



REPUBLIC OF KENYA
IN THE HIGH COURT OF KENYA AT NAIROBI
COMMERCIAL & ADMIRALTY DIVISION - MILIMANI

CIVIL SUIT NO. 107 of 2013

HIGH FLYER SERVICES & PUBLISHERS LIMITED....PLAINTIFF/APPLICANT

VERSUS

PETER GICHUKI MWANGI T/A

HIGH FLYER PUBLISHERDEFENDANT/RESPONDENT

R U L I N G

1. The Application now before the Court is brought by the Plaintiff in the Suit. The Application was filed on 19th March 2013. It is brought “***Under Order 40 Rules 1, 2, 3, 4, and 10 of the Civil Procedure Rules, Sections 1A, 1B, 3A and 63(e) of the Civil Procedure Act, and all other enabling provisions of the Law***).

2. The Application seeks the following Orders:

(1) That this application be certified urgent and the same be heard ex parte in the first instance and thereafter be Listed for hearing inter partes (spent);

(2) That pending the hearing and determination of this application and with immediate effect, a temporary order of injunction be and is hereby issued restraining the Defendant whether by himself, his servants and/or agents or any other person whatsoever from doing the following acts’ that is to say’ photocopying, branding, reproducing, publishing, issuing, promoting, advertising, printing, selling, offering for sale, offering for hire, hiring supplying, distributing and/or displaying for sale or for promotion, any books copied from the Plaintiffs books or works otherwise generally now as HIGH FYER SERIES, COMBINED ENCYCOPAEDIA and in particular, HIGH FYERS SERIES, COMBINED ENCYCLOPAEDIA STD 1, THE HIGH FYER SERIES COMBINED ENCYCLOAEDIA STDs 2, 3, 4, 5, 6, 7 AND 8, 5TH Edition or any other edition or class whatsoever.

(3) THAT the Plaintiff/Applicant be and is hereby permitted to forthwith enter the Defendant/Respondent’s business and/or printing remises and seize and remove therefrom, for safe custody, all of the Plaintiff’s books and/or other publications which have been photocopied, rebranded and reproduced by the Defendant and/or inspect all purchases and sales records and such other documents, copies and/or any items of whatever nature which constitute or could constitute evidence in this cause of action and preserve the same.

(4) That pending the hearing and determination of this suit, an order of injunction be and is hereby issued restraining the Defendant whether by himself, his servants and/or agents or any other person whatsoever from doing the following acts that is to say, photocopying, branding reproducing, publishing, issuing, promoting, advertising, printing, selling, offering for sale, offering for hire, hiring, supplying distributing and/or displaying for sale or for promotion, any books copied from the Plaintiff's books or works otherwise generally known as HIGH FLYER SERIES, COMBINED ENCYCLOPAEDIA and in particular, HIGH FLYER SERIES, COMBINED ENCYCLOPAEDIA STD 1, THE HIGH FLYER SERIES COMBINED ENCYCLOPAEDIA STDs 2, 3, 4, 5, 6, 7 and 8, 5th Edition or any other edition or class whatsoever.

(5) That the costs of this application be provided for.”

3. The Application sets out the Grounds on which it is based, which are, inter alia;

(i) The Plaintiff is a well-known publisher, promoter, seller, supplier and distributor of various books which it has marketed widely and extensively and sold in Kenya for the last Nine (9) years and the Plaintiff still continues to so publish, promote, sell, supply and distribute.

(ii) The Plaintiff is the publisher of the original literary works, titled “HIGH FLYER SERIES COMBINED ENCYCLOPAEDIA STD 1” “THE HIGH FLYERS SERIES COMBINED ENCYCLOPAEDIA, STD 2, STD 3, STD 4, STD 5. STD 6, STD 7 and STD 8 and others for Secondary Schools.

(iii) As a consequence, the Plaintiff is the owner of the copyright related to the said books or works and therefore enjoys protection with regard to the said copyright and is entitled and endowed with the exclusive rights to the said copyrights and the same ought to be respected by all persons.

(iv) Without any colour of right, the Defendant has unlawfully photocopied rebranded and published the Plaintiff's aforementioned books as the 5th editions and is selling and offering the same for sale throughout Kenya

(v) The books illegally published by the Defendant and offered for sale as the 5th edition are the exact same content and get up as those published by the Plaintiff as the 4th edition and in the case of Standard 4, the Defendant is replicating the Plaintiff's 5th edition.

(vi) The Defendant has infringed and continues to infringe the Plaintiffs copyright.

(vii) The Defendants actions are contrary to the provisions of the **Books and Newspaper Act cap 111** of the Laws of Kenya which prohibit and criminalize his conduct.

