Efficacy of Selected Civil Remedies and Procedures Against Copyright Infringement in Kenya

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July 11, 2006
Nairobi
I, RICHARD C. N. KULOBA, do hereby declare that this thesis is my original work, and that it has not been, and is not currently being submitted for a degree in any other University.

R. C. N. KULOBA
(Candidate)

The thesis has been submitted for examination with my approval as University of Nairobi Supervisor.

Dr. Bernard Sihanya
(Supervisor)

Nairobi
2006
DEDICATION

To the late Chief Justice
Z. R. Chesoni,
A great legal mind, an astute Judicial administrator, who would lay down his life for the triumph of the Rule of Law and the dignity of the Judiciary
PREFACE

This is a study of three judicial civil remedies selected out of many others in the law’s armoury for combating infringement of copyright in Kenya. The three selected remedies are account of profits, injunctions and delivery up. Along with them are studied key procedural and jurisdictional questions affecting those remedies.

The choice is justified on a number of grounds. One reason why they have been chosen for this study is that either one of them individually, or all or some of them supplementary to each other, these remedies are formidable counterblasts against copyright infringement in Kenya.

They can be expeditious and effective. One of them stops infringement. That is an injunction. Another recaptures profits made out of infringement. That is accounts. And the other mops up from the market existing infringing material. That is delivery up. Those are the sort of remedies a copyright owner would most likely go for.

By their respective characters and the job they do, these remedies have a superiority over the money remedy of damages which in copyright infringement may often not be adequate or may end up being a compulsory purchase of the owner’s copyright. Indeed, usually damages are shrouded in uncertainty. Nor does the common inability of the defendant to pay them endear damages to an owner of a copyright which is infringed. In addition, damages and other remedies do not lend themselves to provisional protective measures available under, say, an injunctive remedy.

There is no published up-to-date in-depth study of any of these remedies in the context of copyright infringement in Kenya. And yet statute has provided that these remedies are available to a plaintiff in a suit of infringement of copyright in this country. As copyright infringement increasingly becomes serious in Kenya, there is a good reason to analyse these important remedies.
The study of these remedies is justified in another respect. There is a worldwide concern for the protection of copyright and other forms of intellectual property. Member States of the World Trade Organization are required to have in their legal systems expeditious and effective civil remedies, procedures and measures to fight infringements of intellectual property rights in general, including copyright. Kenya is a member State of the World Trade Organization.

Kenya has partly addressed this concern by the passing of a new law as an Act of Parliament on copyright protection. This is the Copyright Act, 2001 (No 12 of 2001). Parliament has thereby pointed the way. It is upon legal scholarship to undertake studies at least of aspects of that Act. Some of the important aspects under the Act are civil remedies for infringement of copyright in this country. Such studies will help in showing whether the legislative measure will meet the goal.

The enjoyment of copyright can be realized only with the help of efficient, expeditious and effective remedies and procedures. It is important to examine some of the remedies and procedures available to an owner of copyright in order to establish the efficacy of the legal system in the protection of the rights' owner.

This dissertation is an attempt in five chapters to address the three civil remedies a court may grant in a proper case. Some aspects of procedures affect the quality, efficiency, and effectiveness of those remedies. So, in this dissertation the study begins with a look at some of the key procedural and jurisdictional questions in moving to get a judicial civil remedy for copyright infringement. That is the subject of the first chapter.

The next three chapters after the first chapter deal with each of the three civil remedies for copyright infringement. Each remedy is studied not by way of a general discourse on the remedy as a whole. The study of each remedy focuses on copyright infringement.
Accordingly, the second chapter deals with account of profits, focusing on copyright. The third chapter is a study of injunctions as remedies for copyright infringement. It, too, is not a general discourse on injunctions; the focus is on copyright to the limited extent that an injunction is a civil remedy for infringement. The fourth chapter looks at the remedy of delivery up, also focusing on it as relief for copyright infringement.

Finally the fifth chapter draws together from all the preceding four chapters some salient aspects which stand out for particular attention. On the basis of the findings of the study under the earlier chapters some of the essential criticisms are recapitulated in summary form. Some suggested recommendations are then made as pointers to the way forward on certain issues.

The research proposal annexed to this dissertation as an appendix sets out, among other things, the questions addressed, the argument structure, the problem at hand, the objectives of the effort, a brief review of the literature available and related to the subject in Kenya, and the framework of the study.

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APRIL, 2006
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In the undertaking and execution of this study there were individuals who helped me to accomplish the task. They are good. I thank them. Through them I also thank the institutions for which some of them work.

Professor Albert Mumma, the course co-ordinator, gave me an attentive and sympathetic ear and answers that kept my spirit alight.

I acknowledge the fact that the relevant University authorities appointed Dr. Bernard Sihanya to supervise this project. For this, I am grateful for many reasons a statement of which cannot fit in this limited space.

Authors who toiled to create, and the publishers who produced, the works which I made use of, most of which sufficiently appear in the footnotes or bibliography, remain my creditors whom I am unable to repay.

Various librarians of a number of law libraries around the country gave me assistance which I will never forget. But Mr. Alfred Meso of the Attorney-General’s Chambers’ Law Library especially took my problems as if they were his own and did all that was within his power to help me.

My children Albert, Hellen, Cedric and Brian, checked the internet for me and assured me that I had not missed anything of value that could materially change the expositions I was laying down in this work.

Advocate Ahmed Sheikh Adan gave me a desk at which to write at. This facility and the amiable ambience greatly assisted me whenever I needed to work away from my study for a change.

Without Lilian Odock to whom pressure of work was her pleasure, and emergency demands to produce the typescripts within unanticipated tight deadlines added her unfading smile, preparation of this dissertation would have been nightmarish to me.

My present public expression of thanks to helpers would never have arisen had my wife Rose not ensured enduring prevalence of a perpetually serene domestic atmosphere conducive to producing this literary work for which to thankfully acknowledge the help of others.

All errors and misapprehensions if detected on any aspect in this dissertation would be squarely due to my own failing in those respects.

R. C. N. KULOBA
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<td>Court of Appeal, on appeal from the High Court of Zanzibar</td>
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<tr>
<td>Cap.</td>
<td>Chapter (of the Laws of a country concerned)</td>
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<td>C C</td>
<td>Civil Case</td>
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<td>Ch.</td>
<td>Law Reports, Chancery (English)</td>
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<td>Cir.</td>
<td>Circuit (U.S.A)</td>
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<td>CLR</td>
<td>Commonwealth Law Reports (Australia)</td>
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<td>EA</td>
<td>East(ern) Africa(n) Law Reports</td>
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<td>EACA</td>
<td>Eastern Africa Court of Appeal (Law Reports)</td>
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<td>EAPL.R.</td>
<td>East African Protectorate Law Reports (Kenya)</td>
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<td>Eq.</td>
<td>Law Reports, Equity Cases (English)</td>
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<td>F</td>
<td>Federal Reporter (USA)</td>
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<td>F 2d</td>
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<td>Abbreviation</td>
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<td>F 3d.</td>
<td>Federal Reporter, Third Series (USA)</td>
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<td>HC</td>
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<td>Law Reports, House of Lords Cases (English)</td>
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<td>K &amp; J</td>
<td>Kay &amp; Johnson (English Chancery cases)</td>
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<td>KAR</td>
<td>Kenya Appeals Reports</td>
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<td>KB</td>
<td>Law Reports, King's Bench Division (English)</td>
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<td>KLR</td>
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<td>LSKJ</td>
<td>Law Society of Kenya Journal</td>
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<td>Misc</td>
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<td>RPC</td>
<td>Reports of Patent Cases (English)</td>
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<td>Sub Leg.</td>
<td>Subsidiary Legislation</td>
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<td>US</td>
<td>United States Supreme Court Reports</td>
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<td>Ves Sen.</td>
<td>Vesey Senior (English Reports of the Chancery)</td>
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<td>WLR</td>
<td>Weekly Law Reports (English)</td>
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<td>ZLR</td>
<td>Zanzibar Laws Reports</td>
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INTRODUCTION: RESEARCH PROPOSAL

1. The Research Topic

This is a study of selected expeditious and effective civil judicial remedies and procedures against infringement of copyright in Kenya. The selected civil remedies are the remedies of (1) account of profits; (2) injunctions; and (3) delivery up. Since these are judicial remedies, they are applied for in accordance with rules of court. The research topic therefore covers, key procedural matters likely to keep recurring.

The subject matter of the thesis is not all civil remedies or every procedural question in copyright protection and promotion. The centre of interest is on certain aspects of judicial remedial and procedural protection of copyright.

2. Research Questions

This study seeks to answer the following three research questions. First, what are some of the key civil judicial remedies, in the law of Kenya, available for the protection of copyright against infringement? Do they have something about them which makes them peculiarly suitable to the expeditious and effective protection of copyright in this country? Secondly, what are the principles and procedures entailed in the issuance or withholding of each of the remedies identified as especially efficacious in copyright protection and the fight against copyright infringement in Kenya? It is all fine to see these remedies on the statute book and in international Agreements and Treaties; but do we know all about each one of them? Thirdly, do those principles and procedures enure to, or do they impede, the expeditious and effective protection against infringement of copyright in Kenya? Finally, is there room for improvement?
If so, what suggestions can be made for the way forward? In this project, an attempt is made to answer those research questions.

3. Argument Structure

In this study, three civil remedies and their procedural aspects are selected for examination. Each of them is studied individually. Its breadth and depth are analysed. The principles on which each of them is considered by the courts are examined. It is to be shown that, on the whole, basic principles are fairly ascertainable.

It is also to be shown, that not infrequently some procedural requirements do stick out to slow down the process of obtaining a required remedy. Some other procedural strictures can cause injustice.

It is, however, concluded that if they are properly administered in the manner to be suggested in the thesis the very nature of each of the three remedies and what each of them seeks to do, is such that the three remedies, either individually or in complementary roles, are expeditious and effective antidotes against copyright infringement in Kenya. The thesis here is that these are efficient remedies in copyright enforcement. What is needed is that from time to time some edges of each remedy found blunt should be sharpened, while the rough edges should be smoothened. The study points out the drawbacks and suggests fresh look whenever the shortfall in the law is encountered.
4. The Problem

There is in existence in Kenya a fairly modern statute on the subject of copyright. This is the Copyright Act, 2001. It sets out protectable rights, and states available remedies. The trouble is, that there is no published work on judicial civil remedies and procedures focusing on copyright, in Kenya as such. This is a serious problem. Rights without a proper understanding of the procedure and remedies to vindicate them are worthless stock.

Today, the law on civil remedies and procedure regarding copyright infringement in Kenya is shrouded in largely unarranged woods of dispersed sources and largely inaccessible judicial authorities. This state of affairs creates a problem: one cannot tell whether the civil remedies and procedures to fight copyright infringement are expeditious and effective. This study sets out to address these problems.

5. Background to the Problem

Civil judicial and the civil procedure in courts for the enforcement and pursuing of copyright against infringers in Kenya for appropriate civil redress have largely remained something of rural backwater in legal studies. They are generally mentioned, listed and noted, but under analysed in Kenyan legal studies. As shown in paragraph 8 below, this is an area of law which has been misconceived as serving foreign interests only.

In relatively recent times, however, copyright enforcement, through model civil judicial remedies and efficient judicial procedures, has been made an international trade issue worldwide.

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1 Act No 12 of 2001, repealing, by section 52(1), the Copyright Act (Cap 130, Laws of Kenya). Its date of commencement was 31st December, 2001.
The Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPs) of the World Trade Organisation (WTO), requires members of WTO to have in their legal systems desired legal measures, including civil judicial remedies and procedures, to enforce copyright and other intellectual property rights. Kenya is a party to this Agreement. Article 41 of TRIPs contains this obligation on the enforcement of intellectual property rights. Key to the enforcement of intellectual property rights such as copyright, are civil judicial remedies and procedures, as envisaged under Articles 42–50 in particular, and others like border measures (Section 4) in general. Criminal procedures are also provided for, but these are outside the scope of this study.

Because Kenya is now under this international obligation, it is imperative that the existing problem be addressed, at least in part by an examination of important civil judicial remedies and procedures in our legal system with regard to copyright judicial enforcement.

Accordingly this study is undertaken in the context of (a) the new copyright legislation in Kenya; (b) the international concerns calling for efficient copyright regimes in all countries of the world; (c) copyright is now a core subject in the study of law; (d) copyright litigation is making its way through courts with increasing frequency; and (d) the popular press is also more frequently than before highlighting copyright remedial issues. With this background, it is felt that this study is called for, to address the problem.

6. Objectives of the Research

There are two objectives of this research: specific and general objectives. The specific objective is to investigate and bring together and analyse in the context of copyright enforcement in
Kenya, the scattered and unorganised law, principles and practice of the three selected civil judicial remedies against infringement of copyright in Kenya. It is a keen analytical study in which any discernible procedural aspects or inherent qualities of a given remedy, which work towards the expeditious and effective protection against copyright infringement, shall be pointed out. Likewise, any drawback in that regard shall be brought out. Appropriate suggestions shall be made whenever they are called for.

The second, and general objective is to fill a gap in legal scholarship regarding some important civil judicial remedies and procedure against infringement of copyright in Kenya. The objective here is also to reach certain conclusions and point the way forward in law reform programmes in the area of civil judicial remedial and procedural justice in Copyright enforcement in Kenya.

7. Hypotheses or Assumptions

This study is undertaken on, and the researcher is working with, three hypotheses or assumptions. The first assumption is that the country puts a high premium on copyright as a form of property, and the need for its adequate and efficient protection and enforcement. In this connection it is hypothesised that some investment issues concerning information transfer and exchange require to be addressed clearly understood and fully studied civil judicial remedies and procedure for copyright enforcement. Here the hypothesis is that expeditious and effective civil judicial remedies and procedures against infringement of copyright in Kenya are involved in issues of national development, because dilatory and inefficient civil judicial remedies and procedures may work against technology transfer, block the information highway and impede economic and social development generally.
The second hypothesis, is that while the state may be concerned for reasons stated under the first hypothesis, copyright owners themselves are keenly interested to know civil remedies available to them when there is infringement or threatened infringement. In addition, they want to know how expeditious and effective those remedies and procedures for seeking civil redress in courts are. Inadequate or no studies of remedies and procedures can contribute to inefficient copyright enforcement. In turn, this discourages creativity, undermines competitiveness, lets infringers get away with wrongdoing, and ultimately destroys the utilitarian and human rights justifications for copyright regimes.

In short, the core assumption of these remedies is that they help copyright to maximize certain social benefits: providing a necessary inducement for creativity and distribution of knowledge. They serve the human rights qualifies, and the economic value of copyright in Kenya.

8. Literature Review

There is a dearth of published works on civil judicial remedies and procedures against infringement of copyright in Kenya. Nevertheless, there are some pillars of hope.

One early effort is by John Waruingi Chege in his Copyright Law and Publishing in Kenya.² It looks at the law of copyright in Kenya as at that time, basically from the point of legislative history. It also dwells on the history of English copyright statutes, bilateral and limited multilateral arrangements in the West.

Much of what Chege wrote on has since changed. For instance, the local copyright statute has since been repealed and replaced by a new enactment. The latest and current enactment is the Copyright Act, 2001, which repealed the Copyright Act (Cap 130). The new Act came long after Chege’s book was published. It made fundamental changes in the law of copyright, in order to make it compliant with the new world economic order highlighting international concerns over, *inter alia*, the need for efficient civil judicial procedures and remedies.

Chege’s work discusses no remedy. It merely mentions their availability (under the repealed Act), and illustrates one (injunction) with reference to two decided cases whose facts and holding are narrated. But the book misses out on setting out and analysing the applicable principles and procedure, and on offering any informed and studied opinion on whether those remedies and procedures are expeditious and effective.

The book is stagnated in a time warp, between 1963 and 1975. The book argues against private enterprise and recommends nationalization of private investment which is in opposition to the protection of private property under the Copyright Act, 2001, and the remedies the Act makes available to copyright owners.

In “Intellectual Property Confronts Counterfeiting in Africa: Protecting Innovators and Consumers in Cybersociety”, Bernard Sihanya calls for the putting in place in Africa “appropriate mechanisms to confront and stop... opportunistic conduct” of counterfeiting. He

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3 *Gasston and Harbour v Bwatu Mpologoma Growers Co-operative Union Ltd and others*, [1958] EA 549 (U) and the well-known Kenya High Court case of *Sapra Studio v. Tip-Top Clothing Co* [1971] EA 489.

4 It is stated at p.144 that copyright law in Kenya “has prevented the rise of an indigenous publishing industry,” and international “nationalization of foreign interests.”

points out, inter alia, that consumer protective “provisions are scattered in numerous statutes, if they exist at all”, and in “incoherent case law; and a body of largely arbitrary administrative determinations”. The said writer further points out that “there is either no appropriate law, or very weak law to combat counterfeit trade” and “a credibility gap between policy, law and enforcement”. He adds, that “innovators must confront counterfeiters through costly and time-consuming litigation”, and that although there is litigation on intellectual property matters, “the content of the law is still largely inadequate to handle sophisticated, IT-related counterfeiting”. The same piece suggests reform measures which include those which will enable the infringement of intellectual property rights “provoke more favourable remedial responses.”

These observations are a challenge to legal scholars to undertake full and close studies on remedial and procedural law, put the results together, in order that aspects of the law which make litigation expensive and slow can be identified and addressed, and those which require reform to cope with modern sophistication attended to. This present dissertation is an attempt to make a beginning in meeting that challenge.

One final observation on that piece for the present purposes is, the fact that the said study covers Africa, drawing from intellectual property and related consumer laws of many African countries. As such, the civil remedies of account of profits, injunctions and delivery up, and their attendant procedural aspects, in Kenya, are not specifically analysed in that study. They are probably subsumed under the general rubric “civil remedies” a list of which is tabulated in that work with

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6 Ibid, at p. 342.
7 Ibid, at p. 342, fn 45.
8 Ibid, at p. 348.
9 Ibid, at p. 355.
reference to a number of statutes like those on standards and measures, contract and sale of goods, and considered in the context of counterfeiting in Africa. So, in that manner, that contribution further gives a cue to copyright law students to, and allows space for, specific studies be undertaken on specific and individual civil judicial remedies and related procedures, to come up with relevant reports.

In “Towards TRIPs Compliance: Kenya’s Legislative Reforms”\textsuperscript{12} Professor Otieno-Odek makes highlights of the Copyright Act, 2001. However, he does not mention the civil remedies for infringement of copyright, which are set out in section 35, (4).

Since Professor Otieno-Odek does not address the civil remedies and procedure available to a copyright owner, some work on these aspects may complement his contribution to the advancement of legal knowledge on these aspects of copyright law and countering copyright infringement.

\textit{Judicial Hints on Civil Procedure,}\textsuperscript{13} is on the broad provisions of the Civil Procedure Act (Cap 21, Laws of Kenya). It deals with some provisions of the Act which lay out the skeletal framework of civil procedure within which the detailed Civil Procedure Rules setting out the detailed day-to-day practice requirements. In practice, what measures the efficiency and effectiveness of the judicial process, remedies and procedural fairness, are the detailed rules of practice and procedure. The book does not cover these rules, except to a limited extent whenever necessary. Since procedural requirements for seeking the selected remedies are largely covered

\textsuperscript{12} In Christophe Bellmann, Graham Dutfield and Ricardo Melendez-Ortiz (eds.), \emph{Trading in Knowledge: Development Perspectives on TRIPs, Trade and Sustainability}. Earthscan Publications, Ltd, 2003, Chapter 29, pp. 277 – 284.

by the Rules to which the book does not extend, discussing these remedies and assessing their efficiency and effectiveness needs to bring in the study the relevant detailed rules of procedure as may affect civil litigation regarding copyright infringement in Kenya. The book leaves that opening. This study brings out the rules affecting actions for the selected civil remedies for copyright infringement in Kenya.

*Principles of Injunctions*,\(^{14}\) covers only one remedy, but even then, it was not written specifically in the context of copyright infringement and redress, although that subject is dealt with in the book. Space could not allow elaboration where necessary. Also, a lot of time has passed since its writing in 1987, and the subject calls for revisiting to see if there is a need for a different view or presentation before a new edition may be prepared. There is another reason for coming back to the remedy of injunction. It is, *inter alia*, to correct a wrong definition of the concept of injunction which a subsequent writer\(^{15}\) has given, some ten years after the publication of *Principles of Injunctions*.

The said writer has defined an injunction as “a *prayer to the court* to restrain the defendant from engaging in an activity that injures the plaintiff or to command the defendant to do certain things.” An injunction is not “a prayer to the court”. It is not an application. Within the context of “interlocutory applications” which the said learned writer discusses, an injunction is a discretionary *order* of the court after a prayer for it has been granted.

So, it seems imperative for another attempt to be made to clarify aspects of the remedy of injunction which are likely to give rise to a multiplicity of errors.


With regard to the remedies of account of profits and delivery up, there is no known writing in Kenya addressing them. This present work is one effort to fill this gap in our law in this respect.

Courts of Justice in Kenya\textsuperscript{16}, is on Kenya’s court structure, judicial procedure and jurisdiction, court fees and charges, tribunals and boards of enquiry, contempt of court, the rule of law and judicial independence, among other topical issues of a general nature. While the book lays a basic framework on background information on procedure\textsuperscript{17} which can save a writer on specialised topics like the enforcement of copyright by judicial remedies, it did not specifically focus on judicial civil remedies and procedures against copyright infringement in Kenya.

For the foregoing reasons, this present study is undertaken as part of efforts to fill the literary gap existing in the law of copyright enforcement, with particular reference to some of the available civil judicial remedies against and procedures for moving against, copyright infringement in Kenya.

