THE JEWEL IN THE CROWN: PROTECTING BRAND GOODWILL IN THE WAKE OF JOHARI SCHOOL CASE

The High Court of Kenya, in its recent judgment in ***Johari School Limited v Rosemary Wambugu (Civil Case No. 191 of 2018)***, has provided a robust reaffirmation of the protections afforded to business goodwill under the common law tort of passing off. This decision serves as a critical reminder that intellectual property protection extends far beyond the mere administrative registration of a business name.

Case Summary: The Battle for "Johari"

The Plaintiff, Johari School Limited, was incorporated in July 2011 and established a reputable educational institution under the name "Johari School". In 2014, the Defendant registered a business name, "Johari Daycare and Kindergarten," and subsequently sought registration with the Ministry of Education using names strikingly similar to the Plaintiff's, including "Johari School".

The Plaintiff alleged that this similarity misled the public and business associates, causing confusion and financial loss. The Defendant countered that "Johari" is a common Kiswahili word meaning "jewel" and, therefore, cannot be exclusively owned, especially since the Plaintiff had not registered it as a trademark.

Ultimately, Justice Moses Ado ruled in favor of the Plaintiff, finding that the Defendant's actions constituted passing off. The Court awarded the Plaintiff Kshs. 2,500,000 in general damages and dismissed the Defendant's counterclaim.

Critical Appraisal and Legal Implications

- **The Primacy of the "Trinity" Test**

The Court anchored its decision on the established "trinity" of passing off: goodwill, misrepresentation and damage. The Plaintiff successfully demonstrated its goodwill through consistent operation since 2011. The Court found that the names were "strikingly similar" and that an average person would likely conclude the entities were related. Crucially, the law presumes that if goodwill is interfered with via passing off, damage naturally results.

- **The Fallacy of the "Common Word" Defense**

A significant takeaway is the Court's rejection of the argument that generic or common words are immune to protection. While "Johari" is a common word, the Plaintiff proved it had acquired distinctiveness and notoriety through use. Practitioners must advise clients that choosing a common name does not grant a competitor the right to use it once that name has become synonymous with an established brand's services.

- **Administrative Registration vs. Intellectual Property Rights**

The Defendant argued that her name was approved by the Registrar of Business Names, who did not exercise discretion to decline it based on confusion. The Court clarified that administrative approval does not shield a party from a passing off claim. Section 5 of the Trade Marks Act explicitly preserves the right to take action against passing off even for unregistered marks.

- **The High Cost of Reliance on Common Law**

While the Plaintiff was successful, this litigation underscores the vulnerability of relying solely on the tort of passing off. The case was filed in 2018 and not settled until 2026. Had the Plaintiff registered "Johari School" as a trademark with the Kenya Industrial Property Institute (KIPI) at its inception, the path to enforcement would have been more direct and less reliant on the heavy evidentiary burden of proving "goodwill".

Moving Forward

Beyond the Name Search. A "clean" search at the Business Registration Service is not an absolute clearance. Before launching a brand, businesses should conduct a market-wide audit to ensure no existing entity has established prior goodwill in a similar name.

The Mandate for Trademarking. All businesses must be advised to move from "common law protection" to "statutory protection." Registering a trademark with KIPI provides a clear, documented right of exclusivity that simplifies litigation and acts as a stronger deterrent against opportunistic competitors.

Conclusion

The *Johari decision* is a formidable reminder that the law protects the "property" found in business reputation. For practitioners and clients alike, the message is clear: Goodwill is an asset that must be guarded both through proactive registration and vigorous legal enforcement.

By: Willis J. Onyango
Associate Advocate
Corporate & Commercial Law