



REPUBLIC OF KENYA
IN THE COURT OF APPEAL OF KENYA
AT NAIROBI
CIVIL APPEAL 278 OF 2002
BRITISH AMERICAN TOBACCO KENYA LIMITED.....APPELLANT
AND
CUT TOBACCO KENYA LIMITED RESPONDENT
(Appeal from a judgment and decree of the High Court of Kenya

Milimani Commercial Courts, Nairobi (Mbaluto, J) dated 5th July, 2002

in

H.C. C. C. No. 354 of 1999)

JUDGMENT OF THE COURT

This is an appeal by the unsuccessful plaintiff from the judgment of the superior court (Mbaluto, J.) delivered on 5th July, 2002 in which the learned Judge dismissed the appellant's suit in that court.

This is a dispute between two firms which are manufacturers and sellers of tobacco products in Kenya and elsewhere in East Africa. By a plaint dated 26th March, 1999 and filed in the superior court on 29th March, 1999, British American Tobacco Kenya Limited (the appellant herein) sued Cut Tobacco Kenya Limited (the respondent herein) as the defendant seeking judgment against the respondent (defendant) as follows:-

- “a) An injunction restraining the Defendant whether by itself, its directors, officers, employees, servants or agents or otherwise howsoever from infringing in any way the Plaintiff's Trade Mark ‘Sportsman’.***
- b) An injunction restraining the Defendant whether by itself, its directors, officers, employees, servants or agents or otherwise howsoever from passing off its goods as the goods of the Plaintiff by using any deceptively similar shape, colour, configuration, overall design and general appearance and also by using a deceptively similar mark namely ‘HORSEMAN’ or otherwise causing such goods to be passed off as the Plaintiff's goods.***
- c) An injunction restraining the Defendant whether by itself, its directors, officers, employees,***

servants or agents or otherwise howsoever from manufacturing, importing, distributing, selling or offering for sale any cigarettes, tobacco or other products similar thereto bearing the mark 'HORSEMAN' or any other mark, name or designation bearing a close resemblance thereto.

d) An order for

i) the delivery to the Plaintiff of, or destruction on oath, of all infringing 'HORSEMAN' brand cigarettes within the Defendant's possession, custody or power, which would otherwise offend against the provisions of the foregoing injunction; and

ii) The delivery of all documents relating to the manufacture, importation, purchase, distribution, selling or offering for sale of the 'HORSEMAN' cigarettes falling within the provisions of paragraphs (a), (b) and (c) above.

e) An order that the Defendant discloses the names and addresses of all those by whom it has been supplied and to whom it has supplied goods falling within the provisions of paragraphs (a), (b) and (c) above, together with sales and details of quantities so supplied and the price thereof.

f) An enquiry as to damages or alternatively at the Plaintiff's option an account of profits made by the Defendant as a result of the aforesaid infringement by the Defendant and an order for payment of any sums found due together with interest thereon at court rates.

g) Costs of this suit."

As is usual in such disputes, the appellant filed a chamber summons application pursuant to **Order XXXIX Rules 1, 2, 3 and 7 of the Civil Procedure Rules and section 3A of the Civil Procedure Act** seeking the following orders:-

"1. The Defendant be and is hereby restrained until further orders from doing whether by itself, its officers, servants or agents or any of them or otherwise howsoever the following acts or any of them that is to say:

a) Infringing Trade Mark "SPORTSMAN" No. 2012 in Class 45.

b) Manufacturing, importing or exporting, selling, offering for sale, distributing, marketing, advertising and promoting cigarettes and tobacco products bearing the trade name 'HORSEMAN' or any other name, mark or designation bearing a close resemblance thereto.

c) Manufacturing, importing or exporting, selling, offering for sale, distributing, marketing cigarettes or tobacco products bearing a similar shape, colour, configuration, overall design and general appearance to the Plaintiff's goods and especially but not limited to the use of a horse symbol or image whether set against a red background or not.

d) Passing off any of its goods as the goods of the Plaintiff and particularly but not limited to any cigarettes manufactured and/or marketed by it under the trade mark 'HORSEMAN.'

e) Parting with possession, power, custody (other than to the Plaintiff or its agents) of or in any way altering, defacing or destroying the following articles or any of them:

i) Products which infringe the said Trade mark 'SPORTSMAN'.

ii) Goods which are being passed off as the goods of the Plaintiff and particularly but not limited to any cigarettes manufactured and/or marketed by it under the unregistered mark 'HORSEMAN'.

iii) All documents, files, packaging materials, cartons, printing blocks, bromides, prints, invoices, receipts, articles or equipment relating to the importation, purchase, manufacture, sale or supply of

products particularly but not limited to any cigarettes manufactured and/or marketed by it under the unregistered mark 'HORSEMAN' which are being passed off as the goods of the Plaintiff and which are also being or have been passed off as the Plaintiff's goods or relating in any other way to the aforesaid passing off and to infringement of the said Plaintiff's Trade Mark.

