



REPUBLIC OF KENYA

IN THE HIGH COURT OF KENYA AT NAKURU

PETITION NO.8 OF 2010

FRANCIS GICOHI & 20 OTHERSPETITIONERS

VERSUS

KENYA COPY RIGHT BOARD..... 1ST RESPONDENT

THE ATTORNEY GENERAL2ND RESPONDENT

RULING

The petitioners have moved this court under articles 26, 28, 29, 31, 34, 35, 40, 43, and 46 of the Constitution claiming that the 1st respondent published a notice in the Daily Nation Newspaper of 28th May, 2010 intimating its intention to implement an anti-piracy security device for, among others, audio visual works. The notice is said to have been issued under **section 36 of the Copyright Act, No. 12 of 2001.**

The petitioners argue that the works they sell and which the 1st respondent seeks to regulate through the impugned notice do not emanate in Kenya (are works of foreign actors and producers); that the works are produced and/or manufactured in foreign countries and exported to Kenya. Further that they do not have and cannot possibly establish contacts with the manufacturers and producers of the works; and that they derive their livelihoods from the sale of those works and have no other source of income.

The petitioners contend that 'Section 36 of the Copyright Act does not require a trader dealing in foreign works to apply for authentication of such work; that the section only requires the application for authentication to be made by a manufacturers or producers and not dealers in those products. Also that the 1st respondent has no mandate to act on behalf of a foreign producer or manufacturer.

The petitioners have also argued that section 36, in so far as it is being applied to harass them in respect of works manufactured and produced abroad, is unconstitutional.

In opposition to the petitioners' application, the 1st respondent, filed an affidavit sworn by its deputy Executive Officer, Edward Sigei in which he deposes, *inter alia*, that the mandate of the 1st respondent includes enforcement of the Copyright Act, that the principal objective of that mandate is to prevent abuse of property rights vested by the Copyright law on copyright owners (producers and licensees) and that the authentication sticker required under Section 36 is intended to facilitate that mandate.

Contending that the Copyright Act does not create any property rights in favour of traders, stockists or other dealers of copyright products, he explains that the Copyright Act sets out offences to cure the mischief of piracy or infringement of copyright; and that the authentication sticker is intended to facilitate identity and removal of offending products from the market.

As regards the petitioner's contention that section 36 does not apply to them, he contends that any rights holder can and must obtain the authentication sticker upon proof of ownership or entitlement as set out under the Copyright Regulations, 2004.

Regarding the contention that the 1st respondent has no mandate to protect works of foreign producers, he has pointed out that Kenya is a signatory of International Conventions and Treaties, in particular the Berne Convention and the Treaty on Trade Related Aspects of Intellectual Property (TRIPS) Agreement of World Trade Organization. It is contended that under these international Conventions and Treaties, Kenya is obligated not to discriminate between copyright works of citizens and non-citizens. Further that under article 2(6) of the Constitution of Kenya, 2010 Kenya is obligated to give effect to the treaties and conventions to which she is a party.

Arguing that the petitioners have not shown any proof of property ownership or legal recognition under the Copyright, the 1st respondent has submitted that the petitioners should not be allowed to claim rights under the Constitution which rights, if recognized, would take away the property rights of the copyright owners.

Following an order for filing and exchange of written submission issued on 21st October, 2010, the advocates for the respective parties, filed their respective submissions.

From the pleadings herein and the submissions filed by the respective parties, the issues for determination are:-

1. Whether Section 36 of the Copyright Act is unconstitutional?
2. Whether the impugned notice violated or threatened to violate the Petitioners constitutional rights?
3. What is the order as to costs.

Whether Section 36 of the Copyright Act is unconstitutional?

Through the affidavit sworn in support of the petition, the petitioners contend that Section 36 of the Copyright Act, in so far as it purports to create an offence that is not actionable against a foreigner who may not be interested in protecting his/her Copyright in Kenya, is unconstitutional. This contention is reiterated in the submissions filed on behalf of the petitioners.

In a rejoinder, the 1st respondent has submitted that under the **Bernes and Trips Agreements**, to which Kenya is a signatory and which are applicable to Kenya by virtue of **Article 2(5) and (6)** of the **Constitution**; Kenya is obligated to protect Copyright works regardless of their country of origin. Further that **Section 49(b)(ii)** of the **Copyright Act** empowers the Minister to extend the application of the provisions of the Copyright Act to works published in a country which is party to a treaty that Kenya is a party to and which treats copyright works from Kenya in a similar manner.

Reiterating that the works which are the subject of this petition are protected by the Copyright Law of Kenya; and that in view of the provisions of the **Bernes and Trips Agreements**, local and international works cannot be separated; the 1st respondent has submitted that an attempt to separate local and international works for the purpose of protection will be in breach of the country's international obligations under those treaties.

As regards the impugned section of the Copyright Act, the 1st respondent has submitted that owing to escalating cases of piracy of copyright products, the Parliament of Kenya enacted the Copyright Act to deal with the problem of piracy. Further that by introducing a strict liability offence under Section 36, the Parliament aimed at enhancing compliance with the Copyright law. In this regard, the 1st respondent urges the court to find that all what the Section seeks to do is to regulate dealings in Copyright products and not to ban trade.

