



**REPUBLIC OF KENYA**

**High Court at Nairobi (Nairobi Law Courts)**

**Civil Suit 808 of 2010**

**JOHN BONIFACE MAINA..... PLAINTIFF**

**- VERSUS -**

**SAFARICOM LIMITED.....DEFENDANT**

**INTERACTIVE MEDIA SERVICES LIMITED.....1<sup>ST</sup> THIRD PARTY**

**LIBERTY AFRIKA TECHNOLOGIES LTD .....2<sup>ND</sup> THIRD PARTY**

**MUSIC COPYRIGHT SOCIETY OF KENYA .....3<sup>RD</sup> THIRD PARTY**

**CELLULANT (KENYA) LIMITED .....4<sup>TH</sup> THIRD PARTY**

**RULING**

**1.** The bedrock of the plaintiff's suit is a claim for damages for breach of copyright of his music. The defendant is a mobile phone and telecommunication company. In 2008, it introduced a *caller ring back tone* service styled *skiza*. It enabled its subscribers to customize their ringtones leased from the defendant. The 1<sup>st</sup>, 2<sup>nd</sup> and 3<sup>rd</sup> third parties assigned various copyrights, licences and sublicences for music and other content to support the ringtone service. The defendant, in addition had set up a competition styled *surf 2 win promotion* through which its customers could download *skiza* tones for a fee.

**2.** The plaintiff is a musician or recording artist. He had entered into an agreement dated 20<sup>th</sup> June 2007 authorizing the 3<sup>rd</sup> third party to collect mechanical royalties for all his music works. The defendant avers that the 3<sup>rd</sup> third party in turn conferred or assigned those rights to the 1<sup>st</sup> and 2<sup>nd</sup> third parties. The 4<sup>th</sup> third party was to distribute or provide added value services including logos, ringtones and pictures for *skiza*. The plaintiff has now brought this suit alleging that the defendants and the four third parties have infringed his copyright rights over popular *gikuyu* songs *muiritu wa kabete, tiga kumute, njeri, ndwara cece* among others. The plaintiff has now taken out a notice of motion dated 28<sup>th</sup> May 2012 seeking *Anton Piller* orders to enter the premises of the defendant and third parties to seize, collect and keep machines, data, documents or storage materials relating to his copyright rights in the music. The plaintiff also prays for an injunction to restrain the respondents from further infringement, sale, distribution and storage of his music. In a synopsis, the plaintiff asserts his moral and intellectual property rights to the music and ultimately to the remedy of damages.

3. The motion is contested. There are filed replying affidavits of Raymond Jumah, a manager of the defendant sworn on 3<sup>rd</sup> December 2012; Maurice Mwanje, the General Manager of the 3<sup>rd</sup> third party sworn on 7<sup>th</sup> June 2012; and, that of Sidney Wachira, a director of the 2<sup>nd</sup> third party sworn on 26<sup>th</sup> June 2012. The 4<sup>th</sup> third party's learned counsel Mr. Makori stated that the plaintiff's application does not affect it. In a nutshell, the defendant's case is that the averments in the replying affidavit have not been controverted by the plaintiff. On 28<sup>th</sup> May 2013, an interim order was granted by the court (Mutava, J) granting the plaintiff access to the defendant's premises and machinery to "copy and capture" copies of purchases and sale records of the plaintiff's recordings without removing the equipment. The defendant states that it fully complied. The plaintiff has thus not laid a basis for grant of an *Anton Piller* order. In particular, the defendant avers that by virtue of various content provision agreements with the 1<sup>st</sup>, 2<sup>nd</sup> and 4<sup>th</sup> third parties, the inclusion of the plaintiff's works on *skiza* and *surf 2 win promotion* was legal and well within the exceptions to section 35 of the Copyright Act. In the year 2011, the defendant states that it purged part of the plaintiff's music from its portal. In June 2012 and upon service with the interim order, it purged it completely. It denies enjoying earnings from the plaintiff's works or reproducing, altering, mutilating, defacing, pirating or infringing copyright rights of the plaintiff's musical recordings.

4. The 2<sup>nd</sup> third party's case in a nutshell is as follows: that it has not infringed copyright in view of its agreements with the 3<sup>rd</sup> third party; that it has been paying royalties to the 3<sup>rd</sup> third party; that its equipment and machinery supports over 3000 artists; and, that grant of the orders sought will decapitate its business.

5. The 3<sup>rd</sup> third party on the other hand states that the primary dispute is between the plaintiff and the defendant. It submitted that it has no relation with the defendant and does not store or keep the plaintiff's works. It is deponed that it has been paying the plaintiff royalties received from downloads of his music remitted to it by the 2<sup>nd</sup> third party. It claims the plaintiff is still its member, a fact contested by the plaintiff. It denies infringing the rights of the plaintiff. In particular, it contests the claim by the defendant against it and its joinder into the suit.

