REPUBLIC OF KENYA

IN THE HIGH COURT OF KENYA

AT NAIROBI (MILIMANI COMMERCIAL COURTS)

Civil Suit 729 of 2009

OXFORD UNIVERSITY PRESS (E.A) LIMITED ……PLAINTIFF

VERSUS

LONGHORN PUBLISHERS (K) LIMITE……. 1ST DEFENDANT

JOHN GONGWE KIANGO ……..2ND DEFENDANT

JAMES SALEHE MDEE …….. 3RD DEFENDANT

ADAM SHAFI ……. 4TH DEFENDANT

KIMANI NJOGU …… 5TH DEFENDANT

RULING

1. The plaintiff/applicant in the chamber summons dated 1st October 2009 is the co-author and publisher of the books entitled ***"Kamusi Ya Kiswahili Sanifu and Kamusi ya Shule za Msingi***" (herein after referred to as **KKS** and **KSM).** The applicant claims that they are the owners of the copyright in respect of those books. It is contended by the applicant that KKS was first published in 1981 and the 2nd edition in the year 2004, while **KSM** was published in May 2007. The applicant states in the supporting affidavit sworn by **Kithusi Mulonzya** that they, with the co-authors put considerable effort to give their works original character and their works is protected under the Copyright Act.

2. In the development of **KSM,** the applicant commissioned the 2nd defendant as a co-author. They had entered into an agreement on 24th May 2006 wherein the 2nd defendant was not supposed to, during the continuous of the agreement, to publish or cause to be published any work that is likely to onflict with the sale of **KSM**. It was further agreed that the 2nd defendant would not during the continuation of the agreement prepare or edit for any other publisher's work on the same subject matter without the written consent of the applicant.

3. The applicant complaints that on or about June 2009, it noticed the sale of a book known as (***Kamusi Kamili ya Kiswahili*** herein after referred to **KKK**) published by the 1st defendant and co-authored by the 2nd, 3rd, 4th and 5th defendants. The said publication contains words, definitions, notes, summaries and illustrations which are an imitation and are directly copied from the plaintiff's books **KKS**

and **KSM**. It is alleged that the defendant copied the applicant's work by out rightly infringing on the applicant's works without the applicant's consent or acknowledgment. The applicant's has isolated several examples of the items that were plagiarized in terms of headwords, definitions, design and artistry of presentation, pictures and other aspects pertinent to the art of dictionary making.

4. It is further contended that the 2nd defendant admitted that there was fixture resemblances and definition resemblances in the 1st defendants book **KKK** which vary from 9% to 26% and a little bit more in very few letters. The applicant claims that they have used colossal sums of money in terms of research, planning and developing of the two dictionaries, identifying fine editors and unless the defendant is restrained by an order of injunction they intend to continue publishing, advertising and offering **their KKK** for sale thereby giving them unfair advantage.

5. The application was opposed; the defendants relied on points of law contained in the notice of preliminary objection which were argued in response. Counsel also relied on the replying affidavit sworn by **Musyoki Muli** on 23rd October 2009. The defendants contend that the plaintiff lacks locus standi to file the present suit under the Copy Right Act, because the agreement made between the director of Oxford University Press East Africa under the power of Attorney on behalf of Oxford University Press the copyright belongs to the Oxford University press of Walton Street and the University of Dar-es-Saleem which is a different entity from the plaintiff. There is no assignment of copy right as provided for under section 35(4) of the Copy Right Act.

6. Further the agreement in regard to **KKS** was drawn in 2006 when the plaintiff was already incorporated; therefore the provisions of section 35(4) of the Copy Right Act were applicable. Thus the plaintiff is not the owner of the copyright which belonged to the Oxford University Press and the plaintiff is a stranger to these proceedings. It was also denied that the plaintiff has any copyright over **KSM** because it was co-authored with the 2nd defendant. Moreover, the plaintiff failed to comply with the requirements provided for under section 34(2) of the Copyright Act which provides:-

> ***"Before an exclusive licensee or sub-licensee institutes proceedings under sub-section (1), he shall give notice in writing to the owner of the copyright concerned, of his intention to do so, and the owner may intervene in such proceedings and recover any damages he may have suffered as a result of the infringement concerned or a reasonable royalty to which he may be entitled".***

7. On the merits of the application, it was also submitted that the plaintiff's application does not meet the threshold of granting an interim order of injunction as set out in the oft' cited case of **Giella vs. Cassman Brown Limited 1973 EA 358.** Firstly, the defendant had already distributed copies of **KKK** which will be sold outside the defendants control therefore any injunction issued will be in vain. Secondly, the plaintiff has not been able to demonstrate that their case has a high probability of

success. For reasons that dictionary making process necessitates certain similarity World over, for instance all entries in the dictionary must be in alphabetical order, common words have common definitions, the affidavit by the respondent has demonstrated that it is inevitable to have similarities in dictionary making.

8. Moreover **KKK** is more comprehensive as it contains 2,500 more entries than the plaintiff's works. The defendants have also demonstrated in their pleadings, that there is originality in their work which is not found in the plaintiff's works. It is denied that although the defendants work compared to the plaintiffs works, and may look similar, the works are not identical as the defendants illustrations were created by an artist and not copied from the plaintiff's works. The defendant is in fair trade and the plaintiff merely fears fair competition. Finally, it was submitted that the plaintiff's claim can adequately be compensated by damages if any can be proved because the 1st defendant is a large and stable company which can afford to pay damages.

9. Both counsel for the plaintiff and the defendants filed written submissions and cited authorities to support their respective arguments. I have gone through those submissions and the issues that l discern for determination is whether the plaintiff is entitled to an interim order of injunction. In determining that issue it will also be necessary to answer the question on whether a copy right subsists in regard to the plaintiffs works in the books **KKS** and **KSM**, as well as the twin issue of whether plaintiff has any locai standi in the matter.

