



Hassan & another v Anti-Counterfeit Agency & another; Sime Derby Oils Professional SDN.BHD (Interested Party) (Petition E118 of 2024) [2025] KEHC 9200 (KLR) (Constitutional and Human Rights) (26 June 2025) (Judgment)

Neutral citation: [2025] KEHC 9200 (KLR)

**REPUBLIC OF KENYA
IN THE HIGH COURT AT NAIROBI (MILIMANI LAW COURTS)
CONSTITUTIONAL AND HUMAN RIGHTS**

PETITION E118 OF 2024

LN MUGAMBI, J

JUNE 26, 2025

BETWEEN

ABDIRAHMAN ABUKAR HASSAN 1ST PETITIONER

FATHIYA SHEIKH ALI 2ND PETITIONER

AND

ANTI-COUNTERFEIT AGENCY 1ST RESPONDENT

DIRECTOR OF PUBLIC PROSECUTIONS 2ND RESPONDENT

AND

SIME DERBY OILS PROFESSIONAL SDN.BHD INTERESTED PARTY

JUDGMENT

1. The Petition dated 5th March 2024, is supported by the 1st Petitioner’s affidavit in support of even date and a further supplementary affidavit dated 31st October 2024.
2. The gist of the Petition is that the investigation and intended prosecution against the Petitioners by the Respondents was instigated by the Interested Party hence is an abuse of the criminal justice system, the statutory mandates of the Respondents and a violation of *the constitution* in particular, Articles: 10(1), (2), 25 (a) and (c), 27 (1) & (2), 28, 29 (c) & (d), and 47 of *the Constitution*.
3. Accordingly, the Petitioners seek the following reliefs against the Respondents:
 - a. A declaration be issued that the 1st and 2nd Respondents conduct and actions jointly and severally contravene *the Constitution* and/or are likely to contravene or infringe upon the



Petitioner's fundamental rights and freedoms guaranteed under Article 10(1), (2), 25 (a) and (c), 27 (1) & (2), 28, 29 (c) and (d), and 47, of *the Constitution*.

- b. A declaration be issued that the Respondents' conduct and actions which are complained of in the Petition, jointly and/or severally, singularly and/or cumulatively against the Petitioner are oppressive, unfair, unreasonable, irrational, illegal and an abuse of power and the criminal justice system and process.
- c. A declaration be issued that the Respondents investigations jointly and/or severally, singularly and cumulatively into the unknown allegations by the Interested party are tainted with illegality, mala fides and are being and/or have been conducted with and/or for an ulterior motive or extraneous purpose.
- d. An order of prohibition directed to all the Respondents jointly and severally prohibiting any and all of them from carrying out and/or proceeding with any further and/or investigations into or in connection with the baseless allegations by the Interested Party against the Petitioner.
- e. An order of prohibition directed to all the Respondents jointly and severally prohibiting any and all of them from reopening or purporting to reopen, mounting, bringing, instigating, carrying out and/or proceeding with any criminal proceedings or charges against the Petitioners in connection with the Interested Parties' baseless allegations against the Petitioner.
- f. Any other relief that this Court may deem fit and just to grant in the interest of justice.

Petitioners' Case

4. The 1st Petitioner states that he and the 2nd Petitioner are the directors of Nairobi Beauty World Limited.
5. For context, he depones that the trademark was originally registered on 3rd August 2011 under Class 3. They operated with the trademark until 2018 when they discovered that the Interested Party was also using the same trademark. As a result, the Petitioners sought to have that trademark deregistered and this was effected in March 2019.
6. Covertly, the Interested Party applied to have the Petitioners' trademark deregistered soon thereafter and even registered the trademark under Class 29.
7. This was done without the Interested Party serving the deregistration proceedings that were undertaken before the Kenya Industrial Property Institute (KIPI). Instead, the matter proceeded ex parte and a decision was made without the Petitioners being granted an opportunity to be heard.
8. Subsequently, the Interested Party illegally assumed their trademark and sought to have persons utilizing the trademark to be investigated by the 1st Respondent who the Petitioners contend is keen to see Interested Party taken through a malicious prosecution despite being aware of the pending HCCC Case No. E014 of 2023 Nairobi Beauty World Limited Vs Sime Derby Oils Professional SDN. BHD.
9. The Petitioner avers that in the said civil suit; they were granted leave by Justice Asenath Ongeru on 24th September 2024 to file an Appeal against the decision of the Registrar of Trademarks. They filed the appeal in HCOMMA No. E288 Nairobi Beauty World Limited vs Sime Darby Oils Professionals SDN.BHD which is ongoing.
10. He avers that despite this, the 1st Respondent went ahead instituted prosecution vide file number ACA/HQ/ENF/IPRC/69/2023 which case was set to begin on 8th March 2024. The Petitioners



contend that the 1st Respondent is working in collaboration with the Interested Party to frustrate their right to be heard in the illegal criminal proceedings.

11. He further alleges that as a result of the Interested Party's actions, their property was seized by the 1st Respondent yet the same is not counterfeit as purported.
12. It is the petitioner's case therefore that the Respondents are working together with the Interested Party to violate their rights and have exercised their statutory power irrationally and unreasonably. The Petitioners are aggrieved that the 1st Respondent is also working in cohorts with the Interested Party to aid it take over their established brand and trademark, which they built for over 8 years.

1st Respondent's Case

13. The 1st Respondent through its Inspector Collins Okoth filed its Replying Affidavit sworn on 15th March 2024. He depones that the Interested Party lodged its complaint on 11th December 2023 concerning the impugned trademark through its agent.
14. He avers that the Interested Party is the registered owner in classes 3 and 29 of the Nice Classification for the trade mark 'C.B.C. Brand' (word and device) under certificate for trade mark no. 111560 in class 3 of the Nice Classification registered in 2020 and under certificate for trade mark no. 41399 in class 29 of the Nice Classification registered in 1994. He contended that the Interested Party has used this trademark since then within Kenya.
15. He depones that on 25th March 2020, the Interested Party sought to further register the trademark with the Registrar of Trademarks. This application was however rejected owing to the reason that the Petitioners' company had registered 'C.B.C. Pure White Coconut Oil' and been issued with the Certificate of Trade Mark No.72138. In reaction to this, he avers that the Interested Party sought to have the same deregistered.
16. In a Ruling by the Registrar of Trade Marks dated 9th April 2021, the Petitioners' trademark was deregistered and expunged. Soon thereafter, the Interested Party was issued with a Certificate of Registration for trademark No.111560. Considering this, it is stated that contrary to the Petitioners' allegations, they do not have a registered trademark.
17. In light of the foregoing, the 1st Respondent maintained that the Petitioners' allegations are false as the impugned trademark was lawfully expunged in a process where they fully participated. He further disputes the existence of HCCC Case No. E014 of 2023, Nairobi Beauty World Limited v. Sime Derby Oils Professional SDN.BHD.
18. Additionally, he avers that the alleged deregistered trademark effected through the letter dated 12th March 2019 relates to a different company, that is, Coconut Best Limited which has no relationship with the Interested Party.
19. It is asserted that the 1st Respondent's investigations unearthed that the Interested Party's complaint had probable cause and further complied with the provisions of the *Anti-Counterfeit Act*. It is stated that the 1st Respondent has a statutory mandate to investigate criminal complaints relating to infringement of intellectual property rights and in the exercise of that mandate it cannot be said that it acted illegally.
20. He further depones that the investigations established evidence of counterfeiting by the Petitioners through their company.



