



REPUBLIC OF KENYA

IN THE HIGH COURT OF KENYA AT NAIROBI

MILIMANI COMMERCIAL & TAX DIVISION

CIVIL SUIT NO. 827 OF 2009

HILTON MWAKIO JUMA.....PLAINTIFF

-VERSUS-

TELKOM ORANGE TELKOM K LTD.....1ST DEFENDANT

ROYAL MEDIA SERVICES LTD.....2ND DEFENDANT

RADIO AFRICA LTD.....3RD DEFENDANT

HOMEBOYZ ENTERTAINMENT LTD....4TH DEFENDANT

JUDGEMENT

PRELIMINARY

1. The evidence of the plaintiff, in this action was recorded by **Justice Ochieng**. The judge was transferred from the Commercial and Tax Division of the Milimani high court and I proceed to receive the defense evidence.

2. Although as the title of this action will show there were four defendants when this action was filed, the case against the 3rd defendant was withdrawn and 2nd and 4th defendants although served with the summons and plaintiff failed to file their appearance and defences. The plaintiff did not proceed to seek judgment against them in default of appearance and defence. The case proceeded against the 1st defendant.

INTRODUCTION

3. The plaintiff, **Hilton Mwakio Juma** is a male individual who resides in Nairobi. He is a musician. He engages in composing, singing and performing music. The plaintiff composed and produced a musical work called "**Taki Riddim**".

4. The 1st defendant, sued as Telkom Orange Telkom Kenya Limited, is a company registered under the Companies act having it registered office in Nairobi. It is licensed to provide telecommunications and other services to the public under the provisions of the **Kenya Communications Act, 1998**.

5. This action brought by the plaintiff is for damages for the infringement of the plaintiffs copyright in the musical work entitled "**Taki Riddim**".

6. The plaintiff, by this action, alleges that on or about the month of **February 2009** the 1st defendant composed a promotional advertising project known as **Niaje Tariff**. That in that project, the 1st defendant imported into the advertisement the rhythm of the plaintiff's musical work "**Taki Riddim**". That the advertisement was run for several seconds, usually at peak hours and was repeated several times in the day on Citizen Radio, Kiss FM and Homeboyz Radio.

7. The plaintiff alleged that the use of his musical work was without his permission or authority of the plaintiff. The plaintiff therefore alleged that his copyright had been infringed by the 1st defendant.

8. The 1st defendant by its defence denied that it was a business venture between Telkom Kenya and Orange Communication. It pleaded that it is Telkom Kenya Limited and is registered as such under the companies Act.

9. The 1st defendant by its said defence denied that the plaintiff was the author and the producer of the musical work entitled “**Taki Riddim**”. It however admitted that **Niaje Tariff** was part of GSM communications service products.

10. Further that the 1st defendant in **July 2008** entered into commercial communication contract with Access Led Burnet Ltd (ALBL). Under that contract ALBL was to create and supply audio advertisements of independent origin for the 1st defendant. ALBL created **Niaje Tariff** advertisement. 1st defendant further pleaded that, without prejudice to the previous pleadings, if the **Niaje Tariff** advertisement was a reproduction of the rhythm “**Taki Riddim**” the same was coincidental.

11. The 1st defendant has pleaded that it did not know nor did it have reason to believe the existence of the plaintiff’s alleged copyright in the musical work entitled “**Taki Riddim**”, or that the plaintiff suffered loss and damage.

EVIDENCE

12. The plaintiff in his evidence in chief stated that the 1st defendant started to promote a product known as **Niaje Tariff** on various media houses in the year 2009.

13. That the product was in the form of music which music was from his musical work called “**Taki Riddim**”.

14. On being cross examined the plaintiff stated that he composed, in the year 2005, 19 songs comprising of “**Taki Riddim**”. That between the years 2005 and 2006 he launched and promoted the song “**Taki Riddim**”. He was however unable to produce receipts to prove that promotion. He also accepted that he had not shown to the court the frequency of playing is musical work and nor had he provided evidence of royalties collect in respect to that musical work. He stated that in the year 2009, which is the period in this case royalties were not been collected.

