



REPUBLIC OF KENYA
IN THE HIGH COURT OF KENYA AT NAIROBI
CIVIL SUIT NO 336 OF 2002

NEVIN JIWANIPLAINTIFF

VERSUS

GOING OUT MAGAZINE & ANOTHER.....DEFENDANTS

RULING

The plaintiff, Nevin Jiwani, trades as Go Places Publication. Her business name was registered in 1997. She publishes the Magazines known as Go Places Magazine, Go Places Restaurant Guide and Having Fun Magazine. In a plaint filed in court on 13.3.2002, the plaintiff avers that she was at all times the author and owner of the copyright in the above magazines which copyright included the authentic text of each magazine including all photographs, materials and designs. It is also averred that since about May 2000, the defendant has been publishing a magazine known as Going Out Magazine. It is further pleaded that the name Go Places Magazine is widely recognized and acknowledged in the media and by the general public as signifying the plaintiff's magazine and that the plaintiff has a substantial reputation in and by the use of the said name.

The plaintiff's complaints against the defendant are two. The first one is that the defendant has infringed the plaintiff's copyright in Go Places Magazine and Go Places Restaurant Guide by reproducing and authorizing the reproduction of artistic works and text without her authorization or licence. The particulars of the infringement are specified. The second complaint is that by the various acts which are particularized the defendant is in effect passing off its magazine as that of the plaintiff and thereby injuring and causing loss to the plaintiff. On the basis of the aforesaid complaints, the plaintiff in the plaint seeks relief by way of an injunction to restrain the defendant from publishing or distributing Going Out Magazine; an injunction to restrain the defendant from infringing the plaintiff's copyright; delivering up and/or destruction on oath of all copies of Going Out Magazine and more particularly the latest issue due out any time from 12th March, 2002; and an inquiry as to damages for infringement of copyright, passing off and conversion and/or, at the plaintiff's option, an account of profits.

Simultaneously with the plaint, the plaintiff filed an application for interlocutory injunctive orders that the defendant be restrained from;

- i. passing off Going Out Magazine as Go Places Magazine and from publishing and / or distributing the March issue of its magazine, and

ii. infringing the plaintiff's copyright to all photographs designs and artwork and to all written text in the plaintiff's magazines.

The plaintiff also sought an order that the March issue of the defendant's magazine be delivered to the court for inspection to ascertain if there was any passing off or copyright infringement. The application was supported by the plaintiff's own affidavit of even date. The application was presented before Mwera, J. on 15.3.2002 who ordered that it be served for hearing on 18.3.2002. On the latter date, the advocates for both parties appeared before me. The matter was adjourned to 20.3.2002 and the plaintiff granted leave to file a supplementary affidavit if need be. The defendant had not by then filed a replying affidavit. On 20.3.2002 Mr. Orowe, the plaintiff's Advocate, complained to me that he had the previous evening been served with the defendant's replying affidavit to which no exhibits had been annexed but the defendant's advocate, Mr. Okoth, had informed him that the exhibits would be forwarded in the morrow. He admitted that the exhibits had indeed been forwarded as promised but explained that he was unable to file a supplementary affidavit without the exhibits. He asked for time to file it in the course of that very morning.

The record does not show it but I was quite vexed by the defendant's act of serving an incomplete affidavit, an action which I plainly said was illegitimate. I put it to the defendant's advocate that in the premises, I was minded to proceed to hear the plaintiff's application on the footing that no legitimate replying affidavit had been served unless he and Mr. Orowe could come up with a consent securing the plaintiff's position before the matter could be ventilated *inter-partes* after the plaintiff had filed a further affidavit. In the event the parties recorded a consent order whereby the defendant's advocate undertook on behalf of the defendant not to publish or distribute their magazines or to infringe the plaintiff's copyright pending the *inter partes* hearing of the application on 11.4.2002 and both parties were granted leave to file further affidavit on or before 4.4.2002. On 4.4.2002 the plaintiff filed and served on the defendant a further affidavit pursuant to the orders made on 21.3.2002. The defendant filed a further affidavit in response to the aforesaid affidavit on 5.4.2002. I have set out a detailed history of the matter because as will be apparent later on the plaintiff seeks the exclusion of the defendant's affidavit evidence from consideration in opposition to the application and a ruling on the point will be necessary. After a few other twists and turns which I need not set out, the application was finally canvassed before me *inter-partes* on 30th April 2002.