9. Theoretical and Conceptual Framework

The remedies of account of profits, injunctions and delivery up, and the procedure to seek them, are conceived here as the law’s means of protecting, promoting and enforcing copyright as a proprietary right. They are the law’s optimal design to inject meaningful life into property rights. Copyright is one such property.


\textsuperscript{17} Chapter 6, pp 91-136.
The theoretical basis of this study is the conception that rights and duties spelt out in the law, are of no good if a copyright owner does not have expeditious and effective civil remedies and procedures to enforce them when they are infringed or threatened with infringement.

Copyright as property cannot, by its mere recognition stimulate innovation, creativity, and encourage the exchange of information, provide rewards and incentives, and help in economic development, where there are no expeditious and effective civil remedies and procedures, or where these remedies and procedures are not keenly studied and understood reasonably well.\textsuperscript{18}

The focus of this study is on account of profits, injunctions and delivery up as efficient civil judicial remedies against copyright infringement in Kenya. Each of these is discussed in detail in a separate chapter. Account is discussed in chapter 2, injunctions are dealt with in chapter 3, and delivery up is the subject of chapter 4. Their origin is in equity. But now they are expressly provided for in, among others, sections 35(4) and 37(1) of the Copyright Act, 2001.

This study will critically elaborate on what these remedies are, issues of typology, leading principles by which they are governed, and their relevant procedural aspects which tend to affect the remedies’ expeditious and effective availability.

Conceptually, \textit{account of profits} will be shown to be a restitutionary remedy in a money judgment against a copyright infringer. It orders an account to be taken and profits paid over to

the copyright owner. It is thereby an attempt to cure financial maladjustment following the unjust enrichment of a copyright infringer at the expense of the owner of a copyright.\textsuperscript{19}

\textit{Injunction}, in conceptual terms, is a \textit{specific} remedy, in contrast to \textit{substitutional} remedies which money remedies like damages are.\textsuperscript{20} It is the remedy an owner of copyright is most likely to prefer, because it requires an infringer to do the right thing, or to refrain from doing a wrong thing. This is studied under chapter 3.

\textit{Delivery up} directs an infringer to surrender infringing articles to the owner of the copyright therein. It is a recovery order for the requisition of infringing matter. It denies the infringer the opportunity to remain in possession or control of the infringing matter. But more importantly, the idea is to take the infringing articles out of the channels of commerce or the channels of distribution.\textsuperscript{21} This is the subject of chapter 4 of this study.

10. Methodology

Information will be sought in law libraries around the country. In particular, materials held in the judicial libraries of the High Court and the Court of Appeal, will be key sources. Nairobi is the main source, because litigation is done there more than anywhere else in the country. But to be as exhaustive as possible, the collections held in the High Court registries at Bungoma, Eldoret, Kakamega, Kisumu, Mombasa, Nakuru are fairly representative.

\textsuperscript{19} On the principle of unjust enrichment generally, see Lord Goff of Chieveley and Gareth Jones, \textit{The Law of Restitution}, 5\textsuperscript{th} edn, Sweet & Maxwell, London, 1998, at pp. 4-5, 11-15, 46-47, and on account of profits in the context of restitution generally, see \textit{ibid}, at pp. 754, 758-789.

\textsuperscript{20} For a full survey of specific and money remedies, see F H Lawson, \textit{Remedies of English Law}, 2\textsuperscript{nd} edn, Butterworths, London, 1980, Part two and Part 3.

In addition, library research at the State Law Office library in the Attorney-General’s Chambers at Nairobi, is useful. Further, the law library at the University of Nairobi, and the private library of the supervisor for this thesis, provide relevant material. Those libraries have collections of published and unpublished legal materials. In particular, there are textbooks, periodicals, and judgments in decided cases, from which one gets insights and what can be weaved into a report on this research topic. These materials will appear in the citations of the relevant references in the appropriate places in the thesis, as relevant decided cases, texts or articles.

General observation of the goings-on in the court civil litigation, and this researcher’s personal judicial experience in deciding much litigation in the courts also inform this research.

11. Chapter Breakdown

This study is undertaken to be covered in a sequence of five chapters.

Chapter One is on civil litigation to get civil judicial remedies for copyright infringement in Kenya. It serves as an introductory survey of preliminary questions involved in civil proceedings in the enforcement of copyright and redressing copyright infringement.

Chapter Two is on the remedy of account of profits. The contents of that chapter cover an attempt to understand its nature by defining it and considering aspects of its nature and character. The jurisdiction and principles to grant the remedy are to be considered. As a money remedy, it requires a consideration of aspects which may influence its choice over any other money remedy.
Any outstanding difficulties about the remedy need being highlighted, and some concluding observations and suggestions made on the chapter.

Chapter Three is on the remedy of injunctions in copyright cases. For reasons of ensuring a common language and clarity of thought and understanding, it may be helpful to begin the chapter with answering the question: what is an injunction?22 This is followed by an examination of the nature and chief character of the remedy. The remedy lends itself to various classifications which require examination in the chapter. Leading principles need to be identified. A conclusion highlighting some of the pros and cons of aspects of the remedy help to assess the efficiency and effectiveness of the remedy. Suggestions will be made at the end of the Chapter for filling some gaps.

Chapter Four discusses the remedy of delivery up in copyright cases. It begins with the definition, nature, objective and purpose of the remedy. The jurisdictional basis of the remedy needs stating as this is important in discussions of any remedy. The general principles relating to the remedy also require an examination, as these must be clearly understood in order to see whether the remedy helps in the expeditious and effective protection of copyright against infringement. This Chapter also addresses problems of mixing copyrighted and infringing material, and of multiple interests in infringing work. The positions of the Government and third parties are examined. Illustrative cases are looked at. Its position as a mop in the scheme of remedies is highlighted. In concluding the chapter, certain areas of the remedy which require particular attention to be paid to, in order to make it expeditious and effective, need pointing out.

22 Mundane as the question may appear, it is still necessary to answer it because there is evidence that what an injunction is, is sometimes missed: see, e.g. the wrong definition in Kimondo, An Introduction to the Law of Civil Procedure, supra,note 15, at p 18. Indeed, at international level “the concept is not universal” and it is, therefore necessary to define the scope of the remedy contemplated in Kenya. As to its non-universality, see Gervais, supra, note 18, para 2.395, at p 296.
Rather inexplicably, the remedy appears to be lowly regarded and relatively briefly discussed in renowned studies, as it will be noted in this work.

Chapter Five, and it is the last one, contains general conclusions covering all the remedies and procedural matters studied in the research. In it, suggestions are put forward regarding some of the difficulties encountered. The conclusion follows the findings in the course of researching the relevant law, practice and procedure, and any observed gaps in the jurisprudence. Suggested recommendations to fill those gaps in a copyright law reform programme shall be made from time to time.
1.1. Introduction

Civil suits and applications for judicial civil remedies for infringement of copyright in Kenya usually pose fundamental jurisdictional and procedural questions which must always be addressed. This Chapter surveys some of the key preliminary questions of civil judicial procedure relevant in a civil suit or application for a remedy for infringement of copyright in Kenya.

The key ones include questions of the right parties to sue or be sued for infringement of copyright; the limitation of the time within which remedies ought to be sought; and, questions of jurisdiction. Unless these issues are properly addressed at the outset, a suit or application for any of the remedies for copyright infringement may flounder and collapse in limine, or be unduly delayed, usually with a concomitant increase of litigation costs and anxiety.

1.2. Parties

1.2.1. Who may sue for a civil remedy for infringement of copyright?

1.2.2. The first owner. Under the Copyright Act, 2001, an infringement of copyright is actionable by, among others, the first owner of the copyright. Normally copyright vests initially in the author. "Author" is defined by statute, and, basically such a person is one who actually originated and created the work. Copyright is conferred upon him by virtue of nationality or residence or by reference to the country of origin. The giving of the right to sue to the author is

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1 Act No 12 of 2001, section 35 (4).
2 Ibid, section 31(1); but this general position is qualified by the proviso in relation to commissioned works or works made in the course of the author's employment under a contract of service.
3 Ibid, section 2.
4 Ibid, section 23(1).
5 Ibid, section 24(1).
a statutory recognition of the age-old rule that he who has the right, is the person to pursue the remedy.\textsuperscript{5}

By section 35(4) (e) of the Copyright Act, 2001, however, before the owner of the copyright institutes proceedings, he should give notice in writing to the exclusive licensee or sub-licensee of the right concerned of the intention to do so, and the exclusive licensee or sub-licensee may intervene in such proceedings and recover any damages he may have suffered as a result of the infringement concerned or a reasonable royalty to which he may be entitled.

If a party questions the right of another party to bring an action to seek a civil remedy for infringement of copyright, he may do so; but he should raise the question at the earliest possible opportunity, normally by an interlocutory application, and not at the trial. But where want of capacity or authority to sue plainly appears at any stage of the proceedings, the court may, on application at that stage, or on its own motion, in the interest of justice, strike out the party who ought not to be a party to the suit or application in the litigation.\textsuperscript{7} As there is no special code of procedure for copyright infringement suits and applications, it is submitted that this general position applies to copyright enforcement litigation.

1.2.3. **Joint author.** By section 23(1) of the Copyright Act, 2001, copyright is conferred, in the case of a work of joint authorship, on joint authors. As joint owners, therefore, they jointly have a right to the same relief. They are governed by the general rule, that where persons are jointly entitled to the same relief in respect of a transaction, they must all join as plaintiffs in one suit, because such persons together represent a single and indivisible right which cannot be adjudicated upon in the absence of any of such persons. This position is provided for by Order 1, rule 1, of the Civil Procedure Rules\textsuperscript{8} in the following words:

"All persons may be joined in one suit as plaintiffs in whom any right to relief in respect of or arising out of the same act or transaction or series of acts or transactions is alleged to exist, 


\textsuperscript{7} As to the requirement to object at the earliest possible opportunity, see, e.g., *British East Africa Corporation Ltd v. Kanji and another* (1939) 6 EACA 62 (CA-K); and for entertaining objection or moving *suo motu*, at any stage on the ground of lack of capacity or authority, see, e.g., *Qureshi v. Patel*, (1951) 18 EACA 1, (CA-K).

\textsuperscript{8} Cap 21, Sub Leg.
whether jointly, severally or in the alternative, where, if such persons brought separate suits, any common question of law or fact would arise."

Clearly, where the interests of two plaintiffs are identical and not antagonistic, they can sue jointly, and one suit will do. The court retains the power to order separate trials, for by rule 2 of the Civil Procedure Rules.⁹

"Where it appears to the court that any joinder of plaintiffs may embarrass or delay the trial of the suit, the court may either on the application of any party or of its own motion put the plaintiffs to their election or order separate trials or make such other order as may be expedient."

Clearly, joinder is not a matter of right but of discretion exercised liberally.¹⁰

However, a joint author cannot be compelled to bring a suit if he does not want to do so. At the same time, he cannot be prevented from bringing a suit merely because he is a joint owner of a copyright and the other joint owner refuses to join as a co-plaintiff. If, therefore, one joint owner wishes to sue but the other one is not willing to join as plaintiff but his presence before the court may be necessary in order to enable the court effectually and completely to adjudicate upon and settle all questions involved in the suit, the unwilling joint owner may be impleaded and joined as a pro forma defendant in the suit in respect of the joint property or right.¹¹ The proper course is to ask for his consent to join as a plaintiff first, and, if he refuses consent, to join him as a defendant.¹² But normally a court is not entitled to order a person to be added as a plaintiff without the consent of the plaintiff who is already on record.¹³

But at least one practical problem can arise in situations where different persons are entitled to different aspects of copyright in a work. The Copyright Act, 2001, does not have a provision

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⁹ Ibid, Order 1.
¹⁰ Abdulla and another v. Official Receiver and another (1954) 21 EACA 85 (CA-K). The liberal approach is manifested by the rule that no suit shall be defeated by reason of the misjoinder or non-joinder of parties, and the court may in every suit deal with the matter in controversy so far as regards the rights and interests of the parties actually before it: Ord 1, r 9.
¹¹ Order 1, rule 10(2), Civil Procedure Rules.
similar to section 173 of the English Copyright, Designs and Patents Act, 1988. The English provision states, with reference to the construction of references to copyright owner:

"(1) Where different persons are (whether in consequence of a partial assignment or otherwise) entitled to different aspects of copyright in a work, the copyright owner for any purpose of this Part is the person who is entitled to the aspect of copyright relevant for that purpose.

(2) Where copyright (or any aspect of copyright) is owned by more than one person jointly, reference in this Part to the copyright owner are to all the owners, so that, in particular, any requirement of the licence of the copyright owner requires the licence of all of them."

It is possible to reasonably stretch out by construction, the definition of "owner of the copyright" in section 35(13) of our Copyright Act, 2001, to cover most of what the above English provisions expressly state. If that be so, then only a copyright owner of an aspect which is affected by infringement would be the proper plaintiff, unless his aspect is indivisible from those of other owners, in which case they should all join as plaintiffs.

1.2.4. Assignee. By section 35(4) and (13) of the Copyright Act, 2001 a suit seeking any of the civil judicial remedies for infringement of copyright may be brought by an assignee. Where copyright has been assigned in part, only the owner of the particular right which has been infringed may sue as owner of that part. Where an assignee has an assignment from some only of several joint or part owners of copyright, he may sue to prevent a stranger from interfering with his part of the copyright affected by infringement or likely to be affected by threatened infringement, or even a co-owner who interferes with the assigned part of the copyright.

1.2.5. Exclusive licensee. An exclusive licensee is one who has the written licence of the copyright owner authorizing him, to the exclusion of all other persons, to exercise a right which would otherwise be exercisable exclusively by the copyright owner. Section 34 of the Copyright Act, 2001, provides for the rights of action and remedies of an exclusive licensee and

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14 As to transmissibility of copyright by assignment, see section 33 of the Act.
15 The Hon Sir Hugh Laddie, Peter Prescott, Mary Vitoria, Adrian Speck and Lindsay Lane, 2 The Modern Law of Copyright and Designs, 3rd edn. Butterworths, London, 2000, para 39.6, at p 1766, no doubt based on section 173 of the English Act quoted above, but can guide us in the construction of our s 35(13).
16 Lauri v. Renard [1892] 3 Ch 402; Cescinsky v. George Routledge and Sons Ltd [1916] 2KB 325.
17 Such a licence is granted, and copyright thereby transmitted, under section 33 of the Copyright Act, 2001.
sub-licensee. It provides that an exclusive licensee and exclusive sub-licensee has the same rights of action and is entitled to the same remedies, as if the licence were an assignment and those rights and remedies are concurrent with the rights and remedies of the owner of the copyright under which the licence and sub-licence were granted.

However, by section 34(2) of the Copyright Act, 2001, before an exclusive licensee or sub-licensee institutes proceedings for any civil remedy, he must give notice in writing to the owner of the copyright concerned, of his intention to do so. The owner may intervene in such proceedings and recover any damages he may have suffered as a result of the infringement concerned or a reasonable royalty to which he may be entitled.

But the requirement to give notice in writing to the copyright owner can present some practical problems where the owner is difficult to trace or is unapproachable, for example, for political reasons. For instance, the copyright infringer may vanish for purposes only of avoiding service. He may make himself physically inseparable from a feared politician. He may be found only in a restricted or protected area and hide behind alleged State security. Indeed, giving notice can even precipitate acceleration of infringement, concealment or destruction of vital evidential material on infringement.

Another point that requires attention concerning the giving of notice is in cases of emergency. There may be no time to give the written notice. In other situations urgent temporary relief may be required, but it is not yet clear as to who is to be served with such a notice. This may particularly arise where the owner of copyright is dead and no grant of letters of administration has been taken in respect of his estate; or where he cannot be found or is otherwise unavailable. The statute is silent in this regard.

1.2.6. Who may be sued for a civil remedy for copyright infringement in Kenya?

1.2.7. General. As a general rule, any person who has infringed copyright protected under the Copyright Act, 2001, may be sued as a defendant for infringement of copyright for an
appropriate civil remedy to be issued against him. The Act defines what amounts to infringement as “any act which violates a right protected” by that Act.  More particularly, but not exclusively, copyright is infringed by a person who, without the licence of the owner of the copyright  

\[(a) \text{ does, or causes to be done, an act the doing of which is controlled by the copyright; or} \]

\[(b) \text{ imports, or causes to be imported, otherwise than for his private and domestic use, an article which he knows to be an infringing copy.} \]

Any person who does any of these things without the authority or proper licence of the owner of the right protected under the Act, may be sued as a defendant. Defendants fall into two basic broad categories: one, primary infringers, and two, secondary infringers.

1.2.8. Primary infringers. Persons who are liable to be sued as primary infringers are individuals or companies who, without the licence of the owner of the right in question, do, or authorize others to do, any of the separate and distinct acts restricted by the right in question. One who does either of these acts may be sued as a defendant. For example, in relation to a published book said to be infringing copyright, the writer, printer and publisher are primary infringers. A primary infringer is strictly liable; that is, he is liable to be sued for infringement of copyright, regardless of whether he knew or had reason to believe that his work infringed copyright. Primary infringement, therefore, is a tort of strict liability.

1.2.9. Secondary infringers. Secondary infringement is the doing of certain secondary acts like trading in infringing copies. It differs from primary infringement in at least one respect, that is, to be a secondary infringer it is necessary that the person knows that he is dealing with a piracy, or has reason so to believe. A person may be sued for secondary acts of infringement such as

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19 Section 2(1).
20 Section 35(1). For infringement of rights of performers, see section 35(2) read with section 30(1).
21 The facts in *Systems Africa Ltd v. Kalamazoo Ltd and another* [1974] EA 21 (CA-K) are an example of primary infringement, that is to say, copying certain forms of the plaintiff protected by copyright.
importation and sale, only upon proof of the requisite knowledge or reason to believe that the book or record was an infringing copy of the work, such as where a retailer has been fixed with the requisite knowledge by having been given express notice by letter and reasonable time has been allowed him to investigate the claim. Thus in Archibald v. CFAO, the recording of the plaintiff’s songs by the defendant without the plaintiff’s license to do so, would be categorized as primary infringement, while the trading in them by selling the recorded songs would constitute secondary infringement of copyright. Such a seller may be sued as a defendant.

1.2.10. Joint tortfeasors. By Order 1, rule 3 of the Civil Procedure Rules, all persons may be joined as defendants against whom any right to relief is alleged to exist, whether jointly, severally or in the alternative. But this is allowed only where, if separate suits were brought against such persons common question of law or fact would arise. And, by rule 4(b) of the same Order, judgment may be given against such one or more of the defendants as may be found to be liable according to their respective liabilities.

This may arise where two or more persons are connected with or somehow associated with the infringement of the copyright. Such tortious association may be by reason of conspiracy with a primary infringer, or inducing the commission of an infringement; or it may be by reason of joining a common design pursuant to which the infringement was committed. As explained by an authority, a conspiracy to injure may be established in cases where there is an agreement between two or more persons to damage a person by unlawful means or to effect, by means which are not in themselves unlawful, an unlawful purpose for the sole or predominant purpose of injuring the plaintiff. This raises the difficult problem of proving the predominant purpose or object which the persons combining together have in view; and also the problem of the form a conspiracy may take. In copyright infringement where a lot depends on the speed of judicial intervention, these problems can present tricky hurdles to surmount and may work against expedition and effectiveness. The requisite degree of participation has not been defined, and it can only be suggested that such participation may correspond to the description attached by the

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23 1966 (1) ALR Comm 82.
criminal law to principals in the first and second degree, so that anyone who "aids and abets" infringement is liable.²⁶

1.2.11. Employers, principals and the doctrine of vicarious liability. An employer or a principal is vicariously liable where his employee or agent commits an infringing act in the course of his employment or agency. "Where an employee of a person, firm or company personally commits an act of infringement in the course of his employment, the employer will usually be vicariously liable."²⁷ So, a person may be sued for copyright infringement committed by himself or by his servants or agents.

As Trevelyan, J, pointed out in *Nairobi City Council v. Patel*,²⁸ various classes of persons may find themselves liable in law for someone else’s torts; but here it suffices to note only a master’s and a principal’s liability for his servant’s or agent’s torts, as the case may be.

Often the troublesome question is, who was the servant’s or agent’s master or principal when he committed the infringing act? For sometimes he might have two masters or principals (his general master or principal, and his special master or principal) and one of them only, subject to statutory limitation, could be vicariously liable for his actions.²⁹ It is a question of fact; and the facts of one case cannot rule the facts of another, however useful they may be as a help and guide to its solution.³⁰

The responsibility of an employer for the tort of an agent, who is not a servant, is well recognized. Indeed, the law reports abound with cases³¹ where a principal has been held liable for loss or injury caused by the wrongful acts of his agent although he was not a servant. The principal will be liable for the wrongful act of his agent if it is one of a class of acts within the

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²⁶ For common intention in criminal law under ss 393-395 of the Penal Code (Cap 63), from which this analogy is drawn and suggested, see *R v. Chebiegon arap Cherono and Kepilit arap Munyaken* (1933) 15 KLR 100 (act arising from intention of three persons setting out to commit a wrong, to wit, a felony, sufficing to make them all liable for act of one of them to fulfill their purpose).

²⁷ Garnett, James and Davies (eds), *Copinger and Skone James on Copyright, supra*, note 25, para 22-23, at p. 1004.


²⁹ That was the situation in *Nairobi City Council v. Patel, supra*, note 28.


actual or apparent authority of the agent or if such wrongful act amounts to a breach by the principal of a duty personal to himself, liability for non-performance or non-observance of which cannot be avoided by delegation to another.\textsuperscript{32}

An incorporated company is a separate person from its members. It has the choice of performing its duty through its own servants, for whose torts it may be liable on normal principles, or through agents. If it chooses to do the latter, by doing so it is unable to delegate its responsibilities so as to avoid liability for the torts of its agents in the performance of the duty. Infringement by the agents in the scope of their authority is the company’s infringement.\textsuperscript{33}

\textbf{1.2.12. The Government.} Under the Copyright Act, 2001, the Government is not given any special place giving it a right to infringe copyright. Section 4(1) (a) of the Government Proceedings Act\textsuperscript{34} expressly provides that the Government shall be subject to all those liabilities in tort to which, if it were a private person of full age and capacity, it would be subject in respect of torts committed by its servants or agents.