15. The 1st defendant’s evidence was led by **Nelson Mogaka**.

This witness confirmed that the 1st defendant did a promotion known as **Niaje Tariff**. He then stated:

“It has now come to our attention that promotion contained a part of the plaintiff’s music.”

16. That 1st Defendant had contracted ALBL to do the production and advertisement of the **Niaje Tariff**. The said ALBL under that contract had indemnified the 1st defendant in the event the 1st defendant was sued.

17. That witness also relied on his written statement.

18. By that statement the witness stated that the 1st defendant was registered as Telkom Kenya Ltd and was not registered as sued in this action.

19. He further stated that the 1st defendant had entered into a contract with ALBL whereby ALBL was to undertake, on behalf of the 1st defendant, telecommunication product launches, promotions, management of media planning and placing of advertisement supervision, management and co-ordination of production works or events. One such promotional media advertisement by ALBL was the product called **Niaje Tariff**.

20. The witness, in evidence then stated that the 1st defendant had no knowledge and reasonable grounds of suspecting the subsistence of copyright in the plaintiff’s musical work entitled **Taki Riddim**.

ISSUES

21. Although the parties identified eight issues for determination by the court, having considered the parties pleadings, evidence and submissions I am of the view those issues can be condensed into four issues. The four issues are as follows:

(i) Is Telkom Kenya Limited a party in this action?

(ii) Is there a copyright in the musical work called Taki Riddim?

(iii) If so what claim if any is the plaintiff entitled to.

(iv) Who will bear the costs of the suit?

ANALYSIS AND DETERMINATION

22. The first issue for consideration is whether Telkom Kenya limited is a party in this suit. The title that the plaintiff gave to the 1st defendant in this action is “**Telkom Orange Telkom Kenya Limited**”.

23. The 1st defendant's contention is that Telkom Orange Telkom Kenya Ltd is not the Corporate person in the name of Telkom Kenya Ltd. Indeed the 1st defendant produced its certificate of incorporation No.C.75646 dated **3rd April 1997** which reflects the corporate name as Telkom Kenya Ltd.

24. What is clear from the pleadings is that the plaintiff combined two names into one. On one part it seems there is Telkom Orange and Telkom Kenya Ltd.

25. Telkom Kenya Ltd by its defence admitted that it contracted with ALBL to create advertisement or promotion and that one such promotion was **Niaje Tariff**. The plaintiff's claim herein is that his copyright in the musical work entitled **Taki Riddim** was infringed when the advertisement of **Niaje Tariff** was aired on radio stations. It therefore follows that it is Telkom Kenya Limited and not Telkom Orange who is the rightful party in this action. The suit does not fail for the combination of the two names. This finding by me is supported by Order 1 Rule 9 of the Civil Procedure Rules which provides:

“No suit shall be defeated by reason of the misjoinder or non-joinder of parties, and the Court may in every suit deal with the matter in controversy so far as regards the rights and interests of the parties actually before it.”

26. The parties before Court are **Hilton Mwakio Juma** the plaintiff, and Telkom Kenya Ltd the 1st defendant.

27. It is also worthy to note that the contract between the 1st defendant and ALBL dated **25th August 2008** clearly states that Orange is the brand name of Telkom Kenya Ltd: see clause 15 thereof.

28. This Court therefore finds that the 1st defendant is Telkom Kenya Ltd and it follows that Telkom Kenya Limited is a party in this case.

29. The plaintiff by evidence and from correspondence, part of 1st defendant's documents, proved that the copyright in the musical work of **Taki Riddim** belongs to him.

30. There is an email by **Patrick Mogaka**, an employee of ALBL, which showed that that musical work was forwarded to Kiss Kcreative production house for use in a promotion that was called 'keep it Kenya'. Kiss Kcreative then without licence or permission from the plaintiff used the music bed of the musical work Taki Riddim to create the Niaje Tariff promotion. It is that promotion of Niaje Tariff that was aired on radio without the plaintiff's permission.

