



**IN THE COURT OF APPEAL**

**AT NAIROBI**

**(CORAM: KARANJA, WARSAME & AZANGALALA, JJ.A.)**

**CIVIL APPEAL NO. 318 OF 2010**

**MOUNT KENYA SUNDRIES LTD.....APPELLANT**

**AND**

**MACMILLAN KENYA (PUBLISHERS) LTD..... RESPONDENT**

*(An appeal from the Judgment and Decree of Hon. Justice Mr. Visram dated 23<sup>rd</sup> October, 2008*

*in*

*H.C.C.C. NO. 2503 OF 1995)*

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**JUDGMENT OF THE COURT**

[1] This is an appeal from a judgment of **Visram, J.**, (as he then was) dated 23<sup>rd</sup> October, 2008. The principal question to be decided in this appeal, in our view, is whether the respondent, **Macmillan Kenya(Publishers) Ltd** and the appellant, **Mount Kenya Sundries Ltd**, each have copyright to their respective maps and whether any of the parties had infringed the other's copyright. **Visram, J.**, decided that the respondent established that copyright subsisted in its maps and that the appellant had infringed that copyright. He therefore granted to the respondent an injunction to restrain the appellant from selling by way of trade or exposing or offering for sale the map christened Kenya Pictorial Tourist Route Map or any map based thereon; an order for delivery up of all such maps as were in the appellant's possession or control; an inquiry as to damages or alternatively an account of profits and payment of all sums found due upon making such inquiry; interest and costs.

[2] The appellant was aggrieved and therefore lodged this appeal premised upon twelve (12) grounds of appeal which were condensed into eight (8) grounds by **Mr. Opini**, learned counsel who canvassed the appeal before us. By leave of this Court, learned counsel was allowed to argue one additional ground namely, that the respondent had no *locus standi* to bring the action in the High Court. This argument was made because by the time action was brought, the respondent was not in existence as an independent entity and could not therefore

claim copyright in the maps which copyright was not in any event assigned to it by its parent company, Macmillan Publishers Ltd of the United Kingdom.

[3] The appellant maintains that it did not infringe any copyright when it published and sold its maps which it produced using its own skill, artwork and judgment even before the respondent produced and published its maps. It was contended for the appellant that the basic source of the maps for both parties was the survey of Kenya and that similarities were inevitable. There could therefore be no question of copyright infringement as claimed by the respondent. According to learned counsel for the appellant, the respondent through its first witness admitted not carrying out any survey before producing its maps and could not thereon claim any copyright in the maps. Learned counsel further faulted the learned Judge for not being impartial and for not specifying which of the respondent's maps had been infringed.

[4] **Mr. Murugara**, learned counsel for the respondent, supported the findings of the learned Judge of the High Court. Learned counsel submitted that the respondent produced maps of Nairobi and Mombasa Island in 1985, which were amended in 1989 and published in 1990. Those maps, according to learned counsel, were copied by tracing by the appellant. They were then published and sold as the appellant's. On the contention that the respondent's parent company had not assigned its copyright to the respondent at the commencement of the suit, learned counsel contended that assignment can be made even after commencement of action. It was learned counsel's further contention that application of Kenyan Law did not invalidate assignment made under English Law. It was, therefore, learned counsel's view that the appeal had no merit and he urged that it be dismissed.

[5] The duty of this Court as a first appellate Court is well settled. See **Selle & Another vs Associated Motor Boat Co. Ltd. & Others**, [1968]EA 123 which was followed in **Kenya Ports Authority v Kustron (Kenya) Limited** [2009] 2EA 212, where we stated:-

*“On a first appeal from the High Court the Court of Appeal should reconsider the evidence, evaluate it itself and draw its own conclusions though it should always bear in mind that it has neither seen nor heard the witnesses and should make due allowance in that respect. Secondly that the responsibility of the Court is to rule on the evidence on record and not to introduce extraneous matters not dealt with by the parties in the evidence.”*

[6] The respondent's case before the High Court was presented through **David Njuguna Muita**, its Managing Director (PW 1) (Njuguna), **Esther Mbeke Muya** (PW 2) (Esther), a cartographer and **Lusichi Dismus** (PW 3) (Lusichi), a former employee of the appellant in its map-making section.

[7] With regard to the respondent's *locus standi* to file the suit before the High Court, Njuguna testified that he joined the respondent in 1984 as a Senior Sales Representative and rose to become its Managing Director, which position he held at the time of his testimony. According to him, the respondent was originally wholly owned by Macmillan Publishers Ltd. of the United Kingdom (UK) which initiated the production of the maps in question for the Kenyan subsidiary, the respondent. Eventually the UK company's rights over the subject maps were assigned to the respondent by an agreement dated 20<sup>th</sup> January, 2003. That was Civil Appeal 318 of 2010 | Kenya Law Reports 2017 Page 2 of 9.

long after the suit before the High Court was filed i.e in August 1995. The appellant contended that at the time of lodging its claim, the respondent had no property or right to protect in the subject, maps. The respondent's response was that an assignment subsequent to the filing of the suit was still valid.

