



REPUBLIC OF KENYA
IN THE HIGH COURT OF KENYA AT NAIROBI
MILIMANI COMMERCIAL & ADMIRALTY DIVISION
CIVIL CASE 263 OF 2004

ALTERNATIVE MEDIA LIMITED.....PLAINTIFF

VERSUS

SAFARICOM LIMITED.....DEFENDANT

JUDGMENT

This is a case in which the Plaintiff is asserting ownership to a copyright in some artistic work. It is the Plaintiff's case that the Defendant had infringed upon his copyright in the said artistic work. Therefore, the Plaintiff is seeking orders to permanently restrain the Defendant from further infringement. The Plaintiff also wishes to have the Defendant ordered to forfeit, and deliver up to the Plaintiff, the copies of the infringing works, as well as the articles specifically designed or adapted for making the infringing copies. In the alternative, to the order for forfeiture, the Plaintiff asks that the infringing copies be destroyed.

The other remedy sought by the Plaintiff is for an inquiry as to damages, for the alleged infringement. Alternatively, the Plaintiff asks that it be accorded the option to seek an account of profits.

Following the inquiry into damages or the taking of accounts, the Plaintiff wishes to be paid all such money as are found to be due to it. Finally, the Plaintiff sought costs and interest.

In its Defence, the Defendant denies the assertions that the Plaintiff owned any copyright, as alleged. It was the Defendant's position that the scratch-cards were designed by its own designers. Therefore, the minor additions to the said cards could not, in the Defendant's view constitute a copyright. Similarly, the Defendant asserted that the slogans used on the scratch-cards were not coined by the Plaintiff, in any event. Furthermore, the Defendant contends that the cards in issue were designed for it, by Tequila Kenya, which is an advertising and design firm, which had been engaged by the Defendant.

The Defendant categorically denied copying the Plaintiff's artistic work. It also denied having, within its control, lithograph plates designed for making the infringing copies, in the knowledge that the plates had been used, and were still to be used to make infringing copies. If anything, the Defendant said that its scratch-cards were printed in the United Kingdom, and that the Defendant did not have any lithographs under its control.

Furthermore, the Defendant asserted that it had not deprived the Plaintiff of potential or substantial benefit, in its copyright, if any. As far as the Defendant was concerned, it had not infringed, and also had no intention of infringing the Plaintiff's copyright. The Defendant insists that the alleged infringed copies were formulated by Scanner Agencies Limited, without any input from the Defendant.

When the case came up for trial, the parties formulated the following three issues which they then placed before the trial court for determination:-

“1. Does the Plaintiff have a copyright over the artistic work?

2. If so, have the Defendants infringed the said copyright?

3. If so, what is the measure of damages?”

Thereafter, once the trial got underway, the Plaintiff called two witnesses, whilst the Defendant called three witnesses.

PW1, **Michael Joseph Adede**, was the Chief Executive of the Plaintiff. He described the Plaintiff as being involved in media communication, advertising and outdoor displays.

He testified that in 2003 he came up with a concept which would enable the Plaintiff use the medium of the Defendant’s scratch-cards for communicating AIDS awareness. PW1 approached Telkom Kenya Limited, Kencell, as well as the Defendant to promote his said concept. The approach to the three companies was in the form of written proposals, which were accompanied with artistic works.

The proposal sent to Telkom Kenya Limited was dated 3rd May 2003, and is marked as **Exhibit 1**. The proposal to Kencell Communications Limited was dated 29th April 2003, and is marked as **Exhibit 2**. Then, finally, the proposal to the Defendant was dated 29th April 2003, and it is marked as **Exhibit 3**.

Telkom Kenya Limited failed to respond to the proposal, whilst Kencell Communications Limited wrote back on 2nd May 2003, declining the proposal. On its part, the Defendant wrote back on 19th June 2003, also declining the Plaintiff’s proposal. It is the Plaintiff’s case that notwithstanding the Defendant’s decision to decline its proposal, the Defendant later released scratch-cards, in May 2004, bearing the AIDS campaign, which bore similarities to the Plaintiff’s artistic works, which had earlier on been given to the Defendant.

