



**Lens Eye Images Limited v Mediamax Network Limited (Commercial Suit E231 of 2022)
[2023] KEHC 22881 (KLR) (Commercial and Tax) (29 September 2023) (Judgment)**

Neutral citation: [2023] KEHC 22881 (KLR)

**REPUBLIC OF KENYA
IN THE HIGH COURT AT NAIROBI (MILIMANI COMMERCIAL COURTS)
COMMERCIAL AND TAX
COMMERCIAL SUIT E231 OF 2022
FG MUGAMBI, J
SEPTEMBER 29, 2023**

BETWEEN

LENS EYE IMAGES LIMITED PLAINTIFF

AND

MEDIAMAX NETWORK LIMITED DEFENDANT

JUDGMENT

Background

1. This suit is founded on infringement of copyright. The plaintiff, Lens Eye Images Limited is a limited liability company incorporated to carry out video and photography business. The defendant, Mediamax Network Limited is also a limited liability company in media business with investments in platforms including newspaper print operations, television and radio broadcasting, digital and online services.
2. The plaint dated 23rd June 2022 sets out the dispute between the parties, the gist of which is the publication by the defendant, of two photographs taken by the plaintiff without the consent or acknowledgement of the plaintiff. The photographs were published in the defendant's newspaper, The People Daily, on social media and on its website, epaper.pd.co.ke. The first photograph was used on 9th April 2020 at page 29 of The People Daily newspaper. The second photograph was used on 26th February 2022, in the same paper.
3. The plaintiff decried the breach of duty and infringement of its copyrighted images and sought a declaration that the defendant's actions are a violation of its rights under the Copyright Act, injunctive reliefs as well as damages and costs of the suit.
4. The defendant entered appearance and filed its statement of defence dated 18th July 2023. The gist of its defence is that the images were used as fair dealing and therefore fell under the exceptions to copyright



infringement. It also averred that the phrase “photo courtesy” was used in both photographs first as it was an acceptable mode of acknowledging the author of a copyright and second as it was not possible to establish the plaintiff as the owner of the second photograph.

5. The defendant denied having truncated and removed the plaintiff’s watermark on the second image and instead stated that the image in question was sourced from a social media platform (WhatsApp Status) and did not have the plaintiff’s watermark as alleged. The defendant further denied the statistics of circulation in the plaint.
6. During the hearing parties each called 1 witness. PW1, was Antony Munge, the director of the plaintiff company, who adopted his witness statement as his evidence in chief. During cross examination the witness confirmed that he had taken both photographs.
7. The first photograph was taken around 20th May 2018 and was water marked with the plaintiff’s logo. He testified that he had given the photo to one of the persons appearing in it but with an agreement not to share it although he could not confirm whether it was shared with other people or not. The witness also stated that this photograph was used by the defendant in a story about one Felix Oloo, a renowned coach, to identify him and inform the public who he was.
8. The second photo, featuring rugby players celebrating during the Kenya cup match between Nondies v Impala at Ngong race course was taken on 19th February 2022. On 20th February 2022, the plaintiff watermarked it and posted it on its Instagram page, leriseyeimages. PW1 further confirmed that the article and the photograph that appeared in the defendant’s paper were about the game of rugby.
9. The witness confirmed that he did not have the consent of the persons appearing in the photographs to take the photos. That the photographs had not been used in a derogatory way by the defendant and that they had the words photo courtesy written on them. He acknowledged that the images were used for information and for purposes of reporting current events. The witness noted that there was an advertisement on the same page as the page where the second image was used and decried the fact that he was not able to sell the photos as the defendant had used them already.
10. DW 1 was James Waindi, a sports editor with the defendant. He also adopted his witness statement as his evidence in chief. During cross examination he confirmed that he was not in a position to confirm if the pictures had been taken by the defendant but that as far as he was concerned, the defendant had not paid for the use of the photographs in the articles He did however confirm that the photos had been published in a newspaper owned by the defendant, that the newspaper was a free publication given to the public and that it had wide circulation in the country.
11. When referred to the advisory from KECOBO on acknowledgement of copyright holders, it was the witness’s testimony that the advisory bore no date. As such it was difficult to tell whether it was published before or after the pictures had been published. The witness stated that the images were used for information purposes and that the first picture was in fact sent to the defendant by the said Felix Oloo.

