THE REPUBLIC OF UGANDA

IN THE HIGH COURT OF UGANDA AT KAMPALA
(COMMERCIAL DIVISION)

MISCELLANEOUS APPLICATION NO. 1653 OF 2025
ARISING FROM CIVIL SUIT NO. 0909 OF 2025

CROCS, INC. :: APPLICANT

VERSUS

LANDY INDUSTRIES LIMITED ::: RESPONDENT

(Before: Hon. Justice Patricia Mutesi)

RULING

Background

The Applicant filed this *ex parte* application by way of chamber summons under **Section 79(1) and 79(2)** of the Trademarks Act seeking orders that:

1. An injunction prohibiting the Respondent from continuing to infringe the Applicant's **"CROCS"** trademark until the disposal of Civil Suit No. 0909 of 2025 doth issue.
2. The Respondent's factory and premises at Seeta Ward, Mbalala Industrial Zone, Mukono District and its sales outlet situate at God's Grace Building, Room K13, William Street, Kampala be inspected and any right-infringing materials found thereat be removed and preserved as evidence.
3. Costs of this application be provided for.

The grounds and the evidence on which the application is founded are set out in the supporting affidavit which was sworn by Mr. Henry Sebunya, the Applicant's private investigator. Therein, Mr. Sebunya stated that the Applicant was at all material times, the registered owner of Trademark No. 43489 consisting of the word **"CROCS"** in Class 25 of Part A of the Trade Marks Register in respect of footwear, clothing and light weight clip-resistant footwear.

Mr. Sebunya stated that it came to the Applicant's knowledge in May 2025 that the Respondent was manufacturing counterfeit Crocs footwear at its factory in Mbalala Industrial Zone, Mukono. On 28th May 2025, on the instructions of the

Applicant, he visited the Respondent's said factory and was able to confirm that the Respondent was indeed manufacturing counterfeit Crocs footwear from the factory. He attempted to purchase a few pieces of the counterfeit Crocs branded footwear but the Respondent's employees advised him that the footwear could only be purchased from the Respondent's sales outlet at God's Grace Building Room K13, William Street, Kampala.

Mr. Sebunya stated that, on the same day, he went to the said outlet and bought a carton of the Crocs branded footwear. He established that the Respondent distributes large quantities of the said counterfeit footwear all over Uganda and to South Sudan and the Democratic Republic of Congo through the same outlet.

Finally, Mr. Sebunya stated that there is a substantial risk that Respondent will destroy, conceal, or dispose of the infringing products, before any inter-parties application for their preservation for evidential purposes even can be heard.

Issue arising

Whether this application should be allowed.

Representation and hearing

At the hearing, M/S Kabayiza Kavuma Mugerwa & Ali Advocates represented the Applicant. The hearing proceeded *ex parte* and counsel filed written submissions to argue the application. I have carefully considered those submissions, the laws and authorities cited therein and all the other materials on record while deciding this application.

Determination of the issue

Section 79(1) of the Trademarks Act Cap 225 provides that a person whose rights under that Act are in imminent danger of being infringed or are being infringed may institute civil proceedings in the High Court for an injunction to prevent the infringement or to prohibit the continuation of the infringement. **Section 79(2)** of the Trademarks Act Cap 225 then anticipates the grant of Anton Piller Orders by providing that:

> *"Upon an ex parte application by a right owner, the High Court may in chambers make an order for the inspection of or removal from the*

infringing person's premises or control, of the right infringing materials, which constitute evidence of the infringement by that person."

Having analysed the 2 provisions, it is clear that there was a misjoinder of actions in this application. While **Section 79(2)** of the Trademarks Act allows this Court, proceeding *ex parte* in chambers, to issue an Anton Pillar Order, **Section 79(1)** does not similarly permit the Court to discard the participation of the party said to be infringing on a trademark in the proceedings leading up to the findings that are anticipated therein. It is therefore certain that, save for the circumstances in which the Civil Procedure Rules allow a suit to be heard ex parte, a proceeding in a cause of action brought under **Section 79(1)** of the Trademarks Act must be conducted inter-parties.