PW1 gave the following examples, to illustrate the similarities between its artistic works and the scratch-cards released by the Defendant.

(a) In the expressions, the words;

(i) “We Declare Total War on Aids.”

(ii) “Break the silence and talk about Aids.”

(iii) “Choose Life.”

(b) The face of a person, covered with a ring.

(c) The smile of a person celebrating life.

(d) The positioning of the expressions at the bottom of the scratch-cards, as recommended in the Plaintiff’s proposal.

It is the Plaintiff’s case that by the actions of printing and using scratch-cards which bear its artistic works, the Defendant was infringing its copyright. The said acts of infringement are said to have caused the Plaintiff to suffer losses. Therefore, PW1 testified that the Defendant ought to be ordered to pay to the Plaintiff all the money which NASCOP paid to the Defendant.

PW1 explained that donors were going to pay, to the Plaintiff, money for the promotion of HIV/AIDS awareness. Thereafter, the Plaintiff would have paid a portion of the said money to the Defendant. The

difference between the money paid by the donors, and the portion paid over to the Defendant would have been the Plaintiff's profits. For that reason, PW1 urged this court to order the Defendant to pay to the Plaintiff, compensation at the rate of Kshs. 10/- for each of the scratch-cards circulated countrywide.

Later, during cross-examination, PW1 emphasized that the Plaintiff was not laying claim over the words used in the proposed promotional material, such as **"We Declare Total War on Aids."** The Plaintiff's claim was thus only limited to the positioning of the said words, which were placed at the bottom of the scratch-cards. But at the same time, PW1 conceded that in the Defendant's original scratchcards, there had been an "environmental message." The said message read as follows;

"COMMITTED TO SUPPORTING KENYA'S ENVIRONMENT"

And the message was at the bottom part of the Defendant's scratch-cards. In the circumstances, I am not convinced that the "positioning" of the Aids awareness message was the Plaintiff's original idea. The Defendant had already been placing environmental messages at the same position on the scratch-cards. Thus the only thing which changed was the nature and content of the message, not the positioning thereof.

Then there is the issue of the photograph of a smiling lady. The said lady is within a ring, and has her left arm raised at **"the 2.00 O'clock angle."** PW1 said that the healthy smiling lady signifies "a celebration of life," even though those words were not used by the Plaintiff in its proposal. And, as far as PW1 is concerned, the artistic work lay in the fact that the smiling lady was placed within the ring. This is what he said, in his evidence;

"The concept of a person protected with a ring is our artistic work." At the same time, PW1 did concede that the ring itself was a concept which had been originally derived by the Defendant. Therefore, the Plaintiff did not claim any rights over the said ring. However, when asked to compare the Defendant's **"offending works"** to that produced by the Plaintiff, PW1 admitted that the head of the man in the **"offending works"** was outside the ring.

In my considered view, if the artistic work was to found in the fact that the ring offered protection to the person who was celebrating life, that piece of work would be distinguishable from the picture of a man whose head was outside the ring. The man would not be enjoying the protection of the ring!

PW2, Morris Ochieng Odeny, was a graphic designer. He is a graduate of the Kenya Polytechnic.

Between February and April 2003, PW2 was contracted by the Plaintiff, who had a concept on Aids awareness; which concept was to be put down on scratch-cards. PW2 said that he is the one who came up with designs for Telkom Kenya Limited, Kencell Communications Limited and the Defendant. He used a computer to produce the designs.

The design which PW2 produced for the Defendant is contained in Exhibit P3. Two of the three designs bear the picture of a jovial lady. And, according to PW2, the cards also contained the following messages:-

(a) **"Choose Life."**

(b) **"Life is Short. Protect it."**

(c) **"You have the right to live."**

Don't let Aids take it away."

Choose Life."

(d) **"Break the Silence."**

(e) "We declare Total War on Aids."

