot operated sanitary bin and/or holding out to customers the use of such bin.
 - ii. Trading in Kenya in a manner likely to cause the business of the defendants to be confused with the business of the plaintiffs.



- iii. Trading in any manner which does not sufficiently differentiate or distinguish the defendants business from that of the plaintiffs.
 - iv. Using the patent registered under certificate number AP 773 hereof or any other calculated to confuse the goods sold by the defendants as being goods manufactured or provided by and on behalf of the plaintiffs, or otherwise infringing any of the plaintiff's registered patent.
 - v. Otherwise passing-off the business of the defendants as the plaintiff's business.
3. The respondent maintained that the order was served upon the appellant and its two directors, who denied service. They also denied violating the orders.
 4. Although the learned judge was unable to make a conclusive finding on whether the directors were served, he nonetheless held that the appellant and its two directors were aware of the orders as they had participated in the court proceedings in which the orders issued were the subject matter that the orders were of a permanent nature and that, if they were violated subsequent to previously dismissed contempt applications, it was open to the 1st respondent to bring fresh applications; that the doctrine of *res judicata* did not apply; that the orders were not limited to barring manufacturing of the foot operated sanitary bins; and that, if the appellants were importing such foot operated bins which could be confused with the 1st respondent's patented bins, there was no exoneration.
 5. The trial court found that the bins utilized by the appellant were distinguishable from the 1st respondent's patented ones. However, some could be confused with those of the 1st respondent, and such bins would be violating the order. The learned judge refrained from making a blanket condemnation and, instead, authorized the 1st respondent to enter into the appellant's premises with a view of obtaining the offending bins, gather them and, upon further verification of their status by the court, destroy them. The costs were to abide the outcome of further verification.
 6. Aggrieved by the outcome, the appellant filed this appeal, contending that the learned judge erred in ordering the 1st respondent to enter into the appellant's premises for purposes of seizing any offending material despite having made no finding of patent infringement on the appellant's part; and in holding that the sanitary bins sold by the appellant were distinguishable from those sold and patented by the 1st respondent; in finding that the appellant's were not infringing on the 1st respondent's patent; in failing to find that it was against the interests of justice to give the respondent unsupervised access to the appellant's premises to inspect and seize the alleged offending bins; for failing to appreciate that the impugned ruling gave the 1st respondent a free role to decide which bins allegedly offended the patent, thereby making them judge, jury and executioner; by authorizing the respondent to enter into the premises of the appellant's clients with a view of obtaining therefrom the bins deemed to be violating the court orders, by failing to appreciate that those clients were third parties who were not party to the suit, and who would be affected, by the impugned orders, which would, also tarnish the appellant's reputation as well as compromise its business relations.
 7. The appellant laments that its clients were condemned unheard. It cited article 47(1), and (2) of the [Constitution](#), which guarantees the right to fair administrative action, as well as the decision in [Msagha vs Chief Justice & 7 others](#) Nairobi HCMCA as cited in [Republic vs National Land Commission & others](#) [2001 [eKLR]] in relation to the right to be heard. The appellant also submits that the order issued by the learned judge was ambiguous and incapable of execution. According to the appellant, the learned judge ordered that the bins obtained by the respondent would be "gathered together" without specifying where this would take place, and without addressing the means of storage, transportation or where the bins were to be taken to after collection. The appellant faulted the learned judge for failing to



provide safeguards against tampering by the respondents with the bins. It contended that there was no mechanism for confirming that the bins presented would be the same bins gathered from the appellant.

8. The 1st respondent opposes the appeal and urges for its dismissal, contending that it is unmerited. It submitted that it was necessary for the trial court to view the bins belonging to the appellant so as to give a well-informed direction; that, in a subsequent ruling, the court directed the respondent to obtain photographic evidence which would thereafter be availed to the court for assessment; and that the act of allowing the respondent to enter the premises was for the purposes of gathering the necessary evidence and, hence, no determination had been made on the issue of contempt at this point in the proceedings.
9. We are referred to the position adopted by the court in its decision in *Aktiebolaget Jonkoping vs East Africa Match Co Ltd* (1964) EA 62 as cited in *Pastificio Lucio Garofalo SPA vs Debenham & Fear Ltd* [2013] eKLR where Udo Udoma CJ (Uganda) held:

“...As a general proposition of law, ... the burden of satisfying the court that there has been an infringement of its trademark 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 does so nearly resemble 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. That was the principle enunciated by Lord Macnaghten in *Payton & Co Ltd vs Snelling Lampard & Co Ltd* [1901]

AC where he said at p 311:

“...I think as I have said before that a great deal of evidence is absolutely irrelevant and I do not approve the way in which the questions were put to the witnesses. They were put in the form of leading questions, and the witnesses were asked whether a person going into a shop as a customer would likely to be deceived and they said they thought he would. But that is not a matter for the witness; it is for the judge. The judge looking at the exhibits before him and also paying attention to the evidence adduced, must not surrender [sic] his own independent judgment to any witness...”

