



**REPUBLIC OF KENYA
IN THE HIGH COURT OF KENYA
AT NAIROBI (MILIMANI LAW COURTS)
CIVIL SUIT 542 OF 2011**

**WILSON MURIITHI KARIUKI
T/A WISKAM AGENCIES.....PLAINTIFF
VERSUS
SURGIPHARM LIMITED.....DEFENDANT**

RULING

By a Motion on Notice dated 28th November 2011, the plaintiff herein seeks the following orders:

“1. That this Honourable Court be pleased to certify this application urgent and be heard ex-parte in the first instance.

2. That pending the hearing and determination of this application inter partes, an injunction be granted to restrain the Defendant, its directors, promoters, shareholders, officers, servants and/or agents or any of them or otherwise howsoever from:

3. That this Honourable Court be pleased to grant prayer 2 above pending the hearing and determination of the suit herein.

- i. Passing off its water purifying apparatus and machines as those of the plaintiff.
 - ii. Infringing the Plaintiff's intellectual property rights the registered proprietor of the Zero B Trade Mark.
 - iii. Trading, promoting, advertising, marketing, carrying on business and or dealing in any other way howsoever with the trademark Zero B.
 - iv. Printing letterheads, contracts, promotional materials, brochures or any other trade documents of any nature whatsoever with the trade mark Zero B or a variant thereof or any other trademark closely resembling the Plaintiff's trade mark".
4. That costs of this application be in the cause".

The said application is supported by an affidavit sworn by Wilson Muriithi Kariuki, the plaintiff herein on 28th November 2011. According to the deponent, he registered his business "Wiskam Agencies" on 4th November 1992 and since the said registration he has been engaging in the distribution of water purifying apparatus in the major towns in the country. Pursuant to the success of his business the plaintiff applied to the Registrar of Trade Marks for registration and protection of his Trade Mark "Zero B" an acronym for Zero Bacteria. His application was accepted vide a certificate of Trade Mark No. 96052 valid for a period of 10 years with effect from 24th August 2010 till 24th August 2020. While in the process of importing water purifying apparatus from a Chinese Company he learnt that the Defendant had introduced water purifying gadgets labelled Zero B in the leading super markets in the major towns in the country. It is the deponent's contention that the defendant introduced the aforesaid purifying gadgets with the full knowledge that the plaintiff was the registered owner of Trade Mark "Zero B" with the protection for the said ten years. The defendant's said conduct, it is contended has injured, disparaged and lowered the technological quality, efficacy, reputation and standing on the plaintiff's trade mark among his customers in Kenya. Despite knowledge of the plaintiff's Trade Mark the defendant went ahead and launched similar products prompting the plaintiff to issue a demand letter through his advocates seeking that the defendant desists from passing off his purifying apparatus as the plaintiff's. When the defendant refused to comply therewith the plaintiff obtained a certificate to sue the Defendant for infringement of the said Trade Mark. It is his belief therefore that the Court has unfettered powers to grant the orders sought herein.

This ruling was due for delivery on 9th May 2012. However, just before the delivery, it transpired that a replying affidavit which was filed by the defendant on 2nd December 2011 was not placed on record. I accordingly deferred the delivery of the ruling in order for the court to peruse the said replying affidavit and make a decision based on all the material put before the court by the parties.

In the said affidavit sworn by one Vijay Maini, the defendant's managing director, it is deposed that the defendant is only an agent of M/s Ion Exchange (I) Ltd of India. Although not expressly denying importation of large quantities of Zero "B" water purifying apparatus, the said allegation is challenged for lack of evidence. It is deposed that the said M/s Ion Exchange (I) Ltd also referred to as IEL are the registered innovators and proprietors of the Zero "B" Trade Mark in respect of water purifiers worldwide for the last 25-30 years which product has been tested and approved in the Middle East, South East Asia, Europe, Sub-Saharan Africa and the USA. With the intention of having the Trade Mark registered locally, it is averred that the Defendant had the product tested on behalf of IEL in 1992 and M/s Nelion Enterprises Ltd and M/s Spike Enterprises were engaged to market and distribute the said products within Kenya and East Africa which contract was terminated in 2007 after over 15 year of continuous marketing and distribution pending the incorporation of a local company. With the intention of entering the market with what the deponent calls "a bang" a launch of the product was organised on 16/09/10 and was widely covered in the media, after which IEL imported sufficient quantities of the product only to be confronted with a claim that the plaintiff was the registered proprietor of the said Trade Mark in Kenya. It is the deponent's averment that while appreciating the fact of the registration of the Trade Mark by the plaintiff, proceedings have been initiated with Kenya Industrial Property Institute. It is the defendant's case that the products if any that are being imported by the plaintiff are fake liable for confiscation by the Kenya Counterfeit Authority. It is further averred that the registration of the said Trade Mark by the plaintiff was effected in order to pre-empt the entry into the local market by the said IEL and is therefore an act of fraud that should not be entertained by the court as it is an act of irresponsible and unbridled greed which should not be sanctioned by equity.