It was the evidence of PW2 that the Defendant produced cards which had similarities to his artistic works. In particular, PW2 felt that the Defendant had placed various elements on the cards, in the same position as he had done in Exhibit 3. Furthermore, the font used by PW2 for the phrase "**We declare Total War on Aids,**" is said to have been copied by the Defendant.

However, during cross-examination PW2 admitted that he had not used the phrase "**We declare Total War on Aids**" in his proposal to the Defendant. Those words had only been used by him, in Exhibit P1, which was a proposal to Telkom Kenya Limited. That notwithstanding, PW2 lay claim to the concept of a human being, who was in a jovial mood. As far as he is concerned, whether the picture was of a man or a woman, the concept was his, as the lady in his proposal, was representative of humanity. Yet, when pressed further, PW2 admitted that a comparison between his design (as in Exhibit P3) and the Defendant's design (as in Exhibit P4) yielded many differences. In a nutshell, he concluded that;

"There is a huge difference."

And with that conclusion, the Plaintiff closed its case, without re-examining the witness.

Thereafter, the Defendant called three witnesses, in an endeavour to answer to the Plaintiff's case.

DW1, Khuzema Bashir Bhajjee, is a senior art director at Red Sky, an advertising agency.

DW1 testified that he designed the original scratch cards for the Defendant. The said cards are at pages 50 to 55 of the "**Agreed Bundle of Documents.**" It was his evidence that the ring used on the cards was designed by Scanad. He added that the basic idea was to have coloured pictures inside the ring, whilst outside the ring would all be green. The emphasis on the colour green emanated from the environment, which was a theme that the Defendant was supporting.

Also there was a red dot, which was derived from the logo for Vodafone, an international investor, who was the Defendant's partner. The first card designed for the Defendant is shown at page 56 of the "**Agreed Bundle of Documents.**" Basically, the whole card is in two shades of the colour green. The predominant feature in it is the left hand of a person, who is holding five scratchcards, all which bear the prefix "072". Each of the five cards has a picture of one of the following animals, elephant, rhino, buffalo, leopard and lion.

The catch-phrase on the first cards was "**the better deal.**" And, at the bottom right-hand corner are the words "**The Telkom Vodafone Connection.**" Those first cards were launched in 2000. Thereafter, in 2001, the Defendant launched "The Green Card." It is that card which introduced the ring within which there were coloured pictures. The said pictures ranged from a mountain; on acacia tree, during sunset; a tree on a bright day; a waterfall; a mountain range; and a lake., According to DW1, the first two proposals of the Plaintiff utilised the Defendant's original works. That fact was confirmed by both PW1 and PW2.

To the said original works, the Plaintiff added a red strip, to the left-hand margin of the card. In effect, the rest of the Defendant's original design was left intact. It was only inside the red strip that the Plaintiff introduced the Aids messages. In his assessment, DW1 found that there was nothing original about the red strip introduced by the Plaintiff. He explained that the Helvetica font which was used by the Plaintiff and the Defendant was not special. It was one of the many fonts available on the computer, and was easier to reach.

DW2, Flora Njeri Kariuki, is a graphic designer. She testified that she was the designer of the Defendant's scratch card, as shown on page 47 of the "**Agreed Bundle of Documents.**"

DW2 said that at the material time, she was employed at Tequila Kenya. The Client Service Department of his employer gave her a brief, to prepare scratch-cards for the Defendant. She, together with the Creative Director, Erick Van Vliet; Ashley Myers and Joana Athanasius came up with the three options.

The said three design options are shown at page 49 of the “Agreed Bundle of Documents.” They depict the following themes:-

(i) “Manchester United Collectors Scratch Cards”, which depicted pictures of the various players, who were members of that football club.

(ii) “Aids awareness campaign scratch cards”

(iii) “Cancer Awareness scratch cards”

In respect of the first two themes, the witness (and her colleagues) came up with two pictures each. But for the third theme, there was only one picture.

All the pictures were put together on a **“mock-up”** and presented to the Defendant. A “mock-up” is a presentation mounted on a frame, so as to enable the client appreciate what the proposed concept would finally look like.