(viii) The Defendant's publications have not been authorised by the issuance of the International Standard Book Numbers as required under the Kenyan Law

(ix) The Defendants have no bar-codes as required of such publications

(x) The Defendant caused and continues to cause embarrassment, confusion and deception in the market.

(xi) Unless restrained by this Honourable court, the Defendant threatens and intends to continue and repeat the acts of infringement complained of and is in fact in the process of repeating his awful acts to cover the Plaintiff's books for all primary classes as well as secondary schools.

(xii) The Orders sought ought to be granted ex-parte in the first instance, including the seize Order so that the Plaintiff/Applicant can enter the Defendant/Respondent's premises to inspect and seize all books or works which contain materials that infringe the copyright, the books documents,

copies and any items of whatever nature which constituted evidence necessary to support this cause of action and preserve the same.”

4. In addition to the above grounds the Application is also supported by the Affidavits of each Anthony Kiai and Mr Charles Mbugua Mburu. In his Affidavit Mr Kiai describes himself as the Managing Director of the Plaintiff. He says “2) *The Plaintiff is a well-known publisher, promoter, seller, supplier and distributor of various books which it has marketed widely and extensively and sold in Kenya for the last seven (9) (sic) and the Plaintiff still continues to so publish, promote, sell, supply and distribute books and has established tremendous goodwill in its business.*” And “3) *The Plaintiff regularly engages professional teachers to write the said books and pays for the copyright therein as well as the exclusivity thereof. The author of HIGH FYER SERIES COBINED ENCYCLOPAEDIA STD 1*” and “*THE HIGH FLYER SERIES COMBINED ENCYCLOPAEDIA STDs 2, 3 and 4*”. That is said to be dealt with in the Affidavit of Mr Charles Mbugua Mburu

5. Mr Kiai’s Affidavit Exhibits at AK-1 to AK-4 copies of the High Fiers Series combined Encyclopaedia for Std 1-4. It is deponed that these are genuine, true and original copies of the Plaintiff’s books for those classes. Annexed as Exhibits **AK-5 to AK-8** are the Defendant’s books for the same classes. The Affidavit describes them as “the Defendant’s offending books”. Mr Kiai says in relation to these that “*It has come to the Plaintiff’s knowledge that the Defendant, in violation of copyright and with intent to deceive, has photocopied, rebranded, reproduced, word by word, the said books... and is offering the same for sale and has indeed sold numerous copies thereof.*” That last statement is demonstrated by paragraph 7 where the deponent says that he was able to purchase the books exhibited from Blessings Bookshop and Stationers in Nairobi. It is said that the bookshop believed that the books were published by the Plaintiff. The acts of infringement complained of is the wholesale photocopying and/or rebranding and/or reproducing the entire of the 4th Edition of the Plaintiff’s High Flier Series etc as High Flyer Series etc 5th Edition. At paragraphs 9 and 10 of the Affidavit it is said that;

“9) The Plaintiff has further learnt that the Defendant is in the process of further infringing the Plaintiff’s copyright by photocopying, rebranding and and denote them 5th editions distribute them and offer them for sale. The Plaintiff believes that the Defendants illegal action will be replicated to cover secondary school books.

10) As a result of the Defendant’s actions the Plaintiff’s book is the same as the Defendant’s book, word by word and even by the get up. Accordingly the trading business and consuming public has been misled, deceived and confused as to buy the Defendant’s said books believing them to be the Plaintiff’s books to the obvious detriment of the Plaintiff’s business. The only item the Defendant has omitted from the offending books is the logo “soaring greater heights”.

6. The Defendant’s conduct is said to be illegal, a fraud on the public and confusing and misleading. At paragraph 15 it is said that “15) The acts and conduct of the Defendant were at all material times and are even now calculated to deceive, mislead and confuse and have in fact deceived, misled and confused the trading and business world and the general public into the belief that the Defendant’s book is the Plaintiff’s book to the detriment of the Plaintiff’s business.

7. At paragraph 16 it is said that “As a result of the Defendant’s illegal action he has been arrested and charged in **Criminal Case Number 224 of 2013** Republic v Peter Gichuki Mwangi. Paragraph 17 sets out the case for passing off as follows; “The Defendant seeks to pass of its books as the Plaintiff’s books which not only infringes upon the Plaintiff’s godwill and market share , which the Plaintiff has painstakingly and patiently established over a period of 7 years.” It is also said that “*the Plaintiff has been prejudiced and injured in its business reputation and market share as the Defendant continues to mislead, deceive, and confuse the business and trading world and the general public and the Plaintiff has suffered continues to suffer and will continue to suffer losses and damage both in monetary terms, shrinkage in its market share and business reputation and infringement of its goodwill*”. The need for an Anton Pillar Order is said to be justified in order to preserve the evidence to prevent the purpose of this suit from being defeated.