21. As a result, the 1st Respondent seized the items on 18th December 2023 which if ascertained, the 1st Respondent will recommend the same to the 2nd Respondent for prosecution.
22. On this premise, the 1st Respondent averred that in carrying out its mandate, it did not violate the Petitioners' rights as alleged nor did it act maliciously as alleged. Further, that the Petition is premature as the 1st Respondent has not even recommended charges to the 2nd Respondent and neither has the 2nd Respondent approved any prosecution.

2nd Respondent's Case

23. In reaction to the Petition, the 2nd Respondent filed its Grounds of Opposition dated 4th April 2024 on the basis that:
 - i. The instant Petition is misconceived, bad in law and incompetent to the extent that it fails to give the particulars of the threat or the infringement of the Applicants' constitutional rights and freedoms by the Respondents.
 - ii. Pursuant to Article 157, the 2nd Respondent is the only institution with the constitutional mandate to institute and undertake criminal proceedings and the exercise of this mandate cannot be interfered with unless in exceptional and clearest circumstances where there is infringement of fundamental freedoms, violation of the constitution and the law or where there is abuse of the legal process.
 - iii. The 2nd Respondent in exercise of his Constitutional mandate conferred by Article 157 of the Constitution will make a decision to charge the Petitioner based on sufficiency of evidence and the public interest underlying prosecution of cases.
 - iv. The Petitioners herein misapprehended the provisions of Article 157 and Article 158 of the Constitution as read with the Office of the Director of Public Prosecutions Act, 2013 to the extent that they seem to imply that the 2nd Respondent is involved in the investigations and arrests of suspects.
 - v. Pursuant to Section 193A of the Criminal Procedure Code, criminal and civil cases can proceed concurrently and nothing prohibits the 2nd Respondent from preferring criminal charges against the Petitioner where criminal culpability has been established based on evidence placed before the Respondent.
 - vi. The Petitioner discloses no cause of action against the 2nd Respondent as the matter relates to the conduct of the 1st Respondent and not the decision to charge the Petitioner/ prosecutions has been made.
 - vii. The institution of the instant Application and Petition is premature since no arrests and/or preference of any charges against the Petitioners has happened, accordingly, the Petitioners' apprehension is unfounded.
 - viii. The instant Petition is frivolous, vexatious and amounts to an abuse of the court process as it seeks to have the Respondents restrained from performing their respective constitutional duties and mandates.

Interested Party's Case

24. The Interested Party filed its Replying Affidavit through its representative, Abdulkadir Warsame sworn on 11th April 2024.



25. He depones that on 14th April 2020, the Interested Party lodged its application to have the Petitioners' Company trademark expunged. He states that during the proceedings, the Petitioners filed their counter statement dated 5th June 2020 maintaining that they were the registered owners of the impugned trademark hence the Petitioners claim that they did not participate in the proceedings is false.
26. In the end as stated, the Registrar of Trademarks in its Ruling dated 9th April 2021 found in favour of the Interested Party. He affirmed that to date, no Court Order has been issued to set aside the Registrar of Trade Mark's Ruling.
27. Aggrieved by the said Ruling, the Petitioners on 13th October, 2023 lodged an appeal vide HCCC Case No. E204 of 2021 Nairobi Beauty World Limited Vs Sime Derby Oils Professional SDN. BHD. It is stated that Hon. Justice C. Meoli on 24th January 2024, dismissed the application on account of procedural impropriety and the Petitioners were directed to lodge a proper appeal before the Court within 10 days.
28. Instead, the Petitioners appealed the said Ruling before the Court of Appeal. In addition, the Petitioners soon thereafter lodged HCCC Case No. E014 of 2023 Nairobi Beauty World Limited Vs Sime Derby Oils Professional SDN. BHD.
29. He depones that on 30th April 2023, the Trade Mark Application No.111560 'C.B.C. Brand' (Words and Devices) was published and in a further Journal dated 31st May 2023, Trade Mark No.KE/T/2011/72138 'C.B.C. Coconut oil' expunged. Subsequently on 8th August 2023, the Interested Party's trademark was entered in the register of Trademarks and a Certificate of Registration issued.
30. In view of the foregoing, it is alleged that the Petitioners in lodging the instant suit concealed material facts and misrepresented the true account of events. On the contrary, he contends that it is clear that it is the Petitioners who have persistently continued to infringe upon the Interested Party's rights as the registered owner of the impugned trademark. As a result of this, the Interested Party even proceeded to lodge HCCCMM Case No. E604 of 2023 Sime Derby Oils Professional SDN. BHD vs Nairobi Beauty World Limited against the Petitioners.
31. Likewise, he avers that the purported deregistered trademark was in relation to a different company called Coconut Best Company Limited which is not the Interested Party.
32. The Interested party also asserted that on investigating its complaint, the 1st Respondent was acting within its mandate as empowered under Section 33 of the [Anti-Counterfeit Act](#) as read with the Anti-Counterfeit Regulations.
33. To this end, it is averred that the Petitioners have failed to establish how the 1st Respondent violated their rights. Further, he stressed that the Petitioners had not approached this Court with clean hands.

Petitioners' Submissions

34. The Petitioners through Oscar Otieno and Company Advocates filed submissions dated 24th July 2024 where the issues for determination were identified as: whether the Petition is hypothetical, whether the 1st Respondent has the power to investigate the Petitioners, the effect of the existence of High Court Civil Case No. E014 of 2023 on the Investigations by the 1st Respondent and whether the Petitioners are entitled to the orders sought herein.
35. On the first issue, Counsel submitted that contrary to the Respondents allusion that the Petition is premature, the Petition raises a real controversy as under Article 22 and 258 of [the Constitution](#) a person



can institute court proceedings claiming that a right is threatened. Reliance was placed in Bernard Murage v Fineserve Africa Limited & 3 others, Petition 503 of 2014 [2015] eKLR where it was held that:

“... that a party does not have to wait until a right or fundamental freedom has been violated, or for a violation of the Constitution to occur, before approaching the Court. He has a right to do so if there is a threat of violation or contravention of the Constitution. The High Court has held previously in the case of Coalition for Reforms and Democracy v Attorney General Petition No.630 of 2014 as follows on the same point; “We take this view because it cannot have been in vain that the drafters of the Constitution added “threat” to a right or fundamental freedom and “threatenedcontravention” as one of the conditions entitling a person to approach the High Court for relief under Article 165(3) (b) and (d) (i). A “threat” has been defined in Black’s Dictionary, 9th Edition as “an indication of an approaching menace e.g. threat of bankruptcy; a Person or a thing that might cause harm” (emphasis added). The same dictionary defines “threat” as “a communicated intent to inflict harm or loss to another...” The use of the words “indication”, “approaching”, “might” and “communicated intent” all go to show, in the context of Articles 22, 165(3) (d) and 258, that for relief to be granted, there must not be actual violation of either a fundamental right or of the Constitution but that indications of such violations are apparent.”