After the Defendant had given due consideration to the “mock-up”, they chose one of the two pictures, under the theme “Aids Awareness Campaign.” However, they also suggested some changes to the presentation, so as to incorporate the white ring (or swoosh), and the Vodafone red dot. Also the validity period of the card was increased from fifteen to thirty days. Thirdly, the Defendant’s logo was changed, in its presentation. For the first time, the said logo was presented in the form of a sim card. It was explained by DW2 that the photo which she used was obtained from the Image Bank in South Africa. She explained that the Image Bank collects photographs from photographers around the world. A user would then log onto the website, and specify what he was looking for. Once the user was given access to the site, he could download what he liked. However, the downloaded version would not be clear, and could therefore not be used, for the final product. The user was therefore obliged to buy the rights to the desired image, in order to get a clear picture.

In this case, DW2 explained that the brief from her client had included the phrase “Celebrate Life.” Therefore, when searching in the website of the Image Bank, DW2 went looking for **“African, happy and in celebration mood.”**

She therefore used the following words in her search;

“African”, “Happy”, and “Celebration.”

After identifying the picture which she deemed appropriate, Tequila Kenya (who were DW2’s employer) bought the image from Image Bank, South Africa. Thereafter, DW2 used her computer to crop the picture. Originally, the said picture depicted the full-sized man who was drumming. Behind the man was a group of dances, in a street. Having cropped the picture to her satisfaction, DW2 superimposed it onto the Defendant’s pre-existing scratch card.

Kefa Nyakundi (also of Tequila Kenya) designed the shield which bore the words:-

“WE DECLARE TOTAL WAR TO AIDS”

The said shield was also incorporated into the final product, which was then produced in size **“AO”**, which is large enough for purposes of a public launch. According to DW2, she did not see the Plaintiff’s proposal before designing the card which is now in contention. If anything, the first time when DW2 saw the Plaintiff’s work was long after this suit had been instituted. The witness was very categorical about that fact, even when she was being cross-examined.

DW3, NZIOKA SIWADIE WAITA, is the head of legal services at the Defendant company. He had worked with the Defendant for four-and-a-half years, by the time he gave evidence in court.

He explained that the Plaintiff's proposal, which was addressed to the Defendant's Managing Director, was forwarded to the Defendant's "**Sponsorship Committee.**" The reason for sending it to that committee was that anything which the Defendant perceived to be in relation to "Corporate Social Responsibility", ordinarily went to that committee.

The Committee considered the proposal and rejected it. According to DW3, the proposal should then have been archived. However, in this instance, it would appear to have been destroyed, as the Defendant's new offices did not have sufficient space for storage.

On 15th September 2003 Scanner Agencies wrote to the Defendant, proposing to put Aids messages on the Defendant's scratch cards. The Defendant accepted the proposal.

DW3 explained that the said proposal was accepted by the Defendant because it had been accompanied with a reference from the Ministry of Health; and specifically the division charged with managing Aids i.e NASCOP. The reference by NASCOP is what swayed the Defendant into accepting the proposal from Scanner Agencies, even though the earlier proposal from the Plaintiff had been rejected.

On 6th October 2003, Dr. K. L. Chebet, the Director of NASCOP/NLTP, wrote to the Defendant notifying it that the Ministry of Health was ready to support the initiative through which Scanner Agencies was to utilise the Defendant's scratch cards, to disseminate HIV/AIDS messages.

By a letter dated 14th October 2003, Scanner Agencies proposed to pay 50 cents per scratch card. That proposal was not accepted by the Defendant, and finally, the parties agreed that Scanner Agencies would pay to the Defendant, the sum of 70 cents, in respect of each scratch card. The said sum of 70 cents was only one-half of the extra cost which the Defendant was to incur when re-designing its cards, to incorporate the Aids awareness campaign.

DW3 testified that the Defendant produced six million cards, at about Kshs. 4,200,000/=, over and above the normal production costs. That sum only represented the Defendant's contribution. Scanner Agencies were to contribute a similar sum. However, as at the date of trial, Scanner Agencies had not yet made good their payment, as they contended that the Government of Kenya had not paid them.

