Softcare Kenya Company Limited v Kot Group Limited & another (Commercial Case E322 of 2025) [2025] KEHC 12475 (KLR) (Commercial and Tax) (1 September 2025) (Ruling)

Neutral citation: [2025] KEHC 12475 (KLR)

REPUBLIC OF KENYA

IN THE HIGH COURT AT NAIROBI (MILIMANI COMMERCIAL COURTS)

COMMERCIAL AND TAX

COMMERCIAL CASE E322 OF 2025

JWW MONG'ARE, J

SEPTEMBER 1, 2025

BETWEEN

SOFTCARE KENYA COMPANY LIMITED .... PLAINTIFF

AND

KOT GROUP LIMITED .... 1ST DEFENDANT

HILALIUM AND SONS (UR HOME) LIMITED .... 2ND DEFENDANT

RULING

Introduction and Background

1. By an application dated 7th May 2025 that was amended on 23rd May 2025, the Plaintiff("Softcare") seeks an interlocutory injunction against the Defendants, alleging that they have infringed on its trademark rights. It seeks to restrain the Defendants from importing, distributing, selling, manufacturing, or offering for sale sanitary products that bear the "My Girl" mark or any other similar mark or name that resembles Softcare's "Softcare" brand and packaging. The application was heard ex parte on 14th May 2025, and the court granted interim orders. This prompted the Defendants to file the Notice of Motion dated 21st May 2025 seeking to discharge the said orders and refer this matter for determination before the Industrial Property Tribunal.

2. Through grounds set out on the face of the application, affidavits by Softcare's Legal Manager, Mary Mawia Mulyungi sworn on 7th May 2025 and 23rd May 2025 and submissions, Softcare asserts that it has satisfied the three-part test for a temporary injunction, as outlined in *Giella v Cassman Brown & Co., Ltd*. [1973] E.A. 358: Softcare argues that it has a strong prima facie case with a likelihood of success and that it has been importing or manufacturing and selling sanitary pads under the registered trademark "Softcare" for over fourteen years. It claims to have acquired substantial goodwill and

reputation in the "Softcare" trademark and its purple packaging and alleges that the Defendants are infringing on this trademark with their "My Girl" product in various ways.

3. Softcare claims that the "My Girl" brand is used on goods in the same class as the "Softcare" trademark, the packaging of the "My Girl" product copies the "Softcare" product's purple and blue color scheme, a lady's image on the left side, and other design elements, making it confusingly similar. That this similarity is likely to cause confusion and deception, leading consumers to mistakenly buy the Defendants' product thinking it is from Softcare. Its submissions cite section 7 of the *Trade Marks Act*(Chapter 506 of the Laws of Kenya), which grants the registered owner of a trademark the exclusive right to use it.

4. Softcare contends it will suffer irreparable injury if the injunction is not granted, and this harm cannot be adequately compensated by damages. It claims that the confusion and deception caused by the Defendants' product have already led to a drop in their sales, and this loss is difficult to quantify because their products are sold in various outlets across the country. Softcare also emphasizes that its valuable goodwill and reputation, built up as a prior user of the mark, will be severely eroded if the infringement continues and that the balance of convenience favors it. Softcare states that granting the injunction would not significantly harm the Defendants, as it deals with a variety of other products, while Softcare would suffer greater inconvenience if the injunction is denied.

5. As such, Softcare submits that its application is urgent, well-founded, and has met the necessary legal tests for an injunctive order and it urges the court to grant the application with costs. The Defendants jointly responded to the application through the replying affidavits of the 1st Defendant's non-executive director, Deng Xiangwen, sworn on 21st May 2025 and 10th June 2025 respectively. They also filed written submissions in support of their positions.

6. The Defendants state that Softcare has not shown a valid legal right that is being infringed. They contend that they are the registered owners of the "My Girl" word mark which was registered in 2013 and the specific industrial designs for the blue and purple pads registered in 2024. The Defendants argue that registration provides a presumption of validity and they challenge Softcare's ownership of its "Softcare" word mark, stating it is officially registered to a different company with no proof of assignment provided. They argue "My Girl" and "Softcare" are completely different in spelling, sound, and meaning, making a claim of trademark infringement between them unsustainable. That Softcare's pictorial mark was only registered in 2024, 11 years after the Defendants' mark and came with significant disclaimers.

7. The Defendants point out that Softcare's own deposition admits it only has an issue with the purple "My Girl" pads, not the entire brand. They argue Softcare's request for a blanket injunction against all "My Girl" products is therefore overly broad and malicious. They cite *Solpia Kenya Limited v Style Industries Limited & Sana Industries Limited* [2015] KEHC 8101 (KLR) to argue that a prior user of a mark has rights that cannot be interfered with by a later registrant. They further argue that complex questions of infringement and consumer deception are matters of fact that require a full trial with witness evidence and cross-examination, not a decision at the interim injunction stage.