6. I have heard the rival arguments and submissions. I have considered the pleadings, depositions and written submissions as well as the oral submissions by the parties. I take the following view of the matter. Section 35 of the Copyright Act provides as follows:

*"35. (1) Copyright shall be infringed by a person who, without the licence of the owner of the copyright –*

*a) Does, or causes to be done, an act the doing of which is controlled by the copyright; or*

*b) Imports, or causes to be imported, otherwise than for his private and domestic use, an article which he knows to be an infringing copy.*

*(2) The rights of a performer shall be infringed by a person who without the consent of the performer-*

*a) Does, or causes to be done, any act specified in section 30 (1); or*

*b) Imports or causes to be imported, otherwise than for his own private or domestic use, an article which he knows would have been made contrary to section 30 had it been made in Kenya by the importer.*

*(3) Copyright and related rights shall be infringed by a person who –*

*a) Circumvents any effective technical measure designed to protect works; or*

*b) Manufactures or distributes devices which are primarily designed or produced for the purpose of circumventing technical measures designed to protect works protected under this Act; or*

c) Removes or alters any electronic rights management information; or

d) Distributes, imports, broadcasts or makes available to the public, protected works, records or copies from which electronic rights management information has been removed or has been altered without the authority of the right holder”.

7. Musical works under the Act means “any musical work, irrespective of musical quality, and includes works composed for musical accompaniment”. An infringing copy is a copy, the manufacture of which constitutes an infringement of any rights protected by the Act. Section 35 (4) of the Act provides that an infringement of copyright is actionable at the suit of the owner of the right. One of the reliefs to a plaintiff is at section 35 (4) (b) of the Act for an order for:

“Delivery up to the plaintiff of any article in the possession of the defendant which appears to the court to be an infringing copy, or any article used or intended to be used for making infringing copies”.

8. In addition, a successful plaintiff is entitled to an order for injunction, accounts, and damages. In the replying affidavit of Raymond Jumah at paragraphs 12, 13 and 14, there is an express admission that the defendant previously uploaded the plaintiff’s works for its *skiza* and *surf 2 win promotion* on the basis of the content provision agreements I mentioned earlier. It also concedes that in 2011, it was advised by its legal department to purge or remove the plaintiff’s works from its portal. It only partially did so because of a “glitch” within its storage or library system for the name of J B Maina. It only removed the works completely after service with the Court’s order of 28<sup>th</sup> May 2012.

9. The plaintiff’s case is that he is not a member of the Music Copyright Society, the 3<sup>rd</sup> third party. I have seen a copy of his letter attached, and irregularly so, to his submissions, withdrawing from the society. The society had assigned rights over the plaintiff’s recordings to the 2<sup>nd</sup> third party in agreements dated 22<sup>nd</sup> August 2008 and 22<sup>nd</sup> October 2008. The plaintiff asserts that he never authorized the defendant or third parties to exploit his works in that manner. For example, he states that the defendant, since 2009, was charging its customers Kshs 5 for every ringtone and that it has “sold over Kshs 60,000,000” value without compensating the plaintiff.

10. In particular, the plaintiff depones at paragraph 10 of his affidavit as follows:-

“That before the defendant started giving out my music I had a contract with a musical company to pay me Kshs 7 for every download. By the month of December 2011 I had confirmed that SURF 2 WIN had (sic) downloaded 3,840,000 and skiza tunes totaling to Kshs 45,600,000 (Fourty five million, six hundred thousand) based on a Kshs 7/- per tune and over 10,000 cartoon synchronization given at the same costs which gives 15,000,000 which totals to over Kshs 60,600,000 and which amount increase (sic) daily”.

11. The third parties enjoined to the suit by the defendant have denied liability. From the plaintiff’s documents “J B 1” and “J B 2”, I am satisfied that the defendant used the catalogue of the plaintiff’s music and that the public was downloading the tunes from the defendant’s website before it was deleted.

12. The defendant retorts that the website has not been deleted or pulled down. It also says that if the plaintiff, as he says, was able to download his tunes from the website, he then has enough information to quantify damages. I can infer from a totality of the circumstances that the defendant was doing so for profit and that the plaintiff’s claim to injunction and account are not too remote or ill founded. As I shall show shortly, the defendant admits that it was charging varying prices for every ring tone. To the extent of the prayer for injunctive relief, I am satisfied that the plaintiff has established a *prima facie* case as per the principles laid down in Giella Vs Cassman Brown & Company Limited [1973] E A 358.