8. It seems there is also another suit between the Plaintiff and the Defendant relating to the infringement of the Trademark Rights of Trade Mark No 60247. Mr Kiai has exhibited the pleadings and ruling in that matter. (**High Court Civil Case No 45 of 2011**). It seems in that suit the Plaintiff was unsuccessful in obtaining an injunction. The Ruling that appears at Exhibit **AK-12** was delivered by Hon Lady Justice Okwengu.

9. The Second Supporting Affidavit is sworn by Mr. Charles Mbugua Mburu who states in effect that he is an Headmaster and the author of the Plaintiff's books. The suggestion is that he is the sole author. He says that he was contacted by the Plaintiff and they have been doing business since 2006. He says that he has never been contracted by the Defendant to do any work for him and therefore the purported publication of any of these books by the defendants can only amount to infringement of copyright rightly held by the Plaintiff.

10. The Defendant , Mr. Peter Gichuki Mwangi has filed a Replying Affidavit on 28th May 2013. He has also filed a Further Affidavit on 1st August 2014 which does not seem to have been served until November 2014. The Replying Affidavit sets out the history of the relationship between the Plaintiff and the Defendant. The Deponent sets out his case from paragraph 10 onwards. He says:

*10. THAT further to the above the Defendant has not copied any works owned by the Plaintiff or printed by it but what the Defendant has been publishing and printing are works jointly owned by the Plaintiff and the Defendant initially published in the year 2004, 2005, 2006 and 2007 which the Plaintiff has been attempting to peddle as his alone. The Defendant has been publishing and selling all over Kenya as per the LPO's annexed herein and marked **PGM-12** and invoices supplied and received annexed herein and marked **PGM-10**"*

*11. THAT further the aforesaid works was printed and publishes as "Highflyer Series" through **Highfyer Services** and later High Flyer Services Ltd owned jointly by the Plaintiff and the Defendant*

12. THAT further the Plaintiff is not a publisher but one who paragarises books and materials earlier written and published by others and was in fact introduced to the world of publishing and printing by the Defendant after he was deregistered by the Law Society of Kenya

13. THAT the issue of copyright is neither here nor there as the books peddled by the Applicant are not original works to be copied as they were first published by e in the year 2004, 2005, 2006, and 2007 and others are original works we did together before we split each party continuing with own work and previous and present work.

14 . THAT the Plaintiff cannot have protection of something he does not own solely.

15. THAT the Plaintiff's alleged books are not original books but revision materials held together and holding and having contents of previous exams and papers earlier done or set by various teachers and are essentially copied from the Kenya National Examination Council Exams previously set by the Council or by various schools and they are just guides for students for them to prepare for National primary Exams or Secondary Schools exams."

11. The Deponent then goes on to deny all the Plaintiff's allegation and whether the complaints of fraud, deception, misleading etc as well as the allegation of passing off his books as the Plaintiff's. He says that he has built a mutual relationship with the customers and has been publishing and selling **High Flier Series** books all over Kenya since the year 2004. In relation to Mr Charles Mburu he says that he never published the alleged material. That he was hired jointly to author the books in 2005 and 2006. In relation to publications during 2006 and 2007 they belonged to the company and were therefore owned jointly, in so far as it is relevant

12. The Affidavit sets out the history of these proceedings and the fact that the Plaintiff through its Managing Director has instituted a number of suits against him. These being **HCC 45 of 2011** which

raises the issue of ownership of the copyright and trademark, **Criminal Cases No 224 of 2013, 225 of 2013 and 295 of 2013** relating to the same subject matter, and **Petition 176 of 2013** brought by the Defendant to prevent further malicious prosecutions (as he sees them) and this suit **HCC 107 of 2013**.