8. The Defendants state that Softcare provided no concrete evidence of a loss that could not be compensated by monetary damages if they eventually won the case and they argue the harm they are suffering from the current injunction is severe and outweighs any potential harm to Softcare. They claim the injunction has "fully crippled" their operations, causing financial hemorrhage, reputational damage, and an inability to service loans. They also invoke public interest, citing a Ministry of Health policy that emphasizes the importance of access to quality sanitary products, noting their product is independently rated more popular and of higher quality than Softcare's.

9. The Defendants state that the validity of their purple pad design is already the subject of a separate revocation proceeding before the Tribunal in IPT Case No. E002 of 2025 filed by Softcare before this court case and they accuse the Plaintiff of failing to disclose this material fact to the court. They argue that the Tribunal is the specialized forum with the expertise and statutory power under the *Industrial Property Act* to handle such technical disputes over industrial designs. They thus frame Softcare's court action as an improper attempt to get a second bite at the cherry or to bypass the specialist Tribunal.

10. The Defendants conclude that Softcare has thoroughly failed to meet any of the requirements for a temporary injunction and they pray for the court to allow their application to discharge the injunction and dismiss Softcare's application for an injunction.

Analysis and Determination

11. I have gone through the applications, the respective responses and the parties' submissions. The main issue for determination is whether the court ought to grant the injunctive orders sought by the Plaintiff or whether the orders should be discharged and this matter be referred to the Tribunal for determination. I propose to first deal with the Defendants' contention that this matter ought to be referred to the Tribunal considering that Softcare has filed a suit therein. Whereas Softcare admits to filing a separate case before the Tribunal, it contends that the two cases are distinct as the case before the Tribunal concerns the "Trade Dress," or the overall look and feel of the product's packaging, which falls under industrial design whereas this case is about trademarks infringement. It relies on the court's decision in *City Eye Advertising Agency v Mwenge Miraa Sacco Ltd* [2022] KEHC 2083 (KLR) where P.J.O. Otieno J., held as follows:-

> 8. The law remains trite that without jurisdiction the court makes no move and that when it acts without jurisdiction, the action is no more than a nullity. There is also the firm jurisprudence that where there is established by statute or other legal instrument, a forum to address a dispute, such must be, under the doctrine of exhaustion, be strictly resorted to before the court can entertain the dispute. The coronary is that every court has a duty to sit and handle every matter that properly falls on its docket.
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> 9. The objection being grounded on the provision of the *Industrial property Act* which creates a tribunal, the Industrial Property Tribunal, one must ask what the jurisdiction of that tribunal entails. While a trade mark is indeed an industrial property, it is a genre of industrial property that unlike the rest, is governed by a specific statute. It is thus safe to say that the Kenyan intellectual property legal regime is coded in three statutes; Intellectual Property Act, Copyrights Act and the Trade Mark Act. The argument on the objection I am called upon to determine is really a question of whether Intellectual Property Act and the Tribunal it creates apply to a dispute under the *Trade Marks Act*.
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> 10. The short title to the *Industrial Property Act* and the definitions at section 2 determines that the act is intended for the regulation of patents, utility models, technovation and industrial designs. Accordingly, when the Act creates the tribunal to determine disputes, such disputes must be those concerned with the statute. I see no invitation of matters trademarks under the *Industrial Property Act* and I do find that Trade Mark disputes were never intended by Parliament to be governed by the *Industrial Property Act*.

11. In construction of statutes, it is a rule that if there is to be a conflict between a generic statute and a specific one, the provisions of the specific statute would prevail. I find that the *trade Marks Act* is a complete code on its subject and that there would be no justification to invite the application of section 105 of the *Industrial property Act* on a dispute on trade marks.

12. I am in agreement with the aforementioned holding by my colleague judge and Softcare's submission that the Tribunal's jurisdiction does not extend to matters and disputes relating to Trademarks as is the case herein. I therefore find that this court has the requisite jurisdiction to determine this matter and that there is no legal basis to refer the same to the Tribunal.

13. I now turn to the substance of Softcare's application. For it to obtain an injunction, it must demonstrate that it has a prima facie case with a probability of success, demonstrate irreparable injury which cannot be compensated by an award of damages if a temporary injunction is not granted, and if the court is in doubt show that the balance of convenience is in its favour. In *Nguruman Limited v Jan Bonde Nielsen& 2 others* [2013] KECA 347 (KLR), the Court of Appeal reiterated these conditions and further clarified that they are to be applied as separate, distinct and logical hurdles which an applicant is expected to surmount sequentially. This means that if the applicant does not establish a prima facie case then irreparable injury and balance of convenience do not require consideration. On the other hand, if a prima facie case is established, then the court will consider the other conditions.