[8] Relying on the treatise of **Copinger and Shone James** on Copyright, 14<sup>th</sup> Edition, at page 996, the learned Judge of the High Court, held that the respondent was entitled, in equity, to commence the suit pending assignment of the copyright. The learned Judge did not apply English Law to the facts before him but merely found that the respondent was the equitable owner of the subject maps given that its parent company, Macmillan Publishers Ltd., made the maps specifically for the respondent. We find no fault in this finding. Njuguna testified that he was involved in the research in the original material to produce the subject maps, which maps were made by "*Stephen Jonathan Beck Company in U.K..... for Macmillan Kenya*". We agree that the respondent was the company entitled to the copyright in equity and had capacity to commence the action in the High Court. The respondent would not however, have been entitled to relief if the assignment had not been obtained before the High Court suit was concluded. In any event, the issue of the respondent's locus to institute proceedings was not in contention. Indeed the appellant's written statement of defence acknowledged that "**Kenya Travellers Map**" was the work of the respondent and **Kuldip Sapra** (DW 1) (Sapra), the appellant's director, in his testimony before the High Court, freely acknowledged the respondent's works.

[9] We resolve the issue of standing in favour of the respondent.

[10] Having found that the respondent had *locus standi* to bring the action before the High Court, the next issue to determine is: as between the appellant and the respondent, which company had copyright to protect" The gist of the respondent's case was that it produced travel maps for Nairobi and Mombasa in 1985 which maps were improved in 1989 and released into the market in 1990. The appellant did not, in reality, dispute the production and release of the respondent's maps as pleaded. In paragraph 11 of its amended statement of defence and counterclaim, the appellant averred:

**" COUNTER CLAIM**

11.

*The defendant repeats the contents of its defence herein and further states that the plaintiff has in their 1990 Revised Edition reproduced republished and circulated/sold the defendant's work in the following respects:*

i.

***Copied the defendant's distance chart showing distances between towns which was not in their 1985 Edition.***

ii.

***Added more site names to places appearing in the defendant's KENYA PICTORIAL TOURIST ROUTE MAP***

*(underlining ours)*

[11] The above pleading demonstrates beyond peradventure that the respondent was making maps as early as 1985, to which maps it made additions and/or alterations in 1990. The appellant's averment in paragraph 11 (i) above of its amended defence and counterclaim was in consonance with the testimony of Njuguna who produced the original material used for preparation of the respondent's maps: "**Kenya Tourist Map**" published in 1985 which was later renamed, **Republic of Kenya Travellers Map.**"

[12] So, it is plain that the respondent first produced their contentious maps in 1985 which were subsequently revised in 1989. The appellant on its part, through Sapra, contended that it started map-making in 1982 but still bought and sold the respondent's map christened "*Kenya TouristMap*". It then, in 1988/89, commenced ground work for preparation of the maps in dispute which maps were then published around 1990. Sapra admitted that by the time the appellant was producing the disputed maps the respondent's maps were on the market. In his own words:-

***DEX 9: Original art work. When we were producing this map, I was aware of only one map of the plaintiff. Kenya Tourist Map, I found out about their 1988 map on 9/1/95 when I received a notice from them.***

Sapra subsequently added:

***"We denied any infringement, and told them that certain elements of our map were copied. Westopped selling plaintiff's maps after we produced our own. I did not see their 1998 (sic) map until 22/3/95 when demand was made."*** (emphasis ours).

[13] It cannot therefore be gainsaid that the respondent was in map-making business long before the appellant joined the business. Prior to becoming a map maker, the appellant relied upon the respondent for its supply of maps including the 1985 edition of the latter's maps. As the respondent was assigned the copyright in the maps, it was entitled to protect the same against infringement.

[14] Our perusal of the record further demonstrates that the respondent's 1985 map was revised in 1989 and was published in 1990 whereas the appellant produced the maps in dispute in 1990. By the time the appellant was producing the disputed maps, the appellant's 1985 maps had been revised and were released into the market at about the same time the appellant produced the disputed maps. Given those facts, there was some controversy as to

which of the maps were first produced. The learned Judge of the High Court accepted the version of the evidence given by the respondents. In doing so, he stated:-

*“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 (Njuguna) was taken before Justice Githinji with the unfortunate result that I did not benefit from his demeanor, his evidence on record was a (sic) matter of facts and consistent in many respects even in cross-examination. By contrast, DW 1’s evidence came out mainly as self-serving and not very consistent.”*