36. On the second issue, Counsel submitted that the 1st Respondent does not have the power to investigate the Petitioners herein as the Anti-Counterfeit Regulations, 2010 which donates this power, lapsed on a 25th January, 2023 as revoked under Section 21(1) of the Statutory Instruments Act, 2013. As such any investigations by the 1st Respondent argued to be null and void and further the 1st Respondent cannot arrogate itself the power to lay a claim and investigate the Petitioners herein.

37. According to Counsel, the Anti-Counterfeit Regulations, 2010 should be considered to have been made under the Statutory Instruments Act and the 10-year period began to run on 25th January 2013, on its commencement date and thus these Regulations lapsed on 25th January 2023.

38. Reliance was placed in Okiya Omtatah v Central Bank of Kenya & 7 others [2018] eKLR where it was held that:

“It is also important to note that section 27 of the said Statutory Instruments Act imports all these instruments as if they were made under the said Act and continue to be in force under the Act unless the same are repealed by the parent statute. In this regard I agree that the 10-year period can only begin to run from the commencement date and not before...”

39. Like dependence was placed in Vipul Kakad T/A Kavico Auto Spares & 328 Others vs. Kenya Bureau of Standards [2017] eKLR.

40. Turning to the next issue, Counsel submitted that the existence of High Court Civil Misc. Application No. E014 of 2023 (Nairobi Beauty World Limited vs Sime Darby oils Professionals) means that the pursuit for investigation and subsequent prosecution of the Petitioners by the 1st Respondent is in bad faith as the appeal has not been determined. Counsel stressed that the intended prosecution would be incapable of being reversed if the appeal against the decision of the Registrar of Trademarks succeeds.



41. To buttress this point reliance was placed in *Saisi v Director of Public Prosecutions & 2 others (Civil Application 2 of 2020)* [2020] KESC 24 (KLR) where it was held that:

“It behoves the Court to be satisfied that prima facie, with no objection, the application is meritorious and the prayers may be granted (see *Gideon Sitelu Konchellah v. Julius Lekakeny Ole Sunkuli & 2 Others Civil Application No.26 of 2018* [2018] eKLR). The Applicants’ assertion is that the effect of the decision by the Court of Appeal is that they will be subjected to a criminal trial, a situation that will violate their constitutional rights to fair trial and equal benefits and protection of the law as more particularly set out in the petition of appeal.

We therefore find that the Applicants have demonstrated an arguable case which would be rendered nugatory in the absence of our intervention by way of granting the orders sought. We shall not at this juncture delve into the merits of the Applicants’ arguments as they will be addressed in the appeal itself”.

42. In view of the foregoing, Counsel submitted that the Petitioners were indeed entitled to the reliefs sought. Reliance was placed in *Centre for Rights Education & Awareness (CREAW) v Attorney General & Another* [2015] eKLR where it was held that:

“I fully agree with the sentiments of the Bench in the CORD case. A party need not wait for a violation of a right or a contravention of *the Constitution* to occur before approaching the Court for relief. It appears to me that the intent behind the use of the word “threatened” in both Articles 22 and 258 was to preempt the violation of rights, or of *the Constitution*. If a clear threat to either is made out, it cannot be properly argued that the petitioner should have waited for the violation or contravention to occur, and then seek relief. It is therefore my finding, and I so hold, that this petition is not premature, and is properly before me.”

1st Respondent’s Submissions

43. On 9th August 2024, the 1st Respondent through its Counsel, J.O. Adera filed submissions and set out the issues for determination as: whether the 1st Respondent has powers to investigate the Petitioners, whether the Petitioners have a registered trademark, whether there is an appeal against the decision of the Registrar of trademarks of 9th April 2021 and whether the Petitioners raise any constitutional issues for grant of the orders sought.
44. Counsel in the first issue opposed this assertion as it had not been raised by the Petitioners in their Petition. Counsel pointed out that this is offensive to the principle to wit parties are bound by their pleadings as seen in *Dakianga Distributors (K) Ltd v Kenya Seed Company Limited* [2015] eKLR. The Court of Appeal held that:

“As the parties are adversaries, it is left to each one of them to formulate his case in his own way, subject to the basic rules of pleadings... for the sake of certainty and finality, each party is bound by his own pleadings and cannot be allowed to raise a different or fresh case without due amendment properly made. Each party thus knows the case he has to meet and cannot be taken by surprise at the trial. The court itself is as bound by the pleadings of the parties as they are themselves. It is no part of the duty of the court to enter upon any inquiry into the case before it other than to adjudicate upon the specific matters in dispute which the parties themselves have raised by the pleadings. Indeed, the court would be acting contrary to its own character and nature if it were to pronounce any claim or defence not made by the



parties. To do so would be to enter upon the realm of speculation. Moreover, in such event, the parties themselves, or at any rate one of them might well feel aggrieved; for a decision given on a claim or defence not made or raised by or against a party is equivalent to not hearing him at all and thus be a denial of justice... In the adversarial system of litigation therefore, it is the parties themselves who set the agenda for the trial by their pleadings and neither party can complain if the agenda is strictly adhered to. In such an agenda, there is no room for an item called “Any Other Business” in the sense that points other than those specific may be raised without notice.”

45. Like dependence as placed in *David Sironga Ole Tukai v Francis Arap Muge & 2 others* [2014] eKLR.
46. That said, Counsel submitted that the Anti - Counterfeit Regulations, 2010 were still in force at the time of the seizure of the infringing goods on 18th December 2023. Thus the 1st Respondent had the requisite power to act as it did, following the extension of operation of Statutory Instruments vide Legal Notice No. 217 on 29th November 2022.
47. Furthermore, it was argued that the 1st Respondent is empowered under Section 33 of the [*Anti-Counterfeit Act*](#) to receive complaints from intellectual property rights owners or their agents, in this case the Interested Party and to act on those complaints, as it did in this case by seizing infringing goods from the Petitioners.
48. Reliance was placed in *Kenafriic Matches Limited v Anti-Counterfeit Agency & another* [2020] eKLR, where it was held that:

“Opposition proceedings are therefore part of the registration process and a trademark can only deemed to be duly registered after the opposition proceedings have been concluded in favour of the person seeking to register the trademark. All the parties agree that the Interested Party has filed opposition proceedings before the Registrar and the proceedings are pending determination. The outcome of those proceedings will determine whether the Petitioner’s trademark will be registered or not. It therefore follows that the Petitioner’s seized product was not manufactured under a registered trademark and was therefore exposed to a complaint that it is counterfeit.”

49. Accordingly, Counsel submitted that investigation of the Petitioners by the 1st Respondent does not amount to violation of their constitutional rights. This is since the 1st Respondent was satisfied that there was reasonable ground to believe that the Petitioners were engaging in conduct that violated the Interested Party’s trademark rights.
50. On the following issue, Counsel submitted that by virtue of the Registrar of Trademarks Ruling dated 9th April 2021 and the Notice issued on 31st May 2023, the Petitioners’ trade mark “C.B.C Pure white coconut oil” trade mark no. 72138 was expunged and from that date onwards ceased to exist. In view of this, the Petitioners are argued not to be the registered owners of the impugned trademark.
51. To support this point reliance was placed in *Pharmaceutical Manufacturing Co. Vs. Novelty Manufacturing Ltd. Nairobi* [2001] 2 EA 521 where it was held that:

“that registration of a trademark confers the right exclusively to use the trademark and the infringement of the trademark is a tort of strict liability hence intention and motive are irrelevant considerations.”

