



REPUBLIC OF KENYA
IN THE HIGH COURT OF KENYA AT NAIROBI
COMMERCIAL AND ADMIRALTY DIVISION
MISCELLANEOUS SUIT NO. 193 OF 2015

JOSEPH MUYALE INZAI.....APPLICANT

- VERSUS -

**HENRY WANJALA, SYLVESTER MATETE MAKOBI, CLIFF NJORA NJUGUNA,
MASAMBAYA FREDRICK NDUKWE AND GEOFFREY SAUKE TOGETHER T/A**

KENYA BOYS CHOIR.....1ST RESPONDENT

HENRY WANJALA, CLIFF NJORA NJUGUNA GEOFFREY SAUKE TOGETHER T/A

BOYS CHOIR OF KENYA.....2ND RESPONDENT

JUDGEMENT

1. On 27th February 2015 the Assistant Registrar of Trade Marks, Ms Eunice Njuguna, delivered a Ruling in which she ordered that the Register of Trade Marks be rectified by expunging therefrom the trade mark No **KE/T/2010/67586 “KENYA BOYS CHOIR?”**.
2. In arriving at that decision the Registrar held that the trade mark had been entered in the Register of Trade Marks without sufficient cause and in error, as the Applicants were not entitled to the said mark, in law.
3. The appellant, **JOSEPH MUYALE INZAI** was the registered proprietor of the trade mark in issue. The trade mark was registered on 26th January 2010.
4. The respondents are **HENRY WANJALA; SYLVESTER MATETE MAKOBI; CLIFF NJORA NJUGUNA; MASAMBAYA FREDRICK NDUKWE** and **GEOFFREY SAUKE**, Together Trading As **KENYAN BOYS CHOIR**; plus **HENRY WANJALA; CLIFF NJORA NJUGUNA; GEOFFREY SAUKE** Trading As **BOYS CHOIR of KENYA**. The said respondents filed an application before the Registrar of Trade Marks, seeking rectification of the Register. The application for rectification of the register was filed on 11th April 2011. It is that application which was finally determined on 27th February 2015. When the Register of Trade Marks ordered that the trade mark **KENYA BOYS CHOIR** be expunged from the record, the appellant felt aggrieved, and moved to the High Court, on an appeal. This judgement is in relation to that appeal.
5. The appellant’s position was that the learned Registrar erred on the following issues;

“a). The Learned Registrar erred in fact in holding that the KENYA BOYS CHOIR was derived from the Aquinas Boys High School without attributing the derivation

of the choir and the works performed to me as the Founder and Director of the Choir;

b) The Learned Registrar erred in fact in holding that my contribution to the KENYA BOYS CHOIR had been acknowledged and rewarded whereas the only reward received was from training Aquinas High School which was a hired trainer and Director;

c) In making the above finding the Learned Registrar relied on the letter dated 29th March 2004 where there was an alleged change of name and form of Aquinas Boys Choir to Kenya Boys Choir;

d) The Learned Registrar failed to consider the evidence on oath of the applicants on paragraph 11 of the First Declaration that the ‘decision to transform the Aquinas High School to a national choir was made during the tour’;

e) Paragraph 12 of the first declaration states that the members of the Aquinas High School choir resolved to establish a national choir upon their return from the tour in the United States;

f) Therefore, the Learned Registrar erred in holding that the letter dated 29th March 2004 was referring to a ‘transformed Aquinas High School Choir’ because such Choir never existed;

g) The above notwithstanding, the Learned Registrar totally erred in concluding that the KENYA BOYS CHOIR and the Aquinas High School Choir were the same;

h) I was hired to train the Aquinas High School Choir and not the KENYA BOYS CHOIR. As indicated above, the KENYA BOYS CHOIR is made up of young men/boys who have various music talents. The majority of these members were drawn from the Aquinas Boys Choir which I was training when the KENYA BOYS CHOIR was formed. Reference is made to pages 115 to 124 which contains the details of the recruited and the various dates they were recruited;

i) As is clear from the consent forms, some of these members were not students at Aquinas High School;

j) Although the KENYA BOYS CHOIR drew its first membership mainly from Aquinas Boys High School, it was and is an independent choir from the school and also from the school’s choir. In fact as at 2004, the KENYA BOYS CHOIR drew its membership from Aquinas Boys High School continuing and former students and also members from other schools;

k) A press release on page 29 herein by St. Louis African Chorus where they acknowledged that I am the founding director of BOYS CHOIR of KENYA. It goes further to state that the BOYS CHOIR of KENYA is (was) located at the Aquinas High School in Nairobi;

l) Lastly, it is notable that none of the respondents produced evidence to show that they were students of Aquinas High School at the time of its formation or change of name from Aquinas Boys Choir to KENYA BOYS CHOIR?.

6. According to the appellant, the choir had, from its inception performed at various functions, leading to their being invited to perform at the **FESTIVAL of AFRICAN AND AMERICAN MUSIC [FE SAAM 2004]**

7. The appellant insists that he was not just a hired trainer of the choir. He was also the person who directed and founded all the music and songs which were performed by the choir.

