REPUBLIC OF KENYA

IN THE HIGH COURT OF KENYA

AT NAIROBI (NAIROBI LAW COURTS)

Civil Case 2503 of 1995

MACMILLAN KENYA (PUBLISHERS) LTD ...……...……. PLAINTIFF

VERSUS

MOUNT KENYA SUNDRIES LTD ……..…….. DEFENDANT

JUDGMENT

I. Introduction and Pleadings

The Plaintiff instituted this suit against the Defendant on 9th August, 1995 and sought Judgment as follows:

"(a) an injunction to restrain the Defendant from doing the following acts, selling by way of trade or exposing or offering for sale its said Kenya Pictorial Tourist Route Map or any map based thereon

(b) an order for delivery up of all such maps as are in the Defendant's possession or control

(c) an inquiry as to damages or alternatively an account of profits and payment of all sums found due upon taking such inquiry

(d) interest and costs."

The basis of the Plaintiff's claim is that the Defendant's map called "Kenya Pictorial Tourist Route Map" ("the Defendant's map") aforesaid infringed the Plaintiff's copyright in its maps called "Kenya Tourist Map" ("the 1985 map") and later "Kenya Traveller's Map" ("the 1989 map").

The Plaintiff's claim was not admitted. The Defendant filed a Defence and Counterclaim to the suit on 13th September, 1995 which was later amended in 2002. The thrust of the defence was that the Plaintiff had no *locus standi* to bring this suit; that the Plaintiff did not enjoy any copyright over the maps it published; that in fact there was no infringement of any copyright; and finally that the Plaintiff's claim was barred by the doctrine of laches.

By way of Counterclaim, the Defendant averred that it was the Plaintiff who had, in fact, infringed the Defendant's copyright. According to the Defendant, the map which the Plaintiff sought to impugn was produced in 1990 ahead of the Plaintiff's map (which the Defendant alleges was also produced in the same year).

It is most unfortunate that there was an inordinate delay in the commencement of the trial. It eventually took off in early 2003 before the Honourable Mr Justice Githinji when he was still a member of this Court, before his elevation to the Court of Appeal. Upon his elevation to the Court of Appeal, the trial was further delayed as the proceedings before him had to be typed for a new Judge to take over. As fate would have it, the trial continued before me from 16th November, 2005 until I finished hearing the last testimony on 7th April, 2008. Thereafter, I directed Counsel for the contending parties to file Written Submissions and I invited them to make oral submissions before the Court on 3rd July, 2008. I had initially hoped to deliver my decision on 16th September, 2008 after the Court's Summer Vacation but that was delayed on account of other official duties assigned to me almost throughout the Vacation.

II. Issues

The following are the agreed issues in this case:

1. When did the Plaintiff alter certain elements of "Kenya Tourist Map" and market it as "Kenya Traveller's Map"?

2. Was "Kenya Traveller's Map" published before or after "Kenya Pictorial Tourist Route Map" was published?

3. (a) Does any copyright subsist in the "Kenya Traveller's

Map?"

(b) Does the Plaintiff have the copyright in "Kenya Traveller's Map?"

(c) Has the Defendant been aware or did it have reasonable grounds for suspecting that copyright subsisted in the Plaintiff's work?

4. (a) Has the Defendant infringed the Plaintiff's copyright?

(b) Whether the references taken by the Defendant constitute any substantial part of the Plaintiff's work

5. (a) Is the Defendant the author of its work?

(b) Has the sale of the Defendant's work in any way affected/interfered with the Plaintiff's business? If so to what extent?

6. (a) Is the Plaintiff's claim and cause of action barred by

laches

(b) Do they constitute a defence to the Plaintiff's claim

7. Is the Plaintiff entitled to the reliefs claimed?

8. (a) Has the Plaintiff copied the Defendant's map?

(b) To what extent has the Plaintiff copied from the Defendant's map?

9. (a) Has the Plaintiff claimed ownership of copyright in the

Defendant's works?

(b) Whether the Defendant has copyright in its works?