13. In the first, the Plaintiff was unsuccessful in obtaining the injunction sought which was along the same lines as that sought herein. It seems the Plaintiff has a degree of success at the ex parte stage. In the Criminal Cases there appears to have been no final resolution but the Plaintiff relies on the fact of the Defendant's arrest. The Judgment on the Petition was delivered on 12th September 2014. Hon Lenaola J made a final order that:

“An order do issue that the 1st Respondent and the 2nd Respondent's decision to charge the Petitioners in Criminal Cases Nos 224, 225 and 295 of 2013 together with any charges presented to the 3rd Respondent be stayed pending the final determination of HCC 45 of 2011 as the lawful or legal owner of the copyright in relation to HIGH FLYER SERIES”

14. In relation to the Orders the Defendant states that the Orders sought are intended to inure/damage and cripple the Defendant's business to the Advantage of the Plaintiff as these are the same orders sought by the Plaintiff in **HCCC 45 of 2011** and which were denied by Justice Okwengu and the matter is not yet concluded. He says the Plaintiff's claim is malicious, however there is no application to strike out filed. He clarifies that the Managing Director of the Plaintiff were business associates and that some of the books were authored by a Mr Mbugua, Mr Muhoro, Mr Mutuku and Timothy Kamau. He says that the evidence of Mr Mbugua is unreliable and untrue. He says the ex parte order meant that the Defendant was unable to publish his books during 2011 and 2012.

15. The Defendant has exhibited numerous documents including the Memorandum and Articles of High Flyer Services Limited. That shows that the MD of the Plaintiff and the Defendant were, at inception (in 2005), both shareholders. The Plaintiff has not mentioned that. Also Mr Kiai has not produced evidence of his authority to bring this suit on behalf of the Plaintiff Company. The Defendant has also filed a Defence and Counterclaim within the main suit.

16. This Application came before the Court (Ogola J) on 20th March 2013 when he Ordered the Applicant to serve the Respondent. That was not done and the matter was re-listed for Hearing before Havelock J on 16th July 2013. On that date Havelock J gave the Parties leave to file a Supplemental Affidavit and a Further Affidavit respectively. The Supplemental Affidavit does not appear to be on the Court file, nor is it referred to in the Further Affidavit. It is therefore uncertain whether it was ever filed. The Application came before this Court for Hearing on 13th November 2014. No Interim Orders have been made.

17. The Application seeks two injunctions in the form of Prayers 2 and 4 (above) together with an Anton Pillar Order in the terms of Prayer 3 of the Application.

18. The Injunctions sought are interlocutory injunctions. The Application is brought under ***Order 40 of the Civil Procedure Rules***. ***Order 40*** provides:

“1. Where in any suit it is proved by affidavit or otherwise—

(a) that any property in dispute in a suit is in danger of being wasted, damaged, or alienated by any party to the suit, or y g wrongfully sold in execution of a decree; or

(b) that the defendant threatens or intends to remove or dispose of his property in circumstances affording reasonable probability that the plaintiff will or may be obstructed or delayed in the execution of any decree that may be passed against the defendant in the suit, the court may by order grant a temporary injunction to restrain such act, or make such other order for the purpose of staying and preventing the wasting, damaging, alienation, sale, removal, or disposition of the property as the court thinks fit until the disposal of the suit or until further orders.

2. (1) *In any suit for restraining the defendant from committing a breach of contract or other injury of any kind, whether compensation is claimed in the suit or not, the plaintiff, may, at any time after the commencement of the suit, and either before or after judgment, apply to the court for a temporary injunction to restrain the defendant from committing the breach of contract or injury complained of, or any injury of a like kind arising out of the same contract or relating to the same property or right.*

(2) *The court may by order grant such injunction on such terms as to an inquiry as to damages, the duration of the injunction, keeping an account, giving security or otherwise, as the court deems fit.*

It is clear from the above that the Court has the power to grant the Orders sought. The question that arises is; are those orders justified in the circumstances of this case.

19. The Court takes further guidance from the well known and celebrated authority of **Giella v Cassman Brown** which sets out the analysis and steps to be taken. **Giella vs. Cassman Brown 1973 EACA 358**, and the speech of Spry VC at 360D-F. These well accepted principles were set out by the Court of Appeal established that the Court has to consider the following questions before granting injunctive relief: (i) is there a prima facie case with a probability of success? (ii) does the applicant stand to suffer irreparable harm, if relief is denied? (iii) on which side does the balance of convenience lie? In its decision, the Court of Appeal also referred to earlier cases where it said:

1. *“I will begin by stating briefly the law as I understand it. First, the granting of an interim injunction is an exercise of judicial discretion and an appellate Court will not interfere unless it be shown that the discretion has not been exercised Judicially (**Sargent V. Patel, 16 E.A.C.A.63**).*

2. *The conditions for the grant of an interlocutory injunction are now, I think, well settled in East Africa. First, an applicant must show a prima facie case with a probability of success. Secondly, an interlocutory injunction will not normally be granted unless the applicant might otherwise suffer irreparable injury, which would not adequately be compensated by an award of damages. Thirdly, if the Court is in doubt, it will decide an application on the balance of convenience (**E.A. Industries v. Trufoods, (1972) E.A. 420**).*

20. In the circumstances of the case now before the Court, the Court has to be satisfied that the Plaintiff has established a prima facie case on the following:

- (1) The Plaintiff is the original author of the High Flyer Series of study aids (“the Works”)
- (2) The Plaintiff is the owner of the Trademark;
- (3) The Plaintiff has an established reputation in the Works
- (4) The Plaintiff has engaged Mr. Charles Mbugu to create the Works
- (5) The Defendant has (a) breached the Plaintiff’s copyright in the Works, (b) breached the Plaintiff’s Trademark in the Works, (c) passed off his own publications as the Plaintiff’s Works and (d) does so for gain.
- (6) Unless he is stopped the Defendant will continue to do the acts complained of to the detriment of the Plaintiff.

