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The Republic of Uganda

In The High Court of Uganda at Kampala

(Commercial Division)

High Court Miscellaneous Application No. 808 of 2020

[Arising from High Court Civil Suit No.866 of 2018]

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Kyanninga Royal Cottages Limited :::::::::::::::::::::::::::::::::::::: Applicant

Versus

Kyanninga Estates Limited T/A Kyanninga Lodge :::::::::::::::::::::::::::::: Respondent

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Before: Hon. Justice Dr. Henry Peter Adonyo:

Ruling:

1. Background:

This application was brought under section 98 of the Civil Procedure Act Cap. 71, section 33 of the Judicature Act Cap. 13 and Order 6 rule 30, Order 7 Rule 11 and Order 52 rules 1 and 3 of the Civil Procedure Rules S. I 71-1 for the following orders; that,

- 5 a. The plaint in HCCS 866 of 2018 does not disclose a cause of action against the applicant;
- b. The averments in the plaint and orders sought by the Respondent in HCCS 866 of 2018 is barred by law.
- c. The Respondent's suit HCCS No. 866 of 2018 be dismissed with costs.
- 10 The grounds of the application the application are that;
- a) HCCS No. 866 of 2018 is expressly barred by law as the suit is *res judicata*, the same having been filed by the Respondent subsequent to the dismissal of HCCS No. 546 of 2017 by this same Honourable court.
- b) The plaint in HCCS No. 866 of 2018 does not disclose any cause of action against the applicant, is frivolous and vexatious.
- 15 c) The orders sought by the Respondent in the HCCS 866 of 2018 are barred by Articles 21 and 40 of the Constitution, 1995 and the Trademarks Act, 2010.
- d) It is in the interest of justice and equity that this application be allowed

20 **2. Affidavits:**

This application is supported by an affidavit deponed by Mr. Kamaradi Joseph, who states that the respondent had previously filed HCCS No. 546 of 2017, which was subsequently dismissed on the basis that the suit was filed by a non-existent entity upon the applicant filing HCMA No. 551 of 2018 but that yet again

25 the respondent filed this instant suit with the facts constituting the Respondent's cause of action under paragraph 4 and the orders sought against the Applicant

5 under paragraph 3 of the instant suit being similar to those which were
previously disclosed in the plaint in HCCS No.546 of 2017 and that the matters
in issue in the instant suit directly and substantially being in issue between the
same parties, litigating under the same / similar titles in the former suit of
HCCS 546 of 2017 rendering the current suit against the applicant *res judicata*
10 on the basis that the same had previously been adjudicated upon.

Additionally, it was deponed that the grounds of defence in HCCS No. 546 of
2017 were substantially dealt with rendering the present suit not to disclose any
cause of action.

Furthermore, the Applicant averred through Kamaradi Joseph that there was no
15 trademark in the names of '**Kyaninga**' and also that the words '**Kyaninga**
elegance at its peak' consisted of a geographical name and commonly used
words in the English language with no monopoly allowed in law thereto and that
given the above averments then the applicant was right to carry out the
occupation and trade lawfully as it was protected by the constitution which the
20 plaint sought to infringe upon.

In an affidavit in reply deponed by Mr. Steven Williams for the Respondent it was
averred that the applicant's averments that the HCCS No. 546 of 2017 was *res*
judicata remained unproved with Mr. Steven Williams stating that the previous
suit HCCS No. 866 of 2018 was not heard and concluded on its merits but that
25 it was disposed of prematurely upon a preliminary objection raised by the instant
applicant in HCMA No. 551 of 2018 meaning that the issues in question between

5 the parties having never been adjudicated upon and are thus not directly in issue herein yet HCCS No. 866 of 2018 sought to enforce the plaintiff's intellectual property rights.

In an affidavit in rejoinder Mr. Kamaradi deponed briefly that the respondent's averments should not be considered for doctrine of *res judicata* equally applied
10 to suits dismissed on preliminary points of law.

3. Submissions:

The applicant filed its written submissions raising three issues for consideration by this Honourable court. The issues raised are;

- 15 i. Whether the plaint in HCCS No. 866 discloses a cause of action against the applicant.
- ii. Whether the plaint in HCCS No. 866 of 2018 is properly before this Honourable Court.
- iii. The remedies available to the parties.

The Applicant's submissions on the three issues are combined and are as below.