In his submissions, the plaintiff relying on *Glaxo plc & Another vs. Glaxowellcome Ltd & Another and Beiersdorf AG vs. Emirchem Products Ltd* NBI HCCC No. 559 of 2002, contends that registration of Trade Mark confers the right to exclusively use the mark and that infringement of the trade mark is a tort of strict liability. Intention and motive are irrelevant considerations and as the right is statutory one's acquiescence cannot constitute an estoppel or any other defence which the statute itself does not recognise. Further reliance is placed on *Delta Airlines INC vs. Delta Connection Ltd* NBI HCCC No. 770 of 2008. It is the plaintiff's case therefore that he has satisfied the conditions to warrant the grant of the orders sought.

Having considered the application, the supporting affidavit and the submissions on record I form the following view of the matter.

In *Lords Healthcare Limited vs. Salama Pharmaceuticals Limited Nairobi (Milimani)* HCCC No. 334 of 2007 Okwengu, J (as she then was) stated that in an interlocutory application for injunction to restrain infringement of a copyright the principles upon which such an application can be determined are, first, an applicant must show a prima facie case with a probability of success, secondly, an interlocutory injunction will normally not be granted unless the applicant might otherwise suffer irreparable injury which would not adequately be compensated by an award of damages and, thirdly, if the court is in doubt, it will decide an

application on the balance of convenience. Again in *Sapra Studio vs. Tip-Top Clothing Co.* [1971] EA 489, Chanan Singh, J, expressed himself as follows:

“Section 4 of Copyright Act confers copyright on the work of an author who is a resident of Kenya. Although the general position is that interlocutory injunction should not be granted if damages will be an adequate remedy if the plaintiff wins, in this case the court having satisfied itself that the defendants have committed a breach of the copyright of the plaintiff, the court is not entitled to refuse an injunction on the basis of general court practice. The general principles upon which injunctions are granted for the protection of copyright do not differ from those upon which they are granted for the protection of other property. The nature of the copyright property, however, makes an injunction a peculiarly suitable, and indeed, the normal remedy. If the granting of such an injunction will not seriously interfere with the defendant, it may be granted although the plaintiff does not fully prove his title to the right alleged to be infringed or has only an equitable title, or although the quantity of the defendant’s work which constitutes the infringement has not been ascertained. An interlocutory injunction will not, however, be granted where the plaintiff can be properly protected by the defendant being ordered to keep an account and the defendant might suffer irreparable injury from an injunction restraining him from publishing pending the trial; nor will an interlocutory injunction be granted if the plaintiff has been guilty of undue delay in coming to the court or if his conduct has amounted to acquiescence in the infringement, or there is any substantial doubt as to the plaintiff’s right to succeed. Having heard the advocates the court does not think that the plaintiff’s title will be open to any serious challenge at the trial and the court cannot say that there is any substantial doubt as to the plaintiff’s right to succeed. There has been no acquiescence unless negotiations for a settlement outside court can amount to acquiescence which is not correct. There has been delay in coming to court but delay has been satisfactorily explained. The defendants will suffer by being stopped from selling the existing stock and their loss may at least in part be irreparable because the terms on which they will ultimately have to sell the scarves in question are bound to be less favourable than sale in open market. But in the circumstances of this case where a breach of the copyright has been proved almost conclusively a loss cannot be avoided. The keeping of accounts by the defendants will not be sufficient because the quality of the scarves sold by the plaintiff is widely different from that of the defendant’s scarves. The assessment of damages, if the plaintiff succeeds will not be a question of mere arithmetic”.

