

**REPUBLIC OF KENYA**

**IN THE HIGH COURT OF KENYA AT NAIROBI**

**COMMERCIAL & TAX DIVISION**

**MILIMANI LAW COURTS**

**HCCC NO. E 250 OF 2020**

**MATCH MASTERS LIMITED .....PLAINTIFF/APPLICANT**

**VERSUS**

**KENAFRIC MATCHES LIMITED ..... 1<sup>ST</sup> DEFENDANT/RESPONDENT**

**ANTI COUNTERFEIT AGENCY ..... 2<sup>ND</sup> DEFENDANT/RESPONDENT**

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**RULING**

1. Two companies involved in the manufacture of safety matches are engaged in a trade mark dispute regarding products they manufacture. In an application dated 10<sup>th</sup> July 2020, Match Masters Limited (**MML or the Plaintiff**) seeks the following orders against the Defendants:-

*1. ....*

- 2. The 2<sup>nd</sup> Defendant be ordered to seal and keep seize the offending merchandise bearing the words and device “Big Five” pending hearing and determination of the application.*
- 3. The 2<sup>nd</sup> Defendant be ordered to seal and keep seize the offending merchandise bearing the words and device “Big Five” pending hearing and determination of the suit herein.*
- 4. Injunction be and is hereby issued to restrain the 1<sup>st</sup> Defendant its servants, employees, agents, distributor and the associates, from, producing, marketing, selling from continued sale of counterfeits in the offending marks and to further production and marketing pending hearing and determination of this application.*
- 5. Injunction be issued to stop the 1<sup>st</sup> Defendant from continued sale of counterfeits in the offending marks and to further production and marketing pending hearing and determination of the main suit.*
- 6. The 2<sup>nd</sup> Defendant be ordered to seal and keep seized the offending merchandise counterfeits pending institution of the criminal conclusion of investigations and or pending decision to*

*prosecute upon the conclusion of the opposition proceedings pending before the registrar of trademarks.*

2. MML is the owner of several brands of safety matches including Rhino, Kifaru, Simba and Paka. The brand names, MML contends, include the names of the “big five” animals. Kenya’s “big five” are the elephant, lion, leopard buffalo and rhinoceros. MML is the proprietor of registered Trade Marks over these brands.
3. On 22<sup>nd</sup> March 2019, Kenafric Matches Limited (**Kenafric or the 1<sup>st</sup> Defendant**) applied to register two marks as trademarks being Number 106346, “Big Five” (word mark) and 106617 “Big Five” (word and device). MML opposed that registration through opposition proceedings presented on 10<sup>th</sup> February 2020. Those proceedings, before the Registrar of Trademarks, were pending at the time the current application was argued.
4. In a Plaint presented alongside the current application, MML grieves that before the opposition proceedings could be determined or the trade marks registered, Kenafric commenced production and sale under the get-ups which were the subject of the opposition proceedings.

5. MML gives pictorial impressions of its mark and the get-ups of Kenafric and avers:-

**“The 1<sup>st</sup> Defendant has now proceeded to continue its acts of infringement and passing-off and counterfeiting the Plaintiff’s brands. Kenafric has copied MML’s base yellow colours, the general design of the match box, slogan such as, “proudly made in Kenya”, “Quality Wooden Matches”, “Excellent quality”, “the one strike light” and “10 quality match boxes” and the “honey comb friction strip.”**

6. MML sees the commencement of production in the controversial get-ups as a deliberate scheme by Kenafric to establish the defence of concurrent use in the market. MML then makes the following argument:-

**“[32] THAT the decision of the Registrar or Trademarks are appealable to the High Court, commercial division. Again a decision permitting the Petitioner to sell under the impugned Trademark will prejudice the right to appeal for either of the parties to the opposition proceedings as this decision of the High Court will tie the hands of the Registrar**

**of Trademarks and the hands of the Appellate Judge of this Court sitting to hear the appeal from, a decision of the registrar of Trademarks.”**

7. The 2<sup>nd</sup> Defendant is the Anti-Counterfeit Authority. It is a statutory corporation established under the Anti-Counterfeit Act, 2013 with a core mandate of fighting counterfeit. MML assails the Authority for failing to institute investigations and proceedings against what MML sees as acts of counterfeit by Kenafric. It accuses the Authority of endorsing counterfeiting.