On behalf of the plaintiff, Mr. Orowe, abandoned the prayers for inerlocutory relief with respect to passing off of the defendant's magazine and the deliver up of the March issue of the said magazine. He opted to pursue only the order for restraining the defendant from infringing the plaintiff's copyright. On that understanding of the matter he took issue with the validity of the defendant's replying affidavit of 19.3.2002 and the further affidavit of 5.4.2002. He submitted that the first affidavit had been found defective by the court on 20.3.2002 and the defects had not been cured by any subsequent consent order. In his view the said affidavit was still defective. He then objected to the second affidavit on the ground that it had been filed out of time. Miss Mululu, who now appeared for the defendant, responded that the court record did not indicate that the first affidavit had been found defective. On the second affidavit, she submitted that the defendant could not have replied to the plaintiff's affidavit of 4.4.2002 earlier than 5.4.2002. She asked for extension of time for it to be deemed to be properly on record.

I can deal with those two objections shortly. As regards the first affidavit, the record does not show that the same was held defective. What is and was true was that the plaintiff had been served with a defective copy thereof in the sense that the exhibits purported to be annexed thereto were not. The Original affidavit which was filed in court was complete with exhibits. It was not defective in any respect. In those circumstances, I am of the opinion that service of the defective copy of the affidavit on the plaintiff's advocate could not render invalid a valid affidavit duly filed on record. I accordingly reject the submission that the defendant's affidavit of 19.3.2002 is defective. As regards the affidavit filed on 5.4.2002, I accept the defendant's advocate's explanation that in the circumstances which transpired, the defendant could not have filed it earlier. However, since the order limiting time within which the affidavit was to be filed was made by consent, I apprehend the law to be that only a subsequent consent by the parties could enlarge such time. The defendant's advocate did not seek any such indulgence from the plaintiff's advocate and they remained bound, regrettably, by the consent order. The court has in my view no express or inherent power to extend time limited by the consent of the litigants however unfair such limitation may turn out to be to one of the parties. In the premises I must, despite my abundant sympathy for the defendant's position, hold that the defendant's affidavit of 5.4.2002 is not validly on record. I shall accordingly ignore it in arriving at a decision in the application before me.

As I understand it the plaintiff's case from its affidavit evidence and the submissions of her Advocate may be summarized as follows. In June 2000 in issue No. 2 at page 5 of Going Out Magazine, the defendant has in its advertisement of "Pavement Café" used photographs scanned from the December '99/January 2000 issue of Go Places Magazine. In May 2001 in issue No. 13 at page 22, the defendant has in its advertisement of "La Cucina" restaurant copied the text and design of 'Savour the taste of Italy in the Heart of Kenya' from the June/July 2000 issue of Go Places Magazine. Also copied is the logo of the Italian chef which was created by the plaintiff. And in February 2002 in issue 21 at page 39 of Going Out Magazine, the defendant has copied the textual wording for 'NyamaChoma Ranch' and "Café 21 Deli" from the February/March 2000 issue of Go Places Magazine. Other copying is as follows:

'Winners Pavilion' copied from February /March 2002 issue of *Go Places*;

'Javan House' copied from February/March 2002 issue of *Go Places*;

'Café Kigwa' copied from February/March 2002 issue of *Go Places*;

'The Moon Flower' copied from February/March issue of *Go Places*;

'The Carnivore' copied from February/March 2002 issue of *Go Places*;

'Arle cchino' copied from February/March 2002 issue of *Go Places*;

Anghiti Restaurant' copied from February/March 2002 issue of *Go Places*;

'Mayfair Restaurant' copied from December/January 2002 *Go Places*;

'Toona Restaurant' copied from December/January 2002 *Go Places*;

'Tamambo Restaurant' copied from December/January 2002 *Go Places*;

'Michelangelo' copied from February/March 2002 *Go Places*;

'La Prugna D'oro' copied from February/March 2002 *Go Places*;

‘Café Latino’ copied from February/March 2002 *GoPlaces*;

‘West Café’ copied from December 01/January 2002 *Go Places* and ‘Rudy’s’ copied from *Restaurant Guide* 2002.

The plaintiff claims that such reproduction by the defendant of the photographs the logo, the design and text from its magazine without her licence and authority is an infringement of her artistic and literary work. The artistic work is said to involve the photography, development, design artwork, colour separation as well as formatting and publishing. The written text is said to be derived from mental labour and to involve collation, arrangement, creativity and individual expression. The creativity and placement of words is said not to be a mechanical process. The plaintiff produced in evidence the originals of the photographs said to have been scanned by the defendant as proof that the copyright therein was vested in her. To put it in a well understood phrase the defendant was, according to the plaintiff a mere copy cat! The plaintiff submitted that on the basis of the foregoing, she had established a *prima facie* case with a probability of success at the trial on the basis of both the old and the new copyright law.