However, no proceedings lie against the Government in respect of any act or omission of a servant or agent of the Government, unless the act or omission would, apart from the provisions of the Act, have given rise to a cause of action in tort against that servant or agent or his estate.\textsuperscript{35}

In addition, by section 4(2) of the same Act, the Government is liable for breach of statutory duty. It can be sued for breach of statutory duty.

Infringement of copyright is a tortious act, or, alternatively, is a breach of statutory duty, and so the Government is vicariously liable for infringement of those rights committed by its servants or agents. The Government is, therefore, like any other employer or principal vicariously liable for copyright infringement by its employees or agents committed within the scope of their


\textsuperscript{33} \textit{Melitus v. Kericho Highland Service Co Ltd} [1971] EA 318, Farell, J.

\textsuperscript{34} \textit{Cap 40, Laws of Kenya}.

\textsuperscript{35} \textit{Ibid.} section 4(1), proviso.
employment or agency, as the case may be, even though those employees or agents may be acting in an unauthorized manner or indeed, contrary to instructions.36

Normally civil proceedings by or against the Government shall be instituted by or against the Attorney-General, as the case may be.37 There is no special statutory provision on copyright infringement suits against the Government. Accordingly, suits against Government for copyright infringement will be governed and regulated by this general procedure.

However, there are a number of statutory provisions and requirements regarding suits against the Government which can work against expeditious and effective civil judicial remedies for copyright infringement. In some instances certain remedies are denied altogether, while in others execution is barred or otherwise limited. No exception is made for copyright infringement cases.

One such restriction on the right to sue the Government lies in the requirement as to notice of intention to institute proceedings. No proceedings against the Government shall lie or be instituted until after the expiry of a period of thirty days after a notice in writing has been served on the Government in relation to those proceedings.38 The notice to be served shall be in a prescribed format with specific prescribed contents: that is to say, it shall be in the form set out in the Third Schedule to the Act, and shall include:39

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(a) the full names, description and place of residence of the proposed plaintiff;
(b) the date upon which the cause of action is alleged to have accrued;
(c) the name of the Government department alleged to be responsible and the full names of any servant or agent whom it is intended to join as defendant;
(d) a concise statement of the facts on which it is alleged that the liability of the Government and of any such servant or agent has arisen;
(e) the relief that will be claimed and, so far as may be practicable, the value of the subject matter of the intended proceedings or the amount which it is intended to claim.```

36 Muwonge v. Attorney-General, supra, note 31.
37 Government Proceedings Act (Cap 40), section 12(1).
38 Ibid, section 13A(1).
39 Ibid, subsection (2).
These requirements do not apply to such part of any proceedings as relates to a claim for relief in respect of which the court may only make an order declaratory of the rights of the parties *in lieu* of an injunction.40

In cases where speed is of the essence, as is usually the case in copyright infringement, these requirements can be a serious handicap. Sometimes getting the requisite particulars is a problem. The Government department concerned may not be readily discoverable. The names of the servants or agents involved may not be easy to ascertain. Valuation of the subject matter may add to costs and make litigation expensive. These provisions may cause real problems for an intending plaintiff seeking a civil remedy for copyright infringement. The copyright owner may be needing court protection before full particulars are known.

Another restriction is on the plaintiff’s normal right to choose the forum for his suit. Provisions on venue and related matters reverse that general rule, and state that in any case in which civil proceedings against the Government in the High Court are instituted by the issue of a plaint out of a District Registry, the Government may enter an appearance either in the District Registry or in the Central Office of the High Court in Nairobi, and, if an appearance is entered in the Central Office, all steps in relation to the proceedings up to the trial shall be taken in Nairobi.41 The trial of any civil proceedings including copyright litigation, by or against the Government in the High Court shall be held at the High Court in Nairobi unless the court, with the consent of the Government, otherwise directs.42 Where the Government refuses its consent to a direction, the court may only take account of the refusal in exercising its powers in regard to the award of costs.43

These provisions deny the plaintiff the right to choose a forum.44 They are clamps on the court’s normal power to control the place of suing. They pay no sufficient or any regard for the interests of justice. If copyright infringement involves works which cannot be moved to Nairobi these

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40 *Ibid*, subsection (3). As to the exclusion of injunctive relief against the Government and its substitution with a declaration see below.
41 *Ibid*, section 14(1).
43 *Ibid*, section 14(3).
44 *Shebai v. Mahomed* (1906-1908) 2 EAPLR 107.
provisions can be a problem. If the Government unreasonably withholds its consent there is no adequate or reasonable redress, costs being fixed without reflecting a true measure of injury.

Similar limitations are put on removal and transfer of proceedings. If, in a case where the proceedings for infringement of copyright are instituted against the Government in a subordinate court, an application in that behalf is made by the Government to the High Court, and there is produced to the court a certificate of the Attorney-General to the effect that the proceedings may involve an important question of law, or may be decisive of other cases arising out of the same matter, or are for other reasons more fit to be tried in the High Court, the proceedings shall be removed into the High Court. The only thing a court can do, is that where copyright proceedings have been removed into the High Court and it appears to the court that the removal has occasioned additional expense to the person by whom the proceedings are brought, the court may take account of the additional expense so occasioned in exercising its power in regard to the award of costs. And, no order for transfer to a subordinate court of any proceedings against the Government in the High Court shall be made without the consent of the Government.

These provisions take away the discretion of the court in matters of transfer of suits under section 18 of the Civil Procedure Act, and subordinate it to the consent of the Government. Under section 18, clear factors must be considered by the court in considering whether a suit should be transferred. Those factors include (but are not limited to) (a) the balance of convenience; (b) questions of expense; (c) the interests of justice; (d) need for expeditious disposal of suits; and (e) the possibilities of undue hardship.

For an aggrieved copyright owner to be subjected to the whims of an Attorney-General and not to the conscientious judicial discretion of the court is a strange mode of administering justice. In copyright, time may be of the essence, and to waste it in this manner may cost a copyright owner enormous, if not irreparable, loss.

45 Government Proceedings Act (Cap 40), section 15(1).
46 Ibid, section 15(2).
Another restriction on suing the Government is in the provisions as to industrial property. It is provided\textsuperscript{49} that where any servant or agent of the Government infringes, among others, any copyright, and the infringement is committed with the authority of the Government, civil proceedings in respect of the infringement shall lie against the Government. The Government is only liable for infringement committed by its servants or agents if the acts were done with the authority of the Government or within the scope or course of employment. The vicarious liability of the Government is restricted to exclude acts committed by servants or agents contrary to instructions even though such acts were within the scope of their employment or authority.

In this regard, an intending plaintiff whose copyright has been infringed or is threatened with infringement faces an initial problem of ascertaining whether a servant or agent of Government was clothed in the authority of his employer or principal. Where does the owner of an infringed copyright obtain a comprehensive definition and delineated boundaries of instructions and authority of every servant or agent of Government? To sue and then investigate the authority and instructions may turn out to be an expensive risk. To extract an answer from the Government about its servant’s precise instructions, before a suit is filed may end in frustrating waiting for either a not forthcoming, or inadequate and unhelpful, answer.

Finally, one does not sue Government if what he seeks is either an injunction or delivery up. The law is precise on this one: no injunction or an order for delivery up of property will be granted against the Government; and in all cases, execution cannot be levied against Government. This is the effect of what section 16 of the Government Proceedings Act provides.

Accordingly, no injunction or delivery up can be granted against the Government for infringement of copyright, either directly or indirectly; and, if to restrain a government official in effect restrains the Government, no injunction shall issue. Thus, where the plaintiff sought an order “directing the director of personnel to review the salary structures and rectify them”, the High Court of Kenya\textsuperscript{50} held that the plaintiff was in effect seeking a mandatory injunction, and

\textsuperscript{49} Government Proceedings Act (Cap 40), section 5(1).

\textsuperscript{50} In Matalinga and others v. Attorney-General [1972] EA 518.
yet, a mandatory injunction cannot be granted against a government official requiring him to take the action required by the plaintiff; that is to say, section 16 restricts the court to making declarations only in proceedings against the Government where it might otherwise grant injunctions.51

Section 16 is riddled with difficulties.52 They include the problem of fathoming any sound rationale for the curtailment of remedies. They include the difficulty for a copyright owner to ascertain what action of a Government official if restrained will ultimately restrain the Government. They include the real task of establishing whether delegated authority has been exceeded by a given Government official. These and other questions can be really difficult questions to resolve before one decides to sue the Government for infringement of copyright by servants or agents of the Government.

1.2.13. Representatives. A case may arise where copyright infringers are too numerous to be all cited and impleaded in a single suit, and when separate simultaneous or successive suits would be too expensive. Where, therefore, persons interested in a suit are too numerous to be all joined as parties, a plaintiff is allowed to proceed against a selected defendant or a few defendants whom he names to represent a group or a class.53 In *Kenya Bankers Association v. Minister for Finance and others*54 the High Court of Kenya stated that for a representative suit to be brought:

"(a) the class or persons in the group should be so numerous that joinder of all members is either impracticable, or may impede or impair justice;

(b) the question of law or fact should be common to the class or all persons;

(c) the defences of the representative parties should be typical of all defences of the class or group;"

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51 For a fuller discussion and critique of this restriction of remedy, see Richard Kuloba, *Principles of Injunctions*, Oxford University Press, Nairobi, 1987, para 7.6, pp. 117-120, particularly sub-para 7.6.4, at p.118, where some of the drawbacks of the statutorily preferred remedy of declaration of right are pointed out. It is there said, among other things, that a plaintiff is left without a speedy and effective remedy in an injunction situation. Indeed, a declaration is not a remedy but a mere pronouncement of rights without requiring anything to be done or stopped.


53 Order 1, rule 8, Civil Procedure Rules.

(d) the representative parties on record should be persons who will fairly and adequately protected the interest of the others, and they must have the nexus with the class or group and its interests;

(e) the class or group representatives should not have a conflict of interest with some of the members whom the court can bind by means of a decree or order;

(f) the group or class should be definite, and not consist of an amorphous membership; and

(g) the *bona fides* of the representative party (or parties) should be evident."

Accordingly, in copyright infringement, where the class of defendants with a sufficient identity of interests is numerous, the owner of copyright may select one or more representative defendants and sue these on behalf of themselves and all the others. In appropriate circumstances an injunction may be granted against the class as a whole. Thus, in the English Court of Appeal case of *EMI Records Ltd v. Kudhai*.55

“a clandestine record pirate organization was making products labelled ‘Oak Records’. Its membership was largely unknown. A street trader selling the records was selected as a representative defendant. An injunction issued against the organization and street traders selling the records.”

The advantage of the class injunction was that copies of the injunction could be served on other street traders, selling the records, as and when they were found. This avoided the need for suing them individually as and when the owner came across a seller. Once served with the class injunction the street traders would be in contempt of court if caught selling those products again. Of course, any particular individual is entitled to apply to the court to have the injunction set aside for good cause; or, he may apply to join in the case as a party.56

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1.2.14. “Friendly” parties. Persons may sometimes go to law as “friendly” parties simply to get an uncertain legal situation judicially settled in a rather advisory and non-coercive opinion of the court, instead of acting on a lawyer’s counsel at one’s peril. By a declaratory judgment provision, if a person wants reassurance that his proposed course of activity will not be an infringement of copyright, he may apply to the court for a declaration that his activity is non-infringing. This is a procedural device for judicially ascertaining and determining the legal rights of parties, or for the determination of a point of law, or the construction of a document and for the determination of the validity of orders or decisions of inferior courts or tribunals unless the relevant statute gives exclusive jurisdiction to another tribunal or hierarchy of tribunals, without requiring an action to be done or stopped on pain of sanctions. But for the court to do so there must at least be a justiciable dispute between the parties, concerning a legal right.

1.2. Statute of limitations in copyright cases in Kenya

Another important matter which must be considered before a suit seeking a suitable civil judicial remedy for infringement of copyright is filed, is whether the suit is within the time prescribed by the Limitation of Actions Act (frequently referred to as a statute of limitations). If the proposed action is statute barred in point of time, it need not be filed, because it is liable to be defeated on the ground of its lateness.

The Copyright Act, 2001, however, does not deal with the period of limitation of actions regarding copyright infringement. When it is recalled that copyright is not just a tort liability rule, but also a property regime, then the silence of this special statute on the question of limitation of actions poses a problem. It poses a problem because it does not state the period within which suits to “recover” such a property may be brought. The silence on the point presents a problem also even if infringement of copyright is regarded as a breach of statutory

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57 Civil Procedure Rules, Order 2, rule 7.
58 See the authorities approved and applied by Simpson, J (as he then was), in the High Court of Kenya, in Matalinga and others v. Attorney-General [1972] EA 518, at pp. 519, 520, for all these principles.
60 See, e.g., Laddie, Prescott and Vitoria, 2 The Modern Law of Copyright and Designs, supra, note 15, para 39.1, pointing out that in England infringement of copyright is treated “by the legislation” as infringement of property rights.
duty to abstain from copyright infringement. It says nothing about the limitation of actions concerning breach of statutory duty.

Many leading works, however, are categorical, that copyright infringement is a tort, but a tort with its own statutory provision for limitation of actions in some jurisdictions. It is submitted that there are no special local circumstances in Kenya which make it necessary to classify copyright infringement differently. It is a tort here as it is elsewhere in the common law jurisdictions like England.

Since infringement of copyright is a tort, the general period of limitations for actions founded on tort applies, subject, of course, to the usual statutorily defined special circumstances in which there can be extension of the periods of limitation. These exceptions apply in the case of disability, acknowledgement, part payment, fraud, mistake and ignorance of material facts. Subject to these usual special circumstances, an action founded on tort may not be brought after the end of three years from the date on which the cause of action occurred.

However, an action for an account may not be brought in respect of any matter which arose more than six years before the commencement of the action.

Pinpointing exactly when a cause of action accrues can be a tangled undertaking in copyright infringement. A twofold answer has been suggested by an authority on the subject. One, the statute begins to run when the copyright owner learns of the infringing act or could have learned of it had he exercised reasonable diligence. Two, the statute is tolled by the infringer’s fraudulent concealment of the infringement. With respect this answer seems sound on principle.

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62 E.g., the United States of America, has this period stated in the Copyright Act of 1976, section 507, prescribing the limitation period for civil actions of three years: Leaffer ibid.
63 Set out in Part 3, sections 22-31, of the Act. See section 3.
64 Limitation of Actions Act (Cap 22), section 4(2). But a tort action for libel or slander must come before the end of 12 months from the date of its commission: section 4(2), proviso.
65 ibid, section 4(3).
66 Leaffer, Understanding Copyright Law, supra, note 70.
Where there has been a series of infringing acts some of which happened more than the limitation period before the suit was brought there is also a problem. The American case of Taylor v. Meirick\(^{67}\) supports the "continuing infringement" theory. The defendant made and began to sell nearly exact copies of the plaintiff's copyrighted maps in 1976. The plaintiff filed infringement action in 1980, after the limitation period had expired. Infringing copies were still on the market. It was held that the defendant was liable for the infringing acts which had occurred in 1976. The underlying reasoning of the holding was, inter alia, that the initial copying was not a separate and completed wrong but simply the first step in a course of wrongful conduct that continued till the last copy of the infringing map was sold.\(^{68}\)

In a situation where the infringement still persists after the expiry of the limitation period, however, it is also possible to approach the issue by regarding each act of infringement as a distinct harm giving rise to an independent claim for relief. If that path is followed, then litigation may be allowed only for those acts occurring within the statutory period, while earlier infringing acts would not form a basis for claim,\(^{69}\) unless fraud or mistake or disability saves the situation.

Whatever view one takes, however, in the face of these apparently conflicting possibilities, it would make for clarity and certainty for the Copyright Act, 2001, to have an explicit provision stating (a) when a cause of action accrues in copyright; (b) the period of limitation for copyright infringement suits, and (c) how to treat a series of infringing acts some of which occurred more than the limitation period. Alternatively, these provisions can be put in the Limitation of Actions Act.

With regard to causes of action arising abroad, the law relating to the limitation of actions applies to actions in the courts of Kenya arising outside, as well as within Kenya.\(^{70}\) But where a

\(^{67}\) 712 F 2d 1112 (7th Cir 1983).

\(^{68}\) Ibid, at p. 1119, per Judge Posner.

\(^{69}\) See, e.g., Kregos v. Associated Press, 3 F3d 656 (2d Cir 1993); and Roley v. New World Pictures Ltd, 19 F 3d 479 (9th Cir 1994).

\(^{70}\) The Limitation of Actions Act (Cap 22), section 40 (1).
foreign law bars either the right or the remedy in respect of action arising outside Kenya which is
sued upon in a Kenya court, the action is barred in Kenya as well.⁷¹

But a contract not to plead limitation, as well as estoppel, affect the rules as to limitation of
actions set out. A period of limitation does not run if (a) there is a contract not to plead
limitation; or (b) the person attempting to plead limitation is estopped from so doing.⁷² Estopped
includes estopped by equitable or promissory estoppel.⁷³

1.4. Jurisdictional issues in copyright infringement

Section 35(4) (a) of the Copyright Act, 2001, provides that an infringement of copyright is
actionable by the copyright owner. But it does not expressly and directly state where such
infringement is to be actionable: in what institution? That question is left to be understood from
a general understanding of where, in our jurisprudence, infringement of rights are normally
actionable; and from reading the entire section.

In general understanding, in Kenya’s jurisprudence, a remedy for an infringement of copyright is
to be sought in a court of competent jurisdiction. A court of competent jurisdiction in Kenya is
one which is “established by law” and is “independent and impartial”, and gives every case
instituted before it for determination “a fair hearing within a reasonable time”,⁷⁴ and is normally
“held in public.”⁷⁵ The law has established a number of such courts.

An intending plaintiff, whose copyright is infringed or is threatened with infringement, must
ponder the question of which court in the judicial structure⁷⁶ is competent to hear and determine
his case. But as copyright litigation is likely to concern big money, or complicated legal issues,

⁷¹ Ibid, section 40 (1), proviso.
⁷² Ibid, section 39(1).
⁷³ Ibid, section 39 (2). As to the general principles on equitable estoppel, see, among others, Nurdin Bandali v.
⁷⁵ Ibid, section 77(10). Public hearing and announcement of a decision of the court may be dispensed with, with the
agreement of all the parties (ibid), or in the interests of justice, defence, public safety or public order (ibid, sub-
section (11)).
⁷⁶ For the structure and jurisdiction of the courts, see Richard Kuloba, Courts of Justice in Kenya, Oxford University
it is more likely to be fought in the High Court than in Magistrates’ courts where the monetary jurisdiction is for the most part severely shut in.\textsuperscript{77}

In addition, the nature of copyright is such that a given copyright infringement may have a transnational dimension to it, and thereby present difficult choice of jurisdiction questions. Such a situation may arise, for example, where the owner of the copyright is domiciled in Kenya (or any other country), and the defendant is domiciled, say, in Italy (or any other country). If that is the case, a decision has to be taken as to where the suit is to be filed. Another scenario may be presented by the infringement taking place in different countries, and the copyright owner wishes to sue all the concerned infringers in one suit. A more complex plot is where copyright infringement is happening on the internet. The \textit{Sapra Studio v. Tip-Top Clothing Co}\textsuperscript{78} case is a well known illustration of these issues. These sample situations raise important jurisdictional issues at the international plane.

Such transnational problems will have to be answered by a consideration of the principles of the conflict of laws which seek to establish rules by which it may be decided, \textit{inter alia}, which courts shall have jurisdiction over any particular matter. This question must be addressed and answered correctly, because where a court is seized of a suit that contains a foreign element, it may turn out that more than one country might have jurisdiction and more than one law can be applied. When such a situation arises, reference must be made to the rules of the conflict of laws\textsuperscript{79} (also known as private international law\textsuperscript{80})

\textsuperscript{77} The practice as illustrated by reported cases points to copyright litigation being normally undertaken in the High court. See, e.g., \textit{East African Standard Ltd v. Coast Guardian Ltd} (1934) 16 (1) KLR 23; \textit{Tootal Broadhurst Lee Co Ltd v. Alinomahed Haji Ahamed & Sons Ltd} (1951) 24 (2) KLR 31; \textit{Bwavu Mpologoma Growers’ Co-operative Union Ltd v. Gasston and Barbour and others} [1959] EA 307, (CA-U) (the decision of the High Court is at [1958] EA549; \textit{Sapra Studio v. Tip-Top Clothing Co} [1971] EA 489; \textit{Kalamazoo Ltd v. Systems Africa Ltd} [1973] EA 242, and on appeal to the Court of Appeal, [1974] EA 21; \textit{Performing Right Society Ltd v. Grand Theatres Ltd and another} [1973] EA 576; \textit{Jiwani v. Going Out Magazine and another}, [2002] 1KLR 856. On the other hand, throughout a period of ten years when this author worked as a civil court resident magistrate, senior resident magistrate, principal magistrate, up to Chief Magistrate in charge of the civil magistrates’ courts at Nairobi where a lot of civil litigation was done, not even a single copyright infringement suit was ever filed in any of the magistrates’ courts at any level. Nor has any such case decided by a magistrate’s court been unearthed in the course of this study.

\textsuperscript{78} \textit{Supra}, note 77. It had a Kenya-Italy connection.