8. As against Kenafric, MML seeks the following order:-

*An order of injunction be and is hereby issued restraining the 1<sup>st</sup> defendant, its agents, employees, servant, distributor or any other person from manufacturing, marketing, selling, distributing, trading or otherwise dealing in safety matches branded “Big Five” (word, or word and device).*

9. And as against the Authority, for an order that it seizes and confiscates all “Big Five” branded safety matches merchandise and removes them from circulation in the market. The Court is also asked to direct the Inspector General of Police to enforce the orders.

10. At the time of making this decision, Kenafric had not filed a defence but opposed the application through an affidavit sworn by Lorna Solopian on 6<sup>th</sup> October 2020. She avers that the dispute does not disclose a Trade Mark and/or passing off claim. Further that no particulars of Trade Mark/Passing off claims are disclosed by the Application and that to the contrary, the issues raised by the 1<sup>st</sup> Respondent is a regurgitation of the ongoing opposition proceedings before the Registrar of Trade Marks.
11. Kenafric takes the position that the main issue in contention, both here and in the opposition proceedings, is whether its marks are similar or confusingly similar to “Kifaru” and “Rhino” marks and whether they are registrable as trademarks under the Trade Marks Act. It contends that the registrar of Trade Marks is properly seized of the opposition proceedings and parties have a right of appeal against the decision of the Registrar of Trade Marks.
12. Kenafric argues that there is a risk of parallel and conflicting judicial findings if the present proceedings proceed simultaneously with the opposition proceedings.

13. Through a pictorial illustration, Kenafric asserts that the two marks are very distinct and clearly distinguishable.
14. Kenafric refutes that it is trying to establish a claim of concurrent use and that it is legitimately making use of its own marks. It makes the point that it is entitled to use its products while awaiting registration of its marks.
15. I think I need to start the discussion with the action against the Authority.
16. In its submissions to Court, counsel for MML cites section 2 of the Anti-counterfeit Act 2008 as defining counterfeit, counterfeiting and dealing in counterfeiting as follows:-

**“Counterfeiting “means taking the following actions without the authority of the owner of intellectual property right subsisting in Kenya or outside Kenya in respect of protected goods—**

- (a) the manufacture, production, packaging, re-packaging, labelling or making, whether in Kenya, of any goods whereby those protected goods are imitated in such manner and to such a degree that those other goods are**

**identical or substantially similar copies of the protected goods;**

**(b) the manufacture, production or making, whether in Kenya, the subject matter of that intellectual property, or a colourable imitation thereof so that the other goods are calculated to be confused with or to be taken as being the protected goods of the said owner or any goods manufactured, produced or made under his licence;**

**(c) the manufacturing, producing or making of copies, in Kenya, in violation of an author's rights or related rights;**

**(d) in relation to medicine, the deliberate and fraudulent mislabelling of medicine with respect to identity or source, whether or not such products have correct ingredients, wrong ingredients, have sufficient active ingredients or have fake packaging;**

**Provided that nothing in this paragraph shall derogate from the existing provisions under the Industrial Property Act, 2001 (No. 3 of 2001);.....**



**"Counterfeit goods "means goods that are the result of counterfeiting, and includes any means used for purposes of counterfeiting."**

17. What MML is in effect asking this court to do, through an interlocutory application, is to compel a statutory body to carry out its duty in a particular way. Once I reproduce the orders sought then this becomes clear:-

*- The 2<sup>nd</sup> Defendant be ordered to seal and keep seize the offending merchandise bearing the words and device "Big Five" pending hearing and determination of the suit herein*

*-The 2<sup>nd</sup> Defendant be ordered to seal and keep seized the offending merchandise counterfeits pending institution of the criminal conclusion of investigations and or pending decision to prosecute upon the conclusion of the opposition proceedings pending before the registrar of trademarks.*

18. The proceedings before me are not in the nature of Judicial Review proceedings. The Applicant is asking the Court to make orders akin to

those of mandamus without a substantive application in that nature and the Court is unwilling to grant it. Yet there is another reason.