Having set out the evidence tendered at the trial, I will now analyse the same, in the light of the applicable law. In the process of the said analysis, the court will strive to answer the three issues which were set out by the parties. The first issue is as to whether or not the Plaintiff has a copyright in the artistic works.

PW2 testified that he is the one who came up with the designs in Exhibits P1 P2 and P3. There is no doubt that his said designs were superimposed onto the Defendant's original scratch-cards. That fact is common ground.

How did PW2 come up with the designs? He said that he used the computer to put together the same. His description of the manner in which he produced the design makes it look easy. But when compared to the description of the work put in by DW2, I have no doubt that the task of putting together a design, such as the one produced by PW2, is no mean feat. One has to identify a picture that represents the theme which he wishes to portray. The said picture is then incorporated onto the pre-existing scratchcard, in such manner as not to interfere with the said cards' original design and purpose.

DW1 testified that there was nothing in the red strip, or the picture of the smiling lady inside the white ring; that can be described as being uniquely artistic.

I had earlier looked at the wordings and the positioning thereof. First, the Plaintiff said that it was not claiming any copyright in respect to the wordings constituting the "**Aids messages.**" Secondly, the Defendant used to position its "**environmental messages**" in the same position which the Plaintiff has now placed the "**Aids Messages.**" In effect, the positioning of the messages, at the bottom portion of the scratch cards is not by itself an original idea produced by the Plaintiff.

But, the Defendant has not challenged the Plaintiff's contention that it is the one which came up with the picture of a smiling lady, who was being used alongside the Aids messages, in the promotion of Aids awareness. Instead, the Defendant has asserted that the effort put in by PW2 was not uniquely artistic. To my mind, the law does not require a person to prove that his work was uniquely artistic, for it to be an "artistic work" Section 2(1) of the Copyright Act 2001, defines "artistic work" as follows:-

"Artistic Work means, irrespective of artistic quality, any of the following, or works similar thereto –

(a)

(b)

(c)

(d) photographs not comprised in audio-visual works;

(e)"

In the light of that definition, I hold that an artistic work may be constituted by something, such as a photograph even if the quality thereof was not "uniquely artistic." The quality of the said works is not material.

In this case, the Plaintiff is claiming a copyright over the photograph of the smiling lady, within the set-up of the white ring, as superimposed onto the Defendant's scratch-cards, together with the Aids awareness message. In other words, the copyright is in respect of the total presentation, as opposed to the picture alone, or any other element of the said presentation, taken on its own. The said works are said to have been produced, using a computer.

In that regard, I find that the definition of the word "author", as found the Section 2(1) (g) of the Copyright Act is significant. It reads as follows:-

**"author," in relation to
(g) a literary, dramatic, musical or artistic work or computer programme which is computer generated, means the person by whom the arrangements necessary for the creation of the work were undertaken."**

Although the said definition is not necessarily descriptive of the role played by PW2, I hold that it is wide enough to include him.

In order to come up with the design, PW2 had to utilize his knowledge, labour and skill, so as to produce something which nobody else had yet done. At least, there is no evidence before me that the Plaintiff's designer merely copied the idea of promoting Aids awareness through scratch cards from somebody else. In the absence of evidence to that effect, I do find that the totality of the Plaintiff's effort was a design which had original character. For that reason, I hold that the Plaintiff did have a copyright over the artistic works. But before moving on from this issue, I wish to take note of the view expressed by Mr. Alibhai, advocate for the Defendant, to the effect that DW2 expended effort and skill in obtaining the photograph and the various design elements on the card, so as to give it a completely original character. To my mind, it is for that reason that the first issue has been answered in the affirmative, as I believe that PW2 did expend comparative effort and skill.

The second issue is as to whether or not the Defendant has infringed the Plaintiff's copyright.

