



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

**MILIMANI COMMERCIAL & ADMIRALTY DIVISION**

**CIVIL CASE NO. 175 OF 2013**

**STRATEGIC INDUSTRIES LTD. .... PLAINTIFF**

**VERSUS**

**SOLPIA KENYA LIMITED ..... DEFENDANT**

**R U L I N G**

1. Before this Court is an application by the Defendant herein dated 14th March 2014, seeking prayers for the striking out of the Plaintiff's Complaint dated 2nd May 2013. The same is brought under the provisions of **Order 2 rule 15 (1) (a), (c) and (d)** as well as **Order 51 rule 1** of the *Civil Procedure Rules*. The application is brought upon the following grounds:

**"1. The Complaint is frivolous and vexatious as the Plaintiff claims a declaration on infringement by the Defendant on their trademark BRAZILIANN IDOL.**

**2. The Plaintiff has no exclusive right of the word BRAZILLIANN as alleged in the Complaint.**

**3. The Defendant's mark, labels, color configuration and get up are different from that of the Plaintiff hence cannot cause any confusion hence the suit does not disclose any reasonable cause of action.**

**4. The suit as filed is offensive, improper and indicates lack of seriousness on the part of the Plaintiff.**

**5. The suit is intended to abuse the process of this honourable court".**

2. The application was supported by the Affidavit of the Operations Manager of the Defendant, one **John Ng'ang'a Waweru** sworn on 14th March 2014. He noted that the Defendant had given instructions to its advocates on record to file a trademark application for the Mark "**Brazilian Hair**". The significant paragraph of the said Affidavit was paragraph 4 which read as follows:

**"4. THAT before filing the trade mark application, I instructed my advocates on record to conduct availability search for the mark "BRAZILIAN Hair" before the Kenya Industrial Property Institute (hereinafter referred to as "KIPI") on 10<sup>th</sup> August 2012. The search revealed that the following marks on the register had the highest degree of similarity to our mark:**

- a. Trade Mark Application No. 26057 BRASILIA in class 16 in the name of AMERICA STANDARD INC, United States, wherein the mark was removed from the register in 2006.
- b. Trade Mark No. 69222 BRAZILIANN IDOL in class 26 in the name of STRATEGIC INDUSTRIES LIMITED, Nairobi, wherein exclusive use of the word “BRAZILIAN” was disclaimed separately and apart from the mark as a whole.
- c. Trade Mark No. 102521 BRESILIENNE in class 26 in the name of LIN CHAO, Guangzhou City”.

The deponent went on to say that according to the search results there was no person with exclusive rights to use the word “**Brazilian**”. After submitting its application for the Mark as above, the deponent stated that he had received an examination report from the Registrar of Trade Marks which detailed that the application had been received, examined and approved for advertisement. He also went on to say that the labels, colour, configuration and get up of the Plaintiff’s Mark was different from that of the Defendant and could not cause any confusion to the buying public. He concluded his affidavit by stating that he had been informed by his advocates on record that the claim on infringement by the Plaintiff did not hold any water as it had no right to the exclusive use of the word “**Brazilian**”.

3. The Plaintiff filed Grounds of Opposition dated 15th May 2014. The same are detailed as follows:

- “1. The application is not based on sound legal tenets or prevailing law and it does not lie at all.
2. The fact of non-exclusivity of a name or disclaimer thereof does not give a right to any person to use the same name for goods in the same class.
3. The suit is not frivolous, nor is it vexatious, embarrassing or an abuse of the Court process and the Defendant’s contention is misplaced.
4. The Defendant seems to be unaware that the tort of infringement of a trade mark is one of strict liability and it matters not, though not admitted, that the Defendant’s mark, labels, colour configuration or get up may be different from those of the Plaintiff.
5. The suit is well founded and discloses a *prima facie* case which ought to go for full trial.
6. Parties have already identified and agreed on triable issues and the Defendant’s application is an abuse of process”.