20 On whether the plaint in HCCS No. 866 discloses a cause of action against the applicant, Counsel for the Applicant while relying on the decisions in ***Ismail Serugo vs Kampala City Council & Another Supreme Court Constitutional Appeal No. 2 of 1998*** and ***Auto Garage vs Motokov (No. 3) [1971] E.A 514*** wherein are described what a cause of action was, urged this Honourable court
25 to look at the plaint, the annexures and the averments attached to the instant

5 suit and determine whether the instant suit with fulfils the description of a cause
of action as pointed out in the two aforementioned cases.

In making this proposition counsel for the applicant submitted that according
an affidavit deposed by Mr. Joseph Kamaradi at paragraph 14 as well as
paragraph 3 and 4 of the plaint, the words '**Elegance at its peak**' and
10 '**Kyanninga**' are common utility words and are not trademark and therefore are
for use by the public and therefore no single person could seek court protection
for their use and that in addition the respondent/ plaintiff does not own any
trademark known as '**Kyanninga**' with the word '**Kyanninga**' being a descriptive
word for an area in Uganda where both the applicant and respondents have
15 established businesses yet the respondent would wish to gain monopoly over the
said name in an unlawful way and using unfair practice contrary to section 9 of
the Trademarks Act, 2010 to the detriment of other business owners given that
there was no trademark for the isolated name of **Kyanninga** registered in the
Plaintiff/ Respondent's name either as alleged or at all as the trademark
20 registered by the Respondent was **Kyanninga Elegance at its Peak** which in its
entirety comprises a combination of a geographical name and words which were
used in common phraseology in the English language and was therefore capable
of distinguishing the services of the Respondent from any person's rendering the
Respondent's objection which is in respect of the Applicant's use of the word
25 '**Kyanninga**' on its own to be baseless as such sole word was not singularly for
the respondent's own use.

5 Given these clear positions of the law and fact, it was thus the prayers of the
applicant that this court finds that the head suit based on the restrictive wishes
by the applicant to have itself solely use words which are not its trademark would
thus show that the said head suit disclosed no cause of action which this court
should find so and subsequently grant this application with the orders sought
10 therein in.

The Respondents submissions did not file in any submissions within the time
granted and even after requesting for additional time still failed to do so.

4. Decision of Court:

I have taken into account the pleadings of parties in this matter in addition to
15 the affidavits in support and in objection to the application and the submissions
of applicant.

From the onset, I would wish to point out that from the pleadings, affidavits and
submissions I am of the considered opinion that this application raises pertinent
issues of whether the plaint discloses a cause of action and whether the HCCS
20 No. 866 of 2018 is competent before this court. These issues are considered
jointly.

As regards a matter exuding a cause of action, it has since been held by courts
as was in the case of ***Ssemakula vs Serunjogi Civil Suit No. 187 of 2012***
where the court while referring to the decision in ***Elly B Mugabi vs Nyanza***
25 ***Textile Industries Ltd (1992-1993)*** pointed out that a cause of action in a civil

5 matter would arise when the right of a plaintiff is affected by a defendant's act or omissions. In **Ssemakula's case (cited supra)** the court then went to define a cause of action as every fact which is material to be proved to enable a plaintiff succeed or every fact which if denied the plaintiff must prove in order to obtain judgment.

10 Additionally, in the *locus classicus* case of **Auto Garage vs Motokov [1971] EA 514** the court highlighted three essential elements required to support a cause of action and these include that;

a) The plaintiff enjoyed a right.

b) The right had been violated.

15 c) The defendant is liable.

In considering a claim before it which raises the issue of whether a plaintiff discloses a cause of action, a court must not only consider whether or not the plaintiff discloses a cause of action but make a determination on whether the complaint raised against a defendant clearly infringed on a plaintiff's enjoyment
20 of its right.

In the present case, the first determination is as to whether the plaintiff enjoyed a right in the name '**Kyanninga Elegance at its Peak**'. This fact is not disputed by any party though the applicant argues that there is no trademark for the isolated name of **Kyanninga** registered in the respondent's/ plaintiff's names as
25 alleged or even at all.

5 Trademark is defined in Section 1 (1) of the Trademarks Act, Act 17 2010 of Laws
of Uganda as follows;

Section 1 (1) of the Trademarks Act:

10 ***“trademark” means, a sign or mark or combination of signs or
marks capable of being represented graphically and capable of
distinguishing goods or services of one undertaking from those of
another undertaking”***

The issue of contention between the parties herein in the head suit refers to
violation of a trademark. The contention before me is that there is no trademark
in the names of the respondent particularly in respect of the word **“Kyaninga”**.