10. Is the Defendant entitled to the reliefs sought?

11. What is the Order as to costs?

The above 11 issues can be summarized more succinctly as follows:

1. Between the Plaintiff's "Kenya Traveller's Map" and the Defendant's "Kenya Pictorial Tourist Route Map" which was published first?

2. Depending on the answer in 1, does the party which was first in publishing possess copyright in its work?

3. If the answer in 2 is yes, has the other party infringed that copyright?

4. Assuming the Plaintiff is the one with copyright is the claim barred by laches?

5. What relief is due to the successful party?

My summary of the issues does not imply that the framing by the parties was lacking in any respect. To the contrary, I found their framing to be very competent, although unduly detailed. Hopefully, the above summary captures all the issues required for resolution.

III. Findings

Let me now provide my answers to each of those five issues.

1. WHOSE MAP WAS FIRST IN TIME?

This is by all means the central issue. Both parties allege that their map was first in time. This point is not made any less difficult by the fact that both parties' maps do not bear the date of publication. So, I will try my best, based on the record, to decide on a balance of probabilities which party published its map first. Before I do that, there is an important issue that needs quick resolution. It relates to the Plaintiff's *locus standii* in filing this action.

The two maps which form the foundation of the Plaintiff's case did not have a copyright notation of the Plaintiff (See PEx 6 and PEx 7 & - particularly PEx 7). The two maps instead bore a copyright notation of a company called Macmillan Publishers Ltd. According to Mr David Nyasuna Muita (PW 1), who is the Managing Director of the Plaintiff, his company is a wholly owned subsidiary of Macmillan Publishers Ltd which is a British Company. On this basis, Mr Opini, Counsel for the Defendant, submitted in writing and orally that the Plaintiff was "non-suited".

In law, it is clear that a suit cannot stand unless there is a cause of action. What constitutes a cause of action was adumbrated in the case of *Auto Garage and Others vs Motokov (No. 3) [1971] E. A. 514* in the following words of SPRY, V. P:

"*I would summarize the position as I see it by saying that if a Plaint shows that the Plaintiff enjoyed a right that right has been violated and that the Defendant is liable, then in my opinion a cause of action has been disclosed …" (p. 521).*

A cause of action has three key elements:

(1) that the Plaintiff enjoys a right; and

(2) that the right has been violated; and

(3) that the Defendant is the person liable for that violation.

In the present argument, it would appear that Mr Opini questions the basis of the Plaintiff's right on account of the fact that the Copyright is owned by a British Company, Macmillan Publishers Ltd, who is not party to this suit. What, in other words, is its *locus standi*? I think the answer to that question is found in the following passage from <u>*Copinger and Shone James*</u> on Copyright (14th Edition, Sweet & Maxwell, London 1999) at page 996:

"*A person entitled to a copyright in equity may start an action and seek interlocutory relief, relying on his equitable title. He will not, however, be entitled to final relief unless he has either joined the legal owner as a party (Co-plaintiff or defendant) or obtained assignment of the legal title."*

In the present case, PW 1 told the court that the aforesaid British Company was the holding company of the Plaintiff and that the subject matter upon which the Plaintiff based its claim (the map) was actually made by the parent British Company for the Plaintiff. This informs one easily that the Plaintiff was the equitable owner of the maps in issue. The point was not controverted. On the contrary, it was affirmed by Mr Kuldip Sapra (DW 1), who is a Director of the Defendant. In his testimony, he referred to the maps in issue as "The Plaintiffs" meaning that he acknowledged that the Plaintiffs had some right in them. That being the position, it is clear that based on the authority cited, the Plaintiff was entitled to commence the action to pursue interlocutory relief.

However, the interlocutory relief appeared not fruitful leading to a full trial. Based on the same authority, the Plaintiff cannot seek relief at the trial unless it fulfills the condition of either joining the British Company as a party to the suit or obtaining from it an assignment of its legal title. This was, of course, done. PW 1 produced a document (PEx 1) by which the British Company assigned its rights in the maps in issue to the Plaintiff. I, therefore, find and hold that the Plaintiff had locus standii in bringing this suit.

Now going back to the question, whose map was first?