[15] It is significant that Sapra (DW 1) testified before the learned Judge of the High Court. The learned Judge therefore had the advantage of hearing and seeing the witness testify. He accordingly was entitled to assess Sapra’s demeanour. He did so, and concluded that her testimony “*came out mainly as self serving and not very consistent*”. We can only interfere with such finding if the same is not supported by the record or if, from the case as a whole, such conclusion could not be correct. We see no basis to interfere with the factual findings of the trial Judge, since no evidence was placed before the trial Judge to enable us to depart from his conclusion. The trial Judge was entitled as he rightly did to believe the evidence of one witness against the others. Here, he attached a lot of weight on the testimony of PW 1, while he attached insufficient or little premium to the evidence of DW 1. Was he entitled to do so? Our firm view is that he was right. Did he consider extraneous issues before he believed the testimony of PW 1? Again, our answer is in the negative. On our part, we have no material to make us interfere with the said findings. We totally agree with the learned trial Judge. Having considered and re-evaluated the evidence we find no basis to differ with the learned Judge on his assessment of Sapra’s testimony. Our inevitable conclusion is that the respondent had copyright in its maps.

[16] The next issue for our determination is whether that copyright was infringed by the appellant. It is preliminary that copyright infringement is actionable at the instance of the owner of the copyright. We are alive to the fact that the owner of the copyright does not necessarily have to be the author of the subject material and the author of copyright work is not necessarily the person who first made or created the work. It depends on the nature of the work. An author may produce copyright material in the course of his/her employment or may produce such material under the control or direction of an organization. In that event, it is the employer or organization which owns the copyright in the material so produced. (See **Section 13(1)** of the repealed Copyright Act). In this case, the original maps were produced under the control and direction of the respondent’s parent company Macmillan Publishers of the United Kingdom for the respondent. The said parent company then, as already found, assigned the copyright to the respondent. Accordingly, the respondents were entitled to complain if the copyright was infringed. We are satisfied that the copyright was passed to the respondent and it was entitled to seek intervention of the court, in the event of copying or alteration of the original designs or material. The failure to do so, would result in confusion and free for all, while a lot of knowledge and finances may have been invested or incurred. That is why, the law protects infringement and prohibits the work designed and devised by others like the respondents or its parent company.

[17] To demonstrate that the appellant infringed its copyright, the respondent called **Esther** who, at the time of her testimony, was a lecturer in cartography at the then Kenya Polytechnic now Technical University of Kenya. Given her qualifications which she enumerated while testifying, there can be no gainsaying that Esther was an expert in cartography. She compared the respondent's maps for Central Nairobi and Mombasa Island and those **made** by the appellant and concluded that the appellant copied the respondent's maps. She explained in detail how she had arrived at that conclusion.

[18] The appellant sought to challenge Esther's expert opinion through **JohnDominic Obel**, (DW 2) **Obel** and **Edward Rabuge Ongong'a** (DW3) (**Ongong'a**). Although the witnesses were offered by the appellant as experts, none of them was a qualified cartographer in the league of Esther. Obel had indeed worked at various times in his life with maps, and could describe himself as a cartographer having been trained on the job, but the fact remained that he had no professional qualification in cartography. He was a graduate land surveyor. Although he undertook

*“further training in cartography in seminars and workshops”* and even became Deputy Director of Survey in Kenya, he nevertheless took no formal specialized training in cartography.

Ongong'a, on the other hand, had originally a survey certificate. He then did photo-mapping. Later he rose through the ranks to become a Principal Cartographer. He did not demonstrate that he had any specialized professional training in cartography.

[19] Notwithstanding the qualifications of Obel and Ongong'a, their testimonies were also discredited. Obel for instance initially maintained that a map can only be described as a copy of another if it is an *“exactreplica”*. He therefore concentrated in pointing out the differences between the appellant's maps and those of the respondent and given the differences he detected, he concluded that copying could not have taken place. He made a complete *volte face* on cross-examination when he finally admitted that a map can be scanned and changes subsequently made to it *“as pirates do”*. Furthermore, Obel's report and that of Ongong'a appeared to have been copied from one another. In Ongong'a's own words:-

*“We are both experts. I cannot explain why report is same.....”*

*I agree one is copied from another.”*

[20] Given their evidence, we are not at all surprised that the learned Judge of the High Court was not impressed by both Obel and Ongong'a. We cannot fault him for preferring the testimony of Esther over that of Obel and Ongong'a and we think the allegation of bias on the part of the Judge was far-fetched. In any event wasn't the question of similarities in the two sets of maps settled by the appellant's counter-claim" It was on the basis of the allegation that the respondent copied the appellant's maps that the counter-claim was mounted against the respondent.

[21] In the end, we agree with the learned Judge of the High Court that it is the appellant who substantially copied the respondent's maps.