2. The Defendant be restrained whether acting by itself, its servants, officers, agents, or otherwise from:

Importing manufacturing, selling, offering for sale, or in any manner disposing of the cigarettes that infringe the aforesaid Trade Marks, or in any manner passing off any goods particularly but not limited to any cigarettes manufactured and/or marketed by it under the unregistered mark 'HORSEMAN' as goods manufactured and sold by the Plaintiff.

3. The costs of this application be awarded to the Plaintiff.”

That chamber summons application was placed before *Onyango Otieno, J.* (as he then was) who in his ruling delivered on 2nd August, 1999 granted the orders sought by the appellant but on terms that the appellant deposits into an interest earning joint account **Shs.20,000,000/-** as security for the loss that the respondent may suffer between then and the date the appeal would have been finally determined. The respondent herein appealed against that ruling and by its ruling in ***Civil Appeal No. 126 of 2000***, this Court allowed the appeal by setting aside the orders made by *Onyango Otieno, J.* That then meant the main suit had to be set down for hearing in the superior court. The suit was finally placed before *Mbaluto, J* for determination. The hearing of the suit commenced on 24th October, 2001 when the appellant opened its case by calling its first two witnesses ***Fanuel Murinjau Ngungu (PW1)*** and ***John Nthiwa Ndeti (PW2)***. The hearing of the suit resumed on 19th March, 2002 when the remaining two witnesses for the appellant testified. The respondent did not wish to call any witness.

Fanuel Murinjau Ngungu (PW1) testified that his occupation was that of a matatu driver cum kiosk owner and that among the items he sold at his kiosk (*situated at Kitale bus stop*) were cigarettes including **Sportsman, Embassy, Champion, Horseman Supermatch** and **Club**. He added that his major customers were *Turkanas, Pokots* and *Saboats* from *Mt. Elgon*. It was his evidence that whenever a customer came to his kiosk and requested for **“horse”** and sold sticks of Horseman cigarettes the customer would complain that he had been sold cheap cigarettes and would abuse the kiosk owner. We must point out at the outset that this particular witness did not impress the learned Judge and in the course of his judgment the learned Judge observed:-

“More crucially however, for the purposes of this case PW1 did not any point in his evidence claim to have been confused by the introduction of the horseman cigarette (sic) in the market.”

John Nthiwa Ndeti (PW2) testified that he was based in Nakuru where he owned a kiosk; and that among the items he sold at his kiosk were cigarettes, maize flour, milk and sugar. It was his evidence that the cigarettes he sold were mostly the brands manufactured by the appellant including Sportsman but also Supermatch by Mastermind and Horseman by the respondent. He further told the superior court that he started selling Horseman in *November, 2000* and that his fastest moving cigarettes were of sportsman brand. He however related how one day a customer came to his kiosk and asked for the new B.A.T. cigarette and on being given a **“safari King Size Filter”** the customer allegedly became abusive and called him (PW2) a **“Burukenge”** which Swahili word PW2 said he did not understand its meaning. In his judgment the learned Judge stated that he had looked up his Swahili/English Dictionary and found that the word **“Burukenge”** meant **“a monitor lizard”** which according to the Judge was **“an extremely ugly creature.”** As regards this witness the learned Judge's impression was as follows:-

“But as I have observed regarding the evidence of PW1, I do not for any moment accept the suggestion by PW2 that the ordinary Kenyan is as uncouth and abusive as he wants us to believe and consequently I do not believe the Burukenge story. Neither do I for that matter believe that any customer went to the witness's kiosk and talked of the “new sportsman.” For all we know the customer could as well have talked about the new “Mastermind” or the like. I believe that if PW2 was unsure of

the cigarette the customer wanted he should instead of acting have sought clarification from the customer. That is not the way ordinary reasonable people act. In my view the person who was confused was not the customer but PW2 because he sold to the customer a cigarette he had not asked for.