The plaintiff also submitted that the injury she has suffered and which she is likely to suffer was irreparable. In the case of artistic work such as photographs and the logo, it was submitted that the loss was irretrievable: the damage had been done and the level of circulation of infringing copies of the magazine could not even be determined. In the case of literary work, it was submitted that the infringement was killing the plaintiff’s business for the reason that whereas the defendant was offering advertisement of the various establishments in its magazines for free, the plaintiff charged for such advertisement and it would logically follow that establishments would rather be advertised for free than at a fee.

Last, but not least, it was submitted on behalf of the plaintiff that even the balance of convenience favoured the grant of an injunction as the defendant had denied any infringement of the plaintiff’s copyright. It was also impressed on me that although the plaintiff could not be certain of future infringements, the present ones should be stopped.

The plaintiff invited me to consider the following cases in arriving at a decision: *Sapra Studio v Tip-Top Clothing Co* [1971] EA 489, *Cut Tobacco Kenya Ltd v British American Tobacco (K) Ltd* (Civil Appeal No. 126 of 2000). *Akt. Jonk. – Vulcan v EA Match Co.* [1964] EA 63, *East African Industries Ltd v Trufoods Ltd* [1972] EA 420, *Gasston v Bwavu etc Coop.* [1958] EA 549 and *Reddy v Banham* [1896] AC 196.

The defendant’s case as I understood it was that it had not infringed the plaintiff’s copyright as claimed for the reason that the plaintiff did not have copyright to the photographs, logo and textual script complained and that even if the copyright therein was vested in the plaintiff that did not preclude the defendant from coming up with similar works provided it had done so by working independently. In expounding on the above broad proposition the defendant’s advocate submitted as follows. For one to claim copyright in any work, it was necessary to show that knowledge, judgment, labour and skill had been brought to bear and sufficient originality had been bestowed thereon. Furthermore, copyright does not confer any monopoly to the authors and it was permissible for another person to produce the same work by independent endeavour. And there was no offence in photographing an object which had previously been photographed by someone else. Reliance was placed on *Halsbury’s Lawsof England* 3rd Edition Paragraph 774.

As regards the degree of labour and skill required to be demonstrated before the work subject matter thereof could qualify for copyright, it was submitted that the same is a matter of fact to be determined on the evidence available in each individual case. There was no precise definition, it was all a matter of degree. The case of *Cram & Sons Ltd v Frank Smythson Ltd* [1944] 2 All ER 92 was cited for the proposition.

On the facts in this case, it was submitted on behalf of the defendant that the plaintiff's claim that it had copyright in the artistic and literary works in question was rebutted by the deposition in paragraph 20 of the defendant's replying affidavit. The purport of that paragraph is this. In the June 2002 issue of Going Out the defendant did not use photographs scanned from the December 99/January 2002 issue of Go Places. The defendant obtained the photographs from the pavement café itself. The said photographs are the property of the said café and not of the plaintiff as the café paid for and approved the network. The advertisement of "LaCucina" restaurant in the May 2001 issue of Going Out did not copy the plaintiff's photographs and logo: the same were obtained from the advertiser who wanted the advertisement and the logo to be standard in order to avoid confusion on the part of the public. And the wordings in the February 2002 issue of the defendant's magazine are from the clients: such wordings belong to the clients and not to the plaintiff. The defendant has annexed copies of messages from clients specifically requesting to be advertised in particular words. The defendant's advocate contended that in those circumstances the issue of whether the literary and artistic works subject matter of the dispute belong to the plaintiff or the various advertisers arises for determination. In that connection, it was emphasized there was no affidavit by any advertiser that they commissioned the plaintiff to do the works for them. It was also pointed out that Pavement Café had not controverted the defendant's deposition that it supplied the defendant with the photographs. In those premises, it was submitted that the plaintiff had not established a *prima facie* case with a probability of success at the trial that she had copyright in the works claimed. On whether the plaintiff would suffer irreparable loss unless an injunction were issued, the defendant's advocate contented herself with the submission that if there was no copyright in the first instance, there would be no loss.

On the balance of convenience, it was submitted that the same tilted in favour of the defendant for the reason that it had been in business since May, 2000 and an injunction would be detrimental to its business.

It was further argued that to let the defendant continue publishing would not kill the plaintiff's business as claimed because both magazines are circulated for free and they rely on advertisers who are sophisticated enough to patronize whichever magazine they pleased.

It was also submitted that the plaintiff's conduct was inequitable and accordingly, it was not entitled to the equitable remedy of an injunction. The inequitable conduct was said to be constituted by the fact of the plaintiff having registered a website in the name of the defendant, that is Going Out. The plaintiff's website is known as *www.goingoutkenya.com*. The defendant's advocate cited the case of *Norman Kark Publications Ltd v Odhams Press Ltd* [1962] All ER 636 as established that he who uses a name first is entitled to subsequent use.