15 In determining a trademark one of the elements which for consideration is
distinctiveness as distinctiveness is a requirement for one to register a particular
trademark since such distinctive trademark or name helps to distinguish goods
of the trademark owner from other goods with which the trademark owner has
no connection. This is the import of section 9 (2) of the Trademarks Act, 2010
20 which provides that ***“...for the purposes of this section, “distinctive”
means—(a) in the case of a trademark relating to goods, adapted in
relation to the goods in respect of which the trademark is registered or
proposed to be registered, to distinguish goods with which the owner of
the trademark is or may be connected, in the course of trade, from goods
25 in the case of which no connection subsists;***

5 Section 9 (1) of the Trademarks Act highlights the requirements for a trademark to be registered for distinctiveness. Among them is the requirement that the intended trademark should not make reference to a geographical name;

Section 9 (1) provides, inter alia that “ ***in order for a trademark other than a certification mark to be registered in Part A of the register, the trademark shall contain or consist of at least one of the following essential particulars—***

(a) ***the name of a company, individual or firm, represented in a special or particular manner;***

15 (b) ***the signature of the applicant for registration or of some predecessor in his or her business;***

(c) ***an invented word or invented words;***

20 (d) ***a word or words having no direct reference to the character or quality of the goods or services, and not being according to its ordinary signification, a geographical name or a surname...***
(underlining mine)

(e) ***any other distinctive mark, but a name, signature or word or words, other than words within the descriptions in paragraphs (a), (b), (c) and (d), shall not be registrable under this paragraph except upon evidence of its distinctiveness.”***

5 From the above it is clear to me that section 9 (1) of the Trademarks Act requires that a trademark must contain one of elements above.

For the present case, part (d) of Section 9 (1) of the Act is most relevant to the circumstances of this case. It specifies that words used in the trademark should not be in relation to a geographical name.

10 Relating that position to this instant application from the pleadings in the head suit, it can be seen that the respondent seeks to protect the words, '**Kyaninga Elegance at Its Peak**'.

A "Google" internet map search of the word **Kyaninga** discloses that the word "**Kyaninga**" refers to a particular place and it is also a geographical name of a
15 crater lake and village in Fort Portal City in Kabarole District found in Western part of Uganda.

Given the position of section 1(1)(d) of the Trademarks Act above, it is trite that geographical names can be said to be distinct unless it was first attributed to a claimant and meant to communicate to consumers the location of the services
20 provided. (**See: World Intellectual Property Organisation Training Manual titled 'Introduction to Trademark Law and Practice', (1993).**)

Thus in accordance to section 9 (1) of the Trademarks Act the name '**Kyaninga**' cannot be protected under the Trademarks Act unless it is distinct.

It is also trite that "**ordinary words should not be inherently capable of**
25 **distinguishing services except through use or distinctiveness generated by**

5 **other factors**” as was held in the case of **Nairobi Java House Ltd vs Mandela Auto Spares Civil Appeal No. 13 of 2015.**

In the present case, the terms, words **‘Kyaninga elegance at its peak’** are not distinct in their character for even a dictionary search also reveals that the words **‘Elegance at its peak’** are commonplace ordinary words in the English
10 language with neither their distinctiveness demonstrated by any other factors. Additionally, according to the World Intellectual Property Organisation Training Manual titled **‘Introduction to Trademark Law and Practice’, (1993) Issue,** common words from everyday language can only be highly distinctive if they communicate a meaning that is arbitrary in relation to the products on which
15 they are used. The training manual goes on to give examples such as the famous **APPLE** mark (both the word and the device) for computers. The word **APPLE** is not an invented word but is highly distinctive for the goods concerned.

In the present case, the above words have not been shown to be adapted to describe a distinctiveness in the provision of hospitality services

20 This in effect means that the above words cannot receive the protection of the law as the word “ **Kyaninga**” is a geographical place name while the words **“Elegance At Its Peak”** are words used in everyday speak rendering me to conclude that the respondent has not at all demonstrated that it enjoyed any right protected by law and consequently no such right was violated by the
25 applicant with the result that the first and second issues raised by the applicant showing that plaint instituted by the respondent not disclosing any cause of

5 action with the end result that HCCS No. 866 of 2018 is rendered incompetent before this court.