We shall skip the evidence of **Joseph Njuguna Kiragu (PW3)** for the time being and consider the evidence of the last witness for the appellant. This was one **Evans Wanjohi (PW4)** a cigarette smoker from Kerugoya. He testified that he was a cigarette smoker who had been smoking Sportsman for about four years or so. He testified that he had come across the Horseman cigarette in the year 2000 when he went to a shop at about 10 p.m. and requested for a packet of Sportsman and gave 50/= for it. He was not given a packet of Sportsman but a packet of Horseman. He went on to narrate that on arrival at his home he opened the packet and took one stick which he lit. On starting to smoke he realized that the taste of the cigarette was different from that of a Sportsman. It was then that he realized he had been given a wrong packet of cigarettes. He concluded his evidence by stating that he threw the stick of cigarette away and slept.

The learned Judge was not impressed by this witness. In his judgment the learned Judge stated:-

“To me the evidence of this particular witness does not suggest any confusion at all. The evidence is clear that the witness asked for the correct packet of cigarettes but the shop owner, who knew or ought to have known the difference between a Sportsman and Horseman cigarette for reason which he did not explain, decided to give him wrong cigarettes. Since the error has not been attributed to any factor it would in my view be presumptive to say that it was caused by any alleged similarity in the get up of the two packets. Anything, including lack of adequate lighting in the kiosk, (most in this country do not have access to electricity) could have been the cause of the error.”

We now move to the evidence of **Joseph Njuguna Kiragu (PW3)** who was the Company Secretary of the appellant Company. His evidence was crucial as it gave the background to the whole dispute. It was Mr. Kiragu's evidence that the appellant's trademark was first registered on 26th July, 1932 and had been renewed on a regular basis since then without fail. He added that the trademark was referred to as “**Sportsman**” and that what was registered as trademark was the name “**SPORTSMAN**” with a picture of a man and the head of a horse. He described the man as a jockey wearing a jockey's cap and holding a whip against a brown background. It was Mr. Kiragu's further evidence that under the trademark the appellant had manufactured and sold cigarettes in virtually every outlet in Kenya e.g. supermarkets, retail shops, kiosks along the streets which are run by hawkers and street vendors and even in international markets like airports, ship chandlers and the like.

As regards the respondent company **PW3** told the superior court that he first became aware of the company in 1995 when he was shown a packet of cigarettes manufactured by it. The packet was labeled “**Horseman**” whose predominant colours were white with an element of blue at the top and two little horses in red. That packet was produced as an exhibit (Exhibit 2) for the superior court to see. According to **PW3** the appellant was not initially aggrieved by the introduction into the cigarette market of this new brand of cigarette labeled “**Horseman**” because the packet's overall presentation did not appear to be similar to the appellant's “**SPORTSMAN**” packet. However, when in 1999 the respondent brought into the market a new brand of “**Horseman**” whose colours appeared to the appellant to be similar to its brand of **SPORTSMAN**, matters took a different turn. That is when the appellant decided to institute this suit against the respondent.

Mr. Kiragu produced in evidence a packet of the new brand of “**Horseman**” cigarette as an exhibit (Exhibit 3). He described the colours of the new packet as predominantly red with a horse with traits of brown and a white strip. He also said that the writings on the packet were in two colours.

According to **PW3**, the appellant's main objection related to the use of a colour in the respondent's cigarettes, which resembled the appellant's products as well as the use of a “*horse with a jockey*”, which according to **PW3** was a direct attempt to copy the appellant's trade mark. He added that the presentation of the “*horse*” on the “**Horseman**” packet was an attempt to represent the horse, which was popularly

associated with the appellant's trade mark. It was Mr. Kiragu's view that the head of a horse in cigarette packets was synonymous with the appellant's brand "**SPORTSMAN.**"

Mr. Kiragu further testified that although the price of "*Horseman*" cigarettes was much cheaper than that of Sportsman since the introduction of Horseman new brand into the market in 1999 the sales of the appellant's "**Sportsman**" had been adversely affected with smokers preferring less of "**Sportsman**" than was the trend prior to the introduction of "*Horseman*". He attributed this development primarily to the confusion which he said had been brought into the market by "*Horseman*" and its relative cheapness as compared with "**SPORTSMAN**".