It is clear from the record that the Plaintiff's parent company was in the business of making Kenyan maps dating back to 1985 when it made the first map, the "Kenya Tourist Map". That map was produced in evidence as PEx 6 and DEx 19. According to the witness statement of Stephen Jonathan Beck, which was produced in evidence by consent, the 1985 map produced by the British Company for the Plaintiff was a pioneer one and won the 1986 British Cartographic Society Design Award.

By DW 1's own admission, the Defendant was a customer of the Plaintiff, purchasing in bulk these maps from the Plaintiff and reselling them at its retail outlets in Nairobi. On cross-examination, he conceded that the Plaintiff's maps were very popular and sold well. So the Plaintiff's assignor i.e. the parent company appears to have had experience in map making and was in the business of map making for a considerably long period of time before the Defendant ever conceived the idea of making its own maps. As I noted before, the 1985 map was "pioneer work" and the 1989 map which followed was nothing but an improvement of the pioneer work.

It is also interesting to note that when the Defendant was confronted with the threat of a claim, it changed its map – possibly to avoid a claim for damages. (See PEx 8 which was the map alleged to be in breach and DEx 18 the new version).

There was, however, some conflicting account of the date when the Plaintiff's second map, the 1989 map was produced. According to DW 1, the Plaintiff did not produce the "Kenya Traveller's Map" in 1989 as claimed in the Plaint but that the map was produced in 1990. In this regard, the Defendant referred to DEx 22, 23 and 24 and argued that the Plaintiff's case should not be believed because the testimony of PW 1 was at variance with the Plaint. I think this is a red herring. PW 1 clearly explained how the second map was developed from the first one, and that the second edition was done in 1989 but released to the market in 1990. Although the testimony of that witness was taken before Justice Githinji, with the unfortunate result that I did not benefit from his demeanour, his evidence on record was a matter of facts and consistent in many respects even on cross-examination. By contrast, DW 1's evidence came out mainly as self-serving and not very consistent.

Based on what I have said above, I find that on a balance of probability, the Plaintiff's 1989 map called "Kenya Traveller's Map" was first in time to that of the Defendant's map called "Kenya Pictorial Tourist Route Map".

2. DOES THE PLAINTIFF HAVE COPYRIGHT IN THE MAP CALLED "KENYA TRAVELLERS MAP"?

Based on the above finding that the Plaintiff's 1989 map, the Kenya Travellers Map, was first in time, and given that the Plaintiff had expended sufficient work in making the map, the Plaintiff enjoyed copyright over the same.

When this suit was filed in 1995, the law applicable to Copyrights in Kenya was the Copyright Act, Cap 130, Laws of Kenya. It was repealed by Act No. 12 of 2001, the Copyright Act, 2001. For all intents and purposes, the Plaintiff's claim herein is governed by the law applicable at that time, that is the Copyright Act, Cap 130. The two Acts are not significantly different, and where appropriate I will point out the difference.

The Copyright Act, Cap 130 (now repealed) was an Act of Parliament to make provision for copyright in literary, musical and artistic works.

"Artistic Works" according to Section 2 (1) (b) of the Act "includes maps, plans and diagrams." Under Section 3 (1) (c) artistic works are eligible for copyright provided:

"3(2) (a) sufficient work has been expended in making work to give it an original character; and

(b) the work has been written down, recorded or otherwise reduced to material form."

Clearly, we have seen that the Plaintiff's first map, the 1985 map was a pioneer and award winning item, and the second map, the 1989 map was a follow-up, and an improvement over its predecessor map. The evidence given by the first two witnesses on behalf of the Plaintiff demonstrate strongly and significantly the amount of work invested in producing these maps to give them an original character. PW 1 produced the original notes comprising the research materials gathered by the plaintiff to enable the plaintiff's cartographer draw the map. These notes were produced as plaintiff's exhibit 2. He testified that he did physical verification of the names of the buildings, streets, rivers as well as other features in plaintiff's map. He had to travel extensively to do all this.