19. 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. In interpreting provisions of the South African Counterfeit Goods Act 37 of 1997 which has a similar definition of counterfeiting as our statute, The Supreme Court of South Africa in **Puma Ag Rudolph Dassler Sport v Rampar Trading (PTY) Ltd and others [2010] ZASCA 140** observed;

**“ It is now necessary to consider the second question, namely whether the shoes were counterfeit. As mentioned above, the answer has to be sought in para (b) of the definition of counterfeiting. In view of the common cause facts the only remaining issue is whether the marks applied to Rampar’s shoes are ‘the subject matter’ or ‘a colourable imitation’ of any of Puma’s registered trade marks. To be ‘the subject matter’ means, as mentioned, that the Rampar mark must be identical to a Puma trade mark. An ‘imitation’, in turn,**

**is by definition a copy, and the adjective ‘colourable’ reinforces the fact that the copy is counterfeit. In other words, the definition says no more than that a counterfeit must be counterfeit. That is why it must be ‘calculated to be confused with’ or ‘taken as being’ the registered mark and why it involves deliberate and fraudulent infringement of trademarks.**

**[24] This test is not the same as the standard trade mark infringement test of ‘likely to deceive or cause confusion but counterfeiting, by its very nature, amounts *a fortiori* to trade mark infringement. Reference during argument to the test to be applied to determine the likelihood of deception and confusion, confusing similarity, to passing-off principles, imperfect recollection, momentary confusion, the prospective purchaser, that a substantial (ie, not negligible) number of people have to be confused, evidence about the public’s perception and how Rampar intended to market the goods was, accordingly, singularly out of place and unhelpful.”**

20. The threshold to be reached in proving criminal counterfeiting is more involved than in proving non-criminal trade mark infringement. The imitation must be to such an extent that the infringing good is identical or a substantially similar copy of the trade marked good, or a colourable imitation therefore. Secondly, it involves a deliberate and fraudulent trade mark infringement. The latter would be the *mens rea*. As will be apparent from the discussion that follows, this Court is unable to find that, on the material before it, a prima facie case of counterfeit has been made by the MML.

21. The application against Kenafric is for an order of temporary injunction and the principles in **Giella vs Cassman Brown 1973 E.A 358** apply:-

- i. An application must show a prima facie case with a probability of success;**
- ii. An injunction will not normally be granted unless the applicant might otherwise suffer irreparably injury;**
- iii. When the court is in doubt, it will decide the application on the balance of convenience.**

22. Yet before I discuss whether the MML has made out a prima facie case against Kenafric, I make some preliminary observations.

23. Kenafric seeks the protection of this Court while there are opposition proceedings subsisting before the Registrar of Trade Marks in respect to the competing marks. Opposition proceedings are taken out under section 21 of the Trade Marks Act which provides:-

**“Opposition to registration**

**(1) When an application for registration of a trade mark has been accepted, whether absolutely or subject to conditions or limitations, the Registrar shall, as soon as may be after acceptance, cause the application as accepted to be advertised in the prescribed manner, and the advertisement shall set forth all conditions and limitations subject to which the application has been accepted:**

**Provided that the Registrar may cause an application to be advertised before acceptance if it is made under paragraph (e) of subsection (1) of section 12, or in any other case where it appears to him that it is expedient by reason of any exceptional circumstances so to do, and where an application has been so advertised the Registrar may**

**advertise it again when it has been accepted but shall not be bound so to do.**

**(2) Any person may, within the prescribed time from the date of the advertisement of an application, give notice to the Registrar of opposition to the registration.**

**(3) The notice shall be given in writing in the prescribed manner, and shall include a statement of the grounds of opposition.**

**(4) The Registrar shall send a copy of the notice to the applicant, and within the prescribed time after receipt thereof the applicant shall send to the Registrar, in the prescribed manner, a counter-statement of the grounds on which he relies for his application, and, if he does not do so, he shall be deemed to have abandoned his application.**

**(5) If the applicant sends a counter-statement, the Registrar shall furnish a copy thereof to the person giving notice of opposition, and shall, after hearing the parties, if so required, and considering the evidence, decide whether, and**

**subject to what conditions or limitations, if any, registration is to be permitted.**

**(6) The decision of the Registrar shall be subject to appeal to the court.**

**(7) An appeal under this section shall be made in the prescribed manner, and on the appeal the court shall, if required, hear the parties and the Registrar, and shall make an order determining whether, and subject to what conditions or limitations, if any, registration is to be permitted.**

**(8) On the hearing of an appeal under this section any party may, either in the manner prescribed or by special leave of the court, bring forward further material for the consideration of the court.**

**(9) On an appeal under this section no further grounds of objection to the registration of a trade mark shall be allowed to be taken by the opponent or the Registrar, other than those so stated by the opponent, except by leave of the court; and, where any further grounds of objection are**