31. It is clear therefore, that the plaintiff had exclusive right to control any reproduction and distribution of his original musical work entitled Taki Riddim. See section 26 of the copyright Act No. 12 of 2001.

32. The answer to issue (ii) above is therefore in the positive, that is there was copyright in the musical work Taki Riddim which copyright was held by the plaintiff.

33. The plaintiff has sued the 1st defendant claiming that the 1st defendant infringed his musical work. The plaintiff by the action prayed for an injunction to restrain the 1st defendant from further infringing his musical work. The plaintiff also prayed for an order for the 1st defendant to deliver up to the plaintiff Niaje Tariff in its possession. The plaintiff further prayed for damages or in lieu such amount of royalties which could have been paid had the plaintiff license been sought.

34. This court by the ruling dated **20th August 2010** granted the plaintiff an interlocutory injunction restraining the 1st defendant from infringing the plaintiff's musical work and playing or continuing to play an advertisement by the name Niaje tariff on radio stations.

35. I listened to the musical work Taki Riddim and to the promotional advertisement Niaje Tariff. I am satisfied that the Niaje Tariff advertisement copied and reproduced the musical work Taki Riddim. Since the plaintiff has proved he did not grant permission for the use of his musical work his copyright in that musical work was therefore infringed.

36. Having made that finding what claim is the plaintiff entitled to. To answer that issue I will first refer to section 35 (5) of copyright Act. It provides:

“(5) Where in action of infringement of copyright it is proved or admitted-

(a) that infringement was committed; but

(b) that at the time of the infringement the defendant was not aware and had no reasonable grounds for suspecting that copyright subsisted in the work to which the action relates, the plaintiff shall not be entitled under this section to any damages against the defendant in respect of the infringement whether or not other relief is granted under this section.”

37. The 1st defendant through the evidence of its witness **Nelson Mogaka** and through the documents relied on by it show that the it contracted with ALBL to create promotional advertisement and it seems that ALBL used a musical bed supplied by Kiss Kreative production house, which musical indeed was the musical work of the plaintiff. The 1st defendant denied knowledge of the existence of the plaintiff's copyright in that musical work entitled Taki Riddim.

38. The plaintiff did not controvert that evidence. It follows that the 1st defendant did not know of the plaintiff's copyright in that musical

work. Section 35 (5) (b) is therefore applicable in this regard.

39. Going by the provisions of section 35(5) of the copyright Act the plaintiff, because of the lack of knowledge of the 1st defendant of the existence of that copyright, is not entitled to the claim of damages. The plaintiff in his evidence abandoned his claim for royalties because as stated when his copyright was infringed royalties were not collected. The plaintiff did confirm when being cross examined that he had not given evidence or his claim for royalties.

40. It follows that the only claims that the plaintiff will be entitled, in view of my findings under Section 35(5) of the Copyright Act is for injunction and for delivery to the plaintiff by the 1st defendant of the Niaje Tariff work.

41. The plaintiff having substantially failed to prove its claim against the 1st defendant will only obtain ½ of the cost of this suit.

42. In the end this court makes the following findings:

(a) An injunction is hereby granted restraining the 1st defendant, Telkom Kenya Ltd, its officers, servants or agents from infringing the plaintiff's copyright in the musical work Taki Riddim.

(b) The 1st defendant shall within 30 days deliver to the plaintiff the Niaje Tariff work which used the plaintiff's musical work Taki Riddim.

(c) The plaintiff's claim for damages and royalties is dismissed.

(d) The plaintiff is awarded half of the costs of this action to be taxed by the taxing master.

DATED, SIGNED and DELIVERED at NAIROBI this 29th day of November, 2018.

MARY KASANGO

JUDGE

Judgment read and delivered in open court in the presence of:

Court Assistant.....Sophie

..... for the Plaintiff

..... for the Defendants

MARY KASANGO

JUDGE