Under the provision of Section 4 and 5 of the Copyright Act, copyright is conferred on works that are eligible for it. In this case the Plaintiff having demonstrated that it had expended sufficient work in making the map to give it an original character, was eligible for Copyright, and did in fact enjoy copyright over both its maps. It did not need to register the same, nor did it need a license of any kind to enjoy its copyright {See *Sapra Studio vs Tip-Top Clothing Company (1971) E A 489*}.

3. HAS THE DEFENDANT INFRINGED THE PLAINTIFF'S COPYRIGHT?

The circumstances in which one could be said to have breached copyright at the time this suit was filed were defined in Section 15 (1) of the Copyright Act (Cap 130) which is now repealed. The Section provided as follows:

"*15. (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."

The point to be decided in this case is whether the Defendant's map (PEx 8) was substantially copied

from the Plaintiff's map, (PEx 7).

The Plaintiff called an expert witness, Ms Esther Mbeke Muya, (PW 2). Ms Muya is a holder of Bachelor of Science Degree in Cartography from Oxford University in the UK. She also holds a post graduate diploma in Remote Sensing from the University of London, both qualifications having been obtained in 1991. Prior to that she had obtained a technologist diploma in Cartography in Netherlands in 1975. She began her career as a Cartographer in 1970 working with the Survey of Kenya. In 1978 she joined the Kenya Polytechnic as a lecturer. At the time of giving her testimony, she was still a lecturer at the Polytechnic.

Ms Muya compared the Plaintiff's two maps with that of the Defendant's map. She did so by using the transparencies used by the Plaintiff to produce its maps with that of the Defendant and concluded that the Plaintiff's transparencies represented the total map image of the Defendant's map save for the fact that the Defendant's Mombasa map was reduced to 64% of the Plaintiff's map. (See PEx 9 and PEx 10 – the transparencies). I should note at this time that the Plaintiff sought, and was granted, an Amendment to paragraph 7 of the Plaint to show that the Defendant's map was reduced "to" and not "by" 64% of the Plaintiff's. She testified that the Defendant's Mombasa Island and Central Nairobi extracts were comparable with Mombasa Island and Central Nairobi of the Plaintiff's 1985 map. She told the court that the Defendant's map bore glaring similarities with those of the Plaintiff in terms of name placement and style of the text characters used. According to her it was not usual to find two people working separately to come up with the same kind of text style and place it on the same location. She also said that the Plaintiff's maps and the Defendant's had the same symbols including the North point and scale line placed in the same position. All this, to her, was an unusual similarity, and clearly the result of copying by one of the other's material. In her view, the copying was done by the Defendant scanning the Plaintiff's 1985 map, and then adding or removing details, then enlarging or reducing the same. In her opinion, the few differences in the Defendant's map were not material – the map having been substantially copied.

The Defence also called two expert witnesses, John Dominic Obel (DW 2) and Edward Rabuge Ngong'a (DW 3). Mr Obel is a land surveyor. He holds a Bachelor of Science Degree in Land Survey from the University of Nairobi which he obtained in 1967. Upon graduation from the University, he worked with the Government of Kenya in various positions for 30 years until 1997. Mr Ngong'a described himself as a "Cartographer by training". He started working with the Government of Kenya in 1973. He obtained a certificate in Survey in 1977. He worked in different offices until 1984 when he got a sponsorship to study in Netherlands. Upon his return, he worked in photo mapping. In 1990 he undertook further training in photo mapping in France.

Mr Obel (DW 2) and Mr Ngong'a (DW 3) attempted strenuously to point out the differences in the two maps produced by the Plaintiff, and the map produced by the Defendant. Their evidence did not impress the Court, as being consistent and truthful. For example, Mr Obel was unable to explain the many similarities pointed out to him in the maps, and tried to shift positions by seeking to give different interpretations on what amounted to "copying". He insisted that for there to be copying, one has to have produced an exact replica of the original. Upon cross-examination he changed his testimony to suggest that a map is considered as copied when the original reproduction materials (known as repromats) of that map are reproduced by camera or by contact techniques without making major changes.