21. Therefore, any analysis must start with which of the above the Plaintiff has demonstrated or established by its Application. The facts appearing in the affidavits are set out above, in brief the Defendant disputes virtually every point put forward by the Plaintiff. At this stage of the proceedings the Court cannot make a final decision. This is an interlocutory stage where the evidence is presented by affidavit and the Court has not had the benefit of the evidence being tested under cross-examination. The Plaintiff has to establish a prima facie case.

22. Firstly as to copyright, the Defendant disputes both the existence of a copyright – because the publications are not original works and also Plaintiff’s ownership of any copyright. He alleges joint ownership. The documents in particular the memorandum and articles seem to support the Defendant’s version of events, namely that prior to the dispute the MD of the Plaintiff and the Defendant worked together. As to the existence of copyright, that is the subject of **HCC 45 of 2011**. The same applies to the Trademark. From the Ruling of Hon Okwengu J (as she then was) it is apparent that the Plaintiff is not the beneficiary of a registered trademark. The registration of that trademark has been objected to by the Defendant. The Learned Judge said “This is a dispute that can only be resolved by the determination of the respondent’s objection to the registration of the 1st applicant’s trademark and a full hearing of this suit. The Applicant has not exhibited proof of registration of any trademark. In relation to the criminal trials, those are stayed pending the resolution of **HCC 45 of 2011**. In relation to an established reputation in the marketplace, again the evidence of Mr Mbugu is challenged by the Defendant with documentary proof. Therefore the Court cannot resolve the issue without hearing evidence at a trial. In the circumstances, the Plaintiff has failed to demonstrate on a prima facie basis that he is entitled to the rights to which he seeks protection. The hurdle of a prima facie case with a prospect of success is higher. As to illegality, as opposed to unlawfulness, that is the preserve of the criminal court. The Criminal proceedings have been stayed pending the outcome of the earlier **Civil Suit 45 of 2011**.

23. There is also the added complication that the Plaintiff has duplicated the suits that it has brought. **Section 6** of the **Civil Procedure Act** provides:

6. No court shall proceed with the trial of any suit or proceeding in which the matter in issue is also directly and substantially in issue in a previously instituted suit or proceeding between the same parties, or between parties under whom they or any of them claim, litigating under the same title, where such suit or proceeding is pending in the same or any other court having jurisdiction in Kenya to grant the relief claimed.

In addition **Section 7** of the **Civil Procedure Act, Cap 21** provides:

7. No court shall try any suit or issue in which the matter directly and substantially in issue has been directly and substantially in issue in a former suit between the same parties, or between parties under whom they or any of them claim, litigating under the same title, in a court competent to try such subsequent suit or the suit in which such issue has been subsequently raised, and has been heard and finally decided by such court.

24. The Plaintiff has failed to establish its case on a prima facie basis. This suit cannot proceed until the earlier suit with the same parties and the same subject matter has been heard and determined or alternatively is consolidated with this suit. No such application has been made.

25. It is clear to the Court that the Plaintiff through its MD was fully aware that there were earlier proceedings before the Court and possibly other tribunals in relation to the trademark. In any event, the Defendant’s Grounds of Objection filed on 24th April 2013 stating that there is a multiplicity of suits and that the Application is res judicata would have brought those issues to the Plaintiff’s attention. In those circumstances, the Court can draw the conclusion that it was the Plaintiff’s intention to circumvent the decisions of the Court in **HCC 45 of 2011** and **Petition 176 of 2013**

26. In the circumstances and for the reasons set out above, the Preliminary Objection is upheld, the Application is dismissed with costs. It is further ordered that this suit be stayed pending the hearing and determination of **HCC 45 of 2011**

Order accordingly.

FARAH S. AMIN

JUDGE

DATED, SIGNED AND DELIVERED THIS 5TH DAY OF OCTOBER 2016

In the presence of:

Isaiah Otieno Court Assistant

Clerk for Defendant

N/A for Plaintiff