



**REPUBLIC OF KENYA  
IN THE HIGH COURT OF KENYA  
AT NAIROBI (MILIMANI COMMERCIAL COURTS)**

**Civil Case 262 of 2010**

**MARGARET SOARES ..... 1<sup>ST</sup> PLAINTIFF/APPLICANT  
AFRO ITALIAN COMPANY LTD ..... 2<sup>ND</sup> PLAINTIFF/APPLICANT**

**VERSUS**

**SIMON KIMAN NJAU  
T/S BOMAS INTERIOR DESIGNS ..... 1<sup>ST</sup> DEFENDANT/RESPONDENT  
JOHN MUTHANI ..... 2<sup>ND</sup> DEFENDANT/RESPONDENT  
RAPHAEL FONDO ..... 3<sup>RD</sup> DEFENDANT/RESPONDENT  
HARRISON FONDO ..... 4<sup>TH</sup> DEFENDANT/RESPONDENT**

**RULING**

1. The plaintiffs/applicants claim to be the author and owner of Copy Right in artistic garden ornament work which consists of pots sculptures of artistic craftsmanship called “**Artistic Garden Ornaments**”. The 1<sup>st</sup> plaintiff claims to have invented the original works by extending labor, innovation and skill for over 27 years. The work is also registered by the Kenya Copy Right Board. This suit is brought against the defendants who are alleged to have infringed upon the plaintiff’s copy right by reproducing adaptation or imitation of the plaintiff’s work. It is further alleged that the pots moulds and ornamental sculptures particularly the flower pots and lions sculptures which the defendants are now distributing to the public and displaying for sale belong to the plaintiffs and the defendants are thus profiting from the plaintiff’s innovation.
2. The plaintiffs filled a chamber summons dated 28<sup>th</sup> April 2010, seeking for restraining orders by way of an injunction against the defendants, their servants or agents from infringing on the plaintiff’s artistic work called “Artistic Garden Ornament”. The applicant is also seeking for **Anton Piller** orders so that a court bailiff or an auctioneer can search the defendants’ premises and seize all the infringing copies of moulds, pots ornaments articles and sculptures in possession of the defendants pending the hearing of the suit. This application is supported by the grounds stipulated on the body thereto and the supporting affidavit by **Margaret Soares** sworn on 28<sup>th</sup> April 2010.
3. Briefly stated, it is the applicant’s case that 2<sup>nd</sup> plaintiff is the registered copy right holder of artistic Garden Ornaments. She annexed the certificate of registration dated 8<sup>th</sup> April 2010 issued by the Kenya Copy Right Board. The artistic Garden Ornaments were in existence for over 27 years. The works comprise of garden flower pots, artistic

ornament with engraving and sculptures designed from cement moulds and casts as per the pictures exhibited. The first defendant approached the plaintiff as a customer in 2009 and bought several assorted artistic garden pots and ornaments and sculptures. He was issued with a cash sale receipt for the items purchased.

4. In the course of the transaction, the 1<sup>st</sup> defendant dealt with the 2<sup>nd</sup>, 3<sup>rd</sup> and 4<sup>th</sup> defendants who were then employees of the plaintiff and were involved in making and manufacturing those garden ornaments and sculptures. Towards the end of 2009 the 2<sup>nd</sup>, 3<sup>rd</sup> and 4<sup>th</sup> defendant left the plaintiff's employment and during the month of April 2010, the plaintiff learned that they were enticed by the 1<sup>st</sup> defendant to join him with the aim of copying and infringing on the plaintiff's copy right. The defendants have now been manufacturing garden pots similar to those of the plaintiff's which they are selling at Karen along Langata Road. The plaintiff exhibited photographs of the pots the defendants are manufacturing which resemble substantially the plaintiff's work. The moulds and adaptive caps and plates being used by the defendants are similar to the plaintiff's exact engraving measurements and design. The plaintiff lodged a complaint with the Copy Right of Kenya and issued a demand letter to the defendant but they have continued to sell the ornaments which infringe on the plaintiff's copy right.

5. This application was opposed by the respondents. Counsel for the respondents relied on the replying affidavits by **Simon Kimani Njau** sworn on 25<sup>th</sup> May 2010 and **Harrison Fondo** sworn on 25<sup>th</sup> May 2010. It was argued that the 1<sup>st</sup> plaintiff has no capacity to bring this suit because the copy right is registered in favour of the 2<sup>nd</sup> plaintiff as evidenced by the certificate of registration which was issued on 8<sup>th</sup> April 2010. Although the plaintiff's claim that the copy right has been in existence for 27 years there is nothing to support that contention. The certificate of registration was issued only 14 days before this suit was filed. Thus there is nothing to demonstrate that the plaintiff's had exclusively conceived the idea of making the flower pots before the registration of the copy right so as to entitle them to the exclusive ownership to the works in question.