**taken, the applicant shall be entitled to withdraw his application without payment of the costs of the opponent on giving notice as prescribed.**

**(10) On an appeal under this section the court may, after hearing the Registrar, permit the trade mark proposed to be registered to be modified in any manner not substantially affecting the identity thereof, but in any such case the trade mark as so modified shall be advertised in the prescribed manner before being registered.**

**(11) If a person giving notice of opposition or an applicant sending a counterstatement after receipt of a copy of such a notice, or an appellant, neither resides nor carries on business in Kenya, the court or the Registrar may require him to give security for costs of the proceedings before the court or the Registrar relative to the opposition or to the appeal, as the case may be, and in default of such security being duly given may treat the opposition or application, or the appeal, as the case may be, as abandoned.”**



24. As correctly pointed out by Counsel for MML, the Registrar of Trade Marks is not empowered to issue orders of injunction as she/he considers an opposition and for that reason a party seeking those orders, like MML, must fall back to the High Court.
25. In considering an application for injunction, the High Court must always be careful not to make findings or observations that could prejudice the opposition proceedings. If the Court were to make determinative findings as to whether or not the competing marks are similar and could cause confusion, then the Registrar may feel some pressure, even if subconsciously, not to depart with the High Court. The net effect would be that the High Court, which will have made its decision on untested evidence, will have made a decision for the Registrar who has the opportunity of engaging in more involved proceedings.
26. Indeed so as not to appear to hamstring the Registrar of Trade Marks, some Courts have been reluctant to grant any orders of injunction where parallel opposition proceedings exist. Take for example **Nzioka J** in **Unga Limited v Capwell Industries Limited** [2019] eKLR where she observes:-

**“Further in view of the fact that, the Trademarks are still a subject of proceedings before the Registrar of Trademarks, the grant of any orders at this stage in favour of or as against any of the parties will not be in the interest of justice as it will have far reaching impact on their business operations and/or may determine the matter at this stage. In that regard, I shall not grant any of the orders sought for at this interim stage hold and order that, the parties proceed expeditiously to deal with the matter at the Registrar of Trademarks and/or prepare this matter for hearing of the main suit. The costs of the application herein to abide the outcome of the main suit.”**

27. On the other hand, there could be instances when non-intervention by the Court will itself lead to an injustice. An argument raised by the Counsel of MML illustrates when Court intervention is desirable. The allegation by MML, and which has not been controverted, is that Kenafri commenced production and sales of products in the get-ups after the opposition had been filed. While MML thought that this was a scheme to build up a defence of honest concurrent use under section

15(2) of the Act, this Court would not think that such a plot can possibly succeed because use that is commenced after opposition proceedings have been presented may not amount to honest concurrent use.

28. The more serious consideration that the contention raises is whether the owner of a mark which could possibly be found to be similar and likely to cause confusion with a registered Trade mark and who commences the use of the impugned mark only after opposition proceedings have been filed, should be permitted to use the mark when there is a challenge to registration of that mark and when that challenge has not been resolved. The Court, I would think, is entitled to interrogate whether a prima facie case of infringement or passing off is made against such a party. On the other end of the spectrum, where there has been use of the mark prior to even the application for registration, then the justice of the matter, generally, would be to await the registrar's determination of the opposition proceedings.

29. Let me turn my attention to the allegations of passing off and trade mark infringement.

30. So what are the elements of the tort of passing off? In **Newton Oirere Nyambariga v KCB Bank Kenya limited & Another [2017] eKLR**, the Court observed;

**“19. A passing off claim is a right of trader to bring a legal action for protection of goodwill. It is actionable under the law of unfair competition and sometimes as a Trademark infringement. In Reckitt & Colman Products Ltd. Vs. Borden Inc & others,(1990) R.P.C.34 Lord Oliver Aylmerton sets out the three element to be proved in an action for passing off. He states:-**

**“The law of passing off can be summarized in one short general proposition, no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the Plaintiff in such an action has to prove in order to succeed. These are three in number. First, he must establish a goodwill or reputation or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying “get up”(whether it consists simply of a brand**

**name or a trade description, or the individual features of labelling or packing) under which his particular goods or services are offered to the public, such that the get up is recognized by the public as distinctive specifically of the Plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the Plaintiff. Whether the public is aware of the plaintiff's identity as the manufacturer or supplier of the goods or services is immaterial, as long as they are identified with a particular source which is in fact the Plaintiff. For example, if the public is accustomed to rely upon a particular brand name in purchasing goods of a particular description, it matters not at all that there is little or no public awareness of the identity of the proprietor of the brand name. Thirdly, he must demonstrate that he suffers or, in a quia timet action that he is likely to suffer, damage by reason of the erroneous belief engendered by**

