

IN THE HIGH COURT OF TANZANIA

(COMMERICAL DIVISION)

AT DAR ES SALAAM

MISC. COMMERCIAL APPLICATION No. 268 OF 2018

(Arising from Commercial Case No. 155 of 2018)

JCDECAUX SA.....1ST APPLICANT

JCDECAUX TANZANIA LIMITED.....2ND APPLICANT

VERSUS

JP DECAUX TANZANIA LIMITED.....RESPONDENT

RULING

B.K.PHILLIP,J

This ruling is in respect of an application for temporary injunction. It is made under Order XXXVII rule 2(1), Order XLIII Rule 2 and section 68 (e) of the Civil Procedure Code ,Cap 33,R.E 2002 (herein after to be referred to as " the CPC"). The applicants are praying before this court for the following orders:-

- i. The Honourable Court may be pleased to issue an order of temporary injunction restraining the respondent, his servants, workmen, agents and or whosoever purporting to act on his behalf from trading, advertising, marketing and/or in any other way dealing in the name "JP DECAUX" or any other name closely resembling the Applicants name or a name including "JP DECAUX"

or resembling the trademark "JCDECAUX" pending the hearing and determination of the main suit.

- ii. Costs of the Application.
- iii. Any other relief as the honourable Court may deem just to grant in the premises hereof.

The application is supported by an affidavit deponed by Ms. Maryam Ngadayo and Ms. Janine Deetlefs. A counter affidavit deponed by Mr. Elia Richard Moshi, has been filed in court in opposition to the application. At the hearing of this application, the learned advocates, Luca Elingae and Frank Mwalongo appeared for the applicants and respondents respectively.

Both advocates filed their skeleton arguments pursuant to the provisions of Rule 64 of the High Court (Commercial Division) Procedure Rules, 2012.

A brief background to this application is that the applicants herein are plaintiffs in Commercial Case No.155 of 2018 (henceforth "the case"), in which the respondent is a defendant. The applicants' prayers in case are as follows.

- i. A declaratory order that the defendant's use of the name "JP DECAUX TANZANIA LIMITED" infringes on the 1st Plaintiff's well-known mark "JCDECAUX".
- ii. A permanent injunction restraining the defendant, its agents, representatives, servants, assigns and/or any other person acting under its instructions from trading, advertising, marketing and/or

in any other way dealing in the name "JP DECAUX" or any other name closely resembling the plaintiff's name or a name including "JP DECAUX" or resembling the trademark "JCDECAUX" registered in favour of the 1st plaintiff.

- iii. A prohibition order restraining the defendant, its agents, representatives, servants, assigns and/or any other person acting under its instructions from holding itself out as an associated or affiliated company of the Plaintiff or of JCDECAUX Group.
- iv. An order that an inquiry as to damages, or at the plaintiffs' option, an account be taken from the defendant of the profits that the defendant has made by trading under the name "JP DECAUX TANZANIA LIMITED" from the time that the defendant was prohibited from using the domain www.jpdecaux.com up to the date of judgment, and payment of all sums found due upon taking such an inquiry or account be paid to the plaintiffs.
- v. An order for destruction and/or delivery to the plaintiffs or obliteration upon oath of all printed matter or labels on or for outdoor advertising materials the use of which would be a breach of the permanent injunction and prohibitory orders sought by the plaintiff.
- vi. An order for compensation for loss of goodwill.
- vii. An order for punitive and general damages.
- viii. Interest at the rate of 12% per annum on the decretal amount awarded from the date of judgment until full payment.
- ix. Costs of the suit.

- x. Interest at the rate of 8% per annum being the Court's rate on the costs from the date of judgment until full payment.
- xi. Such other reliefs as this honourable Court may deem fit and just to grant.

Now, back to the application at hand, submitting for the application, Mr. ELingae started by adopting the contents of the two affidavits in support of this application and the skeleton arguments filed in Court in which, he submitted that the principles for issuance of an order for temporary injunction are well stipulated in the famous case of **Attilio Vrs Mbowe (1969) HCD 284**, the first one is that; *there must a serious question to be tried on the facts alleged and a likelihood that the plaintiff will be given the relief sought*. He proceeded to refer this court to the case of **Kibo Match Group Limited Vrs Mohamed Enterprises (T) Limited, Civil Case No. 6 of 1999** (unreported), in which this court stated the principles governing issuance of an order for temporary injunction, to wit; first, the applicant should show a *prima facie* case with a probability of success against the defendant, secondly the applicant should prove that if the order for injunction is not granted the injury that would be suffered cannot be remedied by way of damages. Mr. Elingae further submit that the major claim in this matter is that the respondent has infringed and continues to infringe the applicants' Trade Mark which is "JCDECAUX". He contended that the respondent uses the name "JP DECAUX TANZANIA LIMITED as his company name in its advertisement business which is also the business undertaken by the applicants. He further contended that the

two conditions for grant of the order for temporary injunction have been met since the name "JP DECAUX TANZANIA LIMITED" is confusingly similar to the applicants' Trade Mark name "JCDECAUX TANZANIA LIMITED". Mr. Elingae was of the view that the applicants have made out a *prima facie* case worth the court's order in protecting their Trade Mark.