6. It was further argued that the specific nature of the work registered and protected by the copy right is vague and unspecified. Thus the applicant has not fulfilled the basic elements for the granting of an order of injunction. The plaintiff has not demonstrated any legal ownership of the designs. The documents attached is an advertisement by the defendant is a mere computer generated pamphlets by the plaintiff's showing photographs of the various garden pots. These are the merchandise the plaintiff's allegedly have in stock for their customers and the pamphlet gives directions how to be located by their customers. However the advertisement does not in any way demonstrate that the plaintiff's are the sole registered owners of the design and artistic work to the exclusion of the defendant or any other person.

7. It was further argued that the photographs exhibited in the plaintiff's supporting affidavit consist merely of photographs taken from some un identified premises. The photographs do not demonstrate which specific design or artistic work is registered or protected by the certificate dated 8<sup>th</sup> April 2010 therefore on a balance of probabilities there

is no proof that the defendants have infringed upon the plaintiffs alleged copy right. The pictures in the photographs are of plants/flowers planted thereon which are mature and that is clear evidence that the pots have been in use for more than two years. The photographs are taken at the hotel premises of the 1<sup>st</sup> defendant in Langata where they were placed after purchasing them from the 1<sup>st</sup> plaintiff. There is no proof that defendants are manufacturing the pots bearing the particular design as alleged by the plaintiff.

7. The defendants contend that they have been in the business of making flower pots for nearly two years. The 4<sup>th</sup> defendant is a trained and qualified mason in the art of making various flower pots of different designs. The 4<sup>th</sup> defendant was working in partnership with the 1<sup>st</sup> plaintiff and one **George Fabrizz** and they were molding flower pots of various designs. Indeed the 4<sup>th</sup> defendant claims that he is the original designer of the pots in question having practiced the trade for a period of over 27 years. Counsel urged the court not to grant the orders especially the Anton Pillar orders which are issued upon a strong prima facie case with a probability of success as was held in the case of **Anton Pillar K.G. vs. Manufacturing Processor Ltd. (1975) EWCA CIV 12.**

8. The above is the summary of the brief information and rival submissions. The issue to determine is where the applicant is entitled to be granted an interim order of injunction based on the claim of infringement of their artistic work and also to be granted a mandatory order of injunction otherwise known as the Anton **Pillar Orders**. Under Section 2 (1) of the Copy Right Act No. 12 of 2001 Artistic works “means irrespective of artistic quality, any of the following, or works similar thereto-

- a) *Paintings, drawings, etchings, Lithographs, woodcuts, engravings and prints*
- b) *Maps, plans and diagrams;*
- c) *Works of sculpture;*
- d) *Photographs not comprised in audio-Visual works*
- e) *Works of architecture in the form of Buildings or models; and*
- f) *Works of artistic craftsmanship, pictorial women tissues and articles of applied handicraft and industrial art.*

**Section 35 of the Copy Right Act** gives the consequences of the infringement of a copy right.

*‘An infringement of any right protected under the Act is actionable and the owner of the copy right can seek relieve by way of damages , injunctions and even seek for the delivery up to the plaintiff of any article in possession of the defendant which appears to the court to be an infringement of the Protected Work’*

9. This being an application for injunction, the applicant has to establish that they have a prima facie case with a

probability of success. Secondly, irreparable harm which may not be compensated for in damages would arise, and if the court is in doubt the matter should be determined on a balance of convenience. See the oft' cited case of **Giella vs. Cassman Brown and Company Limited 1973 EA 358**. The Court of Appeal has explained in the case of **Mrao Ltd v First American Bank of Kenya Ltd & 2 others [2003] KLR 125** what constitutes a prima facie case in the following terms:

*“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.”*

10. The plaintiff registered the copy right on **8<sup>th</sup> April 2010** according to the certificate of registration issued by the Kenya Copy Right Board. The application for registration by the plaintiff was made **on 30<sup>th</sup> March 2010**. before the plaintiffs registered the copyright a demand letter by their advocates **M/s Nyende and Company Advocates** was addressed to the defendants on 29<sup>th</sup> March 2010 demanding that they desist from imitating and passing off the plaintiff's pots, sculpture and goods as if they were those of the defendants. It is obvious that by the time the plaintiffs registered the copyright on the garden pots, the defendants were already manufacturing or creating the pots and sculptures.

11. Secondly the court is not able to comprehend the actual distinctive features of the plaintiff's creations that are protected by the copy right. The plaintiff merely annexed a computer print out with photographs of garden pots. There is nothing to show the pots are the exclusive registered copy right of the plaintiffs. The plaintiff's case is not clear as it would appear that the defendants were already involved in the business of making pots even before the plaintiffs registered their copy right on 8<sup>th</sup> April 2010. It is more probable than not that the plaintiffs registered the copy right after realizing the defendants were making similar garden pots and the fact that some of the defendants were the plaintiff's employees. The plaintiffs did not exhibit any contract to restrain the former employees from creating their works after leaving employment. In view of the above findings, the plaintiffs have not established a prima facie case with a probability of success to be granted an order of injunction let alone the **Anton Piller** mandatory order of injunction.

12. For the above reasons, the application by the plaintiffs must fail. Costs will be in the cause.

**RULING READ AND SIGNED ON 9<sup>TH</sup> JULY 2010 AT NAIROBI.**

**M.K. KOOME**  
**JUDGE**