8. Therefore, by virtue of those roles, the appellant contends that he had intellectual property rights to the choir.

9. The appellant agreed with the Registrar of Trade Marks that the **KENYA BOYS CHOIR** had morphed into a national entity. However, he believes that the Registrar was wrong when she failed to attribute the tremendous growth and development of the choir, to the appellant's creativity and tremendous effort.

10. According to the appellant, he did not dispute that the Choir could belong to all Kenyans. However, as the founder of the choir, the appellant insisted that he had proprietary rights in the name **KENYA BOYS CHOIR**. Therefore, if the state wished to acquire the name, the appellant insists that the state should comply with the laid down laws, regulations and procedures.

11. The name **KENYA BOYS CHOIR** was perceived by the appellant as giving to the boys, who hailed from different backgrounds, a sense of belonging.

12. But, at the same time, the appellant insisted that the continuous use of the trade mark **KENYA BOYS CHOIR**, in Kenya and abroad, for over 10 years, had gained distinctiveness through which his services could be distinguished. He therefore asked that the court should help protect his legal right to the trade mark.

13. I have re-evaluated all the evidence tendered before the Registrar of Trade Marks. I have also given due consideration to the submissions made by both sides.

14. First, it is common ground that the St. Aquinas High School had a choir before the formation of the **KENYA BOYS CHOIR; THE KENYAN BOYS CHOIR** or the **BOYS CHOIR OF KENYA**.

15. Secondly, the Appellant **JOSEPH MUYALE INZAI**, was hired by the St. Aquinas High School to train the school choir.

16. The appellant has been described as a *“music enthusiast?; “a favorite instructor with participants in the African Choral Music Workshops across the United States and Canada?; “music director and conductor?; “Choral Director Aquinas High School? and “founding director of Boys Choir of Kenya?.*

17. In the *“Daily Nation? newspaper dated 23rd July 2004 there was an article in its “Lifestyle Magazine? which had a story captioned;*

“Aquinas School Choir to take its melody to the US?.

18. The article talked about an invitation to perform in both the United States of America and Canada, between 12th and 31st October 2004.

19. According to the said article, the trip by the Aquinas School Choir had been dubbed the *“North American Tour of the Boys Choir of Kenya?.*

20. And the article went on to explain why the tour organizers had chosen the persons to invite. It said that;

“The choice of Muyale and the Aquinas Boys Choir for the tour,...was because his organization needed a ‘creative music director with an ear for African music’?.

21. The article compared the Aquinas Boys Choir to that of groups such as the Harlem Boys' Choir of New York. And it noted that;

“Besides performing for American and Canadian audiences during the tour, the Aquinas Boys will have a chance to meet and exchange ideas with their age-mates and others interested in cultural exchanges?.

22. The appellant believed in the mission so much that he was prepared to sell his soul to it. That is what he was quoted as saying.

23. There can be doubt at all that the invitation, according to that newspaper article, was to the Aquinas School Choir and the appellant.

24. In other words, the choir, was not synonymous with the appellant.

25. In a press release which was issued by **St. LOUIS AFRICAN CHORUS**, to promote the tour, there was talk about;

“The Boys Choir of Kenya North American Tour?.

26. And in describing the group that would be touring North America, the press release said;

“Perhaps no other African youth choir dominated peer competition like the Boys Choir of Kenya, a choral program located at the Aquinas High School in Nairobi?.

27. In other words, Aquinas High School was the place where the choir was located.

28. On October 1st, 2004 the “Sunday Nation? newspaper carried an article which noted that;

“The Boys Choir of Kenya is Africa’s first boy choir of international standard or repute. The core group is drawn from Aquinas High School, where for years they’ve earned acclaim throughout Kenya as a disciplined choral program with a work ethic that parallels the King’s College Cambridge and the Harlem Boys Choir?.

29. I have cited substantially from the newspaper articles and the press release because those were written by independent persons. In other words, neither the appellant nor the respondents wrote those pieces of information.

30. Secondly, in 2004 nobody knew or could have known that later there would be a dispute between the parties herein. Therefore, I hold the considered opinion that the articles in question cannot have been intended to benefit either of the parties against the other. Viewed from that perspective, the said articles are more probable than not, to have been an accurate reflection of the correct factual position.

31. I am fortified in my said finding by the contents of paragraphs 67 and 68 of the Appellant’s Replying Statutory Declaration, which read as follows;

67 “St. Louis African Chorus through its Director and Founder, DR. Fred, invited some members of St. Aquinas choir in March for a 3 week Cultural Exchange Programme which was to start on October 2004 when I was still teaching and coaching the St. Aquinas High School Choir. That invitation for the tour was extended to the St. Aquinas Boys Choir under my courtesy. That eventually, with the consent of the School and the participants, accompanied by three chaperones went on this United States? (sic!).