As regards the second criteria, that is the plaintiffs/applicants have to show that the court's intervention is necessary to protect the plaintiff from the kind of injury which may be irreparable before his legal rights are established, Mr. Elingae submitted that the respondent has been operating its advertisement business using the aforesaid name that resembles the applicants' Trade Mark for several years. The damages caused by Trade Mark infringement cannot be compensated by money, thus the appropriate remedy is to issue an order for temporary injunction, contended Mr. Elingai. He referred this court to the case of **Giella Vs Cassman Brown & CO. Ltd 1973 E.A.358**, to buttress his arguments.

Furthermore, Mr. Elingae submitted that in establishing the existence of irreparable losses, the applicant is required to show that there will be great hardship to the applicants/Plaintiffs by withholding the injunction than will be to the respondent/defendant by granting the injunction. He further argued that on the balance of convenience the applicant being a world leader of outdoor advertisement will continue suffering from the respondent's use of a similar Trade Mark and similar business if the said injunction will not be granted. Thus, he was of the view that on the

balance of convenience if the order for temporary injunction will not be granted, the applicant stands to be more inconvenienced than the respondent.

Lastly Mr. ELingae submitted that an order for temporary injunction is a discretionary order. The court's discretion has to be exercised judiciously. He referred this court to the case of **Ibrahim Vrs Ngaiza (1971) HCD 249**. He invited this court to exercise its discretion judiciously by granting the order for temporary injunction since the applicant does not dispute the similarity of the names "JP DECAUX TANZANIA LIMITED" and "JC DECAUX TANZANIA LIMITED" and that both the applicants and the respondent are doing a similar business, that is advertisements, thus, it brings a confusion into the public. He also referred this court to a decision of the High Court of Kenya, **Agility Logistics Limited and two others Vrs Agility Logistics Kenya Limited, Civil Case No 840 of 2010**.

In rebuttal, Mr. Mwalongo adopted the contents of the respondent's counter affidavit and his skeleton arguments filed in Court, in which he submitted that the respondent is a limited liability Company incorporated in Tanzania on 7th August 2014. Referring to paragraph 5 of the affidavit in support of this application, deponed by Janine Deetlefs, Mr. Mwalongo told this court that the second defendant changed its name to the name at issue, that is "JP DECAUX TANZANIA LIMITED", on the 1st of June, 2016 and the registration of the Trade Mark bearing the 2nd applicant's name took place from May 2015 to March 2016, eighteen months after the

registration of JP DECAUX TANZANIA LIMITED by the registrar of Company. Mr. Mwalongo was of the view that, it is great injustice to restrain the respondent from operating and using its dully incorporated and registered company name by the registrar of Companies. In 2014 when the respondent's company was registered by the registrar of Companies there was neither a company nor a Trade Mark registered by the registrar of Company resembling the applicant's name, that is why the registrar of Companies issued a certificate of incorporation to the respondent, contended Mr. Mwalongo. He referred this court to the provisions of section 20 of the trade and service Mark Act No.12 of 1986 which provides as follows;

"Subject to the provisions of subsection (2) trade or service mark cannot be validly registered in respect of any goods or services if it is identical with a trade or service mark belonging to a different proprietor and already on the register in respect of the same goods or services or closely related goods or services or that so nearly resembles that a trade or service mark as to be likely to deceive or cause confusion".

Expounding on the prerequisite conditions on the grant of the order for temporary injunction as stipulated in the case of **Atilio Vrs Mbowe (1969) HCD 284** and relying on the decision of this court in the case of **Constatine Kalipen Vs Azania Bank Ltd & another, Commercial Case No. 78 of 2010**, (unreported), Mr. Mwalongo submitted that there is no any serious issue to be tried by this court since the respondent has

been using the name at issue since its incorporation in 2014 without confusing the public or complaint from the 1st and 2nd respondents. Mr. Mwalongo was of the view that if this court grants the order for temporary injunction, it is the respondent who will suffer irreparable losses not the applicants. In addition to the above, Mr. Mwalongo contended that granting the order for temporary injunction will be indirectly restrain the registrar of companies from recognizing a company dully registered and publicly published by the registrar of companies. It was the contention of Mr. Mwalongo that any order issued concerning the registration of the respondent without involving the registrar of companies will create chaos and confusion. Also, he invited this court not to rely on the case of **Agility Logistics Limited** (Supra) because it is from another jurisdiction and unreported, thus, its authenticity is questionable. Finally prayed that this application be dismissed with costs.