4. The Defendant’s submissions were filed herein on 23rd June 2014. They commenced by noting that the Plaintiff’s Mark was registered subject to a disclaimer on the word “**Brazilian**”. The certificate of registration read as follows:

“Registration of this mark shall give no right to the exclusive use of the word **Brazilian** separately and apart from the mark as a whole.”

They went on to note that upon publication of the advertisement for the Defendant’s proposed Mark “**Brazilian Hair**”, opposition thereto had been received from Sana Industries Ltd, Styles Industries Ltd as well as the Plaintiff herein. The Defendant submitted that the Plaintiff did not have the exclusive use of the word “**Brazilian**” and it quoted from **Kerly’s Laws of Trademarks and Trade Names 14th Edition paragraph 9-082** as follows:

**“Where a trademark is registered subject to a disclaimer of the rights of the exclusive use of a specified element of the registered mark, the rights conferred by registration are restricted accordingly. It follows that an objection based upon an earlier registration cannot succeed where the only resemblance between the marks in issue is an element for which protection has been disclaimed.”**

The Defendant commented that the requirements to disclaim the word **“Brazilian”** did not bar any other person from filing an application for a trademark with the aspect of Brazilian. The Defendant then proceeded to distinguish various authorities cited by the Plaintiff but maintained that it wished to rely upon the case of **Australian Airlines (1989) 16 IPR 270** in which the Court stated:

**“I must observe that a disclaimer is not a mechanism or device the use of which would permit registration of something that was otherwise unregistrable. The use of a disclaimer is to delineate the proprietor’s rights in a mark, not to confer monopoly.”**

5. The Defendant then went on to submit that the suit herein intended to cause unnecessary anxiety, trouble and expense for the Defendant. It laid the following facts before this Court:

**“2. a) The Plaintiff has sued the Defendant for**

**infringement of its Mark BRAZILIAN IDOL.**

**b) The opposition proceedings at KIPI against the registration of the Defendant’s mark by SANA INDUSTRIES LIMITED who are claiming to be the proprietor of the mark BRAZILIAN IDOL.**

**c) Styles Industries claims to be the registered proprietor of the Trademark Number 69222 similar mark to the Plaintiff’s herein.**

**d) The Plaintiff acknowledges and avers that they have assigned the mark to Style Industries Limited though no assignment deed has either been filed or a copy of the assignment deed been attached.**

**e) There is no infringement case against SANA INDUSTRIES LIMITED who is trading in an unregistered mark which is similar mark to the Plaintiff’s – A fact the Plaintiff has admitted in the replying affidavit paragraph 9 (d).**

**f) The Plaintiff is denying a well-known fact. The Plaintiff lacks exclusivity of the word Brazilian and cannot bar any other party from the use;**

**g) The Getup, color and look of the two products are distinctively not similar thus may not cause confusion in the market;”**

To this end, the Defendant relied upon the case of **Samuel Ndungu Mukunya v Nation Media Group Ltd & Anor. (2012) eKLR.**

6. As regards whether the suit herein discloses any reasonable cause of action as against the Defendant, it referred the Court to the case of **DT Dobie & Co (Kenya) Ltd v Muchina (1982) KLR.** The Defendant asked the question whether the Plaintiff’s case against it raised any reasonable cause of action. The Defendant concluded that it had established that the Plaintiff did not have the exclusivity of the word **“Brazilian”** and thus could not bar any party from the use of

the word. Even if there was an amendment made to the Plaint, such would not revive the suit as the claim of the Plaintiff revolved around the trademark “**Braziliann Idol**”.