By virtue of Section 26(1) of the Copyright Act;

"Copyright in a literary, musical or artistic work or audio-visual work shall be the exclusive

right of control the doing in Kenya of any of the following acts, namely the reproduction in any material form of the original work or its translation or adaptation, the distribution to the public of the work by way of sale, rental, lease, hire, loan importation or similar arrangement, and the communication to the public and the broadcasting of the whole work or a substantial part thereof, either in its original form or in any form recognisably derived from the original.”

The owner of the copyright works is therefore the only person who may reproduce the material either in its original form or its translation or adaptation. If anybody else does any of those acts, he is deemed to have infringed the copyright.

In effect, infringement of a copyright does not only mean the reproduction thereof in its original form; it includes the translation or an adaptation of the copyright work. In the case of **DESIGNERS GUILD LTD V RUSSEL WILLIAMS (TEXTILES) LTD [2001] 1 ALL ER 700 at 708**, Lord Millet expressed himself thus, when comparing actions for passing-off to those of copyright:-

“The gist of an action for passing off is deceptive resemblance. The defendant is charged with deceiving the public into taking his goods as and for the goods of the Plaintiff. A visual comparison of the competing articles is often all that is required.

An action for infringement of artistic copyright, however, is very different. It is not concerned with the appearance of the defendant’s work but with its derivation. The copyright owner does not complain that the defendant’s work resembles his. His complaint is that the defendant has copied all or a substantial part of the copyright work. The reproduction may be exact, or it may introduce deliberate variations – involving altered copying or colourable imitation as it is sometimes called.

Thus the overall appearance of the defendant’s work may be very different from the copyright work. But it does not follow that the defendant’s work does not infringe the Plaintiff’s copyright. The first step in an action for infringement of artistic copyright is to identify those features of the defendant’s design which the Plaintiff alleges to have been copied from the copyright work. The court undertakes a visual comparison of the two designs, noting the similarities and the differences. The purpose of the examination is not to see whether the overall appearance of the two designs is similar, but to judge whether the particular similarities relied on are sufficiently close, numerous or extensive to be more likely to be the result of copying than coincidence. It is at this stage that similarities may be disregarded because they are commonplace, unoriginal, or consist of general ideas. If the Plaintiff demonstrates sufficient similarity, not in the works as a whole but in the features which he alleges have been copied, and establishes that the Defendant had prior access to the copyright work, the burden passes to the Defendant to satisfy the judge that, despite the similarities, they did not result from copying.”

In this case the Plaintiff did establish that the Defendant had prior access to the copyright work. DW2 admitted that:-

“Scanner Agencies held meetings with us at our old offices. That was before the Plaintiff’s proposals were destroyed. The opportunity to see them existed.”

And although PW2 readily conceded that there was a **“huge difference”** between the copyright work and the **“infringing copy”**, that alone did not mean that the Defendant’s work had not infringed the copyright work. As held in the **Designers Guild** case (supra), the court needs to ask itself if the similarities in the features are likely to be due to either copying or sheer coincidence. That there are similarities in this case, is not in doubt.

But the Defendant did adduce evidence, through DW2, to show how it put together the design in contention. She obtained the photograph of the smiling man from Image Bank, South Africa. Having

observed her testifying in court, I have no doubt that DW2 was a straightforward witness. I therefore have no reason to doubt her when she said that she did not see the copyright work prior to coming up with her own design.

However, I nonetheless find that the Defendant's design appears to have been derived from the copyright work. I say so because although DW2 did not see the copyright work in advance, she did receive a brief from the Client Service Department of Tequila Kenya. A copy of the said brief was not made available to the court because, as DW3 said, it must have been destroyed by the Defendant. At the same time, Tequila Kenya also ceased to exist. But, the interesting thing is that the said Tequila Kenya ceased to exist in or about November 2004, which was some five or more months after this suit was filed. In the circumstances, it should have been possible for the Defendant to make available a copy of its brief to Tequila Kenya, so as to satisfy the court that the similarities did not result from copying.

When I make reference to copying, I am not using that word literally, as DW2 cannot have copied that which she had not yet seen, as at the time she was designing the offending copy. To my mind it is possible, indeed probable, that when the Defendant was giving its brief to the designers of the offending copy, it consciously or subconsciously gave such instructions as did lead the designer to adapt the copyright works.