An occasional smoker himself Mr. Kiragu maintained that there was no difference in appearance between "**HORSEMAN**" and "**SPORTSMAN**" packets though he conceded that he had not at any time been confused as to what to buy between the two. Having so conceded he still maintained that consumers would be confused by the two brands.

From the pleadings, the evidence adduced by the four witnesses called by the appellant – and especially the evidence of **Mr. Kiragu (PW3)** and the submission by counsel appearing for the parties, we can now safely say that we have a clear picture of what was in dispute in this dispute between two cigarette manufacturers. It is to be observed that this being a first appeal it is, indeed, in the nature of a rehearing. For that reason this Court is obliged to reconsider the evidence, assess it and make appropriate conclusions on such evidence, but always remembering that we have neither seen nor heard the witnesses – see ***PETERS V. SUNDAY POST LTD. [1958] E.A. 424*** and ***SELLE & ANOTHER VS. ASSOCIATED MOTOR BOAT CO. LTD. & OTHERS [1968] E.A. 123.***

From the evidence it has emerged that for well over thirty years the appellant has manufactured and sold cigarettes under the Trade Mark "**Sportsman**" and has made and continues to make extensive use of the said Trade Mark together with its devices in the course of business in connection with advertising, marketing, sale and promotion of cigarettes under that brand in Kenya since 1956. The Trade Mark which is registered as No. 20112 in the Registry of Trade Marks at Nairobi was by an amendment made on 9th April, 1976. The Trade Mark has altered its present get-up depicting the name "**Sportsman**" and the head of a horse against a brown background.

As already observed earlier what led to the filing of the suit in the superior court was the fact that in 1999 the respondent changed the get-up (the general appearance) of its packet of cigarettes "**Horseman**" whereupon it commenced to manufacture and produce and market it in packets having the appearance of a packet produced as Exhibit 3 – whose prominent colour was red with a jockey riding a horse and having traits of brown and a white strip with the writings "**HORSEMAN**" and "**CIGARETTES**" in white and "**KINGSIZE FILTER TIPPED**" in yellow and black markings. According to **Mr. Kiragu (PW3)** when the two packets are compared the similarities are too close to be able to distinguish one from another. It was the appellant's stand that the word "**Sportsman**" was a well-known and popular English word mainly connoting and signifying a person engaged in sporting and leisure time activities and possessing sportsmanship that the appellant uses distinctive get-up and configuration of colours and wording on the boxes and packets in which its cigarettes bearing the Trade Mark "Sportsman" are publicized and marketed.

The appellant claims that the said get up associated with the Trade Mark "**Sportsman**" includes an emblem or device depicting a brown horse set against a red background and that most of the purchasers of the cigarettes bearing the appellant's Trade Mark would be familiar with the impact and import of the distinctive get up and configuration of colours and wording on the appellants products. The appellant further contended that in the light of its long use by the said Trade Mark, the public expects to get the appellant's cigarettes bearing the Trade Mark when ordering for "**Sportsman**" cigarettes that the "**Sportsman**" brand is the only brand under which cigarettes bearing a name, depiction of a brown horse, imagery of the horse and any form of sporting activity are or have been manufactured and sold in Kenya in significant numbers that the appellant's Trade Mark "**sportsman**" is a distinctive mark which the appellant has used on its cigarettes to distinguish such cigarettes from similar cigarettes of other manufacturers and traders throughout the country.

The appellant claims that the respondent has since **1998** infringed or attempted to infringe the Trade Mark by using in the course of trade in Kenya in relation to cigarettes a brand including the name “**HORSEMAN**” and a device depicting a man riding a brown horse. It was also claimed that the respondent had sold, distributed and put into the market cigarettes bearing identical shape, colour, configuration overall design and general appearance to the appellant’s cigarettes. According to the appellant that has been done under the trade mark “**Horseman**” which is visually and phonetically identical to the appellant’s Trade Mark “**Sportsman**” and by the distribution and sale of “**HORSEMAN**” cigarettes whose shape, colour, configuration and overall design and general appearance are virtually identical to the appellant’s cigarettes marketed under its Trade Mark.