13. Those principles are first, that the applicant must show a *prima facie* case with a probability of success; secondly that he stands to suffer irreparable harm not compensable in damages; and thirdly, if in doubt, the court must assess the balance of convenience. Being a discretionary remedy, there is also ample authority that a party who has misconducted himself in a manner not acceptable to a court of

equity, will be denied the remedy. See Kenya Hotels Limited Vs Kenya Commercial Bank and another [2004] 1 KLR 80.

**14.**I am alive to the intricacies and complexities of this cause of action. Damages are not always a suitable relief where there is a clear breach of a legal right. See Aikman Vs Muchoki [1984] KLR 353, Joseph Siro Mosioma Vs Housing Finance Company of Kenya and others Nairobi High Court case 265 of 2007 [2008] e KLR. I am accordingly inclined to grant injunctive relief from further infringement of the plaintiff's copyright by the defendant and all the third parties.

**15.**I now turn to the contested prayer for an *Anton Piller* order. As I stated, the court (Mutava, J) issued a partial relief *ex parte* on terms. The defendant at paragraphs 16, 17 and 18 of the replying affidavit states it has now deleted the plaintiff's music from its ringtone portal. It concedes however at paragraph 18 that it has been charging varying prices "depending on the price review of the product" and not Kshs 5 as claimed by the plaintiff. The plaintiff takes umbrage to the content provision agreements with the third parties upon which the defendant's right to use the copyright is hinged. The defendant claims to have made payments to the third parties: the plaintiff contends he has not seen the payment from either the defendant or third parties. The defendant avers at paragraph 36, 37 and 38 of the replying affidavit that it does not intend to destroy evidence, that if the *Anton Piller* order is granted it will be extremely adverse to its *surf 2 win promotion*, which promotion in any event ended on 1<sup>st</sup> February 2009. It was also submitted that since the defendant complied with the interim order of court of 28<sup>th</sup> May 2012, the plaintiff has not laid a basis for the extensive orders sought to remove its machinery and storage facilities.

**16.** *Anton Piller* orders derive their title from the ground breaking decision in Anton Piller K G Vs Manufacturing Process Limited [1976] Ch 55. The plaintiff in the suit owned copyright in the design of a high frequency converter used to supply computers. The plaintiff had learnt that their English agents, the defendant, wanted to supply information to a rival of the plaintiff. They made an *ex parte* application to enter the defendant's premises to inspect, remove or make copies of documents belonging to the plaintiff. The Courts view was that the order was extreme and should rarely be made. Ormrod L.J. delivered himself as follows;

*"There are three essential pre-conditions for the making of such an order, in my judgment. First, there must be an extremely strong prima facie case. Secondly, the damage, potential or actual, must be very serious for the plaintiff. Thirdly, there must be clear evidence that the defendants have in their possession incriminating documents or things, and that there is a real possibility that they may destroy such material before any application inter partes can be made".*

**17.**The plaintiff must show that without the order, he will suffer a great injustice than that, which in the absence of the order, would be suffered by the respondent. See Columbia Picture Industries Vs Robinson [1977] 1 Ch 76, *Halsbury's Laws of England* 4<sup>th</sup> Edition paragraph 372. See also Montana (K) Limited Vs Anthony Maina Kara and 2 others Nairobi High Court case 583 of 2006 [2006] e KLR, Microsoft Corporation Vs Mitsumi Computer Garage Limited [2001] 2 E A 460. Section 37 of the Copyright Act has domesticated *Anton Piller* reliefs for copyright infringement. The order can be granted by court *ex parte*.

**18.**When I apply those principles to the evidence available at this stage, I find further as follows. It is common ground that the plaintiff is the author of the *gikuyu* musical recordings that I set out in the opening paragraphs. He has copyright to them. He is thus entitled to assert his moral rights to that intellectual property under sections 32, 35 and 37 of the Copyright Act. The defendant has offered that music to the public for profit. The defendant relies on the content provision agreements with the third parties. The plaintiff denies authorizing the use of his copyright in that manner by the third parties or the defendant.

**19.**The contractual foundation upon which the defendant is trading with the plaintiff's copyright has thus been called to question. The plaintiff seems to be largely out of the loop on the use of his works by the defendant or the accounts. The same appears to be true of the subcontracts or sublicences under the content provision agreements between the defendant and 1<sup>st</sup> to 3<sup>rd</sup> parties. When you bring the 4<sup>th</sup> third

party into the picture, the picture emerges of an intricate web that may circumvent the technical measures to protect the plaintiff's copyright. Granted those circumstances, only the defendant has the records of the downloads made by the public and the monies made or royalties due to the plaintiff. The plaintiff has not received the royalties allegedly paid by the 2<sup>nd</sup> third party to the 3<sup>rd</sup> third party. The plaintiff denies being a member of the 3<sup>rd</sup> third party which is the basis for assignment of certain of his copyright rights. The 3<sup>rd</sup> third party denies giving authority to the defendant to sell or synchronize the plaintiff's works. The plaintiff has in the end become the proverbial grass: suffering as the defendant and third parties iron out their differences. There is the added risk that the defendants and third parties will delete, pull down or interfere with the records of use and sale of the plaintiff's music.