I find that it was more than coincidence to not only utilise the picture of a smiling person, but also the words which the Plaintiff had used in its proposal.

In Halsbury's Laws of England, 14th Edition, Vol 9 (2) paragraph 314, it is said that innocent infringement of a copyright is not a defence. This is how the learned authors of that text have expressed the point:-

"The fact that the defendant acted innocently is no defence, for copyright is a proprietary right, and if it is invaded, the element of motive or intention on the part of the defendant is wholly irrelevant."

The issue of the Defendant's motive or intention is significant because there was no evidence that the Defendant deliberately set out to infringe the Plaintiff's copyright works.

In the treatise "**The Modern Law of Copyright and Designs**", the learned authors gave the following illustration, at page 138:-

"The Defendant wished to make replacement liners for the claimant's customers. When he began to do so he was accused of infringing the copyright. Being aware that an independent created work does not infringe a copyright, he accordingly instructed an independent designer to design a plastic liner suitable for fitting in the rim of the pulley wheels; for his purpose, he sent him a blank pulley wheel (that is without any liner). He also told him it must be so shaped as to accept a rope of a given size. The designer set to work and produced a liner very similar to the claimant's liners, although he had never set eyes on the latter. Held, the Defendant did not escape liability in this way. The similarity between the new liner and the original was not coincidence, but flowed from (and was virtually dictated by) the instructions the designer was given, which afforded a sufficient casual link between the two."

In the light of the foregoing, I do hold that the Defendant did infringe the Plaintiff's copyright work.

Having made that finding, the court must now deal with the issue of damages. In the Plaintiff's prayer was for an inquiry as to damages or, at the Plaintiff's option, an account of profits. The Plaintiff sought an order for the payment of such damages as may be found to be due to the Plaintiff upon taking an inquiry into damages or upon the taking of the accounts.

However, at the trial, the Plaintiff did not put forward the same claims, for compensation. Instead, PW1 asked the court to award compensation at the rate of Kshs. 10/= for each of the scratch cards which the

Defendant made. As far as he was concerned, the Plaintiff may have been able to get between Kshs. 20/= and Kshs. 25/= from NASCOP. Out of that sum, the Plaintiff could have paid about Kshs. 15/= to Safaricom, for leasing the cards.

However, I note that the Plaintiff had only held preliminary discussions with Dr. K.L. Chebet of NASCOP. It was Dr. Chebet who was then expected to, thereafter, hold discussions with donors, who would give financial support to the project. That was the testimony of PW1, Michael Joseph Adede. At no time did PW1, talk to any donors. Therefore, in my considered view the demand by the Plaintiff for Kshs. 10/= for each of the scratch cards circulated by the Defendant is merely speculative.

PW1 also said that the Plaintiff wanted the court to order the Defendant to pay over to it, all the money which NASCOP had paid to the Defendant. Yet, again, the Plaintiff did not adduce any evidence to show that NASCOP had paid any money to the Defendant. Furthermore, even if NASCOP had actually paid some money to the Defendant, the Plaintiff did not justify its claim to such money.

It is clear from the evidence of PW1 that the Plaintiff was expected to share, with the Defendant, the costs of the production of the re-designed cards, had the project come to fruition. PW1 explained that as the Plaintiff was leasing the scratch cards from the Defendant, as a medium for relaying the Aids awareness messages, the Plaintiff was to have paid costs therefor. For that reason, the Plaintiff's written proposal (which is Exhibit P3) stated as follows:-

“We propose to share the cost of production of the scratch cards by paying to you a fee to be agreed upon on your acceptance of this concept.”

To my mind, there is nothing to show the stage at which the Plaintiff's intention, (which was to pay a fee to the Defendant), changed, so that it became necessary for the Defendant to pay the Plaintiff instead.

The Plaintiff has also suggested that the damages be calculated on the basis of the **“internationally accepted United Kingdom Publishers Association Code of Practice Minimum Terms of Agreement,”** which stipulates that the Defendant should compensate the Plaintiff with 15% of the entire sales of the infringing works.