52. Like reliance was placed in *Wilson Muriithi Kariuki T/A Wiskam Agencies V Surgipharm Limited* [2012] eKLR.



53. Counsel noted in the third issue, that no appeal exists against the decision of the Registrar of Trademarks as alleged by the Petitioners. Counsel stressed that the Petitioners continue to withhold material facts by failing to disclose relevant facts. In this case, that the application seeking leave to file the appeal out of time was dismissed on 7th March 2024 and the current application before the Court is an application seeking reinstatement of the application to appeal out of time. Counsel as such asserted that the Petitioners had come before this Court with unclean hands due to their dishonesty in disclosure of material facts.
54. Dependence was placed in *Callen Magoma Omari V Suneka Land Disputes Tribunal & 4 others* [2011] eKLR where it was held that:
- “I do not think that this constitution is the panacea of all manner of ills imagined or not of the past. It is not the solution of the alleged or imagined past historical injustices. It was not meant to resurrect cases which had been dealt with and buried. It was not meant to violate or breach the well-known maxim of law that there must be an end to litigation nor was it meant to assist an indolent litigant where, as here, she had other remedies provided by statute and which she did not take advantage of. In other words, *the constitution* was not meant to take place of or cause conflict to statutory provisions governing appeals or even judicial review proceedings. Finally, I do not think that this constitution was meant to provide another frontier or planc for a litigant who had lost a case in the past or exhausted remedies then available to him to resuscitate it under the guise of violation of constitutional rights. I think that *the constitution* applies to Kenyans equally. That is the essence of articles 2, 3 and 20 of *the constitution*. It cannot be unconstitutional conduct merely because a party has lost a case to a successful party.”
55. Additional dependence was placed in *Latifa M. Ramadhan v Omar M. Ramadhan & another* [2021] eKLR.
56. On the fourth issue, Counsel submitted that the Petitioners had not demonstrated how they had been harassed and threatened by the 1st Respondent to constitute the basis of a constitutional petition. The Petitioners case is argued to constitute mere allegations with no demonstration of how the Respondents acted unlawfully. Counsel cited the case of *Osman & another v Mohamud & 2 others* [2024] KEELC 957 (KLR) where it was held that:
- “The competency of the Petition is put to question and that goes to the jurisdiction of the Court to sustain the same. The 1st Respondent has asserted that the Petition lacks specificity in regard to the alleged violations and lacks substantiation. The Court in the premises has to consider whether the petition as presented by the Petitioners met the threshold of what would constitute a Constitutional Petition to be entertained by the Court as such. In order for a matter to qualify to be raised as a Constitutional Petition it ought to satisfy the criteria that was established in the Case of *Anarita Karimi Njeru –vs- Republic* (1979) eKLR. Firstly, there has to be a precise complaint; Secondly the specific provision of *the Constitution* alleged to be infringed; and Thirdly, the manner in which the Constitutional provision was infringed.”
57. Additional reliance was placed in *Kenafriic Matches Limited (supra), Kenneth Kanyarati & 2 others v Inspector General of Police Director of Criminal Investigations Department & 2 others* [2015] eKLR, *Republic vs. Commissioner of Police and Another ex parte Michael Monari & Another* (2012) eKLR.



2nd Respondent's Submissions

58. Counsel Job Mulati for the 2nd Respondent filed submissions dated 30th August 2024 and highlighted the issues for determination as: whether the 1st Respondent has powers to investigate the Petitioners, whether the Petitioners have a registered Trade Mark, whether Respondents' have infringed the Petitioners Constitutional rights and whether the Petitioners should be granted the orders being sought.
59. Counsel in the first issue answering in the affirmative submitted that Section 3, 5, 23, 33 of the *Anti-Counterfeit Act* makes it plain that the 1st Respondent is empowered to carry out investigations as it did in this matter. Reliance was placed in *Philomena Mbeti Mwilu v Director of Public Prosecutions & 3 others; Stanley Muluvi Kiima (Interested Party); International Commission of Jurists Kenya Chapter (Amicus Curiae)* [2019] eKLR where it was held that:
- “In our view, it would be within the mandate of an investigative body to receive complaints and to investigate them. Such bodies or entities cannot be faulted for acting on the complaints as in so doing, they would be acting within their constitutional and statutory duty.”
60. Like dependence was placed in *Josephat Koli Nanok & another v Ethics and Anti-Corruption Commission* (2018) eKLR and *Kipoki Oreu Tasur V Inspector General of Police & 5 Others* [2014] eKLR.
61. On the second issue, Counsel submitted that it was evident from the parties pleadings that the Petitioners trademark was expunged on 9th April 2021 following the Registrar of Trade marks determination. Counsel stressed that there was no evidence of an appeal or stay of the said expungement.
62. On the third issue, Counsel submitted that the Petitioners had not demonstrated how the respondents infringed and threatened their constitutional rights. Reliance was placed in *Mumo Matemu v Trusted Society of Human Rights Alliance and others* [2013] eKLR where it was held that:
- “We cannot but emphasize the importance of precise claims in due process, substantive justice and the exercise of jurisdiction by a court. In essence, due process, substantive justice and the exercise of jurisdiction are a function of precise legal and factual claims. However, we also note that precision is not conterminous with exactitude. Restated, although precision must remain a requirement as it is important, it demands neither formulaic prescription of the factual claims nor formalistic utterance of the constitutional provisions alleged to have been violated. We speak particularly knowing that the whole function of pleadings, hearings, submissions and the judicial decision is to define issues in litigation and adjudication, and to demand exactitude ex ante is to miss the point...Cases cannot be dealt with justly unless the parties and the court know the issues in controversy. Pleadings assist in that regard and are a tenet of substantive justice as they give fair notice to the other party. The Principle in *Anarita Karimi Njeru* (supra) that established the rule that requires reasonable precision in framing of issues in constitutional petitions is an extension of this principle.”
63. On this basis Counsel submitted that the Petitioners were not entitled to the relief sought.



