



REPUBLIC OF KENYA
IN THE HIGH COURT OF KENYA AT NAIROBI
MILIMANI LAW COURTS
COMMERCIAL & ADMIRALTY DIVISION
CIVIL SUIT NUMBER 873 OF 2009

NAIROBI MAP SERVICE LIMITED..... PLAINTIFF

- V E R S U S -

CELTEL KENYA LIMITED (ZAIN KENYA) 1ST DEFENDANT

Z.K ADVERTISING KENYA LIMITED 2ND DEFENDANT

THE SOUND & PICTURE WORKS LIMITED 3RD DEFENDANT

JUDGMENT

INTRODUCTION

1. The Plaintiff came to this Court by way of the Complaint dated 1st December, 2009 and filed in Court on even date. The Plaintiff sought for judgment against the Defendants as follows:-

a) General damages at the rate of Three Hundred US Dollars (300\$) per day or its equivalent in Kenya Shillings from 29th August, 2009 up to a five year period from that date.

b) Punitive damages.

c) Costs of the suit.

d) Interest on a), b) and c) above at Court rates.

e) Any other relief that this Honourable court may deem fit to grant.

2. In response to the Plaintiff's claim, the Defendants filed their respective Defences. The 1st Defendant filed its Statement of Defence on 20th January, 2010 which it then amended on 12th June, 2012 while the 2nd Defendant filed its Defence dated 7th January, 2010 on 12th January 2010. The 3rd Defendant also responded to the claim by filing its Defence dated 19th January, 2010 on even date.

THE PLAINTIFF'S CASE

3. The Plaintiff described itself as the owner of the copyright in a map known as "Kenya Administrative Map" which map it developed. The Plaintiff averred that in the course of the Civil Suit 873 of 2009 | Kenya Law Reports 2017 Page 1 of 7.

year 2009, the 1st Defendant contracted the 2nd Defendant to prepare a commercial advertisement based on a map of Kenya for promotion and/or marketing of the 1st Defendant's products and that the 2nd Defendant sub-contracted the said job to the 3rd Defendant.

4. It is the Plaintiff's contention that the 3rd Defendant without its permission created the said commercial advertisement in different versions but all based on the Plaintiff's map or portions of it. The said advertisement first came to the Plaintiff's attention on 29th August, 2009 when its chief cartographer **James Mwaura Wamuhii** saw the advertisement on Nation T.V between 8.00 to 8.30 pm. Subsequently, the Plaintiff noticed that the advertisement was being aired in all major television stations especially Kenya Broadcasting Corporation, Nation T.V, Kenya Television Network and Citizen.

5. It is the Plaintiff's case that the 1st Defendant in paying airtime for and allowing the said advertisement to be aired is guilty of passing off the Plaintiff's map as its own and is vicariously liable for the actions of its agents, the 2nd and 3rd Defendants. It is further the Plaintiff's case that the 2nd Defendant having sub-contracted the 3rd Defendant to prepare the advertisement is vicariously liable for the actions of the 3rd Defendant while the 3rd Defendant is liable in its own right having blatantly copied the Plaintiff's map without seeking authorization.

6. It is the Plaintiff's assertion that by reason of the airing of the said advertisement, it has not been able to offer the map to the competitors of the 1st Defendant and other parties for broadcasting on a commercial basis. The Plaintiff avers that it charges the sum of Three Hundred US Dollars (300\$) per day or 10% of the value of one advertisement for each publication of its map based on a minimum time of five years unless negotiated otherwise. It is therefore the Plaintiff's case that it has lost the aforesaid possible income and in that case they are claiming damages from the Defendants jointly and severally for the breach of its copyright at the rate of Three Hundred US Dollars (300\$) per day or its equivalent in Kenya Shillings from 29th August 2009 up to a five year period.

THE 1ST DEFENDANT'S CASE

7. The 1st Defendant filed its Statement of Defence dated 20th January, 2010 on even date which Defence was amended on 12th June, 2012. The 1st Defendant denied the Plaintiff's claim that it was the owner of the copyright in the map known as "Kenya Administrative Map". It was further its assertion that the map referred to was not subject of the commercial and was only incidental to the advertisement and as such the Defendant and its agent were entitled to use it by virtue of **section 26 (1) (c) of the Copyright Act NO. 12 of 2001**. The 1st Defendant admitted to contracting the 2nd Defendant as an agent to provide advertising services on its behalf but denied the allegation that it was guilty of passing off the Plaintiff's map as its own or that it was vicariously liable.