Analysis and Determination

12. I have carefully considered the pleadings, testimony, evidence and totality of the submissions and authorities cited by the parties in respect of their respective cases. In my view, there are three issues for determination:
 - i. Whether plaintiff is the copyright protected proprietor of the images published by the defendant on the 9th of April 2020 and 26th of February 2022.



- ii. Whether there was an infringement of copyright by the defendant.
- iii. Whether the plaintiff is entitled to the remedies sought in the plaint.

Whether Plaintiff is the Copyright Protected Proprietor of the Images Published by the Defendant on the 9th of April 2020 and 26th of February 2022.

13. It is a well-known fact that copyright protects creative works of the human mind. It regulates the ownership and exercise of rights in creative works. Copyright laws vest exclusive rights in the creators of works of authorship. In Kenya, copyright is regulated by the *Copyright Act* (hereinafter the Act). Section 2(1) defines an owner of a copyright as the first owner, an assignee or an exclusive licensee, as the case may be, of the relevant portion of the copyright. The Act also recognizes the author of a photograph, as the person who is responsible for the composition of the photograph.
14. PW1 testified that he took both photographs and watermarked them. The defendant's witness did not controvert the testimony by PW1. He did not claim ownership of the photographs either.
15. I am satisfied that the plaintiff established that he was the composer of the two images and thus, the rightful owner under section 2 of *the Act* and as such enjoyed the rights appurtenant thereof.
Whether there was an infringement of copyright by the defendant.
16. Section 2 defines infringement to mean any act which violates a right protected by *the Act*. The exclusive rights which an owner of a copyright enjoys are listed in section 26. These are rights to the reproduction, translation, adaptation, distribution, sale, rental, lease, hire, loan, importation, communication and broadcasting within Kenya.
17. Copyright is infringed by a person who is either not the owner of the copyright or a licensee of the owner doing any of the acts which are granted to a copyright owner and which are prohibited under section 35 of *the Act*. Section 35(4) of *the Act* in turn provides for the remedies available in case of infringement.
18. It is important to note that copyright protection is not absolute. *The Act* provides for exceptions to copyright protection in section 26(3) and in the second schedule to *the Act*. It provides that the exclusive rights granted under section 26 shall not include the right to control the doing of any of those acts by way of fair dealing for the purposes of scientific research, private use, criticism or review, or the reporting of current events.
19. From my reading of the pleadings and submissions by the parties, the authorship of the photographs by the plaintiff and subsequent use of the images by the defendant are not disputed. The crux of the defence raised by the defendant is that the plaintiff's copyrighted work was used as fair dealing. This defense describes a number of circumstances in which copyright works or extracts from them can be used without permission from, or payment to, the copyright owner. The defendant relied section 26(3) and paragraph 1 of Part A of the second schedule to *the Act*.

Infringement or Fair Dealing?

20. The defendant cited the case of *Communications Commission of Kenya 5 Others V Royal Media Services Ltd & 3 Others*, [2014] eKLR, where the Supreme Court had the opportunity to consider the defence. The Court noted that the Act does not define what is 'fair' leaving it to the courts to determine fairness on a case to case basis. The Supreme Court however went on to adopt a criterion that courts may consider when determining the defence.



21. The Court cited with approval from the holding of the Supreme Court of Canada, in *CCH Canadian Ltd. v Law Society of Upper Canada*, [2004] 1 SCR 339, 366; 2004 SCC13 (CCH). The parameters of fair dealing have also been the subject of judicial discourse in the South African decision of *Moneyweb Pty Ltd v Media 24 Limited and Another*, 31575/2013 and the US decision in *Russell Brammer V Violent Hues Productions, LLC* United States Court of Appeals for the Fourth Circuit No. 18-1763.
22. In the latter (US) decision, the Court laid out the justification for the defence of fair dealing by stating that:

“The fair use affirmative defence exists to advance copyright’s purpose of promoting the progress of science and useful arts. The defence does so by allowing others to build freely upon the ideas and information conveyed by a work but fair use is not designed to protect lazy appropriators. Its goal instead is to facilitate a class of uses that would not be possible if users always had to negotiate with copyright proprietors. The ultimate test of fair use is whether the progress of human thought would be better served by allowing the use than by preventing it.”
23. The totality of these decisions points out to the following factors that the Court is required to consider so as to determine whether the actions of the defendant fall within the copyright exception of fair dealing:
 - i. The purpose and character of use
 - ii. The amount of the dealing;
 - iii. Alternatives to the dealing
 - iv. The nature of the work;
 - v. Effect of the dealing on the work
24. The protection of copyright vis-à-vis the defence of fair dealing requires a delicate balance between a copyright owner and the rights of the public. The Court in the *Russell Brammer case* (*supra*), noted that if the ordinary commercial use of stock photography constituted fair use, it means that professional photographers like the plaintiff would have little financial incentive to produce their work.
25. The purpose and character of use is concerned with whether the use is of a work is for commercial nature or is for non-profit educational purposes. The consideration should be whether the user stands to profit from exploitation of the copyrighted material without paying for it.
26. DW1 testified that the photographs were used to accompany two articles. The first article was published for purposes of informing the public about Felix Oloo, a renown sports personality (in an article titled *Gifted Talent Shaper*). The second article was published to bring the use of rugby slang terms to the knowledge of the public (in an article titled *From Kinyozi to Yumbet-Hilarious Kenyan Rugby Slang Terms and What They Mean*). I note that the plaintiff did not controvert these submissions by the defendant and as such, I am satisfied that the articles were published for purposes of informing the public.
27. As observed by the Court in the *Communications Commission of Kenya case*, a purpose whose aim is to ensure that the public has access to information passes the rationale of fair dealing.
28. In any case, no evidence was presented to the Court that the website where the pictures were uploaded were used to generate direct revenue or that the publication owned by the defendant derived direct



revenue through advertisement. The evidence that the publication is a free publication was also not controverted by the plaintiff.

29. With respect to the amount and substantiality of the portion used in relation to the copyrighted work as a whole, the *Halsbury's Laws of England*, Vol 9(2), 5th ed at pg 235, provides that this consideration looks not just at the quantity but the value of the work that is used. The defendants cited the case of *Nairobi Map Services Limited v Airtel Networking Kenya Limited & 2 Others*, (2019) eKLR where it was held that:

“In order to be an infringement of a man's copyright there must be a 'substantial infringement' of the work and a mere Fair Dealing with any work falls outside the mischief of the *Copyright Act*.”

30. The defendant submitted that in the first publication, only one (1) photograph is contested out of the six (6) photographs appearing in the same page alongside the article. In the second publication, there is again only one (1) photograph in issue. In both instances, I note that there was a single use of the plaintiff's work in the entire newspaper, on both occasions. I would apply the established principle of de minimis as established in *Ringgold v Black Entertainment Television, Inc.*, 126 F.3d 70, 77 (2d Cir. 1997). The Court observed that the copying of the protected material is so trivial "as to fall below the quantitative threshold of substantial similarity, which is always a required element of actionable copying.”
31. I find that the use of the plaintiff's work was not substantial as to fall within the quantitative threshold of actionable copying.
32. I must however point out that the defendant could just as easily have accomplished its goal of depicting the legendary coach and the rugby piece by using a photograph that it had copyright for, or paid a license to use or used a free license photo instead of using the plaintiff's two photographs as an alternative to the dealing. It is not clear why the defendant did not do so, particularly since it was in the media business.
33. That said, the nature of the work is an enquiry on whether the work was published or unpublished at the time of use. This would go towards determining the level of protection that the photos merit. The plaintiff testified that he had already given a copy of the first photo to one of the persons who was in the photo, by the name of Stephen.
34. Although the plaintiff testified that he asked him not to share the photograph, he was not in a position to confirm whether the pact was kept. There is every possibility that the photograph was published in other circles and this is how it came to be in the hands of the defendant. The defendant stated that they received the photograph from Mr. Felix Oloo. The plaintiff further testified that the second photo had been uploaded from the plaintiff's Instagram page.
35. Considering that photographs are visual works which are ordinarily created and sold or licensed for repetitive viewing, I would disagree with the plaintiff that he is unable to use the works by virtue of them having been used by the defendant. This goes to an enquiry on the effect of the use by the defendant on the potential market for or value of the copyrighted work. I am of the view that there was no prejudice to the plaintiff for the use of the works since by the time the photographs were used by the defendant, they had already been published. I would find that the plaintiff still had and enjoyed the right of first publication for both works.
36. The Supreme Court in the *Communications Commission of Kenya case* recognized that the effect of having the reproduced work competing with the original work had potential for unfair dealing.