\textsuperscript{79} In other jurisdictions, such as in England, there is a lot of literature on this subject. See, for example, Lawrence Collins (General Editor) with specialist Editors, \textit{1 Dicey and Morris on The Conflict of Laws}, 13\textsuperscript{th} edn, Sweet & Maxwell, London, 2000, where jurisdiction in claims \textit{in personam}, relevant to this study is dealt with in chapter
When a copyright case falls within the jurisdiction of a Kenyan court and also a foreign court, and there are simultaneous or concurrent lawsuits both in Kenya and abroad, questions may arise as to whether the proceedings abroad should be stopped by a Kenyan court concerning persons subject to its jurisdiction. No Kenyan case has been found yet on this issue. In America, however, the issue has come up from time to time. Courts there have issued foreign antitrust injunctions to enjoin a foreign suit by persons subject to the jurisdiction of American courts. But the courts there emphasize that due regard for principles of international comity requires that this power should be used sparingly, and grant such injunctions only with care and great constraints.\textsuperscript{81}

The principles of private international law operate by reference to the individual subjective factor in each case. This means that it is first necessary to discover those factual matters before the principles of choice of jurisdiction can operate to assign the dispute to its appropriate jurisdiction. Thus, if the relevant principle is that jurisdiction in the given matter is exclusively that of the courts of the parties’ domicile or residence, then before that principle can be applied, one must look to the subjective factors in the individual case to ascertain that the parties are in fact domiciled in the country.\textsuperscript{82} These general principles apply in all cases, and there is no reason why they would not apply to cases of copyright infringement.

The Copyright Act, 2001, is silent on the jurisdictional question in cases involving a foreign element. Similarly the general rules of court under the Civil Procedure Act, are silent in that respect. Clear legislative provisions should be made, to clarify the issues, such as whether and how nationality or fixation, among others, can be a basis of eligibility. These are policy questions for the legislature to consider.

\textsuperscript{80} See, e.g. P. M. North, \textit{Cheshire’s Private International Law}, 9\textsuperscript{th} edn, Butterwords, London, 1974 (and for the purposes of the present study, see pp. 41–127 of that work).


1.5. Going through the ordinary mill, pursuing civil remedies for copyright infringement

In Kenya the process for any kind of civil dispute resolution in a court of law is replete with procedural formalism under statutory rules of court, practice and procedure in accordance with the doctrine of *stare decisis*. Copyright litigation for a judicial civil remedy is one type of civil disputes. The ruling procedural regime is under the Civil Procedure Act (and the Rules made thereunder by a rules-making authority). There is no special court, judge, or separate procedure tailored for copyright issues. There is only one system of civil procedure of uniform application in all courts by all judges. All civil litigants go through the same mill. All civil cases, including those filed in the Commercial Division of the High Court, are filed and processed under the same rules of court.

Thus, there are uniform prescribed modes of beginning proceedings, mandatory formal service of process, and prescribed modes of responding thereto. Long and elaborate pleadings are suffered. Affidavits of documents of all manner, and copies of correspondence, interrogatories and further interrogatories, and other interlocutory applications of near eternity, often furnish materials for learned arguments before the trial courts and then the appeal courts. And when at last the exhausted belligerents arrive at the final decision of the trial court, delay is again given to the defeated party, during which he may appeal, embarking on another luxurious march towards the court of last resort, in wide avenues of appeals. In all these

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83 By section 2 of the Civil Procedure Act, a suit can be a “suit” only if it is a proceeding commenced in a “manner prescribed” “by rules”, that is to say, “rules and forms made by the Rules Committee to regulate the procedure of courts”. The only prescribed manner of commencing an action is by filing pleadings, and these include a petition or summons, statements in writing of claim, defence and reply (see s 2 of the Civil Procedure Act). And complicated rules exist on pleadings and related matters contained in long complex rules under six elaborate Orders in the Civil Procedure Rules (e.g., Orders 6-9A), which apply to copyright litigation as to any other civil case within the purview of the Rules.

84 On which see the Civil Procedure Rules, Order 18; and, generally, the Oaths and Statutory Declarations Act (Cap 15). The frequency with which defective affidavits occur and take much time of the courts is proverbial. See, e.g. *Phakey v. World Wide Agencies* (1948) 15 EACA 1; *Standard Goods Corporation Ltd v. Nathu* (1950) 17 EACA 99; *Ibrahim v. Sheikh Bros Investment Ltd* [1973] EA 118; and *Solomon Software (EA) Ltd v. Microsoft Corporation* [2003] 1 EA 300. They apply to copyright litigation since no separate rules are in place for such cases.

85 As to which, see the Civil Procedure Rules, Order 10, the principles on which are set out in *Omar v. Gordhanbhai and another* [1974] EA 518. This provision governs litigation concerning copyright infringement, because there are no special rules statutorily promulgated concerning copyright cases only.

86 This is neither exaggeration nor hyperbole as the series of applications in *Kamlesh Pattni v. Nassir Ibrahim Ali and others*, HCCC No. 418 of 1998 (unreported), among others presided over by this writer as a civil High Court judge, can testify.
happenings, there is almost total control of the pace of litigation by the parties, the court taking on the role of a mere referee\textsuperscript{87} in long drawn-out and protracted court fights.

Technical rules of evidence take their toll. Often there is a lack of expert witnesses on technical and complex issues. It all happens before the generalist: neither a specialized and experienced judge, nor a specialized and experienced advocate. At the end of it all, comes a dilatory announcement of a decision of the court, heralding further uncertainties: uncertainties of the execution of decrees and orders, with their own concomitant costs on the wallet and time.

These things naturally affect adversely the pace of justice in all cases. Copyright infringement claims are in the same boat.

Given the nature of copyright, the general procedure in which are ingrained causes and opportunities of untoward expense and delay does not fit copyright infringement litigation. If there are cases where courts must have the machinery available to deal speedily and cheaply with cases which require urgent determination, they are copyright infringement causes. Suitors embarking on litigation in the area of copyright seek a just result as promptly and inexpensively as possible. Benefits of copyright are enormous. Copyright infringement, e.g. violation of moral rights,\textsuperscript{88} can be an emotive issue, and in the case of invasion of economic rights\textsuperscript{89} massive sums of money may be involved. Undue delay alone can be a major cause of injustice: it denies justice.

\textsuperscript{87} Thus, when Lyon, CJ, as trial judge took a large part in the examination of a party it gave rise to the question whether the rule that justice must be seen to be done has been observed, and the Court of Appeal for Eastern Africa at Nairobi held that it was impossible for the appeal court to say that there had been a fair trial: \textit{Lambert Houareau v. R} [1957] EA 575. It is normally emphasized that a judge must keep out of the arena and leave the conduct of the case in the hands of lawyers in the case: \textit{Patel v. Joshi} (1952) 19 EACA 42. And he can only decide on what the parties have pleaded: \textit{A-G v. Equip Agencies Ltd} [2006] e KLR (www.kenyalaw.org) (10.2.2006).

\textsuperscript{88} Moral rights include the right to be identified as the author of the work (or as director of a film); the right to object to distortion, mutilation or modification, or other derogatory treatment of the work, which would be prejudicial to his honour or reputation; and the right, no doubt, to object to having a work falsely attributed to him as author: Copyright Act, 2001, ss. 2(1) and 32. In short, these are (1) the right to paternity, and freedom from false attribution; and (2) the right to integrity, enabling one to protect his work from mutilation or disparagement, its alteration or modification.

\textsuperscript{89} Economic rights comprise positive and negative rights, to reproduction, distribution, communication to the public including broadcasting, display or exhibition, performance, or adaptation: Copyright Act, 2001, ss 26(1), (2), 28(1), (2), and 29, 30.
What is the way forward? On the basis of experience gained from the setting up and working as a civil High Court judge at the Commercial Division of the High Court of Kenya, at Nairobi, and from working in the general Civil Division of the High Court of Kenya, at Nairobi, Mombasa, Kisumu and Meru, this author offers certain suggested solutions. A number of practical and legislative measures can be profitably taken towards achieving the expeditious economical and effective disposal of causes involving copyright infringement claims.

One key step is a deliberate departure in some important aspects from the usual litigation procedure, with a view to fostering and securing dispatch. This calls for procedural innovation to create a general business-like atmosphere in the judicial process and administration of civil justice.\(^9^0\)

In particular, informality and efficiency must rank high. In this respect, there should be room for trial without pleadings, the court normally allowing to be approached by application made in a summary manner returnable on two day’s notice supported by affidavit, or within such time as is reasonable in given circumstances. Any simple question of fact or law should be decided forthwith and a difficult one be settled at once for trial on a definite near future date.\(^9^1\)

Indeed, the informality should enable a party to apply to a judge to determine questions involved in a matter or proposed cause, notwithstanding that no cause has been commenced. The aim should be to get immediately to the merits. This can be done, for instance, by requiring the early exchange of experts’ briefs of evidence and prompt and full discovery and inspection. The idea is to eliminate unfair advantage or delay through the use of technical rules of evidence, practice and procedure. Severe sanctions should be devised to keep out frivolous or vexatious litigants.


\(^{91}\) It is being suggested that some provisions analogous to those which obtained in subordinate courts in the old rules of court be enacted, at least in respect of copyright litigation. There was provision that a court could determine at the time of issuing a summons whether the summons going forth should be for the final disposal of the suit, and the summons would then contain a direction accordingly, asking the defendant to attend court on a specified date and time. The summons would direct the defendant to produce required documents on the day fixed for his attendance if he has any documents on which he intended to rely in support of his case, and all the witnesses he wanted to call. On that day the case would be disposed of: see the Civil Procedure (Revised) Rules, 1948, Order 5, Rules 3-5.
e.g., requiring certain undertakings, and meeting certain conditions which only a serious person with a bona-fide claim can accept.

Another area to change concerns the place and role of the court in the judicial process. The whole process should be tightly controlled by the court, right from the moment litigation is filed to the fixture, instead of by the parties as is the case under the present set-up. Judges should be more interventionist than they are to-day. Thus, a judge should closely monitor and control interlocutory stages and disputes, fix timetables, and operate the court in a business-like fashion. He should expedite interlocutory stages. Once a case is set down for trial, there should be no room for parties to make permitted further interlocutory applications. It might be asked whether this should be so, however meritorious the application may be, e.g. if some new issues emerge. Experience has often shown that many new applications come up because commonly legal advisers will not have properly given full consideration of the case initially before filing suit or original applications. Improper or inadequate preparation is a problem.

There is a need to devise a method of ensuring speedy determination of litigation in all appropriate cases whether or not all parties co-operate.

While speed, cheapness, informality and procedural innovations are important, the availability of skilled and experience deciders of disputes should be incorporated in the reform of the civil justice system. In copyright cases, some judges should be trained or helped to develop a thorough knowledge and expertise in copyright litigation. Long exposure to copyright work would be a start for eventual specialization. Speedy and less costly determination of such cases would almost certainly be assisted if they were assigned to judges with copyright expertise and experience.

These are some of the central measures in procedural innovations which can guarantee expeditious and effective judicial civil remedies for infringement of copyright in Kenya.
CHAPTER 2
ACCOUNT OF PROFITS IN COPYRIGHT IN KENYA

2.1. Account of profits for infringement of copyright in context

Account of profits is one of the main remedies in copyright infringement cases.¹ The remedy of account of profits comes ex post facto, that is, one following after actual infringement of copyright has in fact occurred, in order to undo what has been done in breach of copyright. It has been observed by an authority² that an account of profits is relatively underused in copyright cases and it is "relatively unusual for a claimant to opt for an account of profits." But given the main purpose and basis of an account as one to ensure that a copyright infringer does not unjustly enrich³ himself at the expense of the owner of copyright, this remedy is important enough to deserve a close study in the context of copyright law in Kenya. In this chapter, an attempt is made to look at the salient aspects of this remedy in copyright infringement cases in Kenya, to ascertain whether it is an efficient copyright remedy.

2.2. What is an “account of profits” in copyright?

No adequate definition is given in the books.⁴ In Kenya, however, it is important for us to define this remedy because, among other reasons,⁵ this is the first time that a study focusing on this

¹ The Copyright Act, 2001 (No 12 of 2001), section 35(4) (a) lists it as one of the reliefs available to the owner of copyright protected under the Act.
³ Ibid, para 1.26, at p.14. In Kenya, it is a well-established principle that it is unjust to allow retention of benefit received at the expense of another: see Madan, JA (as he then was) in Chase International Investment Corporation and another v. Laxman Keshra and others [1978] Kenya LR 143, at pp. 153-154; and Kuloba J, in Madhupaper International Ltd and another v. Kenya Commercial Bank Ltd and others [2003]2 EA 562, at pp. 565-572.
remedy is being undertaken in this country. It would be presumptuous to discuss aspects of a remedy whose meaning is withheld and is referred to in words whose denotation is not given in the study. It must be assigned a meaning so that everyone knows what it is that is being studied.

Lindley, MR said that in an account of profits "account is taken and you get judgment for the balance." Picking a cue from what Lindley, MR says, account of profits in the context of copyright enforcement, protection and promotion, is a remedy by which a defendant copyright infringer is required by a decree of the court to draw up and furnish the plaintiff owner of the copyright with a detailed formal financial record, inventory, or statement of facts, information and occurrences in a form of list or catalogue of transactions, receipts and payments, whether of debits or credits, growing out of the defendant’s infringing business dealings with copyrighted work, to facilitate the determination of the balance due by a simple calculation, in order that a judicial determination of the rights of the parties regarding the infringement of the copyright can be obtained. The catch-phrase “account of profits” is really a shorthand nickname for “account and award of profits,” the proper denomination which accurately brings to the fore the two key aspects of the remedy: (a) providing information, and (b) paying over what is owed, as explained next.

2.3. A duality in the judicial process to obtain account of profits of infringement

In seeking account of profits the copyright owner wishes to compel the infringer to set out, in black and white, his dealings with the copyright materials so that:

(a) the copyright owner can see how much profit the infringer made and how much he owes to the copyright owner, and

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Other reasons include the importance of nomenclature in any study, especially of intellectual property in general, and copyright in particular, as to which see, e.g., Ben Sihanya, “Copyright Law, LLM Teaching Notes & Materials, 2004-2005” (Feb 21, 05 Monday), p.1.

6 Manners v. Pearson and Sons, [1898] 1 Ch 581.


(b) the owner can then apply for an order to the infringer to have the net profits he has acquired by his wrongful conduct (copyright infringement) paid to the copyright owner.

These two aspects of the remedy are independent of each other. Recapturing the ill-gotten profits is ordinarily the aim of the owner of the infringed copyright in going to law; but the marrow of the remedy is, in a manner of speech, to railroad the infringer to produce the necessary figures in the first place.

The independence of each aspect from the other is illustrable. A copyright owner can go to court seeking account solely for the purpose of having access to the figures. There is no legal requirement that he must also ask for an order to have money paid to him. Thus, in *Choitram v. Dadlani*, the plaintiff seeking an account had made no prayer for payment. So the advocate for the defendant argued that without such a prayer for payment the court should not grant the prayer sought. This argument was rejected, it being held that in a proper case the court can order a defendant to account even in the absence of an allegation in the pleadings that he owed any money to the plaintiff, and a prayer for its recovery. Said Gould, JA:

“If a plaintiff is entitled at law or in equity to an account from a defendant he has a right which he is entitled to enforce through the courts and in the present action we are not concerned at this stage with any difficulty the appellants might have to meet should they, if successful in their claim for an account, later desire to ask for an order for payment.”

The claim in the case at that point for an account was limited only to the first limb of the duality, namely seeking “an order that the defendant do give to the plaintiffs a full and true account of such daily sales and expenditure and an account of the moneys received by the defendant.” The same point was made in *Potgieter v. Stumberg (No 2)*, where Sir William Duffus, P, said:

“I agree that the main issue in this case was that the plaintiffs were seeking to recover what was due to them, and this could only be done by the taking of the accounts. Mr Khanna also argued that when the accounts were taken, it may be found that after payments of such debts as may be properly deducted from the proceeds of the sales that there is nothing left for the plaintiffs. This is

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*ibid, at p. 643, emphasis and italics supplied by author.*
very doubtful, but even if it were so, the plaintiffs would still be entitled to the order for accounts and this order has been consistently resisted by the defendant.”

And in *Tzamburakis v. Rodoussakis*,\(^\text{13}\) the following observations by Briggs, JA.\(^\text{14}\) are very instructive:

“We were asked to amend the decree in various minor respects, notably to provide for the position which would arise if on taking the accounts it were found that no money was due to the respondent. I think this contingency extremely remote, and having regard to the conduct of the deceased, I think the respondent should still be entitled to her full costs of obtaining the decree of accounts.”

The *ratio legis* underpinning that view is, that in a suit for account even if the applicant is shown not to be entitled to any payment of money from the defendant, once the accounts are proved, he will be entitled to have the full costs of obtaining the decree for accounts. In our present context, this holding emphasises the two-stage process in an action for the remedy of accounts of profits. The process is of general application, and on first principles it applies in copyright infringement litigation.

### 2.4. Nature of the remedy in copyright infringement

#### 2.4.1. A remedy *in personam*.

Account of profits is a decree *in personam*.\(^\text{15}\) It requires the infringing defendant to render the required accounts, and then to pay the net profits to the owner of the infringed copyright. Behind the order is the threat that a recalcitrant infringer will be put in prison for contempt, or his property attached, or even he be fined. In other words, a suit for account of profits is a personal action.

\(^\text{13}\)(1956), 23 EACA 247 (CA-T).

\(^\text{14}\)Ibid, at p. 254. And if any doubt ever remains in decided cases on the dual character of the process, statute has removed it by the clear provisions in Order 20, rules 15 and 16 of the Civil Procedure Rules, (Cap 21, Sub Leg), giving the court the power to adopt a step-by-step procedure of making special directions as to accounts, and passing preliminary decrees directing accounts to be taken before passing final decrees.

\(^\text{15}\)The Latin expression refers to a proceeding or decree directed against or with reference to a specific person, in contradistinction with one *in rem* which is against the world at large. The decree *in personam* compels a specific act (e.g. rendering accounts) to be done by the specific person concerned (e.g. copyright infringer): see Chief Justice M. Monir, B.C. Mitra and A.C. Moitra, *Legal Thesaurus*, The University Book Agency, Allahabad, 1997, at p. 414.
However, to-day the power of enforcing its orders by committal of the person has been greatly supplemented by statute,\textsuperscript{16} and equitable remedies can be enforced by any of the methods prescribed which may be applicable to the particular case. This is the case in copyright infringement cases as in other cases of property.

Because the remedy is \textit{in personam}, and primarily over the defendant personally, it is immaterial that the property in question, e.g. infringing copies of a book or recordings, is not within the reach of the court, provided that the defendant himself is within the jurisdiction, or is capable of being served with the proceedings outside the jurisdiction, and that there is proprietary equitable right which the plaintiff could have enforced against him had the property been in Kenya. For instance, in \textit{Mohamed v. Ambaram}\textsuperscript{17} it merely took a defendant who lived abroad, and with no property in Kenya, to pass through Mombasa on his way to India, and being served with a summons in a suit in Kenya, for our court to assume jurisdiction over him concerning a matter abroad.

\textbf{2.4.2. A restitut\textit{ionary remedy}.} Account of profits in copyright is a money judgment rendered on the basis of "restitution."\textsuperscript{18} By it, an attempt is made to cure financial maladjustments by which a defendant has been unjustly enriched at the expense of the plaintiff. The emphasis is not on compensation to the plaintiff for his loss but on the benefit acquired by the defendant through his tortious or other wrongful act such as copyright infringement.\textsuperscript{19}

In the context of copyright infringement, account of profits is a remedy given in order to prevent the unjust enrichment of the defendant in so far as attributable to infringement of copyright. It is

\bibitem{16}Order 21 of the Civil Procedure Rules (Cap 21, Sub Leg), generally governs execution. Of more direct application to account of profits, see rule 26 on execution of decree for payment of money (e.g. money payable to the copyright owner by an infringer after accounts furnished): the decree may be executed by the detention in prison of the infringer, or by the attachment and sale of his property, or by both.

\bibitem{17}\textit{(1915-1916) 6 EAPLR 174 (HC-K)}.

\bibitem{18}The word generally refers to the branch of obligations dealing with the circumstances where a person must restore property or money to another in order that he may not be unjustly enriched. It covers cases where goods or money have been transferred or acquired under, \textit{inter alia}, lack of authority, or where the defendant has acquired a benefit through his own wrongful act or otherwise unjustifiably: see David M. Walker, \textit{The Oxford Companion to Law}, Clarendon Press, Oxford, 1980, at p. 1066. It covers the restoration of profits made by infringing copyright.

\bibitem{19}Cornish & Llewelyn, \textit{supra}, note 4, para 2-44, at p.78 and \textit{Copinger and Skone James on Copyright, supra}, note 4 at p. 1062.
a remedy used to recapture net benefits obtained in breach of copyright, and thereby reverse gains acquired by committing infringement.\textsuperscript{20}

The restitutionary character of this remedy marks it off and makes it distinctly different from compensatory damages. The contrast between the two money remedies is, that by an account of profits the copyright infringer is required to give up his ill-gotten gains to the party whose copyright he has infringed; by damages he is required to compensate the copyright owner for the loss he has suffered.\textsuperscript{21}

The two monetary remedies are said to be mutually inconsistent, in that the remedy of damages is concerned with the loss or damage sustained by the owner of the copyright as a result of the infringer’s wrongful acts, while account of profits is concerned with the profit made by the infringer’s infringement of copyright. The business of accounts is to consider the profit made by the defendant and not the harm suffered by the plaintiff.\textsuperscript{22} With damages it is normally a notional computation; with account it is an investigation of actual accounts, (facts and figures) and it will normally give a better recompense than damages when the defendant has been making profits that the plaintiff would sometimes not himself have made. However, this advantage tends to be blurred by an award of the statutory “additional damages” and/or common law “aggravated damages” in special circumstances. By section 35(6) of the Copyright Act, 2001, it is provided:

“(6) Where in an action under this section an infringement of copyright protected under this Act is proved or admitted, and the court, having regard (in addition to all other material considerations)

(a) the flagrancy of the infringement; and

(b) any benefit shown to have accrued to the defendant by reason of the infringement.

is satisfied that effective relief would not otherwise be available to the plaintiff, the court, in assessing damages for the infringement, may award such additional damages by virtue of this subsection as the court may consider appropriate in the circumstances.”