7. The Plaintiff in its submissions filed herein on 8th July 2014 also cited the D. T. Dobie case detailing that courts should aim at sustaining cases not terminating them. It had long been decided that where pleadings disclose even one triable issue, the parties must be accorded a full trial on merit. The Plaintiff pointed to the Statement of Agreed Issues filed in Court on 10th March 2014. The Defendant having agreed those issues, it was not open to it to urge a position that there were no triable issues. It maintained that the Plaintiff's case was clear in that the Defendant had not only infringed the Plaintiff's trademark No. 69222 but also passed off its goods as those of the Plaintiff.
8. The Plaintiff referred this Court to the cases of Africa Edge Sarl v Supinder Singh Soin HCCC No. 766 of 2012 (unreported), Strategic Industries Ltd v Sana Industries Company Ltd HCCC No. 390 of 2008 (unreported), Chloride Exide (K) Ltd & Anor. v Zakayo M. Wainaina HCCC No. 443 of 2007 (unreported), Pharmaceutical Manufacturing Company v Novelty Manufacturing Ltd (2001) EA 521, Horizon Pharmaceuticals Ltd v Divson Pharmaceuticals Ltd Zambia TMA No. 137 of 2006, Ford-Werke's Application (1985) 72 RPC 191, Vinodeep Investments Property Ltd v Henkel Polymer Co. Ltd & 2 Ors (2004) eKLR, as well as Lynette B. Oyier & Ors v Savings and Loan Kenya Ltd in which my learned brother Azangalala J. quoted from the case of Yobesh Amoro v Heritage Insurance Company Ltd (2007) eKLR as follows:

**“The function of the court in its jurisdiction of striking out pleadings under Order VI rule 13 of the Civil Procedure Rules is not to determine whether an action or defence as framed will or will not succeed at the trial. That is the function of the trial court after hearing evidence and legal submissions. The function of the court under that jurisdiction is to determine whether the pleadings have been formulated in accordance with the established rules of pleading and to impose appropriate sanctions if they have not been so formulated.”**

Finally, the Plaintiff cited the case of Shayona Timber Ltd v Kenya National Highway Authority (2013) eKLR.

The Plaintiff concluded its submissions by noting that the Defendant had anchored its application under **Order 2 rule 15 (1) (a)** of the *Civil Procedure Rules*. Under that sub-rule, no evidence was required. The Defendant had done the opposite by providing evidence by the Affidavit in support of its application. The Plaintiff maintained that the suit did disclose a reasonable cause of action. It was not frivolous or vexatious neither was it geared towards prejudicing, embarrassing and/or delaying the trial of this matter.

9. This Court agrees with the Plaintiff that for the Defendant to support its Application by affidavit, such violates the provisions of **Order 2 rule 15 (1) (a)** of the *Civil Procedure Rules, 2010*. In my view, the putting forward of evidence in that regard would eliminate the Defendant being able to bring before this court its application that the Plaint discloses no reasonable cause of action. However, I don't consider that the fact that there is a Supporting Affidavit nullifies the Defendant's Application under **Order 2 rule 15 (1) (c) and (d)**. The Defendant may still be able to rely upon the grounds that the Plaint may prejudice, embarrass or delay the fair trial of the suit or that it is otherwise an abuse of the process of this Court. In that surmise, I received guidance from the decision of my learned brother Emukule J. in the case of The Cooperative Merchant Bank of Kenya Ltd v Benson W. K. Muigai HCCC No. 781 of 2001 (unreported) where the Judge found:

**“Rule 13 (1) empowers the Court at any stage of the proceedings to order to be struck out or**

amended any pleading on the ground that –

- a. It discloses no reasonable cause of action or defence; or
- b. ....
- c. It may prejudice, embarrass or delay the fair trial of the action; or
- d. It is otherwise an abuse of the process of the Court.

Rule 13 (2) of Order VI, prohibits the admission of any evidence on an application under sub rule 1 (a), but that the application shall state concisely the grounds on which it is made.

The Plaintiff has jumbled the current application as if the Defendant’s Defence is all those things set out in rule 13 (1). A careful reading of that rule requires that the Court may strike out a pleading on any of the four grounds. The grounds are clearly disjunctive, and Counsel should be careful in their pleadings as to which ground the party wishes to rely upon in seeking to strike out a pleading. For instance if the application is that the pleading discloses no reasonable cause of action or defence, then evidence by Affidavit is not admissible. It is a matter to be determined purely on law upon examination of the pleadings, the Plaintiff, the Defence as amended if that is the case. Applications under the other heads of rule 13 (1) may be supported by Affidavit”.