Interested Parties Submissions

64. Onyony and Company Advocates for the Interested Party filed submissions dated 19th August 2024 where the issues identified the issues as: whether the 1st Respondent has powers to investigate the Petitioners, whether the Petitioners have a registered Trade Mark, whether there is an appeal against the decision of the Assistant Registrar of Trade Marks dated 9th April 2021 and whether the Petitioners have laid a sufficient basis for the grant of the orders sought.
65. Similarly, Counsel pointed out that this challenge had been introduced for the first time through the Petitioners submissions yet it is trite law that parties are bound by their pleadings. Dependence as placed in *Ngang'a & Another vs. Owiti & Another* [2008] 1KLR (EP) 749 cited with approval on the case of *Ogando v Watu Credit Limited & another (Civil Suit E098 of 2022)* [2024] KEHC 3074 (KLR). the Court while deliberating on this subject held that:
- “As the practice has it and especially where counsel appears, a court may hear final submissions from them. This, strictly speaking, is not part of the case, the absence of which may do prejudice to a party. A final submission is a way by which counsel or sometimes (enlightened) parties themselves, crystallize the substance of the case, the evidence and the law relating to that case. It is, as it were, a way by which the court's focus is sought to be concentrated on the main aspects of the case that affect its outcome. Final submissions are not evidence. Final submissions may be heard or even dispensed with. But the main basis of a decision in a case we can say are: the claim properly laid, evidence fully presented and the law applicable”
66. Like dependence was placed in *Nancy Wambui Gatheru vs. Peter W. Wanjere Ngugi Nairobi HCCC No.36 of 1993 and Mugi & 11 others (Suing as delegates of Kenya African National Union (KANU) Kiharu Branch) V Maina & another* [2022] KEELC 2718 (KLR).
67. That notwithstanding, it was argued that the 1st Respondent is empowered under Section 33 of the *Anti-Counterfeit Act* to investigate complaints in relation to intellectual property crimes which it did in this matter.
68. On the second issue, Counsel stressed that it was established that the Petitioners do not have a registered trademark in the impugned trademark as made manifest by the Assistant Registrar's Trade Marks decision on 9th April 2021. Reliance was placed in *Unilever PLC v Bidco Oil Industries* [2004] 1 KLR 57, cited with approval in the case of *Mabati Rolling Mills Limited v Royal Mabati Factory Limited* [2020] eKLR, where it was held that:
- “The Plaintiff was the registered owner of the trade mark "Blue Band" and the registration gave it the exclusive right to use the trade mark in relation to margarine and anybody else who used a mark identical with or so nearly resembling that mark as to be likely to deceive or cause confusion in the course of trade in margarine would be stopped by law from doing so.”
69. In addition, Counsel in the next issue submitted that there had been no appeal against the cited Ruling. Counsel submitted that the Petitioners had falsely represented that there was an appeal in High Court Civil Misc. Application No. E014 of 2023: *Nairobi Beauty World Limited versus Sime Darby Oils Professionals. SON. BHD* yet what is before the Court is an application for leave to appeal out of time, not a substantive appeal against the Ruling of the Assistant Registrar of Trade Marks.



70. To support this point reliance was placed in R vs. Paul Kihara Kariuki, Attorney General & 2 Others, Exparte Law Society of Kenya (Supra) cited with approval in the case of Abdiftah Mohamed Abdi v AI-Sawae Mohamed Abudlgader A. Hassan (2022)eKLR where it was held that:

“Abuse of court process creates a factual scenario where a party is pursuing the same matter by two-court process. In other words, a party by the two-court process is involved in some gamble; a game of chance to get the best in the judicial process...A litigant has no right to pursue "paripassu" two processes, which will have the same effect in two courts at the same time with a view of obtaining victory in one of the process or in both.”

71. Nonetheless it was argued that the existence of civil proceedings does not act as a bar to the continuation of criminal proceedings as provided under Section 193A of the *Criminal Procedure Code*. It was argued that the law permits parallel criminal and civil proceedings. Reliance was placed in Sylvester Gaitano Odhiambo v Republic [2022] eKLR where it was held that:

“On the relevancy of the civil proceedings, section 193A of the *Criminal Procedure Code* Chapter 75 Laws of Kenya, provides that notwithstanding the provisions of any other written laws, the fact that any matter in issue in any criminal proceedings is also directly and substantially in issue in any civil proceedings shall not be a ground for stay, prohibition or delay in criminal proceedings.”

72. Additional dependence was placed in Kipoki Ore Tasur vs. Inspector General of Police & 5 Others (2014) eKLR, Sylvester Gaitano Odhiambo v Republic [2022] eKLR and Daniel Ndungu vs. Director of Public Prosecutions & Another (2013) eKLR.

73. Counsel in conclusion submitted that the Petitioners had not adduced any evidence to support the claim that investigations initiated by the 1st Respondent were illegal and an abuse of powers. Accordingly, it was submitted that the Petitioners had not established their case to the required standard that their rights under *the Constitution* had been violated.

74. Reliance was placed in Kenneth Kanyarati & 2 others v Inspector General of Police Director of Criminal Investigations Department & 2 others [2015]eKLR, where the Court held that:

“the mere fact that an investigation is being undertaken by the 1st Respondent, would not itself be unconstitutional and a party must prove much more than the investigation process alone... an investigation into alleged commission of an offence does not amount to violation of a constitutional right. Indeed, neither does arrest and prosecution, for those are all part of the criminal justice system which is sanctioned by *the Constitution*.”

75. Additional dependence was placed in Javid Igbal Karim & another v Ze Yun Yang [2018] eKLR.

Analysis and Determination

76. It is my considered opinion that the issues that arise for determination are as follows:

- i. Whether the Petition establishes a reasonable cause of action against 2nd Respondent.
- ii. Whether the Petitioners’ rights under Articles 10(1) & (2), 25(a) & (c), 27(1) & (2), 28, 29(c) & (d) and 47 of *the Constitution* were violated by the Respondents.
- iii. Whether the Petitioners are entitled to the relief sought.



Whether the Petition establishes a reasonable cause of action against 2nd Respondent.

77. A reasonable cause of action in my understanding is one where on review of the pleadings, the pleadings depict the essential elements that if proved, could establish legal liability against the party sued. It is a case which the court considers worthy to give a chance to hear on merits even if the ultimate success is not guaranteed. i.e. a case that it is not frivolous.
78. The Court in *Njunge v Ministry of Interior & Coordination of National Government & 3 others* [2024] KEHC 4676 (KLR) observed as follows:

“That the application discloses no reasonable cause of action or defence in law. In *DT Dobie & Co. (Kenya) Limited v Muchina & Another* [1982] KLR, the Court of Appeal defined reasonable cause of action to mean “an action with some chance of success when allegations in the plaint only are considered. A cause of action will not be considered reasonable if it does not state such facts as to support the claim prayer...” The court went further to define what constitutes a cause of action and held that a cause of action referred to an act on the part of the defendant which gave the plaintiff a cause of complaint. Up to this point the plaintiff has failed to disclose a reasonable cause of action which would enable him to seek a legal remedy against the 3rd Defendant. It is on this basis that we humbly invite the court to strike out the Plaintiff’s application...

...

That in the case of *Karl Wehner Claasen v Commissioner of Lands & 4 others* [2019] eKLR the Court further defined a cause of action as follows:

A cause of action denotes a combination of facts which entitles a person to obtain a remedy in court from another person and includes a right of a person violated or threatened violation of such right by another person. The applicant did not disclose any such fact which is sufficient ground for the Court to strike out the application.

...

In answering the question: “what is considered to be a cause of action?” the court borrows from the decision in *Anne Jepkemboi Ngeny v Joseph Tireito & another* [2021] eKLR where the Court of Appeal succinctly stated the following:

“ In the Court of Appeal case of *Attorney General & another v Andrew Maina Githinji & Another* [2016] eKLR Waki JA. held that,

“A cause of action is an act on the part of the defendant, which gives the plaintiff his cause of complaint.”

That definition was given by Pearson J. in the case of *Drummond Jackson vs Britain Medical Association* (1970) 2 WLR 688 at pg 616. In an earlier case, *Read vs Brown* (1889), 22 QBD 128, Lord Esher, M.R. had defined it as: -

“Every fact which it would be necessary for the plaintiff to prove, if traversed, in order to support his right to the judgement of the court.”



Lord Diplock, for his part in *Letang vs Cooper* [1964] 2 All ER 929 at 934 rendered the following definition: -

“A cause of action is simply a factual situation the existence of which entitles one person to obtain from the court a remedy against another person.”