\textsuperscript{21} \textit{Per} Windeyer, J, in his typically elegant judgment in the Australian infringement trade mark case, \textit{Colbeam Palmer Ltd v. Stock Affiliates Property Ltd} (1968) 122 CLR 25, at p. 32. See also \textit{Dart Industries Inc v. Décor Corp Pty Ltd} (1993), 179 CLR 101, at pp. 111, 123, a patent case in the High Court of Australia.

\textsuperscript{22} \textit{Peter Pan Manufacturing Corp v. Corsets Silhouette Ltd} [1964] 1 WLR 96, at p. 107.
Clearly, therefore, in the event that the infringement of copyright is an exceptional one, additional damages under this provision, or the common law aggravated damages, may very well achieve a similar result as account of profits may do. The problem, however, is that in the majority of the cases falling outside the “exceptional” case or not covered by the above quoted provision, the plaintiff would be denied the full recompense value of account of profit. Moreover, in the case of aggravated damages they are hedged around with stringent conditions very much limiting the availability of the remedy, amid the courts’ general slowness in awarding such damages.23

Besides, there is this interesting difference between account of profits, and damages. By section 35 (5) of the Copyright Act, 2001, on infringement of copyright it is a defence to damages but not to an account of profits, that the infringer did not know and had no reason to believe that copyright subsisted in the work to which the action relates.

2.5. Jurisdiction to grant the remedy in copyright infringement cases

An action for an account “can be brought in any case in which equity or the common law formerly had jurisdiction to order an account.”24 This is a general jurisdiction outside any statutory jurisdiction. It is this jurisdiction which has been received into Kenya under “doctrines of equity clauses.”25 The reception into Kenya has not modified the action for account; nor have the statutes26 modified the law received. Indeed, even in the area of procedure, it has been held, that where no form is provided in the local statute law,

“one is thrown back on English procedure as on the 12th August, 1897. The local provision may be in the most general terms and may require to be worked out in detail in accordance with English practice…. If

24 Snell, supra, note 4, para 44–08, at p. 707. Thus, account would be ordered where a defined relation or contract existed, or the plaintiff had an equitable right (such as in trusts), or a legal right if the matter could not be fully handled at common law. See also Lord Goff of Chieveley and Gareth Jones, The Law of Restitution, 5th edn, Sweet & Maxwell, 1998, at pp. 780–783, for cases where a plaintiff may obtain restitution of the benefits gained from tortious acts.
26 Copyright Act, 2001; and the Civil Procedure Rules (Cap 21, Sub Leg), Order 19.
the local law does not provide a suitable, or at least a competent, mode of procedure for an application... it must be made as under the old English procedure". 27

This being the case, it is important always to determine whether in a given case a court has jurisdiction, and this can only be done by looking at local statutes and decided cases as well as in English precedents, to determine the circumstances in which a defendant is liable to account. This can be no mean task, which may explain why in Kenya little, if any, is known about this remedy despite its existence on the statute book. However, the High Court of Kenya has the jurisdiction to grant the remedy. It is a court of unlimited jurisdiction. Magistrates' courts have such jurisdiction, subject to limits put by the Magistrates' Court Act. By section 35 (4) and (13) of the Copyright Act, 2001, any court of competent jurisdiction may determine the issue of the remedy.

2.6. Election between money remedies for copyright infringement

Double recovery of money is not allowed, and a plaintiff will have to choose between claiming damages or profits made by the defendant through the infringement of copyright. 28 He has to seek either an award of damages, or an account of the profits made by the defendant: he is not entitled to both, the remedies of damages and account of profits being alternative financial remedies, assuming damages are available. The two remedies are inconsistent. Neither remedy can be claimed in addition to the other, even where the loss to the plaintiff and profit to the defendant are unrelated so that when combined the two remedies would not result in double liability. The doctrine of election of remedies was well discussed in this country in *Tootal Broadhurst Lee Co Ltd v. Alimahomed Haji Ahamed and Sons Ltd.* 29

It was there contended for the plaintiffs that they were entitled at their option either to damages representing the loss which they had sustained, or to the profits realised by the defendants out of the infringement. It was contended for the defendants that the plaintiffs had no such option and that they were merely entitled to damages sustained and that they were not entitled to an account of


29 (1951) 24 (2) KLR 31, at pp. 34, 35, (K), de Lestang, J (as he then was) — a case of infringement of registered designs.
profits. The plaintiffs' contention prevailed. The court held that the plaintiffs had such an option, and they had rightly made a choice: they wanted an account, and they could not be granted damages in addition to account.

Of additional value in that case is the further holding, that a plaintiff is not debarred from making an election to seek an account of profits merely because he has asked for damages in his plaint, so long as he makes it quite clear in the course of the proceedings that he is claiming one or other and not both of his remedies.

The requirement of an election has been explained variously. "It used to be said that the plaintiff must elect either for damages or an account, upon the theory that by seeking an account the plaintiff adopted the defendant's acts as his own, but this explanation is now dubious. The better principle is merely that in respect to any one infringement the plaintiff should not be entitled to be both reimbursed and compensated." But this still does not answer the question: Why should a plaintiff not be compensated for loss and also deny the defendant an unjust enrichment? In Redrow Homes v. Betts Bros, the requirement was explained on the basis that the two remedies are inconsistent. Surely? In Watson Laidlaw v. Potts, Cassels & Williamson, the court explained the requirement of an election as a mechanism to prevent overlapping. Surely there cannot be overlapping in every case. At any rate, it is here submitted, if overlapping is inevitable in order to do complete justice, overlapping is a minor consideration.

Another explanation is:

"A successful plaintiff... is not entitled to both, since the principle which lies behind the equitable remedy of an account of profits is that the plaintiff condones the infringement and takes the profits made by the infringer for the use of his property."

Here we are right in the deep waters of legal fiction far away from reality. Ask any aggrieved owner of copyright if he has condoned an infringement of his copyright. He surely will be outraged by any suggestion of associating him with condonation of the wrong to him. At any
rate, in equity condoning a wrong would defeat a claim for a remedy. Equity regards the conduct of a plaintiff, including his consent to a wrong being done to him, and refuses relief in proper cases.\(^{34}\) It is not right to condone a wrong and then come to equity for a remedy, claiming to have clean hands.\(^{35}\)

Is this election still justified? Why can the plaintiff not claim both loss and profit? It is submitted that the answer lies in allowing recovery of both damages and profits in proper cases. The issue should be for the court to apply its discretion to avoid injustice. For instance, the court may allow a plaintiff to recover only profits that are not taken into account when computing damages. In that manner double award may not arise. That would be a lenient approach favouring defendants. But it is submitted that there is nothing inherently abhorrent to provide in the law a possibility of recovering both damages and profits for the same infringement, e.g., recovering lost sales a plaintiff would have made as damages, and the defendant’s profits from the sales of the infringing works.\(^{36}\)

2.7. **Advantages of pursuing the restitutionary remedy in copyright cases**

There are a number of things which make the remedy of account of profits more attractive to a plaintiff than damages on infringement of copyright\(^{37}\). One advantage is on account of actual damages being difficult to prove. In establishing the infringer’s profits, the copyright owner presents proof of the infringer’s gross profits. Procedurally the burden will then be upon the defendant to prove deductible expenses and elements of profit due to factors other than the infringed work.\(^{38}\)

Another strong point in favour of the remedy of account of profits is that account is an investigation of actual accounts, which may incidentally yield information of tremendous

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\(^{36}\) In America, too, double recovery is forbidden, and a copyright owner can only recover profits that are not taken into account when computing actual damages (US 1976 Copyright Act, s 504 (b)). Nevertheless, in *Abeshouse v. Ultragraphics, Inc*, 754 F 2d 467 (2d Cir 1985) the court recognized the possibility of cumulative damages in addition to profits. However, in the actual case, the plaintiff’s proof was not sufficient on this issue to obtain an award. In Kenya the Copyright Act, 2001, is silent on the issue of election of remedy.


commercial value to the owner of the infringed copyright. He gets sight of customer’s names and other useful information about the infringer. The process of account can expose a lot of information and records necessary for appropriate recovery of money wrongfully acquired by the defendant. The plaintiff is entitled to the disclosure of relevant information by the defendant, including, among others, financial records.

A very important reason why an aggrieved owner of copyright will choose account of profits is that it may happen that the infringer has made a profit from his invasion of the copyright and the profit exceeds in value what would be the normal award of compensatory damages. If the infringement of the copyright has caused the plaintiff little loss but has greatly benefited the defendant, an award of damages would be small. The small award of damages can make it worthwhile for a defendant to adopt a deliberate commercial policy of infringement, setting aside as a business expense the proportion of his profit which may be devoted to the payment of small damages as he pockets the net profits. By means of account of profits, the owner of an infringed copyright may be able to obtain restitution of a benefit gained by the infringer from the infringement in circumstances where he (owner) has suffered little or no loss; and he will be most anxious to do so if the infringer’s gain is greater than his (owner’s) own loss.

Those sympathetic to infringers might have reservations and express a feeling of unhappiness, that a copyright owner can strip the infringer of profits which he (owner) could never have himself gained; and that such restitution comes to him as a windfall; or that it may be that in any event the defendant could have made the profits independently of infringement. But, surely, in all justice, an owner of a property right should be allowed to recover the benefits gained by the defendant invading his rights against the law if it can be shown that the benefits were the product of wrong-doing. It should be irrelevant that the owner suffered no, or little, loss. It is immaterial that the infringer could have made some or all of the profits in a non-infringing way. A law breaker is a law breaker, and an infringer is an infringer: he must be compelled to disgorge any illegitimate profits gained from his infringing acts.

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39 Cornish & Llewelyn, supra, note 4, para 2-43, at p.77.
40 See Cornish & Llewelyn, supra, note 5, para 2 – 43, at p. 77.
41 Bainbridge, supra, note 4, at p. 149.
42 Phillips & Firth, supra, note 4, para 14.13, at p. 203.
43 Goff & Jones, supra, at pp. 774, 786.
44 Ibid, at p. 783; and Laddie, Prescott, Vitoria, Speck & Lane, supra, note 4, para 39.47, at p. 1802.
Recovery should be based not just on loss suffered by the copyright owner, but on the unjust enrichment of the infringer as well. The idea is to strip every infringer of his unjust enrichment. The law must deprive cynical infringers of the fruits of their violations of copyright, and no opportunistic and profitable infringement should be allowed to be a strand in unjust riches. In other cases, it would be harsh indeed for an infringer who has consistently flouted in a most calculated and cynical fashion the plaintiff’s copyright, to be allowed to retain the benefit gained from the infringement: he must be compelled to disgorge. It is submitted that recovery should be based on both loss suffered by the owner of copyright and reversing unjust enrichment, or a synthesis of the two principles.

2.8. Principles upon which account of profits is granted for copyright infringement

The principles upon which account of profits is considered and granted or refused in suits to redress copyright infringement in Kenya are the broad equitable principles. Since the remedy is part of the equitable jurisdiction, and there has not been any variation by statute, a plaintiff is not entitled to it as of right. It is within the court’s conscientious discretion. But the discretion must be exercised judicially, in a selective and discriminatory manner, on fixed principles, and not arbitrarily or idiosyncratically or according to private opinion, for otherwise parties would become dependent on judicial whim.

Accordingly, a claim for an account is liable to be defeated by the equitable considerations and discretionary factors such as acquiescence, unclean hands, hardship, equitable estoppel, plaintiff’s unworthy conduct, impossibility, futility, fraud, laches, triviality and the practical unjust consequences of ordering the remedy in the particular case.

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45 Ibid.
47 These equitable considerations form aspects of the maxims of equity which are well discussed in, among others, Snell’s Equity, supra, note 4, chapter 3; and see Judge Cracknall, concerning laches in Isa v. Kanji (1868-1918) 1 ZLR 37, at p.39 (1892) – a claim arising on an account between 1926 – 1936 and the two principals in all the transactions were dead, one twelve years before action. Held, the claim was extinguished by laches and was dismissed.
2.9. Dark corners of the remedy, requiring illumination under copyright law

Account of profits looks a very attractive remedy on the face of it. But it has some dark corners, and is beset by great practical difficulties.\textsuperscript{48} It is “a laborious and expensive procedure”,\textsuperscript{49} “often extremely difficult and expensive to prepare,”\textsuperscript{50} and “since the taking of an account is usually complicated and expensive, this is a form of relief which is rarely sought in actions for infringement of the property rights.”\textsuperscript{51}

One of the most difficult problems raised by the remedy of an account and bedevils the adjudicatory process concerns the way the profits are calculated. While an account of profits may be a very useful remedy in a simple case, it is very difficult to take where part only of the infringing material infringes the plaintiff’s copyright.\textsuperscript{52} Part of the problem in the calculation of the profits lies in the fact that it will be very rare for the infringement of copyright to be the single cause of any profit, it being more likely that only part of the product sold by the defendant will have been infringing, and the court is called upon to try to determine what profits have been caused, in a legal sense, by those acts.\textsuperscript{53}

It is hard even in factually simple cases to establish what proportion of the defendant’s profit is derived from the copyright infringement in contrast with profits which he would have made anyway or those made by non-infringing endeavours commingled with infringing ones. This difficulty has some major tactical consequences, for a plaintiff who is prepared to subject the defendant to the expense and inconvenience of an account may be better able to settle his suit out of court, on favourable terms, than a plaintiff who only seeks an award of damages.

The court must attempt to apportion profits according to the relative value of the infringing and non-infringing material. It must determine what profits have been caused, in a legal sense, by the infringing acts and issues of fact relating to causality and remoteness require exploration.\textsuperscript{54}

\textsuperscript{48}See some of them raised in paras 2.1, 2.3, 2.4.2, and 2.6 above.
\textsuperscript{49}Cornish & Llewelyn, \textit{supra}, note 4, para 2-43, at p. 77.
\textsuperscript{50}Phillips & Firth, \textit{supra}, note 4, para 14.14, at p. 204.
\textsuperscript{51}Laddie, Prescott, Vitoria, Speck & Lane, \textit{supra}, note 4, para 39.47, at p 1802.
\textsuperscript{52}Copinger & Skone James, \textit{supra}, note 4, para 22 – 95, at p. 1062.
\textsuperscript{53}Bently & Sherman, \textit{supra}, note 5, at pp. 1028, 1029.
\textsuperscript{54}Celanese International Corporation \textit{v.} BP Chemicals Ltd [1999] RPC 203 at p.219 (a patent case, but the process applies in copyright cases also: see 2 Laddie, Prescott and Vitoria, \textit{supra}, note 4, para 39.47, at p. 1802).
Where only part of the defendant’s product infringes copyright, there should be a suitable apportionment of the profits as between infringing and non-infringing parts but it does not follow that any apportionment should be spread evenly if the court forms the view that more of the profit should be attributed notionally to some parts than to others. It may be well nigh impossible to isolate the infringing profit from the other profits made concurrently by the defendant in other, legitimate, dealings.

In Kenya there are at least three peculiar problems which do not help to lighten the foregoing practical difficulties. One problem emanates from the difficulties of getting accurate or even any information. The culture of keeping proper or any accounts and book-keeping, in business and undertakings, is predominantly absent and at best still in nascent stages in our society. In an environment of lack or scarcity or incompetence of accounting, the remedy of accounting of profits for copyright infringement may be impotent, or at best, inchoate.

The other problem is that the statute book does not help matters very much. The Copyright Act, 2001, does not specify which expenses a defendant can deduct and keep for himself out of the profits he made concurrently. Help would be sought by looking to a body of case law for answers. But there is a dearth of precedent. So, deciphering which costs are related to an infringement and which are related to non-infringing aspects of the infringer’s business poses both practical and theoretical difficulties.

A further problem: an application for an account turns the court into an accounting room. This is a specialised and difficult skill. Judges with experience in such matters are yet to be found. In Kenya it is assumed that all judges have the requisite skills. But truly, truly, are they? It is as yet to be demonstrated to be, Yes. In practice reliance is on estimates, and not necessarily accounting. Thus, for instance, in Kamau v. Gecharu, the trial judge had not had accounts availed to him. So he made an estimate of the profits and gave the plaintiff half the total profits. The Court of Appeal approved of this procedure.

In apparent recognition of how the complexity of taking accounts can be and in order to avoid bogging down the court with intricate accounting, courts are empowered (a) to make special

\[(1953) 20\ EACA\ 59\ (CA-K).\]
directions as to accounts, and (b) to refer the accounting exercise to a referee to examine the accounts. Thus, Order 20, rule 16 of the Civil Procedure Rules makes provision for special directions as to accounts as follows: (omitting what is not immediately relevant here):

"16. The court may... give special directions with regard to the mode in which the account is to be taken or vouched..."

In that regard, the court can also direct that during the taking of accounts, books of accounts relevant shall be prima facie evidence of the truth of the matter they contain. But the parties interested are free to object. Of more direct impact on the present study is Order 27, rule 11 of the Civil Procedure Rules. It provides as follows:

"11. On the application of any party or of its own motion in any suit in which the examination of accounts is necessary or desirable, the court may refer the accounts for examination to such person as it thinks fit."

By rule 12(2) of the same Order, the proceedings and report (if any) of the referee is merely evidence in the suit and nothing else and if the court is dissatisfied with them it may direct further inquiry. Getting a referee who is competent to go into the accounts can present problems. If there is an allegation of account-books having been falsified, the investigation of the accounts might complicate matters further. Similarly if the plaintiff raises numerous objections to items in the accounts as found by the referee, the process of settling the issues can be much lengthened.

Reliance on appointment of referees on an ad hoc basis does not appear satisfactory. A better way is to have properly trained court staff, such as specially trained and experienced deputy registrars, to be taking accounts. With experience, such judicial personnel would get the requisite expertise in the area of taking and making accounts which can usually be dependable.

2.11. Conclusion
Account of profits is clearly a useful remedy, given the complexities which arise in business dealings and the difficulties which may face a plaintiff who knows for sure that the defendant is infringing his copyright, but does not know the specific quantum of the monies which the infringer has made out of his wrong-doing. More use might with advantage be made of the remedy to confront copyright infringement by this restitutionary counterblast.

Indeed, since, unlike ordinary damages, accounts are available regardless of the defendant’s knowledge as to whether copyright subsisted in the work, an account of profits may be the only way in which an owner of copyright can recover some monetary award for the infringement if the defendant’s knowledge is likely to be in issue.

But although this is an old equitable remedy the law on it still has dark corners which have not yet been illuminated in litigation or legal writings. Nevertheless, it is a remedy which can be formidable against copyright infringers and in the protection and enforcement of copyright in this country. It is an efficient and effective remedy. But as it is normally a final remedy after the trial of the suit, it can only be as expeditious as the general rules of civil proceedings can permit. In this respect, it is suggested that express provision should be made allowing interim accounts to be furnished and payment out made on proper conditions and undertakings, or payment into court or joint interest-earning account at a reputable bank.

Shorn of these dispensable problems, account of profits is promising as an efficient remedy in the fight against copyright infringement in Kenya.
CHAPTER 3

INJUNCTIONS IN COPYRIGHT IN KENYA

3.1. Injunctions against infringement of copyright

One of the remedies in respect of unauthorised present or future use or threatened use of the whole or part of a work or other subject matter in which copyright subsists, is the remedy of injunction. ¹ Section 35(4) (a) of the Copyright Act, 2001² is explicit on this. It is to the effect that one of the reliefs available to the owner of copyright as plaintiff in a civil action for infringement of copyright is an injunction prohibiting the infringer from committing or continuing to commit the copyright infringement.

This statutory power may be invoked if copyright is infringed or is threatened with infringement, or copies are imported which, had they been made in Kenya, would have been infringements. The owner of the copyright can get an injunction to prevent any or further infringement of copyright or distribution of the offensive material. In a proper case, the court may impose an injunction compelling the copyright infringer to abate the infringement as from the date of the judgment. The remedy prevents unauthorised copying of the plaintiff’s articles. It protects the plaintiff's creative efforts. Without such a remedy, the defendant might continue unauthorised copying with impunity.

It is a remedy that can be sought on its own or as a consequential relief along with damages or account, and delivery up. In comparison, at least one outstanding feature distinguishes the remedy discussed in Chapter 2 above, and the one the subject of the present Chapter. Account of profits is ex post facto, awarded for past infringement. Injunction, on the other hand, is largely anticipatory, and looks to the future. It is designed to restrain an on-going or a threatened infringement.³

¹ The Hon Sir Hugh Laddie, Peter Prescott, Mary Vitoria, Adrian Speck, and Lindsay Lane, 2 The Modern Law of Copyright and Designs, 3rd edn, Butterworths, London, 2000, para 39.32, at p. 1785.

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This Chapter is not a general discourse on the whole law of injunctions. The focus is on the remedy for copyright infringement in Kenya only. Broader principles are referred to or examined here and there only for purposes of providing the general legal environment in which copyright infringement litigation in civil courts is to be perceived.