14. As to what constitutes a prima facie case, the parties have rightly submitted that the Court of Appeal in *Mrao Ltd v First American Bank of Kenya Ltd & 2 others* [2003] KECA 175 (KLR) explained that it is, "….a case in which on the material presented to the Court, a tribunal properly directing itself will conclude that there exists a right which has apparently been infringed by the opposite party to call for an explanation or rebuttal from the latter." Thus, in order to succeed in getting an injunction, Softcare is expected to demonstrate that it has been importing or manufacturing and selling sanitary pads under the registered trademark "Softcare" for over fourteen years. That it has acquired substantial goodwill and reputation in the "Softcare" trademark and its purple packaging. Softcare is also to demonstrate that the Defendants are infringing on this trademark with their "My Girl" product by using the same on goods in the same class as the "Softcare" trademark, that the packaging of the "My Girl" product copies the "Softcare" product's purple and blue color scheme, a lady's image on the left side, and other design elements, making it "confusingly similar" and that this similarity is likely to cause confusion and deception, leading consumers to mistakenly buy the Defendants' product thinking it is from Softcare.

15. In making this determination, I am also cognizant of the fact that at this stage, the court can only make a prima facie finding whose conclusiveness will be determined at trial. The court cannot conduct a mini trial and make a conclusive finding based on the affidavit evidence before it. It is at the trial and main hearing stage that the parties can impeach the veracity and credibility of the documents on record (see *Webtribe Limited T/A Jambopay v Jambo Express Limited* [2014] KEHC 1724 (KLR)].

16. Whereas Softcare has annexed a certificate of the registered trademark "Softcare", I have to agree with the Defendants that the word mark is registered in Class 16 (Baby Diapers) and not sanitary pads and that it was only moved to this class in 2018 as per the Certificate of Addition of List of Goods of a Registered Trade Mark that has been annexed. Further, that this mark is owned by another entity, Housemart Company Limited and not Softcare. A renewal certificate annexed also shows it was later renewed by Sunda (Kenya) Industrial Company Limited and that there is no evidence of an Assignment to Softcare. This creates confusion and casts doubt about who actually owns this foundational mark and undermines Softcare's claim of 14 years of use for the sanitary pads under this specific registration. Further, whereas Softcare has annexed a certificate of a pictorial mark which proves

the registration of the specific purple/blue pack design in Class 5 under sanitary pads from 2018, I note that the same is registered under another entity and that the Assignment was only given in the year 2024.

This also negates Softcare's claim on using this pictorial mark for 14 years.

17. I have also gone through the Trademark License Agreement between the proprietor of the mark and Softcare granting Softcare which license grants it the right to use and enforce the mark in Kenya, and I note that the same is disclaimed as being "non-exclusive" which dents Softcare's claim of exclusivity and depth of the products' goodwill. On their part, the Defendants present their own registered intellectual property, including a Certificate TM 80924 "My Girl" (Word Mark) which is registered in Class 5 (sanitary preparations) on 29th November 2013, years before Softcare's mark was in that class and Industrial Design No.s 1794 & 1795 registered on 2nd December 2024, protecting the design of their product packaging.

18. I have further gone through the annexures presented by Softcare to prove the allegation that the Defendants' products are confusingly similar to theirs and juxtaposed it with the Defendants' explanations to the contrary. I am inclined to agree with the Defendants that on a prima facie basis, the subject marks, products and their packaging are visually and phonetically different and are unlikely to confuse a rational person as to which product belongs to what company. Visually, I find that the packaging contains different patterns as Softcare has what appears to be "parsley," whereas the Defendants has "butterflies and snowflakes". The images on the packaging do not appear to be of the same person and that they are dressed in clothing with different colours. Phonetically, the prominent words are obviously different as Softcare uses "Softcare" whereas the Defendants use "My Girl."

19. The Defendants also annexed a Report where respondents therein indicated that their favourite brands were "My Girl (29%) and Softcare (23%)" which prima facie demonstrates that the Defendants' products is well known and is more favourable as opposed to Softcare's. This also demonstrates that people know of the difference between the two brands and that it is unlikely that they can be confused.

20. I think I have said enough to find that Softcare has failed to demonstrate a prima facie case with a probability of success and the odds are stacked against it from obtaining injunctive orders. In light of the dicta in the *Nguruman* (Supra), this marks the end of the court's inquiry.

Conclusion and Disposition

21. For these reasons, I dismiss the Plaintiff's amended application dated 23rd May 2025 with costs and as a consequence, the interim orders in place are hereby vacated and discharged. As the Defendants' application dated 21st May 2025 partly succeeds, I will award it the costs of the same. It is so ordered.

DATED SIGNED AND DELIVERED VIRTUALLY AT NAIROBI THIS 1ST DAY OF SEPTEMBER 2025

J.W.W. MONGARE

JUDGE

In the presence of

Mr. Ombeta Odongo for the Plaintiff.

N/A for the Defendant.

Amos- Court Assistant