The appellant also claimed that the respondent had wrongfully sold and passed off cigarettes not of the appellant’s manufacture or merchandise in a get up and configuration bearing a label which is a colourable and deceptive imitation of the get up and configuration of the appellant’s cigarettes. Particulars of the alleged passing off were given in **paragraph 11** of the plaint. One such particular was that the respondent had manufactured and put into the same market as that of the appellant, cigarettes under the name “**HORSEMAN**” which can be substantially likened to the appellant’s goods distinctive get up and emblem showing a brown horse set against a red background. It was also claimed that the use by the respondent of its get up and name in connection with cigarettes not of the appellant’s manufacture or merchandise was calculated to lead and had in fact led to the deception and confusion and the belief on the part of the public that the respondent’s cigarettes were associated with the appellant. The appellant finally claimed that by the aforesaid activities, the respondent was passing off its cigarettes as being those of or, in same way related to or associated with the appellant.

The respondent on its part denied all these claims by the appellant. It also denied that the appellant was entitled to the exclusive use of the words and symbols connoting and signifying a person engaged in sporting and leisure time activities and possessing sportsmanship in all and/or any or every sporting activity or that it was entitled to any exclusive use of devices or symbols of animals particularly horses. The respondent also denied the appellant’s contention that the mark “**HORSEMAN**” was visually and phonetically the same as “**Sportsman**”. The respondent contended that the only distinctive feature in the get up of the appellant trade mark was the use of the head of a horse set against a **bright/tomato red background**. As regards to the use of colour red in the Horseman cigarette, the respondent asserted that in tobacco industry both in Kenya and internationally various colours are used to denote different brands as follows:-

1. **Variations of colour red for strong cigarettes.**
2. **Variations of colour blue for mild/light cigarettes; and**
3. **Variations of colour green for menthol cigarettes.**

The respondent further contended that the appellant acquiesced in the respondent’s use of the trade mark “**HORSEMAN**” in that since the launch of the brand in **1995**, the respondent had used it and sold cigarettes bearing the trade mark without any complaint from the appellant. Finally, the respondent contended that the trade mark “**HORSEMAN**” was incapable of causing deception and/or confusion in the minds of consumers of cigarettes as each brand of cigarettes has its own distinctive and individual flavour and that consumers who are sophisticated people know what brand they smoke. If we may pose here for a moment, we would say that it is not correct to say that consumers of cigarettes (smokers) are necessarily sophisticated people. Even from the witnesses who gave evidence in the superior court it was clear that consumers of cigarettes come from all classes of people, the rich and the educated like **Mr. Kiragu (PW3)** and the ordinary Turkana’s from Lodwar, Sabaots of Mt. Elgon, Pokots of West Pokot etc as can be seen from the evidence of **Fanuel Murinjau Ngungu (PW1)** a kiosk owner of Kitale.

We have endeavoured to set out the rival positions presented to the learned Judge by the parties to the dispute. The learned Judge carefully, and, if we may say so, meticulously went over the evidence and the law and came to the view that the appellant’s main complaint against the respondent was the use of the get up in “**Horseman**”. The learned Judge captured the appellant’s complaint when he stated as follows

in his judgment:-

“My understanding of this matter is that the plaintiff’s principle complaint against the defendant is the use of the get up in Horseman in the form it is. With regard to that complaint, it has to be observed that the use of the colour red as the predominant colour in a packet of cigarettes is not the exclusive preserve of anybody including the plaintiff, the colour being a conventional indicator in the industry of a strong brand of cigarettes. That much was confirmed by the plaintiff’s own Corporation Secretary Mr. Joseph Njuguna Kiragu. Indeed there is clear evidence that colour red is used in that fashion by another manufacturer of cigarettes in this country namely Mastermind. It is also used by the plaintiff itself to indicate its other strong brands of cigarettes. What irks the plaintiff and is the root cause of the filing of this suit was the alleged confusion in the minds of customers and retailers upon the introduction of Horseman.”

Having so stated, the learned Judge considered the evidence before him and the relevant law applicable. In the end he came to the conclusion that the appellant had failed to prove its case. And in dismissing the appellant’s suit the learned Judge concluded his judgment thus:-

“Having regard to all the above different characteristics of the get up and/or appearance in the two packets, particularly the principal colours thereof whereby one packet (Sportsman) has two major colours (red and white) while Horseman has one (red) it is my opinion that there is no way any one who is able to see clearly could be deceived by the appearance of the two packets. Besides that, it is also my view that there is no reliable evidence to show that any customer was confused by the introduction into the market of the Horseman cigarette. My own evaluation of the matter is that Horseman packet is not capable of deceiving or misleading a customer into thinking that he is purchasing a Sportsman cigarette.”