3.2. What are injunctions in copyright infringement cases in Kenya?

In essence, an injunction is an order or decree directed at a named person or persons, demanding that the course of action complained of as infringing or likely to infringe copyright be stopped if it is not yet completed, or that it should not start at all if it is contemplated but has not yet been embarked upon, or in relatively less common cases, that it be undone if it has already been completed. It is an order or a decree to do, not to do, or undo. In the Kenyan copyright context, therefore, an injunction is an “order” or “decree” by which one who has infringed or is threatening to infringe copyright is restrained from continuing or commencing the infringement. It may, for example, stop the publication or importation of an infringing work.

3.3. Types and classification of injunctions available in copyright cases

There are various types of injunctions in copyright law, classified according to whether they are “orders” or “decrees”; and whether they are in either of these two categories, whether, again, they are orders or decrees to “do” or “undo” on the one hand, or “not to do”, on the other.

When they are requiring a person to take positive steps to do or undo something, such as to remove devices primarily designed or produced to circumvent technical copyright protective measures, the injunctions are classified as mandatory injunctions These

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5 For example, in *Sapra Studio v. Tip-Top Clothing Co* [1971] EA489, an injunction was granted restraining the defendant from importing into Kenya artificial silk scarves in breach of copyright of certain designs (the defendant’s silk scarves being exact copies of the designs protected under copyright). See also *Jiwani v. Going Out Magazine & Another* [2002] 1 KLR 856.

6 P.L.O. Lumumba, *An Outline of Judicial Review in Kenya*, Faculty of Law, University of Nairobi, 1999, at p. 169, suggests that the Latin name “mandamus” should be changed in order to make its “meaning
injunctions also take on a restorative character. However, they are not common in the area of copyright. Nevertheless, they can be used to require an infringer to restore electronic rights management information removed contrary to section 35(3) (c) of the Copyright Act, 2001; or it may be granted to undo distortion, mutilation, modification or any derogatory action prejudicial to the author’s honour or reputation.

Prohibitory injunctions direct a person to refrain from committing or continuing to commit infringement of copyright. These are “the most important remedy for infringement of copyright, rights in performances and design right”. “In the intellectual property field an injunction is almost always prohibitory (as opposed to mandatory) since it enjoins the threatened commission or continuance of wrongful acts.”

Injunctions may be classified according to the time or stage in the copyright infringement litigation at which they are granted and for how long they are intended to endure. Thus, those which are granted after the right to copyright and its infringement or threatened infringement have been established in an ordinary action at some hearing in which final

more accessible to laymen”, by calling that order, a “mandatory order”. Such a change may lead to a confusion with a mandatory order of an injunction; there is no language of a people without foreign words; *mandamus* is already well understood as a term of art; and nowhere in the world every layman knows the meaning of every legal term, (and even some lawyers struggle to know some words, as demonstrated by the argument over what is to pass as an injunction, in *Patel v. Patel*, [1959] EA 907. At any rate, not every simplified legal term is “accessible to laymen”, and laymen will still seek out legal experts whenever a legal controversy arises over a word; and there is no empirical evidence that de-Latinizing by Anglicizing words and phrases makes “meaning more accessible to laymen” (including the large illiterate population Kenya has). Laymen will still go to lawyers for meaning, and lawyers will end up in courts over meaning for judicial interpretation, Latin or no Latin.

At the final trial if infringement of copyright is established and there is no discretionary bar to relief, the plaintiff is “normally granted a permanent injunction to restrain future infringements”, and “most injunctions sought” on interlocutory applications “are of a negative or prohibitory nature” and not mandatory or restorative: Kavin Garnett, Jonathan Rayner James and Gillian Davis, *1 Copinger and Skone James on Copyright*, 14th edn, Sweet & Maxwell, London, 1999, paras 22 – 55 and 22-84, at pp. 1019 and 1051: emphasis on “restrain” supplied. Indeed, by section 35(7) of the Copyright Act, 2001, the issuing of an injunction which requires a completed or partly built building to be demolished is prohibited: that is, even if the building is erected using architectural drawings and design which infringe copyright.

Such relief may be sought under s 32(3) of the Copyright Act, 2001, protecting moral rights.


judgment is given and are intended to settle finally the relations between the parties in connection with the established infringement, are called perpetual (or final) injunctions.

On the other hand, pre-trial relief, granted before trial of the action, with the object of temporarily holding things in the most just position in the circumstances, until the question at issue between the parties in the suit itself can be determined or until further or other order of the court, is classified in Kenya as temporary injunctions, commonly referred to as interlocutory or interim injunctions. Of all types of injunctions, temporary injunctions are the most efficient and efficacious remedies in the swift protection and enforcement of copyright. As it has been well observed, it enables a plaintiff to “freeze” the present situation and prevent the defendant from presenting him with a fait accompli, while it saves the court from having more than necessary to undo later by mandatory injunction something that should have been prevented more cheaply and conveniently.

Any of these injunctions, if granted before any copyright infringement has actually occurred, is classified as a quia timet injunction: one based on fear only. Here action for an injunction is taken to prevent an apprehended infringement, though none has occurred at present. Generally, what is to be aimed at is justice between the parties having regard to all the relevant circumstances. Naturally, many applications for relief in copyright cases will be for quia timet injunctions, for as Sir Edward Coke early counselled, preventive justice “excelleth punishing justice.”

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11 This does not mean necessarily enduring for ever, but means finally settling the present dispute between the parties at the end of the suit.
14 Employed in, inter alia, Devani v. Bhadresa and another [1972] EA 22, by law, Ag V-P and Lutta, JA.
17 Coke, 2d Institutes, at p. 299.
Finally, if the purpose of a classification is to distinguish injunctions granted against a copyright infringer who has not been served with the application praying for the injunction, from those granted against a defendant who has been duly and properly served, they will be classified as *ex parte* for the former, and *inter partes* for the latter injunctions. *Ex parte* injunctions are strictly temporary injunctions, “granted only once for not more than fourteen days and shall not be extended thereafter.”

3.4. **Nature of the injunctive remedy in copyright infringement cases**

3.4.1. **Remedy *in personam***. An injunction is a remedy *in personam*. When a court grants an injunction it “will not suffer anyone within its reach to do what is contrary to its notions of equity, merely because the act to be done may be, in point of locality, beyond its jurisdiction.” Accordingly, a copyright infringer who resides abroad and physically outside the jurisdiction of the court, is within the reach of the court if service can properly be made upon him under rules of court. The case of *Mohamed v. Ambaran*, well illustrates the position in Kenya, that it is immaterial that the property in question is not within the geographical reach of the court, provided that the defendant himself is within the jurisdiction even in transit, or is otherwise capable of being served with the proceedings somehow, under the rules of the court. So, in the leading English case of *Penn v. Lord Baltimore* an agreement to fix the boundaries of Pennsylvania and Maryland in America was a subject of a suit in England. On objection raised by the defendant as to the jurisdiction of the court, Lord Hardwicke overruled it on the ground that “the conscience of the party was bound by this agreement; and being within the jurisdiction of this court, which acts *in personam*, the court may properly order it as an agreement.” So, although the land was not within the jurisdiction, the defendant was, and the court would hold him in contempt unless he obeyed the court’s order or decree.

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19 Cranworth, LC, in *Carron Iron Co v. Maclaran*, (1855), 5 HL Cas 416, at pp. 436, 437. Also see *Hope v. Carnegie* (1868) LR 7 Eq 254.


21 (1750), 1 Ves Sen 444.
This principle underpins a long line of local Kenyan cases which have decided that in an action in personam, provided a defendant is in Kenya, for however short a time and he is properly served, Kenyan courts have jurisdiction to entertain an action in personam. The governing principle is the doctrine of territorial dominion, and this covers cases where the cause of action arose outside the local jurisdiction. An action lies in Kenyan courts against an absent defendant provided he was duly served. The jurisdiction of our courts over persons outside Kenya is of course, subject to any local enactment on the matter.

3.4.2. Order or decree discretionary. An injunction in copyright litigation is normally a discretionary remedy, granted or refused on the traditional principles of equity, although statute may also regulate the matters. In accordance with the discretionary nature of the remedy, even if a matter is an apt case for injunction, or one where an injunction is a peculiarly suitable and indeed the normal and the most efficacious, remedy like in copyright protection, the court must:

(a) in view of the balance of interests, consider whether some alternative remedy is more appropriate; or
(b) in view of the conduct of the plaintiff, consider whether he has disentitled himself; or
(c) in view of the practical reality, consider whether to grant the injunction the court would act in vain.

The former Court of Appeal for East Africa emphasised this discretion many times, especially in the context of temporary injunctions, but the same character attaches to

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23 Manji v. Bechar (1933) 15 KLR 92.
25 Giella v. Cassman Brown & Co Ltd [1973] EA 358, at p. 360, a restraint of trade case in which the principles were laid down but have been applied in many copyright infringement cases, including Microsoft Corporation v. Mitsumi Computer Garage Ltd [2001] 1 EA 127; Royal Media Services Ltd v. Telkom Kenya Ltd, HCC Suit No 15 of 2000; and Uganda Performing Rights Society Ltd v. Mukubira [2004] 1 EA 343.
26 E.g., no injunction may be granted against the Government or its officers, by reason of the Government Proceedings Act (Cap 40), s 16 (1) proviso (i), and (2), although a declaration of right may be made. For a more detailed consideration and critique of that provision, see Kuloba, Injunctions, supra, note 16, paras 7.6.2–7.6.5, at pp. 117–121.
27 Sapra Studio v Tip-Top Clothing Co [1971] EA 489; and authorities cited in note 26, supra.
permanent injunctions, and numerous cases thereafter have reiterated the discretionary quality of the remedy. It suffices to quote the following:

"the granting of such an order is a matter within the discretion of the court below, and this court will interfere only if it be shown that the discretion has not been exercised judicially."²⁸

In *The Despina Pontikos*,²⁹

"the issue of an injunction is an exercise of discretion and it is well established that this court will only interfere with the exercise of his discretion by a trial judge in exceptional circumstances, though it will not hesitate to do so if the exercise of the discretion has been based on any wrong principles."

And, finally, in respect of a perpetual injunction, to the same effect:

"Mr Hewitt concedes that he cannot claim a perpetual injunction as of right.... I think this is reasonable."³⁰

The discretion is technically unfettered, and there is thus in theory no impediment of granting injunctions. Judges, however, tend to condition the use of their broad powers by their great reliance on precedent and practice. It is made clear by the above passages, that the discretion must be judicially exercised.³¹ Therefore, there must be some grounds for its exercise, for a discretion exercised on no grounds cannot be judicial. If there be any grounds stated for exercising the discretion one way or the other, the question whether they are sufficient is entirely for the judge at the trial, and an appeal court cannot interfere with his decision.³²

### 3.4.3. Flexibility

The remedy of injunction is also best known for its flexibility, a quality which enables the court to make precisely tailored orders or decrees to meet the exact exigencies of each individual case. The flexibility is due to the fact, that it is the necessary requirement of every injunction that it should be certain and definite in its

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³¹ As stated in one copyright case, "In... granting the injunction the court must have regard to the law in question and exercise its discretion judiciously": per Kiryabwire, AJ, in Uganda Performing Rights Society Ltd v. Mukabira [2004] 1 EA 343, at p. 346.
³² Sir Norman Whitley, CJ, in Dhirani v. Gangji (1946) 13 EACA 69, at p 71 (CA-K), and the authorities there approved and adopted.
terms, and it must or ought to be quite clear what the person against whom the injunction is made is required to do or to refrain from doing.\textsuperscript{33}

The court can consider the exact terms of the injunction which the circumstances call for, and grant only "a reasonable injunction" and not "to punish" the defendant, and "the court is particularly careful to avoid the injustice of... a severe punishment."\textsuperscript{34} If need be, where the plaintiff in an action for infringement of copyright claims in general for an injunction restraining the defendant from infringing the plaintiff's copyright, and infringement is proved and judgment for the plaintiff for an injunction against further infringement of the plaintiff's copyright is granted, the required injunction may be granted in court and then its precise terms settled later in chambers as may be desirable.\textsuperscript{35}

In the case of temporary injunctions, Order 39, rule 2A (1) of the Civil Procedure Rules provides that the court may by order grant an injunction on such terms as to an inquiry as to damages, the duration of the injunction, keeping an account giving security or otherwise, \textit{as the court thinks fit}. When an injunction is granted on conditions, it is not automatically dissolved by the breach of those conditions, nor is the court under any duty, on application, to dissolve it. However, a court will, in such circumstances, normally dissolve the injunction, unless the breach is of a very minor or technical nature.\textsuperscript{36}

3.5. General principles common to all classes of injunctions in copyright

3.5.1 Same principles for protection of property rights apply

Basically, injunctions against copyright infringement obey much of the same rules and principles as injunctions granted under all other areas of law, albeit emphases might shift here and there, depending on the nature of the property. Some of the key ones may be noted as below.


\textsuperscript{34} Sir Graham Paul, CJ, in \textit{Mombasa Auto Service v. South British Insurance Co Ltd} (1950) 17 EACA 72, at p. 76 (CA-K).

\textsuperscript{35} That is what Simpson, J (as he then was) directed after granting an injunction in \textit{Performing Right Society Ltd v. Grand Theatres Ltd and another} [1973] EA 576 (a copyright infringement case).

\textsuperscript{36} \textit{K I G Bar Grocery and Restaurant Ltd v. Gatabaki} [1972] EA 503, (CA-K).
3.5.2. **Jurisdiction.** In the present context, jurisdiction is the power of Kenyan courts to grant injunctions. Apart from any particular statutory recognition or assumption, Kenyan courts possess the equitable jurisdiction as developed in England at the Chancery.\(^{38}\)

The total English jurisdiction and procedure was received in Kenya under the doctrines of equity clause\(^{39}\) first contained in the East African Order in Council, 1897, and preserved to-day in section 3 of the Judicature Act. With regard to the jurisdiction to grant injunctions to restrain infringement of copyright, the Copyright Act, 2001, section 35(4) (a) expressly confers it on courts of competent jurisdiction.

3.5.3. **Protection of legal rights.** Of all the basic rules in injunction law, none is as fundamental as the rule that the court will only grant an injunction at the suit of anyone to protect a legal right.\(^{40}\) Copyright is such a right. It has to be a right protected under the Copyright Act, 2001.\(^{41}\) The wide use of injunctions in Kenya proves the importance of injunctions in protecting primarily property rights in general, and copyright in particular.\(^{42}\)

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\(^{37}\) For a recent study of Kenyan courts, especially their structure and jurisdiction, see Richard Kuloba, *Courts of Justice in Kenya*, Oxford University Press, 1997, especially chapter 2, pp. 24–46, with a diagrammatic representation of their hierarchical ordering at p. 46.

\(^{38}\) Invoked in Kenya under the rubric “doctrines of equity,” by 2 3(1) of the Judicature Act (Cap 8, Laws of Kenya).


\(^{41}\) See Section 51 of the Act. The only rights in respect of which an injunction in copyright can be granted are those set out in Part 3 (ss 22-34) of that Act. Hence, see the discussions and arguments in *Performing Right Society Ltd v. Grand Theatres Ltd and another* [1973] EA 576; and *Kalama Zoo Ltd v. Systems Africa Ltd* [1973] EA 242, and then on appeal as *Systems Africa Ltd v. Kalamazoo Ltd* [1974] EA 21.

\(^{42}\) The *East African Standard, Ltd v. The Coast Guardian, Ltd* (1934), 16 (1) KLR 23 (HC-K) (injunction granted for infringement of the plaintiff’s copyright); *Sapra Studio v. Tip-Top Clothing Co* [1971] EA 489 where Chanan Singh, J, said that the nature of copyright property makes an injunction the normal
3.5.4. **Locus standi.** In copyright protection the proper party will be the owner of the copyright or exclusive licensee or assignee, as is made plain by section 35 (4), and (13) of the Copyright Act, 2001. Owners of performing rights in performances assigned to them by members for the objects of, *inter alia*, enforcement on behalf of members of all their rights and remedies, have been held to have the *locus standi* to seek an injunction to restrain copyright infringement of copyrighted work.\(^{43}\)

3.5.5. **Sanction backed.** Injunctions are backed by sanctions for breach. Any person who disobeys an injunction made against him may be committed to prison, fined, have his property attached, or, in a minor disobedience, warned. Disobedience is usually treated as contempt of court.\(^{44}\) Before an appropriate sanction is imposed on the person disregarding the injunction, contempt has to be proved beyond a reasonable doubt – just as in proving a criminal charge against an accused person in criminal proceedings.\(^{45}\)

3.5.6. **Government proceedings.** Section 26(1) (h) of the Copyright Act, 2001, provides that copyright in literary, musical or artistic works and audio-visual works, shall not include the right to the reproduction of a work by or under the direction or control of the Government where the reproduction is in the public interest and no revenue is derived therefrom. Such a reproduction is not copyright infringement, and, therefore injunctive relief is locked out as a matter of *abundans cautela non nocet* (extreme caution does no remedy for copyright infringement. In general, a right that is to be protected by an injunction must be one that is known to law or equity. But in the peculiar circumstances of Kenya the legal right may be one claimed not under common law or equity, but under customary, Islamic, or Hindu, law, and if the draft proposed Constitution is passed as it now stands, Christians of all shades will be entitled to the protection of their rights under canon or other church rights, using injunction where necessary. However, copyright is outside all these regimes of law, as it is covered by the Copyright Act, 2001.

\(^{43}\) *Performing Right Society Ltd v. Grand Theatres Ltd and another* [1973] EA 576.


harm) on what is expressed in section 16 of the Government Proceedings Act by which the Government is immune to injunctive relief.\textsuperscript{46}

3.5.7. \textbf{Inadequacy of damages and other remedies}. In copyright, an injunction may be granted only if the copyright owner is likely to suffer “irreparable loss which cannot be adequately compensated in damages.”\textsuperscript{47} Thus an injunction will be granted where, as in \textit{Jiwani v. Going Out Magazine and another},\textsuperscript{48} considering the nature of the wrong, it may be very difficult if not impossible to calculate the plaintiff’s loss because of level of circulation of the defendant’s infringing product is unknown; or if 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 where the defendant is offering the infringing product cheaply or free of charge.

Where the keeping of accounts offers adequate protection, an injunction will be refused in a suit for infringement of copyright. However, account is not a sufficient alternative remedy to a temporary injunction in an action for infringement of copyright where damages are not a mere question of arithmetic.\textsuperscript{49}

3.5.8. \textbf{Lack of clean hands}. He who comes to Equity must come with clean hands. If an inequity is made out on the part of a copyright owner seeking an injunction, he will not obtain an injunction against an alleged infringer of his copyright.\textsuperscript{50}

3.5.9. \textbf{Equity aids the vigilant and not the indolent}. In copyright litigation, an injunction will not be granted to restrain infringement of copyright if the plaintiff has been guilty of undue delay in coming to the court or his conduct has amounted to

\textsuperscript{46} \textit{Matalinga v. Attorney-General}, [1972] EA 518 (HC-K). For a critique, see Kuloba \textit{Injunctions}, supra, note 16, paras 7.6.4-7.6.6., at pp. 118-121.


\textsuperscript{48} Supra, note 47.

\textsuperscript{49} \textit{Sapra Studio v. Tip-Top Clothing Co} [1971] EA 489.

\textsuperscript{50} \textit{Ibid}. In the \textit{Jiwani} case (\textit{supra}, note 47) the inequity alleged was not made out in the evidence, and so an injunction was granted to stop the infringement of the copyright.
acquiescence in the infringement.\textsuperscript{51} So delay sufficient to be evidence of abandonment of one’s right, or coupled with circumstances which make it unjust to grant an injunction results in \textit{laches} and is one which will bar relief.\textsuperscript{52} But if delay in coming to court to seek an injunction against infringement of copyright is satisfactorily explained, it will not defeat relief.\textsuperscript{53}

3.5.10. Basis for granting injunction is derivation from plaintiff’s work, not differences or similarities of works, or state of mind of defendant. In the copyright law of Kenya, it is strict liability, and the state of mind of the copyright infringer does not count in finding liability and granting an injunction where appropriate. Motive for committing infringement, or intention or innocence on the part of the infringing party does not count as a bar to the granting of an injunction to restrain a copyright infringement complained of.\textsuperscript{54}

Moreover, in a suit for infringement of copyright, the court is not concerned with the appearances and similarities of the original and allegedly infringing works, but with the derivation of the defendant’s work. So even though there is a huge difference between the copyright work and the allegedly infringing copy, it has been held by the High Court of Kenya, that it does not necessarily mean that the defendant’s work has not infringed the copyrighted work.\textsuperscript{55} According to this holding, although there is a huge difference between the works, if the court nonetheless finds that the defendant’s work derived from the copyright work, the defendant will be held to have infringed the copyright in question, and innocent infringement of a copyright is not a defence to a suit for infringement of copyright: injunction may still be granted.\textsuperscript{56}

\textsuperscript{51} Sapra Studio \textit{v.} Tip-Top Clothing Co [1971] EA 489, at p. 492.

\textsuperscript{52} Isa \textit{v.} Kanji (1868 – 1918) 1 ZLR 37, where equity would not aid a suitor coming to seek equity some ten years late and after the death of key parties in the matter in dispute.


\textsuperscript{54} Ochieng, J, in Alternative Media Ltd \textit{v.} Safaricom Ltd, High Court of Kenya at Nairobi, Commercial Courts at Milimani, Civil Case No 263 of 2004 (Oct 4, 2005), (unreported).

\textsuperscript{55} Ibid.

\textsuperscript{56} Ibid.
The point really is, that where there is sufficient circumstantial proof, it is up to the defendant to marshal facts showing independent creation or use of a common source or the plaintiff’s authority to use the copyrighted work in the manner now complained of. Similarity and differences are relevant as evidence on derivation.  

3.6. Some key principles governing perpetual injunctions in copyright cases

3.5.1. Must prove existence of legal rights. To get a perpetual injunction against copyright infringement, the plaintiff must prove the existence of a legal right. Copyright is a statutory right (conferred by the Copyright Act, 2001) and also has precedent protecting it, and is, therefore a right known to the law.