8. The 1st Defendant also averred that it was not liable for the claim as it had entered into a contractual relationship with the 2nd Defendant, whereby the 2nd Defendant was to take care of claims from third parties in relation to the advertisement.

THE 2ND DEFENDANT'S CASE

9. The 2nd Defendant essentially denied the Plaintiff's claim in its Defence dated 7th January, 2010 and filed in Court on 12th January, 2010. It averred that the advertisement created by the 3rd Defendant was not based on the Plaintiff's map or any portions thereof. It further averred

that in the event that the advertisement was similar to the Plaintiff's map then this was due to the similarity in scenery applied in both the advertisements and the map. It is the 2nd Defendant's contention that the Plaintiff is estopped from claiming a monopoly on the usage of natural resources and scenery that have been captured in the said advertisements. The 2nd Defendant's position is that copyrights as envisioned in Kenya's Intellectual property laws do not cover ideas and/or information, but rather the form in which the said ideas and/or information are expressed. It is further the 2nd Defendant's contention that the Plaintiff is barred from alleging passing-off of its copyright having already admitted in its Plea that the Defendants had used different versions of the said map.

10. The 2nd Defendant also averred that the maps included in its advertisements were not the subject matter of the said commercial but was rather incidental to the product advertised in the film.

THE 3RD DEFENDANT'S CASE

11. The 3rd Defendant filed its Defence dated **19th January, 2010** on even date and denied the Plaintiff's claim. The 3rd Defendant denied the Plaintiff's claim that it was the owner of the copyright in the map in question. It further denied the allegations that any permission ought to have been sought from the Plaintiff in relation to the map. The 3rd Defendant averred that the map was not the subject matter of the commercial and was only incidental to the product carried in the film.

THE HEARING

12. The hearing of the suit commenced on 29th November, 2012 and was concluded on 26th March, 2015.

13. The Plaintiff's witness was its Chief Cartographer, **James Mwaura Wamuhiu**. His witness statement dated 24th February, 2012 was adopted as his evidence in chief.

14. The 3rd Defendant called one witness, its employee Sheila Peevers (DW 1) who described herself as a radio television film producer. She adopted her witness statement filed in Court on 19th March, 2012 as her evidence in chief. The 1st Defendant also called one witness, Mr. Patrick Munyororo, an employee at Airtel Kenya.

15. The evidence given by both parties were extensive and the Court will substantially consider the same in its judgment herein.

THE WRITTEN SUBMISSIONS

16. The Plaintiff filed its submissions dated 4th March, 2015 on even date.

17. In reply, the 1st Defendant filed its submissions dated 16th June, 2015 on 23rd June 2015 while the 2nd Defendant filed its submissions dated 30th September, 2015 on 2nd October, 2015. The 3rd Defendant filed its submissions dated 5th May, 2015 on 6th May, 2015.

ISSUES FOR DETERMINATION AND ANALYSIS

18. I have considered the pleadings herein, the oral evidence given by the witnesses and the written submissions by Counsel for the respective parties. Having done so, this Court considers the issues for determination in the present suit to be as follows:-

1. *Whether the Plaintiff has copyright in the map known as ‘KENYA ADMINISTRATIVE MAP’;*
2. *If issue No. 1 is in the affirmative, whether the Defendants or any of them have infringed the Plaintiff’s copyright in the said map;*
3. *Whether the Plaintiff is entitled to damages as prayed, from the Defendants or any of them.*

19. On the first issue, the Plaintiff’s position is that it has copyright in the map known as ‘Kenya Administrative Map’ as it developed the same. The 1st Defendant on the other hand denied this position by submitting that there was no evidence led before this Court to place the said map as a work eligible to be copyrighted within the meaning of **section 22** of the **Copyright Act**. The said section lays out works which are eligible to be copyrighted, among them, literary works, musical works, artistic works, audio-visual works, sound recordings and broadcast. **Section 2** of the Copyright Act defines artistic works to include maps meaning the Plaintiff’s map qualifies for copyright.