79. The 2nd Respondent’s mandate is provided for under Article 157 of *the Constitution*. The relevant sub-Articles for purposes of this determination are set out below.

(4) The Director of Public Prosecutions shall have power to direct the Inspector-General of the National Police Service to investigate any information or allegation of criminal conduct and the Inspector-General shall comply with any such direction.

(6) The Director of Public Prosecutions shall exercise State powers of prosecution and may—
institute and undertake criminal proceedings against any person before any court (other than a court martial) in respect of any offence alleged to have been committed;
take over and continue any criminal proceedings commenced in any court (other than a court martial) that have been instituted or undertaken by another person or authority, with the permission of the person or authority; and
subject to clause (7) and (8), discontinue at any stage before judgment is delivered any criminal proceedings instituted by the Director of Public Prosecutions or taken over by the Director of Public Prosecutions under paragraph (b).

(10) The Director of Public Prosecutions shall not require the consent of any person or authority for the commencement of criminal proceedings and in the exercise of his or her powers or functions, shall not be under the direction or control of any person or authority.

(11) In exercising the powers conferred by this Article, the Director of Public Prosecutions shall have regard to the public interest, the interests of the administration of justice and the need to prevent and avoid abuse of the legal process.

80. The Court of Appeal in *Diamond Hasham Lalji & another v Attorney General & 4 others* [2018] KECA 856 (KLR) opined as follows:

“(41) Thus, the exercise of prosecutorial discretion enjoys some measure of judicial deference and as numerous authorities establish, the courts will interfere with the exercise of discretion sparingly and in the exceptional and clearest of cases. However, as the Privy Council said in *Mohit v Director of Public Prosecutions of Mauritius* [2006] 5LRC 234:

“these factors necessarily mean that the threshold of a successful challenge is a high one. It is however one thing to conclude that the courts must be sparing in their grant of relief to seek to challenge the DPP’s decision to prosecute or to discontinue a prosecution, and quite another to hold that such decisions are immune from any such review at all...”



In Regina v. Director of Public Prosecutions ex-parte Manning and Another [2001] QB 330, the English High Court said partly at para 23 page 344:

“At the same time, the standard of review should not be set too high, since judicial review is the only means by which the citizen can seek redress against a decision not to prosecute and if the tests were too exacting, an effective remedy could be denied.”

Although the standard of review is exceptionally high, the court’s discretion should not be used to stultify the constitutional right of citizens to question the lawfulness of the decisions of DPP.

(42) The burden of proof rests with the person alleging unconstitutional exercise of prosecutorial power. However, if sufficient evidence is adduced to establish a breach, the evidential burden shifts to the DPP to justify the prosecutorial decision.”

81. To succeed, the Petitioners must demonstrate that the conduct of the 2nd Respondent is/was against the law. In this respect, the Petitioners must not only plead the manner the Respondents acted was contrary to their obligation as required in law but must also prove these assertions. The Court in Nganga & 12 others v Kahiu [2024] KEELC 7067 (KLR) observed as follows:

“22. It is trite that he who alleges must prove. The burden of proof in civil cases is on a balance of probabilities. It would be recalled that even in uncontested suits, the burden of proof on a claimant is not lessened in any way. See the case of Kenya Power and Lighting Company Limited Vs. Nathan Karanja Gachoka & another [2016] eKLR.

23. Section 107 – 109 of the Evidence Act which provide;

“107. Burden of proof

- (1) Whoever desires any Court to give judgment as to any legal right or liability dependent on the existence of facts which he asserts must prove that those facts exist.
- (2) When a person is bound to prove the existence of any fact it is said that the burden of proof lies on that person.

108. Incidence of burden

The burden of proof in a suit or proceeding lies on that person who would fail if no evidence at all were given on either side.

109. Proof of particular fact

The burden of proof as to any particular fact lies on the person who wishes the Court to believe in its existence, unless it is provided by any law that the proof of that fact shall lie on any particular person.”



24. The Court of Appeal in the case of *Mbuthia Macharia v Annah Mutua Ndwiga & Another* [2017] eKLR explained that the legal burden is discharged by way of evidence, with the opposing party having a corresponding duty of adducing evidence in rebuttal. That constitutes evidential burden. The learned Judges cited with approval the same principle of law as amplified by the learned authors of the leading Text Book; - *The Halsbury's Laws of England*, 4th Edition, Volume 17, at paras 13 and 14:

“The legal burden is the burden of proof which remains constant throughout a trial; it is the burden of establishing the facts and contentions which will support a party’s case. If at the conclusion of the trial he has failed to establish these to the appropriate standard, he will lose.

14. The legal burden of proof normally rests upon the party desiring the Court to take action; thus a claimant must satisfy the Court or tribunal that the conditions which entitle him to an award have been satisfied. In respect of a particular allegation, the burden lies upon the party for whom substantiation of that particular allegation is an essential of his case. There may therefore be separate burdens in a case with separate issues.”

82. In like manner, the Court of Appeal in *Kurshed Begum Mirza v Jackson Kaibunga* [2017] KECA 244 (KLR) guided as follows:

- “(16) Turning to the second issue; according to section 107 of the *Evidence Act*, the burden of proof in any case lies with the party who desires any court to give judgment as to any legal right or liability. It is for that party to show that the facts which he alleges his case depends upon exist. This is known as the legal burden.

The Halsbury's Laws of England, 4th Edition, Volume 17, at paras 13 and 14: describes it thus:

- “13. The legal burden is the burden of proof which remains constant throughout a trial; it is the burden of establishing the facts and contentions which will support a party’s case. If at the conclusion of the trial he has failed to establish these to the appropriate standard, he will lose.
14. The legal burden of proof normally rests upon the party desiring the court to take action; thus a claimant must satisfy the court or tribunal that the conditions which entitle him to an award have been satisfied. In respect of a particular allegation, the burden lies upon the party for whom substantiation of that particular allegation is an essential of his case. There may therefore be separate burdens in a case with separate issues.”



(17) The legal burden is discharged by way of evidence, with the opposing party having a corresponding duty of adducing evidence in rebuttal. This constitutes evidential burden. Therefore, while both the legal and evidential burdens initially rests upon the claimant, the evidential burden may shift in the course of trial, depending on the evidence adduced. As the weight of evidence given by either side during the trial varies, so will the evidential burden shift to the party who would fail without further evidence...”