For all the above reasons, I find that the plaintiff has wholly failed to prove its claim against the defendant and its suit must be dismissed with costs. It is so ordered.”

It is the foregoing that provoked this appeal, in which the appellant, through its advocates, filed a Memorandum of Appeal citing **11 grounds of appeal**. The hearing of the appeal commenced before us way back in the year 2005 (9th November, 2005) when Mr. F. Ojiambo (a Senior Counsel), appeared for the appellant and Mr. M. Billing, appeared for the respondent.

Mr. Ojiambo started his submission by stating that the suit was based on two claims – infringement by the respondent of the appellant’s trade mark and passing off the cigarettes manufactured by the appellant. Having so stated, *(and correctly so in our view)*, Mr. Ojiambo took us through the pleadings the evidence and the law in a bid to show that the learned Judge erred in his approach to what was before him. It was Mr. Ojiambo’s submission that the learned Judge erred in principle of law as to how the evidence should be treated and that the similarities were such that they were likely to cause confusion in the minds of the customers. He (Mr. Ojiambo) correctly pointed out that the burden of determining whether confusion would arise lies with the Court. And to buttress his submission, he cited the case of **PAYTON & CO. LTD. VS. SNELLING LAMPARD & CO. LTD (1901) AC 308**. This decision was actually on the respondent’s list of authorities but Mr. Ojiambo was of the view that the same supported his submissions. And from his own list of authorities, Mr. Ojiambo sought to rely on **PARKE DAVIES & CO. LTD. VS. OPA PHARMACY [1961] E.A. 556**.

The hearing of this appeal was adjourned to 6th, 7th & 8th November, 2007 when Mr. Ojiambo continued with his submissions. On the last day of hearing (8th November, 2007). Mr. Billing made his submissions which were brief and to the point.

Mr. Ojiambo sought to show that the learned Judge disregarded the evidence before him. He argued that the learned Judge failed to give due effect and weight to the evidence adduced by the appellant’s witnesses. Mr. Ojiambo referred us to a number of relevant authorities like **HARIA INDUSTRIES VS. P.J. PRODUCTS LTD. (1970) E.A. 367**, **BROOKE BOND KENYA LTD. VS. CHAI LTD. [1971] E.A. 10** and **E.A. INDUSTRIES LIMITED VS. TRUFOODS LTD. [1972] E.A. 420**.

On behalf of the respondent, Mr. Billing chose to deal with the grounds of appeal as set out in the Memorandum of Appeal. It was his submissions that there was no misdirection on the part of the learned Judge in that none of the witnesses stated that he was confused by the brand names. He was of the view that the Judge correctly disregarded the evidence of the appellant's witnesses. Mr. Billing pointed out that none of the customers was called to testify and that the burden of proof lay on the appellant. Mr. Billing cited authorities in support of his submission including **Payton's** (supra) which we have already alluded to.

We have endeavoured to set out the rival positions of the parties herein, the submissions by counsel in the superior court the decision of that court and finally the submissions by counsel who appeared before us. This has been a long battle between these cigarette manufacturers. We can safely say that we now know the nature of the appellant's claim in the superior court. This was emphasized by Mr. Ojiambo in his submissions before us. It is a claim based on infringement of trade mark and passing off. What is the law? It would appear that both Mr. Ojiambo and Mr. Billing were in agreement as to the applicable law since they relied more or less on the same authorities. We have considered those authorities but on our part we think that the law as it relates to this case is as stated by this Court in its decision in **Civil Appeal No. 126 of 2000** between the same parties (unreported) in which it was stated:-

“..... there can be no propriety rights in a particular colour and there can be no property in general words descriptive of the goods. We can say that evidence would be needed to show if the “get-up” of the ‘Horseman’ cigarette packet is likely to deceive the cigarette buying public into believing that they (the public) are buying a ‘Sportsman’ packet of cigarettes. Generally smokers stick to their own brand of cigarettes just the way beer drinkers stick to their own brand of beer. It is also a matter of evidence as to whether the word ‘Horseman’ is so deceptively similar to the word ‘Sportsman’ as to enable a judge to say that the trade-mark ‘Sportsman’ has been infringed. The two words ought to be looked at in their normal English language meaning.”

None of the members of this bench is a smoker but we now understand that generally smokers stick to their own brand of cigarettes just the way beer drinkers stick to their own brand of beer. In the present case we have the evidence of **Evans Wanjohi (PW4)** a smoker from Kerugoya who stated in his evidence as follows:-

“On starting to smoke I realized that the taste was different from that of Sportsman. I discovered that the shop attendant had given me a wrong packet of cigarettes.