20. The Plaintiff filed a copy of its map in its bundle of documents dated 9th February, 2010 and further produced the original map at the hearing. The name of the Plaintiff appears in the said map as the author and the Defendants did not offer any rebuttal to the said fact. On the said map, there is also the sign © connoting copyright. This is *prima facie* evidence that the said map is copyrighted unless a rebuttal to the same is offered. The Defendants did not offer any. The Plaintiff’s witness also went ahead to demonstrate the efforts, labor and skill it put in coming up with the said map which had not been produced by anyone else. There is no evidence before this Court that there is a similar map to that of the Plaintiff.

21. In the circumstances, the Plaintiff is the author and therefore the copyright owner in the artistic work known as “*Kenya Administrative Map*”.

22. Having established that the Plaintiff is the copyright owner of the “*Kenya Administrative Map*” the second issue is whether the Defendants infringed the Plaintiff’s copyright in the said map.

23. It is not in dispute that the Plaintiff’s map was used in the ‘Zain Coverage’ advertisement. The 3rd Defendant submitted that it did not infringe on the Plaintiff’s copyright by including the map in the commercial for reasons that the inclusion of the said map was incidental to the primary message being conveyed and that the Plaintiff failed to show that the use had a detrimental effect on the potential market or value of the map. The 1st and 2nd Defendants echoed the same position. The Defendants have essentially relied on **section 26 (1) (c)** of the **Copyright Act**, which provides that copyright in any work does not include the right to control “the incidental inclusion of an artistic work in a film or broadcast”.

24. The Plaintiff relied on the case of **The Football Association Premier**

League Limited v. Panini UK Limited to which the Supreme Court of England and Wales dealt with the issue of incidental inclusion and Lord Justice Chadwick in his judgment stated that the matter turns on the question: **why-having regard to the circumstances in which work ‘B’ was created-has work ‘A’ been included in work ‘B’**” The 2nd and 3rd Defendants relied on the aforesaid authority as well. In addition, the 3rd Defendant relied on the case of **IPC Magazines Limited v MGN Limited [1998] F.S.R. 431** in which the U.K High Court held that, in determining the meaning of the phrase incidental inclusion, the

question to be answered was: “*Was the inclusion of the works incidental in the sense of casual, inessential, subordinate or merely background*”

26. From the authorities cited by the parties herein, the common thread is that what is incidental is a question of fact and will depend on the circumstances of each case.

27. The Plaintiff has contended that the use of its map in the advertisement cannot have in any way been incidental. The Plaintiff’s position is that its map was meant to show the coverage of the 1st Defendant’s network in the Country, which was the objective of the said advertisement.

28. The Court had the privilege to look at the clip showing the ‘Zain Coverage’ advertisement in line with the objective of the said advertisement and it is of the view that the inclusion of the said map was incidental. It is also worthy to note at this point that the Plaintiff used other maps other than the Plaintiff’s. As submitted by the 3rd Defendant the only use of portions of the Plaintiff’s map was to stick a pin to a location. A few locations on the map were pointed out. Emphasis was on the information relayed and transferred to the white board. The appearance of the map was subordinate. The coverage of the Plaintiff’s network had already been demonstrated by the act of the Engineer travelling to various locations and relaying information to the gentleman in the office set up who would tick the relevant locations on a white board. PW 1 also admitted that the map was not the subject of the advert.

29. In the event that the use of the Plaintiff’s map in the advert was not incidental, did the Defendants infringe on the Plaintiff’s copyright in the said map" It was submitted for the Plaintiff that the use of its map in the advert infringed on its copyright as the map was reproduced by making copies of the same using a camera and storing it in a compact disc. Further, the said map was communicated to the public by way of broadcasting in major television channels the whole map as well as substantial parts of the map. The Plaintiff relied on **section 26 (1) of the Copyright Act** which I shall refer to shortly.

30. However, it was PW 1’s testimony that the Plaintiff had no issue with the map as used by the 3rd Defendant in production of the commercial advert. On cross-examination, it was his testimony that his complaint was not with regard to the use of the map but with the ‘blown up part of the map’ which according to him had defaced the map and made the Defendants the owner of part of the map. He testified that the map was blown out of proportion when the Defendants digitized it and made it electronic thereby carrying it. The 3rd Defendant on the other hand denied the allegation that it had ‘digitised’ the map. It further contended that it neither blew up any part of the map nor did it include any pop ups in the commercial.