83. The petitioners’ case against the 2nd Respondent was that the 1st Respondent had compiled the prosecution file number ACA/HQ/ENF/IPRC/69/2023 with a view to recommending to the 2nd Respondent to approve their prosecution.
84. The 2nd Respondent countered that the Petition is premature as no file had been forwarded to it hence no decision had been made to charge the Petitioners as there was therefore no cause of action against the 2nd Respondent. The Petitioners however termed this argument by the 2nd Respondent as misconceived since even a threat is sufficient to found a constitutional violation.
85. There was no pleading, evidence or material that the 2nd Respondent had initiated or in any way taken any step towards the purported criminal investigation or prosecution. The 1st Respondent actually affirmed that the investigations were incomplete as the matter was yet to be referred to the 2nd Respondent.
86. I concur that a constitutional threat is sufficient to found a cause of action for violation of constitutional rights but there is need for the imminency of an actual or real threat to be pleaded and proved. Given the facts of this case, I am not satisfied that this has been shown against the 2nd Respondent. As guided in the cited authorities, a Court can only interfere with the 2nd Respondent’s mandate where it is proved that the action taken was contrary to the law.
87. The Petitioners have not established that the 2nd Respondent given the facts of this case.
88. On whether the 1st Respondent has the power to investigate the Petitioners; it is necessary to refer to the statutory mandate of the 1st Respondent as provided for under Section 5 of the [Anti-Counterfeit Act](#) which states as follows:
- a. enlighten and inform the public on matters relating to counterfeiting;
 - b. combat counterfeiting, trade and other dealings in counterfeit goods in Kenya in accordance with this Act;
 - c. devise and promote training programmes on combating counterfeiting;
 - d. co-ordinate with national, regional or international organizations involved in combating counterfeiting;
 - (da) advise the government through the Cabinet Secretary on policies and measures concerning the necessary support, promotion and protection of intellectual property rights as well as the extent of counterfeiting;
 - (db)) to carry out inquiries, studies and research into matters relating to counterfeiting and the protection of intellectual property rights;
 - (e) carry out any other functions prescribed for it under any of the provisions of this Act or under any other written law; and



- (f) perform any other duty that may directly or indirectly contribute to the attainment of the foregoing.
89. The Court in *Beyond Opinion Business Solutions Limited & another v Manji Food Industries Limited & 2 others* [2023] KEHC 17562 (KLR) discussing the 1st Respondent's mandate observed as follows:
- “ 13. The alleged seizure and confiscation of the applicants' goods and sealing of the premises are sanctioned by the Anti Counterfeit Act. The short title to the Act is very clear that it was intended as an Act of Parliament to prohibit trade in counterfeit goods, and for this reason to establish the Anti-Counterfeit Authority.
14. The Authority is clothed with powers and functions under section 5 of the Act. These are reaffirmed in section 2 of the *Office of the Director of Public Prosecutions Act* which defines an investigative agency in section 2 as follows:-
- In relation to public prosecutions means the National Police Service, Ethics and Anti-Corruption Commission, Kenya National Commission on Human Rights, Commission on Administration of Justice, Kenya Revenue Authority, Anti-Counterfeit Agency or any other Government entity mandated with criminal investigation role under any written law;
15. Section 56 of the Act lays out offences for which a person may be charged with. What is therefore clear is that the framework under the Act is one founded in criminal law sanctions. I must say in the same breath that for purposes of section 25(3) of the Act, the Court of competent jurisdiction referred to in my view would be a court competent to consider the merits of the decision taken by the Authority. That cannot possibly be this Court. The section states as follows-
- Any person aggrieved by a seizure of goods under section 23 may, at any time, apply to a court of competent jurisdiction for a determination that the seized goods are not counterfeit goods and for an order that they be returned to him.
16. This Court concurs with the finding in the case of *Match Masters Limited v Kenafric Matches Limited & another* [2021] eKLR. The Court correctly observed that
- Counterfeiting as contemplated by statute is a criminal offence and while counterfeiting is by its very character trade mark infringement, all trade mark infringement is not counterfeiting. Counterfeiting is something more than trade mark infringement. ...The threshold to be reached in proving criminal counterfeiting is more involved than in proving non-criminal trade mark infringement.”
90. The Petitioners in their written submissions submitted that the 1st Respondent did not have the power to investigate them as the Anti-Counterfeit Regulations, 2010 lapsed on 25th January, 2023 as revoked under Section 21(1) of the *Statutory Instruments Act*, 2013.



91. Firstly, this aspect was not pleaded in the Petition and only came up in the submissions. It is trite law that parties are bound by their pleadings. In *Matindi & 3 others v The National Assembly of Kenya & 4 others; Controller of Budget & 50* [2023] KEHC 19534 (KLR) the Court held:

“284. The Supreme Court in the case of *Raila Amolo Odinga & Stephen Kalonzo Musyoka v Independent Electoral and Boundaries Commission, Chairperson Independent Electoral and Boundaries Commission & Uburu Muigai Kenyatta (Election Petition 1 of 2017)* [2017] KESC 31 (KLR) (Election Petitions) (28 August 2017) (Order) affirmed that parties are bound by their pleadings. The court opined as follows:

“(62) Having addressed our minds to the above issues, it is our view that first, we note that as correctly argued by counsel for the 3rd respondent, a party must be bound by its pleadings... Any prayer in the application that would seem to be an expansion of the case for the Petitioners or which would in effect be a fishing exercise to procure fresh evidence not already contained in the petition would and must be rejected.”

285. Correspondingly, the Court of Appeal in the case of *Independent Electoral and Boundaries Commission & another v Stephen Mutinda Mule & 3 others* [2014] eKLR citing the Nigerian Supreme Court with approval observed that:

“First, in *Adetoun Oladeji (NIG) Ltd vs Nigeria Breweries PLC SC 91/2002*, Judge Pius Aderemi JSC expressed himself, and we would readily agree, as follows;

“...it is now a very trite principle of law that parties are bound by their pleadings and that any evidence led by any of the parties which does not support the averments in the pleadings, or put in another way, which is at variance with the averments of the pleadings goes to no issue and must be disregarded.”

Other judges on the case expressed themselves in similar terms, with Judge Christopher Mitchell JSC rendering himself thus;

“In fact, that parties are not allowed to depart from their pleadings is on the authorities basic as this enables parties to prepare their evidence on the issues as joined and avoid any surprises by which no opportunity is given to the other party to meet the new situation.”

....

As the authorities do accord with our own way of thinking, we hold them to be representative of the proper legal position that parties are bound by their pleadings which in turn limits the issues upon which a trial court may pronounce.



286. Likewise, the Court of Appeal in the case of Richard Nchapi Leiyagu v Independent Electoral & Boundaries Commission & 2 others [2014] eKLR held that:

“There are many decisions of our courts, including those cited by the 3rd respondent’s counsel, to the effect that parties cannot raise matters that are not in their pleadings. Way back in 1930, Scrutton LJ in *Blay vs Pollard & Morris* (1930) 1 KB, 628 at 634 stated that:

“Cases must be decided on the issues on the record; and if it is desired to raise other issues they must be placed on record by amendment. In the present case the issue on which the judge decided was raised by himself without amending the pleadings and in my opinion he was not entitled to take such a course.”

In *Gandy vs Caspair*, (1956) 23 EACA 139, Sinclair V-P reiterated that principle when he stated that: “as a rule relief not founded on the pleadings will not be given”.

287. We are satisfied that the 2nd and 3rd petitioners tried to introduce new issues that were not either pleaded in the original petitions but were found in their further affidavit, supplementary affidavit, submissions, and found in the amended petition filed out of time, which the court declined to admit.

288. Evidently, each party is at liberty to frame his case in his own way while paying regard to the rules of pleadings and in the end, is ultimately bound by the manner in which the pleadings were drafted. As such, a party cannot be allowed to raise a different or fresh case without an amendment to the pleading...”

92. Further, on the question of whether the 1st Respondent has a statutory mandate to investigate complaints relating to counterfeit goods, the answer to this question is in the affirmative. I have already demonstrated from the reading of the legislation and judicial precedent that this contention is now settled, the 1st respondent has a mandate to investigate and recommend prosecution to 2nd respondent for offences under the Act.