In reply to the defendant's submissions, Mr. Orowe reiterated that from the Plaintiff's affidavit it was evident that significant labour and skill had gone into the literary text, design, logo and photographs complained of. He conceded that it was permissible to produce a similar magazine provided it did not infringe the copyright of the plaintiff. However, in his opinion, the fact of consistent replication here discounted the possibility of two great minds

working independently to arrive at the same text. On the photographs, he submitted that it was not possible to produce identical photographs of a scene unless it is taken at the same time or there is a copying. On the point that the advertisers had sanctioned the text used by the defendant, he submitted that the alleged sanction was given on 19.3.2002, a day after the parties came for *inter partes* hearing. He argued that since the plaintiff's case was that the infringements were before March 2002, the advertiser could not retrospectively sanction the use of certain text by the defendant after it had been used by the plaintiff. He contended that the defendant's claim was contrived. On the website, the advocate submitted that the history of the application for the same as disclosed in the plaintiff's affidavit disclosed there was no bad faith on her part and that in any case, having been the first to be registered, she is entitled to use the registered name to the exclusion of the defendant.

I have now considered the application in light of the admissible affidavit evidence and the submissions of the Advocate for the parties. The law in this matter is not in dispute. Under both the old and the new copyright law as contained in the Copyright Act, Cap 130, (now repealed) and the copyright Act, Act No. 12 of 2001 respectively, no artistic or literary work would be eligible for copyright unless sufficient knowledge, labour and skill had been expended on the making of such work to give it some original character. And any person who copies or otherwise reproduces the work of another in which copyright subsists is guilty of infringement of that other person's copyright. And from the cases referred to, and in particular *Sapra Studio v Tiptop Clothing Co.* [1971] EA 489, it would appear that the most efficacious remedy is an injunction. From the above perspective, whether or not the plaintiff has shown a *prima facie* case for infringement of copyright depends on whether or not she has satisfied the court on a *prima facie* basis that the works in question are the result of exercise of sufficient labour and skill on her part which has given them some original character and that the defendant has reproduced the same. In this regard having carefully considered the evidence before me and the submissions, I find that the defendant's attempted repudiation of the plaintiff's proprietorship of the works in question as contained in paragraph 20 of the replying affidavit of Dr. Catherine Musitsa is sufficiently answered in paragraphs 22, 23 and 24 of the plaintiff's further affidavit of 4th April, 2002. I do therefore find that it is more probable than not that at the trial the plaintiff will establish proprietorship in the said artistic and literary works. I am also persuaded that the plaintiff has done sufficient work by way of photography, development, design artwork colour separation, and the publication of the said photographs to confer on them an original character. And with regard to the logo and design in dispute, I am similarly persuaded that sufficient labour and skill has gone into them by way of design and formatting as to confer on them some original character. The same applies to the literary text or script: I am persuaded that sufficient mental labour has gone into its collection, collation, arrangement and creative expression to confer on it an original character. In the premises I do find that the plaintiff is probably going to succeed at the trial in her case that she has copyright in the said artistic and literary works. As regards infringement of the said copyright by the defendant I have diligently scanned the rival magazines exhibited in the affidavits and I have come to the tentative conclusion that the defendant's work is not a product of an independent mind working and arriving at the same work as the plaintiff. It appears to me to be a case of plain copying and reproduction of the plaintiff's work including the errors therein. The defendant's genius is not apparent and the impression that the defendant is a mere 'copy cat' is strong in my mind. I do accordingly find that the plaintiff has made out *prima facie* case of infringement of its copyright by the defendant.

As to whether the plaintiff is likely to suffer irreparable loss which cannot be adequately compensated in damages, I accept the plaintiff's submission that considering the nature of the wrong, it may be very difficult if not impossible to calculate the plaintiff's loss as the level of circulation of the defendant's magazine is unknown. I also accept the argument that the wrong is not merely likely to result in pecuniary loss to the plaintiff's business but it is likely to kill it altogether as the defendant is offering the advertisement of the establishment concerned free of charge. In any case, it is a long established practice to grant interlocutory injunctions in cases of infringement of copyright once a *prima facie* case with a probability of success has been established.

Last, but not least, I have considered the plaintiff's alleged inequitable conduct in registering its web site in a name similar to the defendant. The plaintiff's narrative of the history of that registration has made me doubt whether she acted in bad faith. The inequity is therefore not made out.

In the result, the plaintiff's application for an interim prohibitive injunction succeeds and the same is granted in terms of prayer 3 in the chamber summons filed in court on 13th March, 2002. The costs of the application are also awarded to the plaintiff.

Orders accordingly.

Dated and delivered at Nairobi this 24th day of May, 2002

A.G RINGERA

JUDGE



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