Whether the plaintiff can protect himself from the infringement depends on whether he can bring himself within the scope of the Copyright Act, 2001, and show that under the Act the work is eligible for copyright, e.g., as an artistic work, such as one having an artistic or aesthetic element and originality, and protected as such.

3.6.2. Must prove infringement or threat to infringe. Next, the party seeking a perpetual injunction to stop infringement of copyright must show either that there is an actual or threatened infringement of his copyright. Section 35(4) of the Copyright Act, 2001 provides that an injunction follows after a showing of an infringement of one’s copyright.

Accordingly, if at the trial infringement of copyright is established, the plaintiff is normally granted a permanent injunction to restrain future infringement unless, of course,


there is an equitable bar to the remedy; and it is granted only when it is shown positively that unless restrained, the defendant is likely to continue his infringement. ⁶⁰

3.7. Some key principles governing temporary injunctions in copyright cases

3.7.1. General approach in copyright law in Kenya. In Kenya the High Court has been emphatic that the general principles on which injunctions are granted for the protection of copyright do not differ from those upon which they are granted for the protection of other property, although the nature of copyright property makes an injunction a peculiarly suitable and indeed, the normal remedy in these cases. ⁶¹ This view has repeatedly been illustrated by copyright infringement cases being decided following principles laid down in different contexts. Some examples include Microsoft Corporation v. Mitsumi Computer Garage Ltd, ⁶² and Uganda Performing Rights Society Ltd v. Mukubira, ⁶³ both of which applied the principles as set out in Giella v. Cassman Brown. ⁶⁴

According to the High Court, ⁶⁵ therefore, if the granting of a temporary injunction to restrain infringement of copyright will not seriously interfere with the defendant, it may be granted although the plaintiff does not fully prove his title to the copyright alleged to be infringed or has only an equitable title, or although the quantity of the defendant’s work which constitutes the infringement has not been ascertained.

A temporary injunction will not, however, be granted where the plaintiff can be properly protected by the defendant being ordered to keep an account and the defendant might suffer irreparable injury from an injunction restraining him from publishing pending the

⁶⁰ Bwavu Mpologoma Growers’ Co-operative Union Ltd v. Gasston and Barbour and others. [1959] EA 307 (CA-U). The Court of Appeal for Eastern Africa observed that the defendants who appealed against only the quantum of damages awarded, asking that the figure be reduced, “rightly” did not “challenge the finding that they infringed the plaintiff’s copyright, nor the granting of an injunction”.


trial; nor will a temporary injunction be granted if the plaintiff has been guilty of undue delay in coming to the court or if his conduct has amounted to acquiescence in the infringement of the copyright, or there is any substantial doubt as to the plaintiff’s right to succeed.\textsuperscript{66}

While accepting these general propositions as correct law in Kenya, the High Court has explained in Sapra Studio v. Tip-Top Clothing Co\textsuperscript{67}

(a) that ordering a copyright infringer to keep an account is not a sufficient alternative to a temporary injunction where the assessment of damages, if the plaintiff succeeds, will not be a question merely of arithmetic, e.g., where there is a difference in quality between the goods sold in the allegedly copyright form by the plaintiff, and those sold by the defendant; and

(b) that irreparable loss which may result to the defendant in a suit for infringement of copyright from a temporary injunction restraining him from publishing the copyright material pending the trial of the action will, if the infringement of the copyright has been proved almost conclusively, no longer be a ground for refusing the temporary injunction.

Apart from these general propositions, there are other important principles, as set out in the paragraphs following below.

3.7.2 Purpose of a temporary injunction

"I have always understood that the whole purpose of an injunction is that matters ought to be preserved \textit{in status quo} until the question to be investigated in the suit can finally be disposed of."\textsuperscript{68}

It is granted, “not to enforce an established right, but to maintain the \textit{status quo} until a trial of the merits can take place."\textsuperscript{69}

A fuller and more informative presentation, however, is to say that temporary injunctions are normally granted for the purpose of protecting a copyright owner from irreparable loss during the inevitable delay pending the final determination of his claim against a

\textsuperscript{66} Ibid.

\textsuperscript{67} Ibid. and also see, among others, Royal Media Services Ltd v. Telkom Kenya Ltd, H C suit No 15 of 2000 (as yet unreported); and the cases cited at notes 62-64, supra.

\textsuperscript{68} Per Sir Newnham Worley, V-P, in Jammohamed v. Madhani, (1953), 20 EACA 8, at p. 11 (CA-K).

\textsuperscript{69} Cornish & Llewelyn, supra, note 10, para 2-31, at p. 68.
person infringing his copyright. These injunctions are founded on the rationale that parties to a dispute are to be enjoined *pendente lite* from taking any action which would prejudice the effectiveness of the judgment ultimately rendered on the merits of the case. In granting a temporary injunction, the court is concerned with two matters: (a) the maintenance of a position that will most easily enable justice to be done when its final decree is made, and (b) a provisional control and regulation of the acts of the parties that is, in other respects, the most just and convenient in all the circumstances for the time being.

3.7.3. “Principles” by which courts have been guided

“[I]n their enthusiasm for the merits or demerits of the main case, counsel have tended to lose sight of the principles by which both this Court and the High Court have for years been guided in deciding whether or not to grant a temporary injunction. These principles were firmly stated by Spry, V-P, in *Giella v. Cassman Brown & Co Ltd* [1973] EA 358, at 360.”

And

“I am of the view that the conditions for the grant of an interlocutory injunction are now well settled in East Africa, and I can see no reason to depart from them. These are stated in *Giella v. Cassman Brown & Co, Ltd*, [1973] EA 358, at 360.”

The “principles” or “conditions” which are said to govern the granting or refusing temporary injunctions, stated by Spry, V-P, in *Giella v. Cassman Brown & Co, Ltd*, and are slavishly cited were stated as follows:

“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.”

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72 Some judges refer to the propositions they proceed to state as “principles” (e.g. Kneller, JA, in Shitakha v. Mwamodo, (1982–1988), 1 KAR 965 at p. 970); others refer to the same propositions as “the conditions” (e.g., Mustafa, JA, in Salim v. Okong’o, [1976] Kenya LR 42, at p. 48, among many others); and yet others call them “the law regarding interlocutory injunctions” (e.g., Spry, V-P, in *EA Industries Ltd v. Trufoods Ltd* [1972] EA 420, at p. 421).


74 Mustafa, JA, in *Salim v. Okong’o, supra*, note 72, at p. 48.
In support, the learned judge cited his own earlier decision in the Kenyan case of E A Industries, Ltd v. Trufoods, Ltd. These considerations have been cited and applied in granting or withholding temporary injunctions against infringement of copyright. But in Athi Stores Ltd v. Kenya Commercial Bank Ltd the High Court of Kenya pointed out that an injunction being an equitable remedy "it bears the character of all other equitable remedies – the hallmark of a discretionary remedy – and no iron-clad strait jacket rule of unbending application can be said to apply to every case. The usual equitable considerations, discretionary factors, and worked out principles, must always be brought to bear on any given case – always ensuring that nothing is stated or acted upon so as to stultify the flexibility of this remedy.”

3.7.4. Terms, conditions and undertakings as to damages. In Kenya a temporary injunction against copyright infringement may have conditions, terms, or undertakings as to damages, attached. Order 39, rule 2A, of the Civil Procedure Rules provides that the court may grant such injunction, on such terms as to an inquiry as to damages or otherwise, as the court thinks fit. In Kenya, we have no special copyright remedy rules of procedure concerning these matters and section 1 (2) of the Civil Procedure Act applies the foregoing provisions to copyright proceedings.

In urgent cases, as it may often happen in copyright litigation, imposition of terms and conditions, and requiring undertakings as to damages saves time by enabling courts to be prepared to grant injunctions on terms as fit the case and emergency.

76 See, e.g. Microsoft Corporation v. Mitsumi Computer Garage Ltd [2001] 1 EA 127; Royal Media Services Ltd v. Telkom Kenya Ltd, HCC Suit No 15 of 2000, (unreported) (injunction against interfering with broadcasting activities and to have broadcasting equipment reconnected); and Wambugu v. A I Records (Kenya) Ltd, HCCC No 2230 of 2000 (unreported) (injunction sought but refused on Giella v. Cassman principles, to restrain criminal proceeding for infringement of copyright).
78 Kuloba, J, at Nairobi.
3.8. “Without notice” injunctions in copyright civil litigation

3.8.1. Ex parte injunction. Where the court is satisfied, for reasons to be recorded, that the object of granting the injunction against copyright infringement would be defeated by delay, it may hear the application ex parte. Order 39, rule 3(1) of the Civil Procedure Rules allows it. This is especially necessary if immediate urgency arises or if it does not appear that service on the defendant can be easily effected and it is wished to forestall threatened acts, or, indeed, if giving notice may itself alert the defendant and drive him to expedite his wrongdoing. An ex parte prohibitory injunction restraining the defendant from infringing the plaintiff's copyright in any of its computer software programs was granted in Microsoft Corporation v. Mitsumi Computer Garage. Such an application must be made promptly, setting out strong grounds, and making a full disclosure.

By Order 39, rule 3(2), of the Civil Procedure Rules, however, an ex parte injunction may be granted “only once for not more than fourteen days and shall not be extended thereafter.” And by sub rule (3) of the same rule, in any case where the court grants an ex parte injunction the applicant shall within three days from the date of the order, serve the order, the application and the pleading on the party sought to be restrained.

3.8.3. Procedural rule of practice. As a rule of practice, (a) an application for a temporary injunction to restrain copyright infringement should contain a prayer for either, directions as to service of the notice on the defendant, or, for an order dispensing with such notice, and, in the latter case reference should be made to the affidavit relied upon in support; and (b) every order made making directions as to service, should direct that service of the notice or injunction, as the case may be should be accompanied by service of the plaint if this has not previously been served.

3.9. Anton Piller Orders

80 [2001] 1 ea 127.
“Anton Piller Orders”83 are a range of mandatory injunctions which, direct the defendant to permit the plaintiff or any specified persons to enter on his premises for specified purposes, usually to inspect and take copies of, and remove, specified material or classes of material, or other property; and they may in appropriate situations, also direct that the defendant should answer specified interrogatories or otherwise provide discovery in specified respects. These kind of orders “came into being to deal with situations created by infringements of...copyright, and in particular with acts of so-called video piracy. [They are] designed to provide a quick and efficient means of recovering infringing articles and discovering the sources from which the articles have been supplied and the persons to whom they are distributed before those concerned have had time to destroy or conceal them.”84

The power to issue these orders are now provided in section 37(1) of the Copyright Act, 2001. By sub-section (2) of the same section, these orders may be made ex parte, thus enabling a copyright owner to apply to the court in camera without any notice to the defendant, thereby in effect allowing a plaintiff to launch a surprise attack on the defendant.

This form of injunction can be so effective that it is likely going to be an established weapon to combat copyright piracy. As a pre-emptive order amongst anti-piracy remedies, it is what is needed in copyright enforcement.85

Some of the well-known instances where this procedural remedy has been put to use include the case of Oduor v. Colourprint, Ltd and Textbook Centre, Ltd86 The plaintiff sought an order for search and seizure. It was granted, permitting him to enter the premises of various bookshops and inspect and photograph all documents or equipment.

83 Relief by these Orders is named after the English case in which the English Court of Appeal first gave consideration to the conditions under which such an order could be granted, namely Anton Piller K.G. v. Manufacturing Processes Ltd [1976] 1 Ch 55.


85 Compare this procedure with the power under Order 39, rule 7(1), to order “detention, preservation, inspection” of the subject-matter of the suit, as to which see Kuloba Injunctions, supra, note 16, paras 7.12.1–7.12.3, pp. 157-165, and the local cases there referred to.


Similarly, in *Microsoft Corporation v. Mitsumi Computer Garage, Ltd.*,87 simultaneously with the filing of a suit for alleged infringement of its computer program, the plaintiff moved the court *ex parte* under a certificate of urgency for an *Anton Piller* order. On being satisfied of *prima facie* merits of the application, the court granted the order allowing the plaintiff to enter the defendant’s premises to seize and inspect all computers and other equipment which allegedly contained or could contain pirated computer software, all purchase and sale records for the past one year and other records which constituted or could constitute evidence in the trial of the action. The plaintiff’s advocates went to certain premises and in purported execution of the order carted away fifteen computers, executing the orders against a person who was not a party to the suit and to whom the order was not directed.

On subsequent *inter partes* proceedings, it was held that the plaintiff had not made out an extremely strong *prima facie* or even any *prima facie* case at all for an *Anton Piller* order or any other kind of injunction against the defendant. Neither infringement nor likelihood that evidence of infringement would be destroyed was in evidence. Moreover, as the order was executed against a wrong person who had not been a party to the application and against whom the order was not directed, there had been a clear violation of constitutional rights of a non-party, a trespass to goods, and abuse of process of the court, the orders were discharged.

Having regard for what happened in the *Microsoft* case “the draconian power”88 given by section 37(1) of the Copyright Act, 2001 to issue this type of order in copyright cases needs to be hemmed in by proper safeguards and a strict application of the principles governing the exercise of the power. These principles were set out in the *Microsoft* case itself stated in the form of essential pre-conditions to the making of the order in copyright

87 [2001] 1 EA 127.
cases. There must be made out an extremely strong prima facie case for an Anton Piller order by showing that the plaintiff's copyright is being infringed by the defendant. The existence or otherwise of a prima facie case is to be judged on the evidence adduced and not on pleadings or statements by counsel. The potential or actual damage which the alleged infringement will cause to the plaintiff must be very serious to him. There must be clear evidence that the defendant has in his possession incriminating documents or things, and there is a real possibility that the defendant may destroy such material before any application 'inter partes' can be made. The applicant must make full disclosure of material facts. The application must have been made in good faith. There must be no abuse of the court process. The inspection must do no harm to the defendant or his case; nor be a trespass or violation of his constitutional rights. The court will normally want to be satisfied that the plaintiff is good for any damages which might ultimately be ordered against him on the undertakings in damages that he should give as a condition of the order.

3.10. Conclusion

3.10.1. Qualification of principles of injunctions in the protection of copyright is required. It is a well founded observation that the law of injunctions is beset with over-general propositions that require qualification in particular areas of application. This is particularly true of the area of copyright. There are certain considerations which are only appropriate in the context of copyright infringement proceedings and not for proceedings in respect of other proprietary rights. These special aspects may be recapitulated in brief for convenience and expounded upon as summarised in the following paragraphs (3.10.2-3.10.8).

3.10.2. Normality of the remedy in copyright. Where in many other areas an injunction is perceived as an "extraordinary remedy", there is a general acknowledgement that injunction is a peculiarly suitable, and, indeed, "the normal

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89 Per Cornish & Llewelyn, supra, note 10, para 2-31, at p. 68.
90 See, e.g., Kneller, J (as he then was), in Nyakinyua & Kang’ei Farmers’ Co, Ltd v. Kariuki & Gathecha Resources, Ltd, HCCC 1020 of 1976 (Nairobi), (unreported).
remedy" for copyright infringement, and it is acknowledged that "the most important remedy for infringement of copyright, rights in performances and design is an injunction."\(^9^2\)

There are key reasons for an injunction being the principal remedy in copyright infringement cases. They include these considerations. Although courts may, in proper cases, award damages *in lieu* of injunction, award of damages may enable a copyright infringer compulsorily to purchase the right to infringe copyright at will and pay money awards. In the next place, the plaintiff specifically wants a particular unique position to obtain: his economic and moral rights to remain intact – only an injunction, and not damages, gives him that, and hence it is the peculiarly suited and normal remedy for that in copyright protection. Injunction is then the most popular antidote against copyright infringement.

3.10.3. Special jurisdictional and statutory limitations in copyright cases. Sections 23(1), 24(1) and 26(1) of the Copyright Act, 2001, conferring copyright by virtue of nationality or residence in Kenya, and by reference to the country of origin being Kenya, and by defining the nature of copyright in literary, musical or artistic works and audio-visual works, as being the right to control the doing *in Kenya* of any of the acts defined in section 26(1), give a limiting complexion to the extent of the jurisdiction to grant an injunction.

What is certain from a reading of these statutory provisions, however, is that infringement of copyright committed abroad by a defendant domiciled in Kenya, in respect of activities elsewhere, the plaintiff may pursue his case in Kenya in respect of alleged infringements of, say, architectural copyright by construction of a building outside Kenya.\(^9^3\) These geographical limitations of injunctive relief do not obtain in


\(^{92}\) *Copinger and Skone James*, *supra*, note 9, para 22-55, at p 1018. And it is "the most appropriate remedy to restrain the infringement" of copyright: *Pettit supra*, note 84, at p 581.


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other forms of property (indeed, quaere, rights of performers under section 30 as read with section 35 (2) (b) which contains no specific reference to “in Kenya”).

Finally, there is an express statutory ouster of the court’s power to grant injunctions against infringement of copyright in relation to building plans. It is expressly provided in section 35(7) of the Copyright Act, 2001, that no injunction shall be issued in proceedings for infringement of any right protected under the Act which requires a completed or partly built building to be demolished or prevents the completion of a partly built building. By section 2 “building” includes any structure. But as to when a building is “completed” or “partly built”, can present difficult questions of interpretation. Nor does “any structure” help in any understanding of terms in remedial questions.

Thus, in the Ugandan case of Bwavu Mpologoma Growers’ Co-operative Union Ltd v. Gasston and Barbour and others, an injunction was issued to restrain the defendant and third party from making any further use of copyright infringing plans for the design and layout of machinery for use in a coffee factory. Sembly if the layout had begun, or proceeded to a point, they would not be dismantled or destroyed: but they could be completed on different plans.

3.10.4. Exercise of discretion in copyright infringement litigation. Although like in all cases calling for equity to intervene, the power to grant an injunction prohibiting a person from committing or continuing to commit infringement of proprietary rights in general is discretionary, in practice in the area of copyright protection “the discretion is normally exercised in favour of a claimant who has succeeded at the trial even though no quantifiable damage has been suffered.” Indeed, it has been observed by a leading commentator on the subject in the context of temporary injunctions, that although in the exercise of discretion a showing of irreparable harm is normally required, in the case of copyright infringement “courts have held that such harm may be presumed when the

plaintiff makes out a *prima facie* case of infringement.” So, as it has been pointed out by an expert, generally a copyright owner can get a temporary injunction upon making out “a *prima facie* case of its copyright’s validity and infringement.” That is all.

3.10.5. Respective burdens on the parties, and the nature of evidence expected on each side on application for a temporary injunction in copyright cases. More than what are stated in the terse statements in the Kenyan cases as the “conditions” for granting a temporary injunction, the parties have greater burdens in copyright cases (and indeed in other cases) than what those presentations convey.

Thus, in a normal application for a temporary injunction to stop infringement of copyright, the plaintiff will be out to (a) identify the subject matter of the right within the Copyright Act, 2001; (b) to show that the right subsists in the subject matter and is owned or exclusively licensed or assigned to him within the Act; (c) identify the alleged infringement and the defendant’s connection with it, infringement being as defined in the Act and not being a uniform act for every form of subject matter; (d) demonstrate that he has come to court promptly and with the minimum of delay; (f) furnish reasons why he thinks he cannot be adequately compensated by damages at the trial (although this is not an inflexible requirement in these cases); (f) give reasons, if possible, for saying that the defendant would be unable to meet an award of damages at the trial; (g) proffer reasons why the defendant would be adequately compensated by the plaintiff’s undertaking in damages; and (h) show evidence that he will be able to pay damages to the defendant on the undertaking in damages if necessary.

In the orthodox formulations of the so-called “the conditions” for granting temporary injunctions, these requirements are not brought out; and yet, in copyright practice if injunctions are not to be just there for anyone’s taking, these requirements must be

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insisted on, many of them being clearly necessary under the Copyright Act, 2001, and in the cases. 98

The defendant, on the other hand, on an application for a temporary injunction by the plaintiff to restrain copyright infringement will be (a) denying the subsistence or ownership of the copyright; (b) denying copyright infringement, with evidence to support the denial; (c) calling evidence to show that the plaintiff has delayed unreasonably in bringing the matter to court; (d) offering reasons why the plaintiff would be adequately compensated by damages at the trial; (e) providing evidence to show that he would be in a position to pay damages at the trial; (f) offering reasons why it would not be possible to compensate him adequately by a money order on the plaintiff's undertaking in damages if the temporary injunction is granted against alleged infringement of copyright and it turns out that it should not have been granted in the first place; (g) offering reasons why the plaintiff will be unable to pay damages to the defendant on the undertaking in damages. 99

Once more, the orthodox formulations are utterly silent on these matters. But in copyright cases they cannot be ignored or glossed over. They are central inquiries. 100

3.10.6. Duty of disclosure. As temporary injunctions are frequently granted in the absence of the defendant where extreme urgency and justice demand, or where there is a real risk that the defendant would take steps to frustrate the remedy if forewarned, a plaintiff who applies for an ex parte injunction to restrain alleged copyright infringement carries a heavy burden to make full and frank disclosure to the court of all material matters known to him or which he could have ascertained by reasonable enquiry which

98 See, e.g. Jiwani v. Going Out Magazine and another [2002] 1 KLR 856, saying that, in addition, if inequity is made out on the part of the plaintiff, no injunction will be granted.
99 These heads of evidence on the part of the defendant, and those on the part of the plaintiff, are adapted from the plaintiff's "checklist of evidence" and that of the defendant, tabulated in Laddie, Prescott, Vitoria, Speck and Lane, 2 The Modern Law of Copyright and Designs, 3rd edn, Butterwaths, 2000, para 39.67, at pp. 1819–1820, which appear to have been the underlying considerations in the issues raised, assumptions made, and the holding, in the recent case of Alternative Media, Ltd v. Safaricom, Ltd, High Court of Kenya, at Nairobi (Milimani Commercial Courts), Civil Case No 263 of 2004, Ochieng, J (October 4, 2005).
100 They constitute some of the defences in copyright infringement cases, as to which see, inter alia, 1 Copinger and Skone James on Copyright, supra, note 24, paras 22-30 – 22-48, at pp. 1007–1016.
might tell in favour of the defendant. A failure to make a full and frank disclosure may cause the court to set aside the order irrespective of the other merits. But the power to dissolve the order is discretionary, and the court may decline to set aside the order despite want of full disclosure if the defendant has not sustained prejudice or if it would be contrary to the requirements of justice, although the plaintiff may be penalised in costs.