As a result, the Applicant's prayer for an injunction prohibiting the continuation of the infringement on the impugned trademark is incompetent and must fail at once. That prayer will be dealt with in the main suit after both parties have been afforded the opportunity to be heard. It is quite obvious that granting an order prohibiting the Respondent from continuing to "infringe" on the impugned mark at this stage before the trial in Civil Suit No. 0909 of 2025 ("the main suit") would be prejudicial as evidence has not yet been led to conclusively prove the alleged infringement. Issuing such an order would be to assume that the Respondent is already guilty of trademark infringement even before the trial in the main suit.

This leaves only the second prayer for inspection and removal (the Anton Piller Order) under **Section 79(2)** of the Trademarks Act for the Court's consideration. This Court, in its decision in **Nile Breweries Ltd v Johnson Sebuggwawo, HCMA No. 0252 of 2024,** explained that:

> *"The Anton Piller Order is one of the truest manifestations of the dynamic nature of the doctrines and maxims of equity in their bid to supply new solutions to emerging challenges in law. It takes the form of an interlocutory search and seizure order issued in an ex parte application where there is a reasonable fear that there is evidence of infringement of intellectual property rights in a person's possession which could be destroyed and lost if that person is alerted of the legal action instituted against him or her before the order is made."*

The Court of Appeal of England and Wales, in its decision on the *locus classicus* on Anton Pillar Orders, **Anton Piller K.G. v Manufacturing Processes Ltd [1976] Ch. 55,** explained the justification for the issuance of an Anton Piller Order. Lord Denning, M.R. (as he then was), writing for the majority of the Court of Appeal, opined that:

> *"... it seems to me that such an order can be made by a Judge ex parte but should only be made where it is essential that the plaintiff should have inspection so that justice can be done between the parties and when, if the defendant forewarned there is a grave danger that vital evidence will be destroyed, that papers' will be burnt or lost or hidden or taken beyond the jurisdiction, and so the ends of justice be defeated and when the inspection would do no real harm to the defendant's case."*

I cite the above authorities with approval as they represent the true motivations, purpose and character of an Anton Piller Order.

It follows that, for the Court to issue an Anton Piller Order under **Section 79(2)** of the Trademarks Act Cap 225, the following conditions must have been met:

1. There must be an extremely strong prima facie case.
2. The damage, potential or actual, must be very serious to the Plaintiff.
3. There must be clear evidence that the defendant has in its possession incriminating documents or things and that there is a real possibility that it may destroy such material before any application inter-parties can be made.

(See **Anton Piller K.G. v Manufacturing Processes** *(supra),* **Uganda Performing Rights Society v Mega Standard Supermarket, HCMA No. 1042 of 2015** and **Nile Breweries Ltd v Johnson Sebuggwawo** *(supra).*

Furthermore, in the case of **Jubilee Industries Ltd v Balle (U) Ltd, HCMA No. 855 of 2020,** this Court had the opportunity to consider an application for an Anton Piller Order under **Section 79(2)** of the Trademarks Act. That decision illustrates how the 3 conditions stated above can be construed and applied. In that case, the applicant presented proof that it was the owner of the registered trademark "FROTO" which had been registered in 2015. It had been distributing beverages countrywide under that name. The applicant adduced evidence proving that the respondent had also been distributing beverages under the name "FROOTI". The

"FROOTI" name was, evidently, visually, phonetically and conceptually similar to the applicant's "FROTI" trademark. Considering those facts, the Court found that the applicant had proved a strong prima facie case of trademark infringement.

In the same case, the Court also received and considered the evidence that the respondent was targeting the applicant's customers and distributors. With this, the Court found that there was imminent danger of the applicant suffering very serious damage which would result into enormous losses.

Lastly, evidence was led to show that the respondent had in its possession, incriminating products bearing the allegedly infringing mark. Indeed, this had not been denied by the respondent who only sought to convince the Court that its mark was distinct from the applicant's trademark. The Court also found that there was a possibility that the respondent could have destroyed those products before any application inter-parties could be made on the basis of evidence that one of the respondent's shareholders was a former employee of the applicant who had probably given the idea of exploiting the applicant's trademark to his new employer.