**the defendant’s misrepresentation that the source of the defendant’s good or services is the same as the source of those offered by the Plaintiff.”**

31. The element of goodwill is an essential to the tort. Looking at both the Plaintiff and the affidavits filed by MML, it has failed to demonstrate a goodwill or reputation in its marks. The mere fact that it is the registered proprietor over the Trade Marks is not enough. There is no evidence that because of use of the Trade Marks or some other association with the Trade Marks it has acquired a reputation attached to the goods it supplies so as to deserve the protection of the law of passing off. This Court is unable to find that MML has established a prima facie case of passing off when it has failed on this important ingredient.

32. As correctly pointed out by Counsel for Kenafic, registration of a trade mark confers on the proprietor rights of exclusive use of the Mark (**Wilson Muriithi Kariuki t/a Wiskam Agencies V Surgipharm Limited [2012] e KLR** among others). It being common ground that MML is the registered proprietor of the “Kifaru” and “Rhino” Marks in class 34 of Nice Classification and Kenafic has applied for registration

of the impugned marks in the same class, this Court, at this nascent stage of the proceedings, is simply expected to make an interim call, without any finality, as, whether the marks of Kenafric are similar to the Trade Mark of MML and likely to cause confusion.

33. But first the Court comments on Kenafric's argument that the pleadings of MML do not have particulars of trade mark/passing off. This Court has looked at the Plaint presented by MML and finds that paragraphs 16 and 17 set out what MML sees as the similarities between the marks.

34. Then, in paragraph 7 of the affidavit of Kushal Shah, he deposes:-

**“That Kenafric has copied MML's base yellow colours, the general design of the match box, slogans such as, “proudly made in Kenya”, “Quality Wooden Matches”, “Excellent quality”, “the one strike light” and “10 quality match boxes” and the honey comb friction strip.”**

35. It helps to reproduce the representations of the competing marks. One side of the match boxes ( and this is face on which the Trade mark and impugned mark are displayed) looks;



36. The similarity on the two is that the base colour is yellow, although that of MML is more subtle. There is use of the blue colour on both. The words “safety matches” appear on both. The difference is that on MML’s mark is a depiction of a full body a Rhino while that of Kenafri’s are depictions of faces of the “big five” animals. Another difference is use of colour red on part on Kenafri’s get-up and which also has the words “superior quality.” Given that comparison, one may not be able to readily say that the marks and get-ups are so similar as to be a source of confusion to potential customers. Yet that is not all to it.

37. The other side of the match boxes reveals greater similarity. The pictorial representation is;





The similarities are;

- i. the use of yellow as a boundary colour
- ii. the main base colour is white.
- iii. words which are not dissimilar appear on the boundary.

These include “proudly made in Kenya by”, “quality wooden matches”.

Not to be unexpected is that there would be differences. These are;

- i) “Big 5” is on one and “Kifaru” on the other.
- ii) words “superior quality” is on one and a “quality product from a quality company” on the other.
- iii) the placement of the bar codes and KEBS mark are on different parts of the box.

Yet the differences, notwithstanding, this side of the match boxes are somewhat similar.

38. Similarities seem greater still on the wrappings;



- i. There is a dominant yellow base.
- ii. The design on the on both wrappings is similar.
- iii. Use of the words “one strike light”, “Excellent quality”, “10 quality match boxes” on both wrappings.

39. As to whether confusion is likely to occur, the Court must put itself in the position of a reasonable or average consumer. In this regard this passage from the decision in **Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV** (case C- 342/97) is instructive;

**“The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. For the purposes of that global appreciation, the average consumer of the category of products concerned is deemed to be reasonably well-informed and reasonably observant and circumspect. However, account should be taken of the fact that the average consumer only rarely has the chance to make a direct comparison between the different marks but must place his trust in the imperfect picture of them that he has kept in his mind. It should also be borne in mind that the average consumer’s level of attention is likely to vary according to the category of goods or services in question”**

40. Emerging from the evidence is that while there may be some doubt as to the similarity between the registered trade mark and the impugned mark, the overall get-ups of the match boxes and the wrappings have similarities. Given that what matters is the global appreciation of the sight and concept, the similarities in the get-ups on the match boxes and wrappings are not to be ignored because they may lead the consumer to in fact confuse the competing marks. Put

differently, the impugned mark on its own may not be confusable with the Trade Mark on its own. Yet the trade mark and the mark are in the midst of other elements of the get-ups on the match boxes and the wrappings and because the consumer perceives the get-up or dress of the good as whole without dissecting it into different parts, the likelihood to confuse the two marks becomes real.