10. Firstly, it is alleged that the plaintiff lacks locus standi to bring this matter. In the further affidavit in the support of the application sworn by **Kithusi Malonzya** on 6th November 2009, they have annexed a copy of the letter dated 25th September 2000 notifying the Registrar of Companies that Oxford University Press changed its name to Oxford University Press East Africa Limited. They have also annexed copyright pages of the two books which show that Oxford University Press is the licensed copy right holder. According to the provisions of section 33(1) of the Copy Right Act it is provided that:-

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

11. This now leads me to the next question on whether on the face of the record the defendants publication has infringed the plaintiff's copyright by copying or plagiarizing the plaintiff's works in **KKS** and **KSM**. It is not disputed that there are several definitions, illustrations, headwords which were lifted directly from the plaintiff's works. A letter written by the 2nd defendant to the plaintiff admits that there were resemblances and he regretted the oversight and promised to take necessary steps to rectify the situation. In fact the letter reads in part as follows;

> ***…"In response to your second question, I would like to confirm that I did participate in the preparation of the dictionary and I am considered as one of the authors of the Dictionary. I did***

participate because it didn't occur to me that a specialized dictionary which is designed to cater for primary school children would be in direct competition with a general dictionary which is designed to cater for native speakers and adult second language learners. I regret the oversight and I'm ready to take any necessary step to rectify the situation.

In response to your first question, although I participated in writing of the dictionary, the printing was done prematurely by the publisher as the phase of polishing the manuscript in order to make sure that it does not have any material in a form of definitions and pictures that resemble those of the existing dictionaries was not yet over. However, when we authors were still waiting for the vetting phase to be completed, to our surprise we were told that the dictionary had already been printed. This means that to us, we still consider what has already been printed as a manuscript and not a publication".

12. In another letter dated 13th September 2009 the 2nd defendant admitted as follows:

…"I went through a number of letters with the assistance of the University students who are doing their practical training and found out that there are picture resemblances and definition resemblances which vary from 9% to 26% and a little bit more in very few letters. The resemblances in some entries are in areas where authors were supposed to be brief or to list synonyms as required by dictionary principles. Whatever the case, those areas can also be improved."

13. I have also considered the sound arguments by the defendants that dictionary making is a unique craft requiring the words to appear alphabetically and the definitions of words have similarities. There is also no ownership over the language as the words emanates from the language and there is no originality that can be said to be the monopoly of the plaintiff in the language. This may very well be so, but in this case there are so many similarities not only in the definitions but in the design and artistry of presentation as well as the illustration. Interestingly, even in some pages where the plaintiff made errors in their works, the same were repeated in **KKK.** More fundamentally, there is no reference to or acknowledgement of the works by the plaintiff. Even if dictionary making involves sharing of the raw materials in terms of the words, however creativity and originality is necessary.

14. Borrowing from the decision in the case of **Ladbroke Limited v William Hill, Limited**

as per Lord Reid [1964] 1 All E.R.

> ***"The word 'original' does not in this connexion means that the work must be the expression of original or inventive thought. Copyright Acts are not concerned with the originality of ideas, but with the expression of thought, and, in the case of 'literary work', with the expression of thought in print or writing. The originality which is required relates to the expression of the thought. But the act does not require that the expression must be in an original or novel form, but that the work must not be copied from another work – that it should originate from the author."***

15. Going by the evidence on record especially the admission by the 2nd defendant that there are substantial similarities that appear in the defendants work, the plaintiff's work was in existence before the defendant's publication, I find that the plaintiff has established a prima facie case with a probability of success. The Court of Appeal has explained what constitutes a prima facie case in the case of; Mrao **Ltd v First American Bank of Kenya Ltd & 2 others [2003] KLR 125 it was** held that:

> ***"A prima facie case in a civil application includes but is not confined to a "genuine and arguable case". It is a case which, on the material presented to the court, a tribunal properly directing itself will conclude that there exists a right which has apparently been infringed by the opposite party as to call for an explanation or rebuttal from the latter***."

> ***"Remembering that the legal onus is always on the prosecution to prove its case beyond reasonable doubt, we cannot agree that a prima facie case is full consideration might possibly be though sufficient to sustain a conviction. This is perilously near suggestion that the court would not be prepared to convict if no defence is made, but rather hoes the defence will fill the gaps in the prosecution case.***
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> ***Nor can we agree that the question whether there is a case to answer depends only on whether there is some evidence, irrespective of its credibility or weight, sufficient to put accused on his defence. A mere scintilla of evidence can never be enough: or can any amount of worthless discredited evidence. It is true, as Wilson J. said that the court is not required at that***

stage to decide finally whether the evidence is worthy of credit, or whether if believed it is weightily enough to prove the case conclusively: that that determination can only properly be made when the case for the defence ahs been heard. It may not be easy to define what is meant by a 'prima facie case' but at least it must mean one on which a reasonable tribunal, properly directing its mind to the law and the evidence could convict if not explanation is offered by the defence."

16. Even going further to consider the issue of damages the plaintiff who published **KKS** in 1981 have been in the market longer and they have demonstrated that they have extended colossal sums of money in research and development of their works. On the other hand the defendants published their works in 2007. Thus the applicant will suffer substantial loss unless the defendant is restrained from further publishing and selling their works which imitates the plaintiff's works. Accordingly I grant prayer number 2 of the application on condition that the plaintiff will issue an appropriate undertaking to compensate the defendant for damages which should be filed in court within seven (7) days of this order. Costs of this application shall be in the cause.

RULING READ AND SIGNED ON 29TH JANUARY 2010 AT NAIROBI.

M.K. KOOME

JUDGE