[22] Under *Section 15 (1)* of the *Copyright Act*, then in existence, copyright could be infringed by a person who, without the license of the owner of the copyright, did or caused to be done, an act the doing of which was controlled by the copyright.

The nature of copyright was described in *Section 7* as follows:-

***“ 1) Copyright in a literary musical or artistic work or copyright in an audio-visual work shall be the exclusive right to control the doing in Kenya of any of the following acts, namely the reproduction in any material form, the distribution of [to] the public for commercial purposes of copies by way of sale, rental, lease, hire, loan or similar arrangements, the communication to the public and the broadcasting, of the whole work or substantial part thereof, either in its original form or in any form recognizably derived from original, .....”(underling ours)***

[23] It is therefore not only the reproduction of the entire protected work that would constitute an infringement, in our view, reproduction of a substantial part of the work would still constitute an infringement. In this case, the testimony of Esther demonstrated to the satisfaction of the Court that the appellant had substantially copied the respondent's maps. And as observed, the entire case of the appellant in its counter-claim, hinged on the similarities in the subject maps. The appellant freely acknowledged that before the respondent complained, it produced the copied maps for sale to the public. It did so without the licence of the respondent. By so doing, it infringed the respondent's copyright in its maps.

[24] Further, afield the position in India is the same. Authorities deciding the same point in India are of persuasive value, because India, like Kenya, is a former colony of Britain has the same common law background and share legal history. The **Copyright Act of 1911** passed by the British Parliament was the source of law on Copyright in India. That Act had similar provisions as our **Copyright Act, Chapter 130 Laws of Kenya**, now repealed. In *R.G. Anand v M/S Delux Films & Ors [1978] A 1 R 1613, [1979] SCR (1) 218 [1978] SCC (4) 118*, the Supreme Court of India when considering a copyright dispute, said at page 15, as follows on infringement of copyright:

***“.....it is not necessary that the alleged infringement should be an exact or verbatim copy of the original but the resemblance with the original in a large measure, is sufficient to indicate that it is a copy”***

[25] The learned Judges in that case cited, with approval, the case of *Macmillan & Co. Limited v K and Cooper [51.1A 109]*, a decision of the Judicial Committee wherein, Lord Atkinson, *inter alia*, observed:

***“Third that to constitute piracy of a copyright it must be shown that the original has been either substantially copied or to be so imitated as to be a mere evasion of the copyright.”***

[26] In the case before us the points of resemblance and dissimilarity in the maps of the respondent compared with the appellant’s maps taken as a whole clearly give the impression to an ordinary observer that the appellant’s maps are those of the respondent. Esther, on cross-examination stated, in part:

*“The scale in both maps is same. Although presentation is different, details are same. Maps are supposed to give current information. Maps can be similar [but] different in method of presentation. Details in both are same. I say some are the same but not all.....”*

*The 2 maps are same, except for some details. In P’s map Nairobi River is fine but in D’s it is hazy-meaning it was scarred (scanned”) and the name was deliberately omitted. The city centre remains the same for everyone. It is the way the text is presented that is copyrightable (sic).”*

Esther was explaining the copying of the respondent’s Nairobi Map by the appellant.

[27] With regard to the Mombasa Island Map, she stated as follows in cross-examination.

*“.....Certain features in both maps are not different. They are the same nearly all. What is different is the placing of names, colour (blue in P) but in D position and text style same – D’s is reduced. Coast line is blue in P and black in P*

.....

*Overall presentation of ocean in both slightly, different lighter in Ps. I do not believe plaintiff did ground survey to make map. They acknowledge using survey of K. One cannot borrow line work the source has to be different. I am not disputing details but its placement is exactly the same spot.*

.....

*Overall presentation size is different but details are the same. There are different features in both maps.”*

We reiterate that the respondent’s expert evidence on the copying of the respondent’s maps by the appellant received support in paragraph 11 of the appellant’s counter-claim.

[28] The appellant’s averments in that paragraph suggest that save for the distance chart showing distances between towns, and addition of more site names, the maps were similar. Given our finding that the respondent’s maps were produced in 1985, and revised in 1989, the inevitable conclusion is that the appellant’s maps which were produced in or about 1990 were produced after those of the respondent and if any copying took place it was by the appellant.

[29] For the reasons stated in the aforesaid discussion, based on a consideration of the entire evidence, circumstances and material on record, we have come to the conclusion that the appellant committed violation of the respondent’s copyright and the learned Judge of the High Court came to the correct conclusion on the evidence and the law. The result is that the appeal fails and is accordingly dismissed with

costs.

**DATED AND DELIVERED AT NAIROBI THIS 15<sup>TH</sup> DAY OF JULY, 2016.**

**W. KARANJA**

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**JUDGE OF APPEAL**

**M. WARSAME**

.....

**JUDGE OF APPEAL**

**F. AZANGALALA**

.....

**JUDGE OF APPEAL**

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