Whether the Petitioners’ rights under Articles 10(1) & (2), 25(a) & (c), 27(1) & (2), 28, 29(c) & (d) and 47 of *the Constitution* were violated by the Respondents.

93. The facts of this case disclose that the Petitioners initially registered their impugned trademark on 3rd August 2011 under Class 3. As shown in the Interested Party’s exhibit ‘SD 5’ this evolved into a dispute at the Registrar of Trade Marks after the interested Party lodged a complaint following rejection of its application. A determination was made by Registrar of Trade Marks on 9th April 2021 after a hearing on merits with the Registrar concluding thus:

“For the above-mentioned reasons and on a balance of probabilities, I conclude as follows:

- a. The Applicants have succeeded in these expungement proceedings:
- b. I hold that the Proprietors’ trade mark no. KE/T/2011/72138 “C.B.C. PURE WHITE COCONUT OIL” [WORDS AND DEVICES) was entered in



the Register of Trade Marks without sufficient cause and in error since the Proprietors were not entitled to the mark as required by law; and

- c. The Register of Trade Marks is hereby rectified by expunging trade mark no. KE/T/2011/72138 "C.B.C. PURE WHITE COCONUT OIL" (WORDS AND DEVICES) from the Register under the provisions of section 35 (1) of the *Trade Marks Act*.

Each Party in these proceedings shall bear their own costs."

94. The Petitioners omitted to depone to this fact. The Petitioners instituted court proceedings to challenge the findings by the Registrar of Trademarks of which so far, neither stay nor an order setting aside has been issued. The Petitioners' trademark was thus expunged and deregistered pursuant to the decision by the Registrar.

95. In addition, the Interested Party lodged its complaint with the 1st Respondent on 11th October 2023 as evidenced under exhibit 'C1' in the 1st Respondent's Replying Affidavit. This was after petitioners' Trade Mark was expunged and its trade mark registered on 8th August, 2023. The Interested Party in the complaint under paragraph 4 and 5 informed that:

4. Description of the Suspected Counterfeit Goods.

Coconut oil beauty hair product bearing the trade mark "C. B. C. COCONUT HAIR OIL

5. Places where the goods are situated or the intended destination Nairobi Beauty World limited situated at Shell Petrol Station, Lunga Lunga Road, Nairobi, adjacent to the tyre centre at an unmarked Godown is the manufacturer of the product in question, whereas Galaxy Plastics Limited situated at Mogadishu Road, off Lunge Lunga Road, Industrial Area Nairobi, is the manufacturer/source of the packaging material (bottles).

The products in question bearing the trademark "CB.C. COCONUT HAIR OIL." Are available in all branches of Sleek Lady Cosmetics Limited, commonly known as "Best lady."

96. Further at Paragraph 11 the Interested Party stated as follows:

Nature of Complaint.

That Nairobi Beauty World limited has been engaging in the distribution, sale and or manufacture of coconut oil-based beauty products bearing the trade mark "C.B.C COCONUT HAIR OIL," which is identical to the Complainant's trade mark "CBC BRAND (WORDS AND DEVICES) in contravention of Section 32 (a), (b), (c), (d), (e), (g) and (h) of the Anti- Counterfeit Act.

97. It is manifest that this complaint was lodged after the Petitioners trademark had been expunged and deregistered following the Registrar of the Trade Mark's Ruling and the registration of the Interested Party's Trademark on 8th August 2023. In my view, the continued violation of the Interested Party's Trade Mark by the Petitioners created a probable cause for the 1st Respondent's mandate to be put in motion.

98. It is my finding that given the facts of this case; the 1st Respondent's conduct following the institution of the complaint was reasonable as their mandate empowered them to inquire into the complaint of the infringement of trade mark by the petitioners' despite the ruling by Registrar which had not been overruled or stayed. Part of the 1st Respondent's mandate is to undertake investigations concerning counterfeit goods. The allegations of malice against the 1st Respondent are thus unfounded.



99. The Petitioner further challenged the continuation of the 1st Respondent’s investigations and intended prosecution by the 2nd Respondent in light of the Petitioners’ appeal of the Registrar of Trademarks Ruling. Hon. Justice A. N. Ongeru in the Ruling dated 24th September 2024 exhibit ‘AH-1’ in the Petitioner’s further supplementary affidavit granted leave to the Petitioners application to file their intended appeal out of time.
100. However, there is no stay of the Registrar of Trademarks Ruling which still stands. Furthermore, the law provides that both civil and criminal proceedings can run concurrently. Section 193A of the [Criminal Procedure Code](#) Cap 75 provides that:

Concurrent criminal and civil proceedings

Notwithstanding the provisions of any other written law, the fact that any matter in issue in any criminal proceedings is also directly or substantially in issue in any pending civil proceedings shall not be a ground for any stay, prohibition or delay of the criminal proceedings.

101. The Court in *Republic v Director of Public Prosecutions & 2 others ex-parte Joseph Gathuku Kamuiru & another* [2014] KEHC 8432 (KLR) observed as follows:

“Whether a prosecution will be quashed or prohibited will therefore depend on the facts of each case. The existence of civil proceedings arising out of the same set of facts is, however, not in itself a bar to commencement or continuation of criminal proceedings. Section 193A of the [Criminal Procedure Code](#), Cap 75 is clear on this.

In *KURIA & 3 OTHERS*, supra, it was stated that:

It is not enough to simply state that because there is an existence of a civil dispute or suit, the entire criminal proceedings commenced based on the same set of facts are an abuse of the court process. There is a need to show how the process of the court is being abused or misused. There is a need to indicate or show the basis upon which the rights of the applicant are under serious threat of being undermined by the criminal prosecution. In the absence of concrete grounds for supposing that a criminal prosecution is an “abuse of process”, is a “manipulation”, “amounts to selective prosecution” or such other processes, or of even supposing that the applicants might not get a fair trial as protected in [the Constitution](#), it is not mechanical enough that the existence of a civil suit precludes the institution of criminal proceedings based on the same set of facts”

The question the court will therefore ask is whether an applicant has demonstrated that a prosecution is contrary to the public interest, the interests of the administration of justice or amounts to an abuse of the legal process.”

102. The Supreme Court of India in *P. Swaroopa Rani vs. M. Hari Narayana* (AIR 2008 SC 1884) made a similar finding noting thus:

“ 13. It is, however, well-settled that in a given case, civil proceedings and criminal proceedings can proceed simultaneously. Whether civil proceedings or criminal proceedings shall be stayed depends upon the fact and circumstances of each case. [See *M.S. Sheriff v. State of Madras* AIR 1954 SC 397, *Iqbal Singh Marwah v. Meenakshi Marwah* (2005) 4 SCC 370 and *Institute of Chartered*



Accountants of India v. Assn. of Chartered Certified Accountants (2005) 12
SCC 226].”

103. It is my considered opinion that the petitioners have not demonstrated circumstances warranting this Court to stop the 1st or even the 2nd Respondent from carrying with their mandate or have not in way established a violation of their rights and fundamental freedoms as alleged.
104. This Petition is bereft of any merits and is hereby dismissed with costs to the Respondents and the Interested Party.

DATED, SIGNED AND DELIVERED VIRTUALLY AT NAIROBI THIS 26TH JUNE, 2025.

.....

L N MUGAMBI

JUDGE