It was further held by Ringera, J (as he then was) in *Pharmaceutical Manufacturing Co. Vs. Novelty Manufacturing Ltd. Nairobi* [2001] 2 EA 521 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. In *Nevin Jiwani vs. Going Out Magazine & Another* [2002] 1 KLR 856 the same Judge held inter alia that any person who copies or otherwise reproduces the work of another in which copyright subsists is guilty of infringement of that other persons copyright and the most efficacious remedy is an injunction. Mbaluto, J on the other hand, in *Beiersdorf Ag vs. Emirchem Products Limited* [2002] 1 KLR 876 held himself as follows:

“In an interlocutory application, the court cannot conclusively determine the issue of infringement of the plaintiff’s trade mark and passing off this being a matter for the trial judge to decide after hearing oral evidence thereon; it can only decide whether the plaintiff’s suit has a reasonable probability of

success. The tests to be applied in the exercise of this type of judicial discretion are now well settled and were clearly set out in the now famous case of *Giella vs. Cassman Brown & Co. Ltd* [1972] EA 358 where Spry, VP stated: First an applicant must show a prima facie case with a probability of success. Secondly, an interlocutory injunction will not normally be granted unless the applicant might otherwise suffer irreparable injury which would not adequately be compensated by an award of damages. Thirdly, if the Court is in doubt, it will decide an application on the balance of convenience. By virtue of section 7 of the Trade Marks Act, the registration of a person as the proprietor of a Trade Mark gives that person the exclusive right to the use of the trade mark in relation to the goods or in the connection with the provision of any service and without prejudice to the generality of the foregoing that right is infringed by any person who, not being the proprietor of the trade mark uses a mark identical with or so nearly resembling it as to be likely to deceive or cause confusion in the course of trade or in connection with the provision of any services in respect of which it is registered. The section means and implies that a proprietor of the trade mark has the exclusive user of the mark and any person who wishes to use it has to do so with a license from the proprietor”.

In the present case, from the evidence on record Wiskam Agencies whose proprietor is Wilson Muriithi Kariuki is the registered proprietor of a Trade Mark known as “ZERO B” vide Trade Mark No. 69053 effective from 24th August 2010 till 24th August 2020. Rightly or wrongly, that fact is not in dispute as that is the grievance that the defendant has taken before KIPI for determination. It is also not disputed that the defendant herein launched a product going by a similar name some time in 2010. The plaintiff has also obtained a certificate from the Registrar of Trade Mark which enables him to claim the said trade mark in these proceedings.

Whereas it may in the end turn out that the products that the plaintiff is distributing are counterfeits and that the registration of the Trade Mark by the plaintiff was meant to pre-empt the entry into the market by the said IEL, that issue will have to await the determination either of this case or the decision of KIPI. Either way, the position as of now is that the plaintiff is the registered proprietor of the said Trade Mark and until that proprietorship is successfully challenged, has the right to enjoy the benefits that accrue therefrom. To allow the defendants to also distribute a product bearing the same name would amount to introducing not only unnecessary confusion in the mind of the consumers of the said product but may engender chaos in the market. Since the defendant denies that they have imported large quantities of the said product into the local market, in the interest not only of the plaintiff but also of the consumers of the said product it is only fair that the defendant do hold their horses for the time being at least pending the unravelling of the truth behind Zero “B”. If the products being distributed by the plaintiff are counterfeit as alleged, there is an adequate legal machinery for dealing with such matters in this country.

In the circumstances I am satisfied that the plaintiff has established a prima facie case for the purposes of injunction. On the authorities, the remedy in such kind of cases is injunction. The court has also taken into account the fact that the defendant is just an agent of a principal and without disclosing its investment worth in the said distributorship there is no means of gauging what is the exact loss the defendant stands to suffer in the event of the injunction is granted in order for the court to make a determination with respect to the principle of proportionality and the need to ensure equality of arms as envisaged by the overriding

objective under sections 1A and 1B of the Civil Procedure Act. The issue of the need to stay these proceedings pending the determination by KIPi does not call for determination at this stage as the same may be heard and determined on merits notwithstanding this ruling.

Accordingly I find the Notice of Motion dated 28th November 2011 merited and I accordingly grant the injunction sought in terms of prayer 3 aforesaid on condition that the plaintiff files a suitable undertaking as to damages within 14 days from the date hereof. The costs of the application are awarded to the plaintiff. The plaintiff's attention is drawn to the provisions of Order 40 rule 6 of the Civil Procedure Rules.

Ruling read, signed and delivered in Court this 25th day of May 2012.

G.V. ODUNGA

JUDGE

In the presence of:

Mr. Arusei for Mr. Ondabu for the plaintiffs/applicants.

Ms. Kamwende for the defendant/respondent.



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