Although the Plaintiff has invited the court to adopt the Code of Practice of the United Kingdom Publishers Association, it has not laid any foundation which would enable the court accept that invitation. For instance, where else is that Code of Practice applied other than in the United Kingdom? Are the circumstances in the United Kingdom, and any other territories where the code is applicable, comparable to Kenyan Conditions?

Secondly, I hold the view that the method provided, for the calculation of the royalties, in the U.K. code of practice, would only be applicable if the Plaintiff was able to prove that the sales made were attributable to the use of the infringing copies. In other words, it would have been necessary for the Plaintiff to prove that if the Defendant had not utilised its infringing works, the Defendant would not have made the sales.

In this case, DW3 testified that the sales of the Defendant's scratch cards is not attributable to the message on the card. He explained that the sole reason why the Defendant makes sales of its scratch cards is because of the value of the airtime. I find, and do hold, that the evidence of DW3, in that regard is convincing. A customer would buy the scratch card for Kshs. 250/= because he wished to utilize the airtime, and not because of the Aids awareness message. For that reason, even if the United Kingdom Publishers Association Code of Practise, Minimum Terms of Agreement were applied in Kenya, I find no basis, in law or fact, to apply them to this case.

Whilst still on that point, it is noteworthy that PW1 wished to have compensation calculated at the rate of Kshs. 10/= per card. If I had accepted that piece of evidence, it would certainly have been at variance with the method of calculation which was then suggested in the Plaintiff's submissions. Two points emerge from that comparison. First, the evidence is at variance with the submissions. Secondly, the magnitude of

the divergence between the evidence of PW1 and the Plaintiff's submissions on the damages, is a clear reflection of the difficulty in which the Plaintiff has placed itself.

In a nutshell, the Plaintiff has failed to place before me such material as would enable the court carry out any meaningful calculation of the damages awardable to it. I also hold that the Plaintiff has failed to prove that it is entitled to any damages for the infringement of its moral rights, pursuant to Section 32 of the Copyright Act. I say so because the Plaintiff failed to prove that the Defendant had mutilated, modified or otherwise treated its copyright works in such a derogatory manner, so as to prejudice the honour or reputation of the Plaintiff.

In the final analysis, the Plaintiff has proved that it is the owner of the copyright in the artistic works in issue. The said copyright has been infringed by the Defendant. Therefore, the Plaintiff is entitled to, and is hereby granted an injunction to restrain the Defendant, whether by itself or by its agents howsoever, from infringing the Plaintiff's copyright. This order is limited to the use of the photograph of the man playing the drums. However, the Defendant is not restrained from utilising any of the Aids awareness messages, if such messages are utilised independently of the picture in issue. The reason why the Defendant has been granted the liberty to utilise the messages is that the Plaintiff expressly said that it did not object thereto.

Secondly, the Defendant is ordered to destroy, upon oath, all infringing copies of the scratch cards. The said destruction must be finalised within 30 days from today, and an affidavit of compliance should then be filed by PW3, confirming the quantities destroyed, as well as the date and time when the destruction took place. The affidavit should make it expressly clear that there were no other infringing copies still held by the Defendant or its agents.

I decline to order either an inquiry as to damages or an account of profits. As far as I am concerned, these two remedies would have been available to the Plaintiff only if it had opted to first have the issue of liability determined. In that event, once the court had made a pronouncement on the issue of liability, the Plaintiff could have been put to an election, and appropriate directions would have been made for further proceedings. But, the Plaintiff already sought to prove the damages it was entitled to, albeit unsuccessfully. In these circumstances, I can do no more than to award the Plaintiff, nominal damages. Accordingly, I hereby award to the Plaintiff the sum of Kshs. 100,000/= as General damages for the infringement of its copyright. This sum shall attract interest at court rates from the date of judgement. Finally, the Defendant shall pay the costs of this suit.

Dated and Delivered at Nairobi this 4th day of October 2005.

FRED A. OCHIENG

JUDGE