In rejoinder, Mr. ELingae reiterated his submission in chief and further submitted that the 2nd applicant has been into existence since 1964 and is the branch of the 1st applicant. The Trade Mark at issue has been registered in more than 134 countries including Tanzania. He insisted that for the interests of justice, under the circumstances it proper to grant the application.

Having analyzed the submission made by the learned advocates, the task of this court is to determine whether the prerequisite conditions for a court to grant the order for temporary injunction have been met to move

this court to grant the same. It is a common ground that the prerequisite conditions for grant of the order for temporary injunction are as stipulated in the case of **Atilio** (supra) and other decisions of this court in a number of cases such as the case of **Constatine Kalipeni** (supra) and **Kibo Match Group Limited** (supra). These prerequisite conditions are; First , *existence of a prima facie case, that is, the court has to be satisfied that there is bonafide dispute which deserves to be tried and decided by the court, and that there is a likelihood that the applicant/plaintiff will be given the relief sought.* Secondly, *Irreparable injury, that is the applicant has to establish that he/she will suffer irreparable injuries if the order for temporary injunction will be not be granted this goes together with, balance of convenience, that the court has to be satisfied that the hardship /inconvenience that will be caused to the applicant will be greater than the one which is likely to be caused to the opposite party by granting the order for temporary injunction.*

It is also a common ground that the order for temporary injunction is a discretionary order. It is granted at the discretion of the court upon being satisfied that the aforesaid prerequisite conditions have been met.

Starting with the first condition, the pleadings in the main case (Commercial Case No 155 of 2018) reveals that there is a dispute between the applicant and the respondent over the use the names "JC DECAUX TANZANIA LIMITED" and "JP DECAUX TANZANIA LTD", the former name belongs to the applicant , who alleges that it is his registered Trade Mark , the latter belongs to the respondent who also claims that he registered it

as the name of his company. The issue here is in the similarity of the names. The applicant alleges that the similarity of the names has been causing confusion to the general public and consequently its business is affected, some of its clients have mistakenly gone to the respondent. The dispute becomes more vivid due to the fact that the applicant and the respondent are doing a similar business, that is the advertisement. During the hearing of this application both sides conceded that the names at issue are similar and that both parties are doing a similar business. From the foregoing it is my settled opinion that there is a *prima facie* case which deserves to be tried and determined by this Court.

As regards the second condition on irreparable injury, in the case of **Giella** (supra), the court held that an injunction will not be granted unless there are indications that applicant might suffer irreparable injury, which would not be adequately compensated by an award of damages. Mr. Elingae contended that if the order for temporary injunction will not be granted, the respondent will continue using a business name which is similar to the applicant's Trade Mark, thus causing the applicant to suffer irreparable losses. Mr. Elingae contended that injuries caused due to infringement of Trade Mark cannot be equated to money value, without giving any explanations to support his proposition. He just told this court that most importantly the respondent will continue conducting business using the name which is confusingly similar to that of the applicants and cause more damages to the applicant. In my considered view the injury that can be caused to the applicants' business to a great extent can be

compensated in monetary form in terms of specific or general damages. Thus, it is my finding that no irreparable injuries can be occasioned to the applicants if the order for temporary injunction is not granted.

As regards the third condition on the balance of conveniences, if the order for temporary injunction is granted, it means that the respondent will have to stop all its business for a while pending the determination of the main case. It is undisputed fact that the respondent is a registered company, so the name in dispute is the company name in which the respondent conducts its business. So, all licences and any official document pertaining to the respondent's business is in that name. In my opinion if the application is granted, the respondent will be inconvenienced more than the applicants and will face so much hardship than the applicants, since restraining it from using the business name at issue will be tantamount to closing its business, which will definitely bring great hardship to the respondent. I have read and considered the cases referred to me by Mr. Elingae, with due respect to him, those cases are distinguishable from the case at hand as they have different facts and scenarios. For instance, in the case of **Kibo Match Group Limited** (Supra) in which the court granted the order for temporary injunction sought by the applicant, the respondent was Mohamed Enterprises (T) Limited, which was not registered as "Kangaroo" the trade Mark that was in dispute. The court's order for temporary injunction to stop importing Match Boxes bearing the said Trade Mark ("Kangaroo") did not affect the operation of all of the businesses conducted by the respondent, as "Kangaroo" was not its

Company name. The case in this application is different, as I have narrated herein above, the Trade Mark at issue in this application is the respondent's registered Company name.

In the upshot, this application is dismissed. I give no order as to costs.

Dated at Dar Es Salaam this 3rd day of October, 2019.



A handwritten signature in blue ink, appearing to read "B.K. PHILLIP".

B.K. PHILLIP

JUDGE