68 “The group on the United States Tour was composed of talented boys, members

and non members of the then St. Aquinas Boys High School Choir. However, many members of this group were drawn from the St. Aquinas Choir which I was still Coaching. The group touring the United States was to represent Kenya as the Boys Choir of Kenya which was already in existence by this time. I refer to annexure marked JMI4 above where the St. Louis African Chorus even recognized that their invitation was to the St. Aquinas Choir as the representatives of the Boys Choir of Kenya?.

In a nutshell, the St. Aquinas High School Choir was not founded by the Appellant. He was only hired as its conductor, because he was recognized as possessing unique skills and passion.

32. Secondly, it is the choir which was invited.

33. However, those who went on the tour were not limited to students of the School Choir. Whilst the bulk of the boys were from the school choir, there were other members from elsewhere.

34. In effect, the St. Aquinas High School Choir did grow into the **KENYA BOYS CHOIR**. The learned Registrar of Trade Marks was therefore not wrong to have concluded that the **KENYA BOYS CHOIR** was derived from the St. Aquinas Boys High School Choir.

35. I also find that the learned Registrar of Trade Marks expressly noted the fact that;

“The Proprietor’s irrefutable commitment to the Kenya Boys Choir has been acknowledged and recognized both in Kenya and internationally?.

36. That is clear recognition of the immense contribution which the Appellant made to the development of the choir.

37. The Registrar of Trade Marks did not make a finding on the issue as to whether or not the Appellant had been rewarded for his contribution. But the question about the reward, if any, had been given to the Appellant, was not an issue for determination by the Registrar. Therefore, the failure to make a finding in that respect did not render the Registrar’s decision erroneous.

38. As regards the letter dated 29th March 2004, the Registrar said that by virtue of the recognition of the Appellant’s commitment to the Choir, that could not amount to the transfer of the intellectual property associated with the choir.

39. In my understanding, the Appellant has talent, passion and commitment in African choral music. He has ability to compose songs. He also has the ability to transform old songs, both in lyrics and presentation.

40. Those are his assets, which are in the nature of intellectual property.

41. On the other hand, it was the boys who sang and performed the songs. If the boys did not compose, arrange or conduct the songs or performances, they could not be given credit for those aspects of the songs and the performances. The boys could only be credited with the singing and performances.

42. Whilst the said singing and performances could be credited to the boys, the composition and arrangement could only be credited to the Appellant or such other person or persons who undertook those tasks.

43. The appellant cannot have been credited for singing and performing well, as a choir. He was not the choir. He was the Director, the Conductor or the Instructor. Therefore, when the prowess of the Appellant was recognized for the tasks he had excelled in, that did not, and could not transfer

to the Appellant, the intellectual property which vested in the choir.

44. Accordingly, I find that the Registrar's view on that aspect of the case was accurate.

45. I further find that it was Dr. Fred Onovwerosouke, the Founder & Artistic Director of African Chorus, St. Louis, who first stated that the St. Aquinas Boys High School Choir would, during their tour of the United States in October 2004, be representing Kenya as the Boys Choir of Kenya.

46. The appellant's suggestion that it was only during the tour that a decision was made to transform the choir to the Boys Choir of Kenya, is not borne out by the evidence.

47. The appellant's criticism of the Registrar, that she had concluded that the **KENYA BOYS CHOIR** was the same as the Aquinas High School choir, is also lacking in foundation. The Registrar expressed the view that the **KENYA BOYS CHOIR** was derived from the Aquinas High School Choir.

48. The "**Oxford CONCISE?** Dictionary defines the word "*derive?* as;

"Originate; be formed from; be descended or obtained from, arise from; show or state the origin of?.

49. That would imply that the Kenya Boys Choir was formed from the Aquinas High School Choir. The Appellant has confirmed that fact in his Statutory Declaration. He also reiterated that fact in paragraph (h) and (j) of his appeal herein. He cannot therefore fault the Registrar for arriving at a conclusion which was well anchored in fact and also in law.

50. If the registration of the trade mark in the name of the appellant remained in the Register of Trade Marks, he would be entitled to the exclusive right to use it. Therefore, the boys who were performing under that trade mark or under any of the other 2 derivatives could not be permitted to use it without his authorization or his concurrence.

51. It was for that reason that the Respondents were, correctly, held to be aggrieved persons pursuant to Section 35 of the Trade Marks Act.

52. The Respondents were not simply persons who had wished to gratify their intellectual concerns. The continued validation of that trade mark, in the appellant's name, could have a direct and adverse impact on the Respondents.

53. For all the reasons stated above, I hold the considered view that the learned Registrar of Trade Marks made the correct determination on the application which the Respondents had lodged. Therefore, there is no merit in the Appeal. The said Appeal is thus dismissed, with costs to the Respondents.

DATED, SIGNED and DELIVERED at NAIROBI this 27th day of January 2016.

FRED A. OCHIENG

JUDGE

Judgement read in open court in the presence of

Miss Mwangi for the Appellant

Kanyonge for the 1st Respondent

Kanyonge for the 2nd Respondent

Collins Odhiambo – Court clerk