37. Considering the factors that I have stated, I do not think that there is any market harm that would be caused by the defendant's use of the plaintiff's work. The fact that the newspaper is a free publication limits the possibility of the defendant exploiting the plaintiff's images for commercial gain. The plaintiff alleges that the pictures and particularly the second picture was used to lure advertisements for the defendant.
38. I am not convinced by this submission because no evidence has been placed before the Court to prove that the advertisement that ran in the second publication was a result of the picture that was published by the plaintiff. Besides, no evidence was tendered by the plaintiff to show that the actions of the defendant decreased the market for the plaintiff's work.
39. I am therefore of the opinion that the conduct of the defendant would not result in a substantially adverse impact on the potential market for the plaintiff's original photographs such that once the photos had been published the market for them would be diminished.
40. Finally, it has been held that fair dealing with a copyrighted work does not result to infringement provided that there is sufficient acknowledgment of the copyright owner. The plaintiff takes issue with the use of the words "photo courtesy" as an acknowledgement by the defendant. The plaintiff relied on the directive issued by the Kenya Copyright Board that the term "photo courtesy" was not an acknowledgement as an acknowledgement must clearly show name of the author.
41. In his defense, the defendant states that the first image was printed together with the plaintiff's name; Lens Eye Images Limited. The acknowledgment took the form of the plaintiff's name appearing on the photograph and on the second image since it did not have any legible identification, the editor acknowledged by way of "photo courtesy". I must say here that no evidence has been laid before the Court to blame the defendant for truncating the image and removing the plaintiff's watermark. In response to the advisory from the Kenya Copyright Board (KECOBO), the defendant states that the advisory on acknowledgment came much later after the images had been published and cannot be applied retrospectively to the images that had already been acknowledged as photo courtesy.
42. I have considered the said advisory and I note that KECOBO acknowledges that photo courtesy had gained widespread use as a form of acknowledgment within the Kenyan market, forcing KECOBO to issue the advisory of what entails sufficient acknowledgment. This advisory in my view was only a restatement of the legal requirement of acknowledgment in copy right law and that it did not serve to prescribe any new requirement under copyright law.
43. Sufficient acknowledgment ought to indicate the name of the author and the name of the work. The defendant being in the media industry ought to have known what the parameters of sufficient acknowledgment were and cannot therefore rely on the advisory as an excuse for not sufficiently acknowledging works of another artist. The defendant has not shown what efforts it put in to determine the ownership of the second photograph. On this ground, I would find that the defendant failed to sufficiently acknowledge the plaintiff's work.

Whether the Plaintiff is Entitled to the Remedies Sought in the Plaintiff.

44. Having found that the defendant had satisfied all the grounds for fair dealing save for sufficient acknowledgment, I now turn to the remedies and if the plaintiff is entitled to any. The plaintiff prayed for general and punitive damages against the defendant.
45. Section 35(6) of the Act provides for the assessment of damages based on the resulting loss suffered once infringement has been proved. I note that this Court is required to consider the flagrancy of



the infringement as well as the any benefit shown to have accrued to the defendant by reason of the infringement.

46. Judicial pronouncements further require the court to consider the loss suffered from the alleged infringement or the loss of profit which a plaintiff might otherwise have made. These observations were made by the Court in *Mathew Peevers v Leo Slingerland & Another*, [2000] eKLR as well as in *Nairobi Map Services Limited v Airtel Networking Kenya Limited & 2 Others*, [2019] eKLR.
47. I have already stated that the defendant did not benefit commercially from the infringement and that the infringement herein was very trivial, although the defendant cannot be excused for not sufficiently acknowledging the plaintiff as the author of the work.
48. Unfortunately, the Court is unable to form a basis for calculation of the damages suffered by the plaintiff in the absence of any evidence on which to base its calculations. The plaintiff alluded to a catalogue which was not produced. I am of the view that the plaintiff has not proved the general damages claimed.
49. In the circumstances, I award nominal damages of Kshs. 500,000/= with interest at court rates until payment in full and costs of the suit.

DATED, SIGNED AND DELIVERED IN NAIROBI THIS 29TH DAY OF SEPTEMBER 2023.

F. MUGAMBI

JUDGE