Upon considering the arguments of the petitioners on the constitutionality or otherwise of the impugned section of the Copyright Act, I find as a fact that the petitioners problem is application of the law to them. I say so because the petitioners don't allege or complain that the law, as applied universally is unconstitutional. Their prayer confirms as much. The prayer is as follows:-

"(b) A declaration that the provisions of Section 36 and more particularly Section 36(5) in so far as it affects the petitioners is unconstitutional and invalid." (Emphasis supplied).

The question that arises is whether a law which is meant to regulate an entire sector can be said to be unconstitutional simply because a certain section of the society is unhappy with it?

In answering this question, I take judicial notice of the fact that the process of law making involves balancing of interests; and that in that process some sections of the society may feel oppressed by the law but that does not render the law unconstitutional. In my view, the question that the petitioners are concerned with is whether their activities/ dealings form part of the activities/dealings sought to be regulated through that Section. I will determine that question in the course of this judgment.

Are the petitioners subject to the regulations contemplated under Section 36 of the Copyright Act?

The petitioners have argued that they are not the manufacturers and/or producers of the works they sell; that the works belong to foreign actors and producers; that the works are produced and/or manufactured out of the country and exported into the country; and that the petitioners do not and cannot establish contacts with the manufacturers and producers of the products they sell.

Contending that **Section 36(1)** of the **Act** only imposes the obligation to apply for authentication of copyright works on a manufacturer or producer of sound and audial visual works or records, the petitioners have submitted that Regulations 11 and 12 which makes it an offence for anyone to import, sell or distribute sound and audio-visual work without an authentication device are inconsistent with **Section 36(1)** as that Section does not impose a similar obligation on a person whose duty is to import and sell the products sought to be regulated under that Section.

Maintaining that the duty to apply for authentication sticker under Section 36(1) lies with a manufacturer or producer, and not a person trading in such works, the petitioners contend that the 1st respondent has no mandate to act on behalf of a foreign producer or manufacturer who may not be interested in protecting his or its copyrights in Kenya. In this regard reference is made to the case of **Music Copyright Society of Kenya Ltd vs. Parklands Shade Hotel Ltd t/a Club House** (2000) KLR 569 where Gacheche, Commissioner of Assize (as she then was) inter alia, observed:-

"(1). Normally, the author of the Music, that is, one who actually writes, compiles or composes it, is the first owner of the copyright. However, a copyright can be transferred by assignment in writing signed by the owner of the right or by its duly authorized agent."

In that case (**Music Copyright Society of Kenya Ltd vs. Parklands Shade Hotel Ltd t/a Club House**) Gacheche opined that the Music Copyright Society of Kenya was not entitled to claim to be the sole licenced authority to enforce copyrights of all musical works. In her view, only the owner of the copyrights would have a right to enforce compliance.

In reply, the 1st respondent has submitted that the Copyright Act, 2001 does not envisage the distribution, importation or any dealing in copyright goods by a person other than the copyright owner or his nominees, assignees or licensees; that **section 35(1) (a) and (b)** of the **Act** defines infringement to include the doing of any act controlled by copyright or importation, other than for private use, articles which are infringing. Further that section 26(1) restricts the distribution to the public, by way of sell or other means, importation or other arrangements. . . .

Contending that section 33 encompasses partial or full transfer of property rights in copyright by way of assignment or licenses, the 1st respondent has submitted that the law expects that only the producer or his

authorized importer can legitimately import, distribute and deal in copyright goods which would be considered genuine; and that a product is genuine if it is authorized to be in the market.

The 1st respondent has argued that through the impugned notice, it is expected that documents authorizing importation of the goods would be filed with the Board if the producer/ manufacturer is not the importer; and that since it is mandatory to authenticate such works, distributors and dealers are expected to avoid dealing in such products.

The sub-issues that arise from the foregoing submissions are:-

- a) Whether the Copyright Act applies to foreign works? If yes,
- b) Whether the 1st respondent has mandate or power to extend protection to copyright works of foreign producers and / or manufacturers?
- c) Whether regulations 11 and 12 of the Copyright Regulations are inconsistent with Section 36 of the Copyright Act?
- d) Who bears the obligation to apply for authentication sticker under section 36 of the Copyright Act?

Whether the Copyright Act applies to foreign works?

The answer to this question is found in **Section 50. (1) (b)** of 10 the **Copyright Act** which provides:-

"50. (1). This Act apply to-

(b) performances, sound recordings or broadcasts that are to be protected under an international treaty to which Kenya is a party."

Article 3(1) of the **Berne Convention**, to which Kenya is a party imposes an obligation on state parties to extend protection to authors who are nationals of the Countries of the Union, for their works, whether published or not. Article 3 of the TRIPS agreement, on the other hand, imposes an obligation on member states to-

"Accord to the nationals of other members treatment no less favourable than it accords to its own nationals with regard to protection intellectual property..."

From the above quoted provisions of the law, it is clear that Copyright Act applies both to locally produced works and imported works. Section 34 which makes it an offence to import or cause to be imported, without the licence of the owner of the copyright, otherwise than for private and domestic use, an article known to be infringing, confirms as much.