I threw the stick of cigarette away and slept.”

The appellant's complaint related to the “get up” of the new packet introduced in the market by the respondent. Regarding “get-up” generally, in **Clerk & Lindsell on Torts 16th Edn. P. 1645** states:-

“It is possible for the ‘get-up’ of goods – the shape, colour and decoration of the goods or the wrapping in which they are sold – to become well enough known as indicating the goods of a particular trader, for use of that get-up by others to amount to passing off. Except in the most flagrant cases, however, actions based on imitation of get-up alone have seldom succeeded.”

It is of course trite law that the burden of satisfying the court that there has been an infringement of its trade mark is on the plaintiff. In this case it was upon the appellant to satisfy the learned Judge that there had been an infringement.

In **AKTIEBOLAGET JONKOPING – VUKAN INDSTRICKSFA – BRIKSAKTIEBOLAG V. EAST AFRICA MATCH COMPANY LTD [1964] E.A. 62** Sir Udo Udoma C.J. stated:-

“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. From that duty the judge cannot

abdicate. That was the principle enunciated by Lord MACNAGHTEN in the House of Lords in Payton & Co. Ltd. v. Snelling Lampard & Co., Ltd. (2) when he said ([1901] A.C. at p. 311):

“I think as I have said before that a great deal of the evidence is absolutely irrelevant and I do not myself altogether approve of 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 be likely to be deceived and they said they thought he would. But that is not a matter for the witnesses; it is for the judge. The judge, looking at the exhibits before him and also paying attention to the evidence adduced, must not surrender his own independent judgment to any witness.”

The same principle was reaffirmed by Lord Denning in Parker Knoll Ltd., v. Knoll International Ltd. (3), when he observed as follows:-

“No witness is entitled to say that the offending mark so nearly resembles the registered mark as to be likely to deceive and cause confusion for that is the very question that the judge had to decide. It is a question on which the judge has to bring his own mind to bear and which he has to decide himself.”

The learned Judge considered the principles of law stated above and then looked at the two cigarette packets which were at the centre of controversy and came to the conclusion that the appellant had failed to prove its case.

As we went over this appeal and bearing in mind the evidence adduced in the superior court, the submissions, the judgment of the superior court and the submissions of the counsel before us, we have come to the conclusion that the appellant’s claim was as stated by Mr. Ojiambo in his submissions. It is to be observed that the appellant called four witnesses (***PW1, PW2, PW3 and PW4***). The learned Judge was not impressed by the evidence of ***PW1, PW2 and PW4***. The evidence of ***Mr. Kiragu (PW3)*** was, in our view, very important as it set out the background and nature of the complaint by the appellant. We have gone over this evidence and re-evaluated it as we are obliged to but in the end came to the same conclusion as did the learned Judge, i.e. the appellant failed to prove its case.

In ***EPHANTUS MWANGI & ANOTHER V. DUNCAN MWANGI WAMBUGU [1982-88] KAR 278*** at p. 292 Hancox JA (as he then was) said:-

“A Court of Appeal will not normally interfere with a finding of fact by the trial court unless it is based on no evidence or on a misapprehension of the evidence or the Judge is shown demonstrably to have acted on wrong principle in reaching the findings he did.”

The first holding in that case is also relevant, namely that:-

“The Court of Appeal would hesitate before reversing the decision of a trial Judge on his findings of fact and would only do so if (a) it appeared that he had failed to take account of particular circumstances or probabilities material to an estimate of the evidence of (b) that his impression based on the demeanour of material witness was inconsistent with evidence in the case generally.”

In view of the foregoing and having considered what was urged before us by counsel appearing, we are of the opinion that the learned Judge cannot be faulted in any way in the manner he handled this dispute of cigarette manufacturers. We therefore find no merit in this appeal and accordingly we order that the same be and is hereby dismissed with costs to the respondent.

Dated and delivered at NAIROBI this 20th day of December, 2007.

P.K. TUNOI

.....

JUDGE OF APPEAL

E.O. O’KUBASU

.....

JUDGE OF APPEAL

E.M. GITHINJI

.....

JUDGE OF APPEAL

*I certify that this is
a true copy of the original.*

DEPUTY REGISTRAR