**20.** From the number of music recordings of the plaintiff used in the ringtones, I have little doubt that the plaintiff has established an extremely strong *prima facie* case for grant of an *Anton Piller* order; not necessarily in the terms proposed, but to some extent to ensure that his statutory rights of copyright are salvaged at this stage. This court must strike a blow to protect such fragile copyright rights. It must preserve vital evidence at this stage necessary at the trial. As the suit is still pending, the less I say the better to avoid embarrassing the trial court. The alleged infringements run back to the year 2009. The suit was commenced on 23<sup>rd</sup> November 2010. I acknowledge there was delay in bringing the motion dated 28<sup>th</sup> May 2012. Considering the complex nature of the claim, that delay is not inordinate or inexcusable. I also acknowledge that the plaintiff has not explained sufficiently the manner in which he has utilized the interim order of court granted on 28<sup>th</sup> May 2012. That however cannot be a bar to the grant of the orders I propose. What the delay does however is to defeat the object of the *Anton Piller* order in the terms proposed by the plaintiff. If the object was to catch the respondents by surprise before they destroy evidence, the plot has been lost. There will be little purpose to be achieved by carting away the machinery that may be in use for other purposes by the respondents. Certainly, any records or documents need to be preserved. I am thus persuaded to grant a limited *Anton Piller* order. The plaintiff is also entitled to an injunction.

**21.** For all the above reasons, I find that the plaintiff's notice of motion dated 28<sup>th</sup> May 2012 has some merit. The orders that then commend themselves to me grant are as follows:

a) **THAT** the defendant and third parties, their servants and agents or howsoever be restrained by injunction from infringing upon the plaintiff's copyright by offering for sale, selling or storing of any data relating to the plaintiff's musical works including but not limited to *Muiritu wa kabete, Tiga kumute, Njeri, Ndwaru cece, Arata, Tuhuuu twa rose, Unyinyi wakwa, Kirindi Mundia and Tumura Kanua* or cover versions by Salim Junior pending the hearing and determination of this suit.

b) **THAT** the plaintiff is hereby authorized, in the company of an Inspector of the Copyright Board, to enter into the defendant's and third parties' premises situated in Safaricom House Waiyaki way, Maua Close Westlands, Lutheran Plaza Mall and General Post Office Building during business hours to inspect machines where the plaintiff's music data has been stored, take records of such data, make copies of all purchases and sale records and any item which constitutes or could constitute evidence necessary to prove his claim and for purposes of preserving such evidence.

c) **THAT** the plaintiff is further authorized, in the company of an Inspector of the Copyright Board to enter the defendant's and third parties' premises situated in Safaricom House along Waiyaki way in Westlands Nairobi and elsewhere within the Republic of Kenya where the defendant or third parties have stored data in machines, documents and electronic gadgets or copies of the plaintiff's music offered for sale through the internet, media works or networks or mobile phones in the *Surf to Win promotion* and *Skiza* ringtones and to seize and keep such records, data, documents and materials relating to his musical works including *Muiritu wa kabete, Tiga kumute, Njeri, Ndwaru cece, Arata, Tuhuuu twa rose, Unyinyi wakwa, Kirindi Mundia and Tumura Kanua* or cover versions by Salim Junior for safe custody and to preserve them to safeguard vital evidence for trial.

d) **THAT** prayers (b) and (c) shall be effected in such a manner as not to remove machinery or computers and not to demolish any building or fittings of the defendant, third parties or their landlords as the case

may be.

e) **THAT** I award the plaintiff the costs of the motion to be paid by the defendant, the 1<sup>st</sup>, 2<sup>nd</sup> and 3<sup>rd</sup> third parties. The 4<sup>th</sup> third party did not contest the application and is accordingly not liable to costs.

It is so ordered.

**DATED** and **DELIVERED** at **NAIROBI** this 14<sup>th</sup> day of May 2013.

**G.K. KIMONDO**  
**JUDGE**

**Ruling read in open court in the presence of**

Mr. D.M. Gikunda for the Plaintiff.

Mr. W. Echesa for the Defendant.

No appearance for 1<sup>st</sup> third party.

Mr. N. Kiingati for the 2<sup>nd</sup> third party.

No appearance for the 3<sup>rd</sup> third party.

Mr. E. Makori for the 4<sup>th</sup> third party.