The other issue pointed out by the applicant relates to HCCS No. 866 of 2018 being *res judicata* in that it is the contention of the applicant that the facts constituting the respondent's cause of action under paragraph 4 of HCCS No. 10 546 of 2017 are similar to those disclosed by the respondent's plaint in the current suit and that the matters in issue in HCCS No. 866 of 2018 were directly and substantially in issue between the same parties who had litigated under the same and or similar titles formerly in HCSS 546 of 2017 with the result that the current suit against the applicant entity should be considered *res judicata*.

15 *Res Judicata* is provided for under Section 7 of the Civil Procedure Act which provides that matters that have been directly and substantially in issue should not be litigated upon in another suit between the same parties. The said provision of the law in its full it provides as below;

Section 7 of the Civil Procedure Act: Res judicata.

20 ***“No court shall try any suit or issue in which the matter directly and substantially in issue has been directly and substantially in issue in a former suit between the same parties, or between parties under whom they or any of them claim, litigating under the same title, in a court competent to try the subsequent suit or the suit in which the***
25 ***issue has been subsequently raised, and has been heard and finally decided by that court.”***

5 The decision in ***Sekidde Richard vs Mbabazi Fiona and Another HCCS No. 214 of 2008*** confirmed this legal position in that the court when presented with similar question went on to consider and pronounced itself that The test to be applied by court to determine the question of *res judicata* is this:

10 ***“...is the plaintiff in the second suit or subsequent action trying to bring before the court, in another way and in the form of a new cause of action which he or she has already put before a court of competent jurisdiction in earlier proceedings and has been adjudicated upon.”***

15 Upon considering the question posed above in ***Sekidde (supra)***, the court found that although a former suit had been previously filed, the matter had not been adjudicated upon on its merits or heard and finally determined by a court as provided for under Section 7 of the Civil Procedure Act court and thus went on to dismiss an application for withdrawal of the head SUIT.

20 In reference to the present case, the respondent filed as a plaintiff **HCCS No. 546 of 2017** against the applicant / defendant seeking a permanent injunction restraining the applicant / defendant and its agents from passing off the respondent's / plaintiff's trademark and style of trading, an order for delivery of any infringing material in print or otherwise and an inquiry as to damages.

25 The applicant then filed **Miscellaneous Application No. 551 of 2018** seeking that the suit be dismissed on various grounds including that HCCS No. 546 of 2017 was commenced in the name of a non-existent company and did not reveal

5 any maintainable cause of action since there was no trademark registered in favour of Kyaninga Lodge Limited. Also, that the alleged trademark, '**KYANINGA ELEGANCE AT ITS PEAK**' comprises a combination of a geographical name and common words of parlance which did not distinguish the services of the respondent from those of others.

10 The then trial court heard the application and dismissed the suit on grounds that the main suit was brought by a non-existent entity but did not determine the merits of the application and the legality of the suit.

Thereafter, the present suit HCCS No. 866 of 2018 was filed by the respondent/ plaintiff and brought against the applicant/ defendant seeking from my reading
15 of the pleadings similar prayers in HCCS No. 546 of 2017 which correctly as averred by the respondent/ plaintiff was never heard on its merits but rather was disposed of via a preliminary objection raised by the applicant/ defendant by way of HCMA No. 551 of 2018 meaning that the issues in question in that particular suit was never been adjudicated upon thus the substantive matters
20 in it were never determined by the court with the result that the plea of *res judicata* would be inapplicable in the present case and the respondent/plaintiff would have acted within its rights to pursue remedies under the law.

However, from my examination and conclusions of issues one and two above, it is clear to me that the plaint in HCCS No. 866 of 2018 does not disclose any
25 cause of action as against the applicant/ defendant for the reasons given earlier

5 with the overall result that this application would succeed with orders given as below.

5. Orders:

- 10 a. Overall this application would be allowed on the basis that the plaint in HCCS 866 of 2018 does not disclose any cause of action as against the applicant/defendant in addition to orders sought by the respondent/ plaintiff therein being barred by law with the result that the said suit considered incompetent before this court is thus dismissed.
- b. The costs of this application and the head suit of HCCS 866 of 2018 is in any event awarded to the applicant /defendant.

15 I so order.



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Hon. Justice Henry Peter Adonyo

Judge

20 23rd March 2021