Whether the 1st respondent has mandate or power to extend protection to copyright works of foreign producers or manufacturers?

To appreciate the functions of the 1st respondent, one needs to consider the provisions of **Section 5** of the **Copyright Act**. The Section provides:-

"5) The functions of the Board shall be to:-

(a) direct, co-ordinate and oversee the implementation of laws and international treaties and conventions to which Kenya is a party and which relate to copyright and other rights recognized by this Act and ensure the observance thereof....."

A reading of this section, alongside Section 36(2)(3) of the Copyright Act and Article 3 of the TRIPS

Agreement reveals that the 1st respondent has mandate to extend protection to copyright works of foreign producers and/or manufacturers.

Whether regulations 11 and 12 of the Copyright Regulations are inconsistent with Section 36(1) of the Copyright Act?

Regulation 11 of the Copyright Regulations, 2004 provides:-

"11(1). Every sound recording and audio-visual work imported into Kenya, intended for sale, rental, hiring, lending or otherwise distributed or intended for distribution to the public for commercial purposes in Kenya shall have affixed to it an authentication device."

Regulation 12, on the other hand, provides:-

12.(1)The authentication device shall be fixed:-

(b) In the case of sound recordings and audio-visual works imported into Kenya, except where such works are exclusively for personal use, before they are released into channels of commerce in Kenya."

It is the petitioners' case that the foregoing regulations, are inconsistent with Section 36 which provides:-

"36.(1).Every sound and audio-visual recording made available to the public by way of sale, lending or distribution in any other manner to the public for commercial purposes in Kenya shall have affixed on it an authentication device prescribed by the Board.

2.The Board shall authenticate copyright works according to all required documents furnished to it by the applicant for that purpose and shall issue an approval certificate in the prescribed form to the applicant for authority to purchase an authentication device.

3.The authentication device shall be issued to an applicant upon proof that the applicant has been authorized by the copyright owner to manufacture, reproduce, sell, import, rent, or otherwise distribute the work;

4.The authentication device shall be affixed to each copy of the copyright work made or published by the applicant."

It is clear from the foregoing provisions that the law expects every sound and audio-visual recording made available to the public by way of sale, lending, or distribution in any other manner to the public for commercial purposes in Kenya to be affixed with an authentication device approved by the 1st respondent (Section 36(1)).

The law also puts an obligation on the 1st respondent to issue an authentication device on an applicant only upon being satisfied that the applicant has been authorized by the copyright owner to manufacture, reproduce, sell, import, rent or otherwise distribute the work (section 36(2)).

Contrary to the petitioners argument that they are not covered by the provisions of **Section 36** (supra) for the simple reason that they are not the producers and/or manufacturers of the works they sell, **Section 36** makes it clear that to deal with any copyright work, by way of sale, lending or distribution to the public one must have obtained authority of the copyright owner to deal with the product in the manner listed in section 36(3) above.

Section 36(5) as read with **sub-section (6)** makes it an offence to sell or exhibit for sale any copyright works that require an authentication device without an authentication device.

The foregoing provisions of the law make it clear that to deal with copyright works by way of sale,

lending or distribution in any other manner to the public for commercial purposes in Kenya, there must be evidence that the one dealing with the copyright work is authorized to deal with it. The only feasible way of doing so is to require for evidence of authentication as required under section 36(6) of the Copyright Act and the Rules made thereunder (the impugned rules).

Who bears the obligation to apply for authentication sticker under section 36 of the Copyright Act?

At the pain of repetition, but for avoidance of doubt for copyright works imported into the country **Regulation 12(b)** (*supra*) imposes the obligation to affix authentication device on the person importing the copyright works into Kenya. This means the obligation imposed by the Copyright Act and the Rules made thereunder, is to buy from importers who have complied with the law. However, the law imposes an obligation on petitioners to apply for an authentication device only and only if they deal with imported copyright works by way of reproduction. See Section 36(3) of the Copyright Act.

Whether the impugned notice violated or threatened to violate the Petitioners rights?

As pointed out in the 1st respondent's submissions, by issuing the impugned notice the 1st respondent had no intention of banning trade with the products that the petitioners deal with. All what it sought in was to accord protection to those works as contemplated in the Copyright Act and the International Instruments to which Kenya is a party to.

Although the petitioners claim that they cannot establish contacts with the authors of the works sought to be protected, I note that under Section 33 of the Copyright Act, the Petitioners are not obligated to deal directly with the copyright owner. The authorization contemplated under the Act can be made by a licensee or assignee of the copyright. See section 33(1) which provides:-

"Subject to this section, copyright shall be transmissible by assignment, by licence, testamentary disposition, or by operation of law as movable property."

For the foregoing reasons, I find and hold that the impugned notice is lawful and that it did not and does not threaten to violate the petitioner's rights. The orders for injunction cannot issue.

The upshot of the foregoing is that the petition has no merit and is dismissed with no orders for costs.

Dated, signed and delivered at Nakuru this 27th day of August, 2014.

H. A. OMONDI

JUDGE