31. It is not clear how the map in the advert was defaced and eventually making the Defendants the owners of the map. The map had been hanged on a wall and the title of the map ‘**Kenya Administrative Map**’ could not be seen. In short, there is nothing to show that the public could come to a conclusion that the map belonged to the 1st Defendant or any of the Defendants. If anything, as has earlier been stated, the map was just used to point out to some locations where the 1st Defendant had network coverage. On cross-examination, PW 1 also testified that one could buy the Plaintiff’s map to read it or hang it up. From the advertisement as shown in the clip, it is clear that the Plaintiff’s map is hang-up in a corner of the office set-up and the sticking of pins on certain locations in the said map, amounts to reading the map.

32. It is further the Plaintiff’s complaint that the Defendant reproduced the map to prepare the commercial advert. As stated above, the map was hanging up on a wall whereby the

person at the office pinned up some locations. The assumption is that this is the map the 3rd Defendant purchased in a bookshop. In that case, the map was just part of the advertisement and the same was not reproduced. It was DW 1's testimony that the 3rd Defendant never reproduced any map either by scanning, photocopying or printing the same. There is no evidence to the effect that the map was digitized or that the Defendants made one or more copies of the same in an electronic form or in hard copy. It is not disputed that only parts of the said map were shown in the advertisement and not the whole or substantial part of the map. **Section 26 (1) of the Copyright Act** expresses the nature of the protected right in copyright work and states as follows:

“Copyright in a literary, musical or artistic work or 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 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 in its original form or in any form recognisably derived from the original...”(Emphasis supplied)

In light of the aforesaid provisions of the copyright Act and the above analysis it is plain that the Defendants and particularly the 3rd Defendant neither reproduced the whole or substantial part of the Plaintiff's map nor did it communicate to the public or broadcast the said map. Therefore, the Defendants cannot be accused of copyright infringement as envisaged under **Section 35 (1) of Copyright Act** the.

33. PW 1 further testified that the agents selling the Plaintiff's maps did not impose any restrictions on the use upon buyers of the map. However, on cross-examination, he testified that the use of the map was restricted though the Plaintiff did not expressly tell the buyer that. According to the Plaintiff, for commercial use one had to purchase the electronic form of the map and the sale charges were dependent on the use the purchaser requested it for. However, such information was not brought to the attention of the purchaser (the 3rd Defendant). In fact, PW 1 testified that when they saw the advert on the Television, they were surprised and worried and that it became clear to them that there was a loop hole in their system. I couldn't agree more. It is plain that the Plaintiff had not offered any public information to the effect that when one wanted to use the map for a commercial advertisement it had to be in an electronic form. In addition, there was no information to the effect that one had to indicate what they intended to use the map for at the time of purchase.

34. The 3rd Defendant demonstrated before this Court that indeed they bought a copy of the said map. The Plaintiff's witness also confirmed that the Plaintiff produced the maps for sale and stated that the map purchased by the 3rd Defendant was an authentic one. In that case, it cannot be said the 3rd Defendant wrongfully used the map.

35. In the circumstances foregoing, this Court finds and holds that the Defendants did not infringe on the Plaintiff's copyright in the “Kenya Administrative Maps”.

36. Is the Plaintiff entitled to the damages sought for in the Plaintiff's Complaint? This is the third and last issue. Having established that there was no infringement on the Plaintiff's copyright, it goes without saying that the Plaintiff is not entitled to any damages as sought for in the Plaintiff's Complaint.

37. Moreover, there is no evidence to the effect that the use of the Plaintiff's copyrighted map by the Defendants in the advertisement interfered with the sale of the said maps or that the 1st Defendant's competitors could not use the maps. The Plaintiff's witness in fact testified that the advertisement by the 1st Defendant did not stop the Plaintiff from selling the maps. In addition no evidence was tendered to the effect that the Defendants were now selling the Plaintiff's map that they had reproduced, if any. In other words, the Plaintiff has not proved any loss arising from the use of its map in the advertisement of the 1st Defendant's coverage.

DISPOSITION

38. In the upshot, the Plaintiff's suit is dismissed with costs to the Defendants.

READ, DELIVERED AND DATED, AT NAIROBI THIS 26TH DAY OF APRIL 2016.

E. K. O. OGOLA

JUDGE

Ruling Read in open court in the presence of:

Mr. Koech for Plaintiff

Mr. Kahura for the 1st Defendant

No Appearance for 2nd and 3rd Defendant

Teresia – Court Clerk



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