10. In response to the contention that the learned judge erred in authorizing the respondent to enter into the premises, the 1st respondent submitted that, at this juncture, the court was yet to make a determination on the issue of the alleged contempt of the court orders; that the appellant was arguing the suit on behalf of third parties who are not party to the suit; and that, once an order of permanent injunction was issued, the appellant was under a duty to obey and ensure that the offending bins were no longer in the market.
11. The 1st respondent submitted that, in the suit, the court already issued orders preventing the appellant from producing bins which would pass off as the respondents’ products, and issue already determined conclusively; and that the only issue left for the court to determine was whether or not the appellant was in contempt of court orders.
12. This being a first appeal, it is this court’s duty, in addition to considering submissions by the appellant and the 1st respondent, to analyse and re-assess the application that was before the trial court and reach our own conclusions in the matter. This approach was adopted by this court in *Arthi Highway Developers Limited vs West End Butchery Limited and 6 others* [2015] eKLR citing the case of *Selle vs Associated Motor Boat Co* [1968] EA p 123.



In *Selle*'s case (ibid), the court held that:

“An appeal to this court from a trial by the High Court ... is by way of retrial, and the principles upon which this court acts in such an appeal are well settled. Briefly put, they are that this court must reconsider the evidence, evaluate it itself and draw its own conclusions...”

13. Having carefully considered the record of appeal, the grounds on which it is anchored, the submissions made on behalf of the parties, and the cited judicial decisions, we form the view that the crux of the appeal is simply whether there was any justification in issuing the orders allowing the 1st respondent to access the appellant's premises as well as its client's premises; whether the order was prejudicial to the appellant in so far as it did not specify where the collected bins would be stored; what preservation measures would be put in place to rule out mischief or tampering by the 1st respondent; and whether in all this seeming flurry of activities, the appellant was denied the opportunity to be heard.
14. The trial court had been called upon to determine whether the appellant was in contempt of the orders issued by the court. The subject matter, and what would constitute evidence for the 1st respondent, and for the court to determine this suit were the sanitary bins which within the confines of the appellant. How else would the court determine the issue on contempt without having first had an opportunity to examine the sanitary bins?
15. We take note of the observations made in the case of *Pharmaken Limited vs Laboratories Almirall SA* [2015] eKLR which cites the authority of *Aktiebolaget (supra)* that:

“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 well-established principle of law that it is the duty of the judge to decide whether the trade mark complained of does so nearly resemble the registered trade mark as to be likely to deceive or cause confusion in the minds of the public...”
16. From the foregoing, we are persuaded that the only rational approach would be for the trial judge to have a physical examination of the evidence before him, which formed the substance of the dispute in order to make a determination of the suit. The decision of the court stated that such bins as would be determined to infringe orders of the court would be gathered together for the purpose of determination of the dispute.
17. Did the orders violate the appellant's right to a fair hearing?

Indeed, the very thought of making a decision without hearing a party affected by the decision is offensive to all notions of justice. We take note that to the credit of the learned judge, he stated as follows:

“...In the first instance the bins will not be destroyed. Instead, the bins will be gathered together, and the parties will thereafter have the opportunity of addressing the court, with a view to having the court make a determination on whether or not the bins so gathered, violated the court orders.”
18. It is clear to our mind that the trial court had not yet made a determination as to whether the appellant was in contempt of court. We find that it was necessary that the respondent be granted access to the appellant's facility to procure such evidence as would have been required by the court, and we do not find any error on the part of the learned judge.



19. In our considered view, the only lapse was the absence of a precautionary measure to ensure that what the 1st respondent collected was what would eventually be presented to the court. The other apparent lapse was authorizing access to the premises of parties who had not been joined in the suit. However, we find that this lapse was mitigated by the subsequent ruling on review of the initial orders dated October 3, 2017 by Ochien’g, J, (as he then was), where the court, in its determination, reviewed the orders that were given previously in view of the difficulty in execution of the said orders.
20. While restating the need for it to examine the sanitary bins in dispute in order to reach a determination of whether the appellant had indeed acted in contempt, the learned judge directed that the bins would not be carted away from the premises but, instead, the respondent was to take inventory of the sanitary bins within the premises of the appellant and provide the court with photographic evidence or such other evidence that would be availed to the court; and to provide the court with an affidavit detailing the clients to whom it had sold the bins. We concur with the 1st respondent’s submissions that these actions as required by the court were not geared at holding the appellant in contempt, but aimed at enabling the court to determine whether the sanitary bins infringed on orders of the court as was determined in the Court of Appeal.
21. Indeed, the appellant’s position has been remedied by the finding of the trial court in the ruling dated October 3, 2017, and there is no need for any other intervention. Consequently, we find that the appeal has no merit, and is dismissed with costs to the 1st respondent.

DATED AND DELIVERED AT NAIROBI THIS 28TH DAY OF JULY, 2023.

H. A. OMONDI

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JUDGE OF APPEAL

DR. K. I. LAIBUTA

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JUDGE OF APPEAL

G. W. NGENYE - MACHARIA

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JUDGE OF APPEAL

I certify that this is a true copy of the original

Signed

DEPUTY REGISTRAR