Mr Ngong'a, on the other hand, had insisted during his examination-in-chief that it was not possible to scan a map and then manipulate it. However, he later agreed that it was possible to manipulate things such as colour, and location of names and symbols. He admitted eventually that it was indeed possible to scan a map and alter details digitally.

I find Mr Ngong'a's evidence to be of little value to this Court for two reasons. Firstly, it was inconsistent and contradictory as I have indicated above, and secondly, his report dated 27th September, 2000 (DEx 28) is almost entirely the same as Mr Obel's report dated 13th November, 1996 (DEx 17) even though they were done four years apart. The comparisons of the two maps provided by those two expert witnesses is so strikingly similar that one could easily come to the conclusion that Mr Ngonga's report

has been "copied" from Mr Obel's, only for the purposes of providing a second opinion to this Court. It is hardly a second opinion, and certainly of no value to this Court.

Although I only got to observe Mrs Muya (PW 2) at the point of cross-examination, she impressed me as an honest and professional witness whose only interest was to tell the truth. Her testimony was logical and consistent in all respects and I believe her over Mr Obel and Mr Ngong'a. In fact, in the end, even the Defendant appears to admit that there were similarities between its map and those of the Plaintiff. Is that not the foundation of the Defendant's counterclaim? Was it not also the reason DW 1 told the court what led to the withdrawal of PEx 8?

From the facts disclosed, it is obvious that there were huge similarities between the Plaintiff's maps and the Defendant's. This is evident to an ordinary person looking at the two maps, and it is certainly evident to the eyes of this Court.

From this conclusion, I find that the Defendant substantially copied the Plaintiff's work. Did that amount to infringement of copyright?

I think yes. As was pointed out in *Alternative Media Ltd vs Safaricom Ltd (2005) 2 KLR 253* infringement of copyright arises not because the Defendant's work resembles the Plaintiff's, but because the Defendant had copied all or a substantial part of the Plaintiff's work. In the case before me, the Plaintiff has submitted evidence which I find to be both sufficient and credible, that its maps (PEx 6 and PEx 7), were copied by the Defendant in the production of the Defendant's map (PEx 8), and I find the Defendant fully liable for the infringement of the Plaintiff's copyright.

4. IS THE PLAINTIFF'S CLAIM CAUGHT BY LACHES?

It has been found that the Plaintiff enjoys copyright in its maps. However, the allegation in the suit is that the Defendant produced the offending map in 1990 yet no action was mounted until 1995.

Although the Defendant proffered the defence of laches in its pleading no serious submission was advanced on it in the written submissions filed on its behalf. Mr Opini, Counsel for the Defendant, alluded to it in his oral submissions saying that the infringement was a tort and was barred by limitation. He did not refer the court to any authority to support his submission. In any event, I agree with Mr Kimani's response that this was a tort of a continuing nature. So long as the Defendant continued to produce and sell the infringing maps the Plaintiff's right was alive until the tort was discontinued, in this case until the Defendant agreed to withdraw the offending map.

Further, I also agree with the submission in the Plaintiff's Written Submissions that it was not enough for the Defendant to plead laches but it had also to show that the Plaintiff had agreed to abandon or release his right *(Hepworth vs Pickles (1900) 1 Ch 108)*, or that the delay resulted in the destruction or loss of evidence by which the claim may have been rebutted *(Bourn vs Swan & Edgar Ltd 1903 1 Ch 211)* or that the Plaintiff had acted so as to induce the Defendant to alter his position on the reasonable faith that the claim had been released or abandoned.

The Defendant did not establish any of those facts and the defence of laches must, therefore, fail.

IV. Conclusion

On this conclusion, I feel that I have exhausted the substantial issues in the suit and I feel entitled to enter Judgment for the Plaintiff as sought in the Plaint. All four prayers in the Plaint are allowed. With regard to prayer (c) the parties are at liberty to apply for further directions and orders should they require same**.**

As the Defendant has failed to prove its counterclaim the same is dismissed with costs.

Those shall be the orders of the Court.

Dated and delivered at Nairobi this 23rd day of October, 2008

ALNASHIR VISRAM

JUDGE