In the end, the Court issued an Anton Piller Order allowing the applicant and its advocates to enter the respondent's premises and inspect and remove samples of the allegedly infringing products. This decision appears to be on all-fours with this application that also seeks an Anton Piller Order under **Section 79(2)** of the Trademarks Act.

In this matter, Mr. Sebunya, the Applicant's private investigator, deponed in his affidavit that the Applicant is the registered owner of the **"CROCS"** trademark. Annexure A1 to the affidavit is the certificate of registration of the trademark dated 20th April 2012. It confirms that the **"CROCS"** trademark was registered in Part A of the Trademarks Register in the name of the Applicant under No. 43489 as of 8th July 2011. Annexure A2 to the affidavit is the certificate of renewal of registration dated 20th July 2018. It confirms that the registration of the **"CROCS"** trademark in the name of the Applicant had been renewed for a period of 10 years with effect from 8th July 2018.

Mr. Sebunya also deponed that he purchased a carton of footwear bearing the Applicant's registered trademark at the Respondent's sales outlet in Kampala.

He annexed to the affidavit in support a copy of the e-invoice for the transaction (Annexure C1) plus a photo showing some of the footwear (Annexure C2).

In light of this evidence, I am satisfied that the Applicant has a very strong prima facie case for trademark infringement. The Applicant is the registered owner of the **"CROCS"** trademark, the trademark was registered in respect of, inter alia, footwear, and there is evidence on record tending to show that the Respondent is manufacturing, marketing and retailing footwear bearing the **"CROCS"** mark that is identical to the Applicant's registered trademark.

I am also convinced that there is very serious damage that has occurred or that is likely to occur to the Applicant as a result of the Respondent's conduct. This is mainly because the Respondent appears to be using the **"CROCS"** mark which is visually, phonetically and conceptually identical to the Plaintiff's registered mark to market the same type of products, that is to say, footwear, in respect of which the Plaintiff's **"CROCS"** mark was registered and in the same geographical place where the Applicant's mark was registered(Uganda). This conduct on the part of the Respondent is likely to have already undercut, and to continue undercutting, the market for the Applicant's footwear, hence negatively affecting its sales.

Finally, I am satisfied that there is a possibility that the Respondent may destroy or hide its alleged infringing products before any application inter-parties for the preservation of those products for purposes of the trial in the main suit can be made, heard and disposed of. It is likely that a party who markets and sells products under a trademark owned by another party may destroy and / or hide those products if it is alerted of the legal consequences of its conduct. Furthermore, Mr. Sebunya's evidence was that the Respondent's supply chain for its products extends beyond Uganda. This implies that the Respondent could very easily transfer most, or even all of the said infringing products, or its business entirely, to markets outside Uganda, thereby making it impossible to find any of them and present them at the trial in the main suit.

Since the 3 pre-conditions for grant of an Anton Piller Order have been satisfied, I am inclined to grant the order. Consequently, this application succeeds in part and I make the following orders:

i. An Anton Pillar Order is hereby issued directing the Respondent to, within 14 (fourteen) days from the date of this Order, permit the

Applicant, in the company of no more than 2 (two) of its advocates, 2 (two) court bailiffs and 2 (two) officers from the Uganda Police Force, to:

(a) enter upon the Respondent's factory and sales outlet situate at Njerere, Seeta Ward, Mbalala Industrial Zone, Goma Division, Mukono District and God's Grace Building, Room K13, William Street, Kampala, respectively;

(b) to inspect the said factory and sales outlet; and

(c) to seize and take away no more than 10 (ten) pairs of footwear bearing the **"CROCS"** mark from the factory and no more than 10 (ten) pairs of footwear bearing the **"CROCS"** mark from the sales outlet for purposes of the trial in Civil Suit No. 0909 of 2025.

ii. The Applicant shall, within 5 (five) days from the date of execution of the Anton Piller Order, transmit any and all seized footwear plus an account/return of the execution to the Registrar of the Court.

iii. Costs of this application shall abide by the outcome of Civil Suit No. 0909 of 2025.

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Patricia Mutesi

JUDGE

(29/08/2025)