41. Although the Trial Court will be called upon to determine whether or not the consumers of safety matches are discerning, for now, I find that the argument by MML that the manner in which Kenafric has presented its products in the market may lead to trade mark infringement is not idle. The Plaintiff has made out a prima facie case with a likelihood of success. It must however be emphasized that the observations of this Court are preliminary and the Registrar of Trade Marks is free to make her/his own findings in considering and determining the opposition proceedings.

42. But even having made my observation on the similarities of the get-ups, I am not prepared to say that the mark or get-up of Kenafric is identical or indistinguishable with that of MML so as to found a prima facie case for counterfeiting.

43. Back to the issue of trade mark infringement. There are instances when an order of injunction will issue even though damages is an adequate remedy. As observed by Ringera j in **Muigai V Housing Finance Company of Kenya Limited And Another (2002) 2KLR 332 ;**

**“On the second condition for the grant of an interlocutory injunction, namely the adequacy of damages as a remedy, I would reiterate what I stated in the case of Lucy Njoki Waithaka V ICDC [HCCC No.321 of 2001]. I took the following view of the matter –**

**“As regards damages, I must say that in my understanding of the law, it is not an inexorable rule, that where damages may be an appropriate remedy, an interlocutory injunction should never issue. If that were the rule, the law, would unduly lean in favour of those rich enough to pay damages for all manner of trespasses. That would not only be unjust, but it would also be seen to be unjust. I think that is why the East African Court of Appeal couched the second condition in very careful terms, by stating that normally an injunction would not issue if damages would be an adequate remedy.**

**By using the word ‘normally’ the court, was recognizing that there are instances where an injunction can issue even if damages would be an adequate remedy for the injury, the applicant may suffer if the adversary were not enjoined. I think some of the considerations to be borne in mind include the strength or otherwise of the applicants case for a violation or threatened violation of its legal rights, and the conduct of the parties. If the adversary has been shown to be high handed or oppressive in its dealings with the applicant this may move a court of equity to say: “money is not everything at all times and in all circumstances and don’t you think you can violate another citizens rights only at the pain of damages”**

44. I think that this is one instance where an injunction must issue in spite of adequacy of damages. The reason is that Kenafric commenced the use of the now controversial mark and get-up after the opposition proceedings had been presented by MML. This Court is not told why Kenafric could not await the outcome of those proceedings or in the

very least commence use in the mark but in a manner that likelihood of confusion would be minimized or eliminated.

45. The Court is therefore inclined to grant an order of injunction in favour of the Plaintiff but I may say this. Prayer 5 of the Notice of Motion of 10<sup>th</sup> July 2020 seeks that an;

**“5. Injunction be issued to stop the 1<sup>st</sup> Defendant from continued sale of counterfeits in the offending marks and to further production and marketing pending hearing and determination of the main suit.”**

While the Court will grant that prayer, the Court has not found the products of the 1<sup>st</sup> Defendant to be counterfeits. So with that qualification, prayer 5 only of the application is allowed on condition that the Plaintiff furnishes to the 1<sup>st</sup> Defendant an undertaking as to damages for the sum of Kshs.10,000,000/= within 14 days hereof. For reasons given early, prayer 6 is declined. As the Plaintiff has not entirely succeeded in the motion, each side shall bear its own costs.

**Dated, Signed and Delivered in Court at Nairobi this 8<sup>th</sup> Day of  
March 2021**

**F. TUIYOTT**

**JUDGE**

**ORDER**

In view of the declaration of measures restricting Court operations due to the COVID-19 pandemic and in light of the directions issued by his Lordship, the Chief Justice on 17<sup>TH</sup> April 2020, this Ruling has been delivered to the parties through virtual platform.

**F. TUIYOTT**

**JUDGE**

**PRESENT:**

Court Assistant: Nixon

Omondi for 1<sup>st</sup> Respondent

Mwangi for Plaintiff/Applicant

Khamba for 2<sup>nd</sup> Respondent