10. To determine this application, the Court must answer whether the Plaintiff’s Plaintiff is scandalous, frivolous or vexatious; or whether it may prejudice, embarrass or delay the fair trial of the suit; or whether it is otherwise an abuse of the process of court. As to what amounts to “frivolous” the Ruling of **Visram J.** (as he then was) in **Brite Prints (K) Ltd v Attorney General HCCC No 1096 of 2000** was helpful in that the learned Judge detailed:

“According to **BLACK’S LAW DICTIONARY (5<sup>th</sup> ed.)**, West Publishing Co., St Paul Minn., U. S. A., 1979) a matter is frivolous if it is of little weight or importance: a pleading is ‘frivolous’ when it is clearly insufficient on its face, and does not controvert the material points of the opposite pleadings, and is presumably interposed for mere purposes of delay and to embarrass the opponent. A vexatious pleading is one without a reasonable or probable base and only intended to harass, disquiet or annoy the other party. A pleading is embarrassing if it is so drawn that it is not clear what case the opposite party has to meet at the trial (see **British Land Asso v Foster (1888) 4 Times Rep. 574**). However, a pleading is not embarrassing only because it contains allegations that are inconsistent or slated in the alternative (see **Re Morgan, Owen v. Morgan (1887) 35 C. D. 492**).

11. Of course, no action to strike out a pleading should be considered without taking into account the classic authority of **D. T. Dobie & Co** (supra) in which **Madan JA** (as he then was) commented *obiter*.

“The court ought to act very cautiously and carefully and consider all facts of the case without embarking upon a trial thereof before dismissing a case for not disclosing a reasonable cause of action or being otherwise an abuse of the process of the court. At this stage, the court ought not to deal with any merits of the case for that is a function solely reserved for the judge at the trial as the court itself is not usually fully informed so as to deal with the merits “without discovery, without oral evidence tested by cross-examination in the ordinary way”. (Sellers LJ (supra). As far as possible indeed, there should be no opinion expressed upon the application which may prejudice the fair trial of the action or make it uncomfortable or restrict the freedom of the trial judge in disposing of the case in the way he thinks right.

**If an action is explainable as a likely happening which is not plainly and obviously impossible, the court ought not to overact by considering itself in a bind summarily to dismiss the action. A court of justice should aim at sustaining a suit rather than terminating it by summary dismissal. Normally a law suit is for pursuing it.**

**No suit ought to be summarily dismissed unless it appears so hopeless that it plainly and obviously discloses no reasonable cause of action and is so weak as to be beyond redemption and incurable by amendment. If a suit shows a mere semblance of a cause of action, provided it can be injected with real life by amendment, it ought to be allowed to go forward for a court of justice ought not to act in darkness without the full facts of a case before it”.**

12. I have carefully perused the Plaint herein. Based on its Trademark No. 6922 known as “**Braziliann Idol**”, the Plaintiff seeks a declaration that the Defendant has infringed the same. It also seeks a permanent injunction restraining the Defendant for manufacturing, packaging and selling any products bearing the Plaintiff’s trademark “**Brazilian**”. It also seeks orders for the delivery up to the Plaintiff of all hair pieces, weaves and wigs, hair additions and braids bearing the infringing mark together with the packaging thereof for destruction purposes. The Plaintiff further seeks damages and costs. I do not consider that the Plaint may prejudice, embarrass or delay the fair trial of the action or otherwise is an abuse of the process of this court.
13. As submitted by the Plaintiff, a Statement of Agreed Issues dated 3rd March 2014 was filed in this Court, the same having been signed by the advocates for both parties. That statement bears details of 11 issues which the parties are seeking for the Court to determine. I fail to see how the Defendant can bring its Application before this Court based on the premise that there is no cause of action as against it where it has identified so many issues for determination. As a result, I dismiss the Defendant’s Notice of Motion dated 14th March 2014 with costs to the Plaintiff.

**DATED and delivered at Nairobi this 7<sup>th</sup> day of August, 2014.**

**J. B. HAVELOCK**

**JUDGE**



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