### 3.10.7. Malleability of form of injunction in copyright

Injunctive relief is malleable to fit the circumstances of a given case. Thus, where the whole of the work or product of the defendant is an infringement of the plaintiff’s copyright, like where it is a slavish copy, the injunction will prevent the entire product or other dealing in it. If part is infringing and part is not and the parts are separable, the injunction will limit the infringer to produce and deal in the non-offensive part. In the words of an authority, “where only part of a work has been copied, and the part which has been copied from the plaintiff’s work can be separated from that which has not been copied, an injunction will be granted only against the objectionable part or parts.”

Difficult questions of fairness arise where the parts of the pirated work and those of the infringing one are so intermingled that they cannot be separated without destroying the use and value of the original matter. One view is that the whole work must be stopped even where a very large proportion of the pirate work is unquestionably non-infringing, because “he who has made an improper use of that which did not belong to him must suffer the consequences of so doing, and an injunction will be granted against the whole.” It is, however, submitted that in keeping with equity’s concern for fairness and dealing with cases on their particular circumstances, the better view seems to be one

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102 For a judicial statement on the duty of disclosure and the consequences of non-disclosure, see the leading case of Uhuru Highway Development, Ltd v. Central Bank of Kenya, CA Civ App Nai 140 of 1995

103 Copinger & Skone James, supra, note 9, 16, para 22-88, at p 1052, citing Jarrold v. Houlston, (1857), 3K & J 708; and Lamb v Evans, [1892] 3 Ch 462. A fitting example at home here is the injunction in Alternative Media, Ltd v. Safaricom, Ltd, supra, note 99, where the injunction restraining the defendant from infringing the plaintiff’s copyright was limited to the use of the photographs of a man playing drums, but not affecting any of the many other features on the defendant’s scratch-cards as a medium for communicating AIDS awareness.

104 Copinger & Skone James, supra ,note 9, at p. 1053.
which allows for exceptions where the infringing portion is very small and trivial compared with the non-infringing part and the harm caused to the plaintiff by continued distribution of the infringing work would be insignificant.\textsuperscript{105}

In \textit{Dun v. Lumbermen's Credit Association},\textsuperscript{106} the Supreme Court of the United States of America, faced with a case where the infringing and non-infringing elements could not be separated and the copyrighted elements were comparatively a small part of the defendant's work, observed:

"the proportion is so insignificant compared with the injury from stopping the [defendant's] use of their enormous volume of independently acquired information, that an injunction would be unconscionable. In such cases, the copyright owner should be remitted to his remedy at law."

In such a case the discretion of the court would be wisely exercised in refusing an injunction and award damages or profits. The equities must always be balanced.

\subsection*{3.10.8. A most efficient civil remedy in copyright law in Kenya.} The brief survey of some of the salient aspects of injunction law in the field of copyright shows, among other things, that an injunction is a most expeditious, effective and "the most efficacious remedy for infringement of another's copyright",\textsuperscript{107}

From the point of view of the plaintiff one great advantage offered by the remedy of injunction in copyright is speed and, in appropriate situations, secrecy where forewarning the defendant may be disastrous. The plaintiff can apply for a temporary injunction at anytime, even before the filing of a suit to secure and protect the interests of justice\textsuperscript{108} before the actual trial of the suit, with the object of freezing the present situation and prevent the defendant from presenting him with a \textit{fait accompli}.

\textsuperscript{105} Laddie, Prescott, Vitoria, Speck and Lane, \textit{supra}, note 1, para 39.38, at p. 1791.
\textsuperscript{106} 209 US 20, at pp. 23–24.
\textsuperscript{107} Jiwani \textit{v.} Going-Out Magazine and another \cite{Jiwani_v._Going-Out_Magazine_and_another_2002} 1 KLR 856.
\textsuperscript{108} Theuri \textit{v.} The Law Society of Kenya HC Miscellaneous Civil Application No 33 of 1984; and Gachara \textit{v.} Kahura HC Miscellaneous Civil Application No 267 of 1996, where the inherent jurisdiction of the court was invoked. But for an application for an injunction under Order 39 of the Civil Procedure Rules there has to be a suit first filed, although a failure to conform to this requirement is not necessarily fatal. See Royal Media Services Ltd \textit{v.} Telkom Kenya Ltd, HCC suit No 15 of 2000.
Whilst ordinarily money is a palliative for copyright infringement, there comes a time when money is just beside the point and the quantum of an award does not count. Heavy monetary compensation awards commonly evoke revulsion and condemnation.\textsuperscript{109} Damages are in the realms of lottery, with figures to be awarded often simply being “plucked from the air”.\textsuperscript{110} They come too slowly. There are no interlocutory damages to cope with emergencies. In copyright infringement moral rights are emotive and can be immeasurable in money atonement. Damages cannot be pre-emptive; they cannot be awarded \textit{in camera}. That remedy, irrespective of how much money can be awarded under it, lacks the beneficial flexibility of an injunction, for, with damages the formula is: right + infringement = damages; with injunctions it is right + infringement – discretionary bars = a tailored injunction.

For the foregoing reasons, injunctions remain king as expeditious and effective remedies and procedures against infringement of copyright, thereby contributing a great deal to the practical efficacy of copyright. This remedy is a great anti-piracy and anti-counterfeit measure. It is a centrepiece in procedural and remedial jurisprudence.

Does it require improvement? Yes. In many respects. It needs to be freed from the shackles of section 16 of the Government Proceedings Act insulating Government from injunctive relief. The requirement under Order 39 rules 1 and 2 that a temporary injunction be in a “suit” requires to be dispensed with. Sometimes to wait until a suit is filed in the prescribed manner can render relief too late where infringement is immediate and extensive. There is a need to reconsider the absolute statutory bar to the granting of any form of injunction requiring “a completed or partly built building to be demolished” or preventing the completion of a partly built building.

Jurisdiction should not be pegged solely on residence or domicil in Kenya or works in Kenya. It should be founded upon service of process upon the infringer and the ability to

\textsuperscript{109} Kneller JA said that inordinately high awards “will lead to monstrous” results: \textit{Hassan v. Kamau Transporters} (1982-88) 1 KAR 946, at p. 948.

enforce the court judgments. The sanctions for breach of an injunction are plain. The breach is a contempt of court attracting well-known sanctions. But the procedure to obtain committal for contempt of court is shrouded in uncertainty. It needs to be prescribed in the rules of court or under the Copyright Act, 2001 with specific reference to copyright litigation.

Order 39, rule 3(2) and (3) of the Civil Procedure Rules, require a critical re-evaluation. To provide that an ex parte injunction shall be limited to a non-extendable fourteen-day period can be dangerous in the context of copyright infringement. If an infringer dodges service and continues infringement beyond the fourteen days and the injunction expires, there can be an injustice. The requirement that the injunction, the application and the pleadings must be served within three days of the order can defeat the essence of surreptitious moves which may sometimes be necessary, unless such an order is perforce also accompanied by an Anton Pillar order. There should safeguards in this rule. It had better be left to the judicial discretion of the court with regard to the details concerning the duration of the order, and with regard to the wisdom of service.

The pre-trial relief by way of Anton Pillar orders permitting search orders to go forth is a powerful and draconian contrivance in the law’s arsenal. Salutary in many respects as already seen in its discussion (at para 3.9), if it remains rudderless as it is at the moment in the Copyright Act, 2001, it poses the danger of impinging on some of the constitutional guarantees, such as the individual rights to privacy, and the prohibition against unwarranted searches. The usual defences and privileges concerning privileged communication, or the rules as to self-incrimination, seem to be threatened. Full guidelines on the scope, working and practical application of Anton Pillar orders should be promulgated in the rules of court before an opportunity presents itself for a comprehensive judicial statement.

Otherwise, injunction is first class as an expeditious and effective judicial civil remedy against infringement of copyright in Kenya. It is a core remedy enabling copyright to achieve its objectives of providing necessary incentive to create, disseminate, and
commercialise works of authorship. Once an injunction is granted an infringer has two limited choices: abandon infringement, or obtain a necessary licence. Hence, there is "a fairly widespread consensus that an injunction... is the appropriate remedy in most cases in which" infringement of copyright is proved, and "most of the time, the prevailing plaintiff in a copyright infringement action obtains an injunction."\textsuperscript{111}

CHAPTER 4

DELIVERY UP IN COPYRIGHT CASES IN KENYA

4.1. The place of delivery up in copyright cases

The remedy of delivery up is one of those remedies which have been regarded as "not central remedies," and it has been said that "what needs to be said regarding them is relatively limited," and for this reason it has sometimes been relegated to a "single residual chapter," along with a motley of relatively minor matters, assigned very little space in major works. But in Kenya's copyright regime Parliament has assigned the remedy of delivery up a key role in the judicial civil remedial scheme and procedure. Section 35(4) (b) of the Copyright Act, 2001, provides that infringement of any copyrighted work which is protected under the Act is actionable at the suit of the owner of the copyright, and in an action for infringement the plaintiff has available to him, among other reliefs:

"delivery up to the plaintiff of any article in the possession of the defendant which appears to the court to be an infringing copy, or any article used or intended to be used for making infringing copies".

In other words, in a proper case, the defendant may be required by the court to deliver up to the plaintiff the offending material in his (defendant's) possession. Indeed, for this
purpose, the plaintiff may be granted an order to search the premises of the infringing defendant and seize the infringing material, invoking section 37(1) allowing the granting of Anton Piller orders.

Considering that Parliament provides that it is one of the remedies which a court may grant for copyright infringement, it should be accorded an extended study in any work on judicial civil remedies for copyright infringement in Kenya.

4.2. What is delivery up in copyright cases in Kenya?

As a remedy, delivery up in discussions of copyright infringement is a decree of the court requiring the defendant who has in his possession, custody or control in the course of business for business purposes, infringing articles or offending implements, to transfer them to, or allow them to be taken by the plaintiff into his custody, possession or control. In the context of copyright infringement, and counter piracy measures, the court may decree that infringing articles, copies, documents or anything designed or adapted for making unauthorized copies of the work of the owner of copyright be delivered up to him. Failure to comply with the decree and deliver up as dictated by the court would be met by an appropriate legal sanction to enforce the coercive decree under the normal rules of court.

4.3. Nature of the remedy in copyright

Delivery up is a positive decree, in aid of the plaintiff to recover desired articles or things and have them in his possession, custody or control. It is a discretionary remedy. Although normally delivery up is a final relief, in principle it can be granted as a temporary and provisional, pre-emptive precautionary measure so that the allegedly infringing articles are kept for safekeeping in the custody of the plaintiff or (normally) his advocate pendente lite. In such a case, the plaintiff will normally be required to give an

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3 Thus, in Bwatu Mpopoma Growers' Co-operative Union Ltd v. Gasston and Barbour and others [1959] EA 307 (CA-U), upon infringement of copyright in certain plans for the design and layout of machinery established, the relief by delivery up of infringing copies of the plan was granted.

4 In exercise of its discretion the court will not grant the decree of delivery up if the decree will cause disproportionate harm to the defendant and is unnecessary to safeguard the legitimate interests of the plaintiff: Ocular Sciences Ltd v. Aspect Vision Care Ltd [1997] RPC 289.
undertaking to keep the material safe pending trial. At the end of the trial after the parties have been heard on their respective merits, and the plaintiff prevails, the court may grant delivery up as final judgment resulting in a decree.

4.4. Object and purpose of delivery up in copyright

The remedy of delivery up is commonly in aid of other remedies such as injunction and damages. For instance, it ensures that the defendant is denied the opportunity and the means of putting the infringing material into circulation in breach of an injunction. It prevents and protects the public being deceived by a free circulation of infringing articles, materials, documents, or performances. By keeping the infringing materials off the market, the order or decree prevents prejudice to the plaintiff’s economic position or moral rights. The remedy is not based on any notion that the infringing materials belong to the plaintiff; rather, the basis is that the plaintiff’s rights need protection by preventing their unauthorized use by the defendant. The relief should, therefore, be limited to what is necessary to protect the rights of the plaintiff, and not to be used as a punishment to the defendant. However, although cases have not been discovered where delivery up of infringing articles was sought without other remedies being asked for, it is an independent remedy, and it does not always have to be asked for and granted as merely a consequential relief.

5 For the jurisdiction to make an order for delivery up on interlocutory application if there is a high degree of assurance that the plaintiff will establish his entitlement at the trial and the risk of injustice if the order were refused outweighs the risk of injustice if granted, see Nottingham Building Society v Eureodynamics Systems Plc [1993] FSR 468.


8 In Brough’s case, supra, note 3, it was sought and granted as a consequential relief. The main relief sought and granted there were damages for infringement of copyright.

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4.5. Jurisdiction in copyright cases

4.5.1. Statutory delivery up. There is a statutory power given to the court to grant the remedy of delivery up under section 35 (4) (b), of the Copyright Act, 2001. The power to grant the remedy as donated by this section therefore takes on a statutory nature.

It seems that the provision extends only to cases where the article is in the possession of the defendant, and the article is an infringing copy or something used or intended to be used to infringe copyright. This being the case, the provision does not provide for temporary delivery up. Such a power is already possessed by the courts in their inherent jurisdiction to make temporary orders in the interests of justice, and it would have been superfluous to make another provision purporting to confer a power already possessed by the courts. Moreover, the section is itself unequivocal by expressly indicating that the article must be an infringing copy, and not one merely alleged to be infringing, and unless it is infringing, delivery up cannot be decreed. This means that under the Act, the court will have made a finding on the allegation and found infringement established before it issues the remedy after trial. Cases on this are yet to be decided.

But this is plain from the enactment itself: a court cannot know an article is an infringing copy unless and until it has, after the trial, found it to be so, and the only way to make such a finding is holding a trial or by default judgment or judgment on admission. The absence, in the section, of any requirement for the giving of undertakings in damages as a price for getting statutory delivery up further re-enforces this line of thinking that there is no provision for temporary statutory delivery up under this provision in the Act. Finally, the statutory remedy seems limited to the specific recovery of the material and no more. So, the statutory power does not extend to destruction or cancellation available in equity as explained next.

4.5.2. Delivery up of copyright infringing articles for destruction in equity. Under the common law system of justice, there has always been a well recognized head of

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equitable jurisdiction to order the delivery up and cancellation of documents or destruction of articles made in infringement of the plaintiff’s rights, or in some cases the destruction of the means of making those articles or documents, under the inherent jurisdiction of the court¹⁰ which is thoroughly established by decisions to be found on the books.¹¹ The statutory remedy is without prejudice to any other power of the court, for although by section 51 of the Copyright Act, 2001, common law copyrights were abrogated, equitable remedies did not suffer similar abrogation. Since courts already possessed the power to order delivery up for destruction, this power was in the package of received law under the emblem “doctrines of equity”¹² No statute has modified them. No special local circumstances render this remedy inapplicable to copyright protection measures.

A good example of where a court ordered delivery up for destruction exercising inherent rather than statutory power, is the well known case of *Brooke Bond Kenya Ltd v. Chai Ltd.*¹³ The plaintiff and the defendant companies packed tea for sale to the public. The defendant company changed some of its tea packets to make them more nearly resemble those of the plaintiff company. It was found that the said packets were likely to cause confusion with those of the plaintiff. The Court of Appeal ordered the defendant company to deliver up to the plaintiff company all packets of whatever size similar to the packets of the plaintiff company for destruction. This decision was not based on any statutory provision but on the inherent jurisdiction of the court to order delivery up for destruction. It is submitted that the same power is possessed by the courts with regard to articles infringing copyright.

### 4.5.3. Some distinguishing features between statutory and equitable jurisdictions.

Some aspects about each jurisdiction stand out for notice. For instance, the jurisdiction


¹¹ Eg those cited in note 2, *supra*. They are books covering doctrines of equity which apply in Kenya on the authority of the Judicature Act (Cap 8), section 3(1).

¹² The Judicature Act (Cap 8), s 3(1).

¹³ [1971] EA 10, a case on trade mark infringement and passing off, but the principle and the power is not restricted to those cases only, and would apply with equal force in copyright infringement.
under statute deals with final decrees only, and, as such the court cannot issue the decree ex parte, and the defendant is entitled to an adversarial hearing unless the court is proceeding under the default process. In equitable jurisdiction, however, in cases of urgency and only as a precautionary measure, delivery up may be ordered ex parte, as with temporary injunctions and analogous to *Anton Piller* orders. This is permissible because the power is donated by equity via the Judicature Act.

Another quickly noticeable distinction is that under the statute, the court may order delivery to the plaintiff rather than order destruction. Delivery up under the inherent powers given by equity will only be ordered to enable the plaintiff to make sure that copyright infringing articles are destroyed or obliterated. The Act does not highlight destruction, although the purpose may be implicit. A further distinction is that delivery up under the inherent jurisdiction is not limited to articles which are copyright infringing copies or devices used for making such copies (as is the case under the statutory jurisdiction). It extends to any article created by means of a breach of the proprietary right.14

4.6. General principles affecting granting or refusing delivery up in copyright

4.6.1 The jurisdiction of the court is discretionary. In considering whether delivery up or delivery up for destruction is appropriate for copyright infringement, the court may take into account a number of factors which may be relevant and proper to consider. Thus, the court may take into account whether other remedies available and less drastic in an action for infringement of copyright would be adequate to compensate the owner, and protect his interests. One ready example of where the other remedies might be inadequate is where the defendant is bankrupt or otherwise unable to pay damages.15

Even where damages are inadequate delivery up may still be refused in certain circumstances on account of discretionary factors or equitable doctrines operating in a given case of copyright infringement. Thus, the courts may deny the remedy because of

the conduct of the plaintiff, such as acquiescence or unclean hands, or unconscionable
delay.\textsuperscript{16}

### 4.6.2. Remedy unavailable against Government

By section 16(1), proviso (ii), of the Government Proceedings Act, in any proceedings against the Government for copyright infringement the court shall not make an order for delivery up, but may \textit{in lieu} thereof make an order declaring that the plaintiff is entitled, as against the Government, to possession. This provision cuts out the remedy as against the Government, and this means that delivery up cannot be ordered or decreed against the Government for copyright infringement. Cases for delivery up have not yet been decided in Kenya in the context of copyright infringement against the Government.

### 4.6.3. Delivery up in copyright not to cause disproportionate harm to defendant or to be oppressive

Delivery up will not be ordered or decreed for copyright infringement where the effect is disproportionate and would cause greater harm than is necessary in order to safeguard the legitimate interests of the plaintiff,\textsuperscript{17} or where delivery up would merely be a commercial nonsense and not in the interests of justice, e.g. where there will soon be compulsory licensing of the defendant and any advantage to the defendant in being able to retain infringing copies can be reflected in an inquiry as to damages.\textsuperscript{18}

### 4.7. Multiple interests in infringing work

Section 35(13) of the Copyright Act, 2001, defines "owner of the copyright" as the first owner, an assignee or an exclusive licensee, as the case may be, "of the relevant portion of the copyright."

This being the statutory position, it is possible to envisage one serious practical problem, and it is this: more than one person can have an interest in infringing copies. A ready example is of an infringing CD, wherein the owner of the copyright in the music, in the

\textsuperscript{16} In \textit{Brooke Bond Kenya Ltd \textit{v. Chai Ltd} [1971]} EA 10 undue delay was raised as an issue but not having been proved, delivery up for destruction was granted. There was no question that if established undue delay would bar an order or decree for delivery up or destruction.

\textsuperscript{17} \textit{Ocular Sciences Ltd \textit{v. Aspect Vision Care Ltd & others} [1997]} RPC 289.

\textsuperscript{18} \textit{Valeo Vision SA \textit{v. Flexible Lamps Ltd} [1995]} RPC 205.
words, in the sound recording, and in the performance (such as the performers) and the record company, are all interested and rights-owners of different aspects. So can be the case with a poem, and many other examples.

Clearly, it would be arbitrary to decree delivery up for the exclusive benefit of whichever of these "owners" of copyright is the first to apply for an order of delivery up. Unfortunately, the Act falls short of providing a procedure by which these matters may be sorted out before the ultimate fate of the goods can be decided.

Moreover, there is no statutory procedure in the Act requiring service of notice on other persons who might be interested, or to all them, served or unserved, to appear. Nor is there any requirement on the plaintiff to wait for any period before he deals with the articles delivered up as he wills. Other owners interested can be surprised and prejudiced.

4.8 No delivery up against third persons

Section 35(4) (b) of the Copyright Act, 2001, is restrictive in one respect with regard to the persons in whose possession the article to be delivered up to the plaintiff is vested. The section provides that a plaintiff has available to him the remedy of delivery up to him of an article "in the possession of the defendant" which appears to the court to be an infringing copy, or an article for making infringing copies. On a reading of that provision, it means that delivery up may not be made against third parties who have come into possession of infringing copies or articles, particularly persons who are not servants or agents of the defendant.

19 Rival claims can be made by owners of performance or recording rights (s 28 for sound recording, and s 30 for rights of performers); owners of design rights; owners of trade marks which have been counterfeited (Trade Marks Act, Cap 506); and third party owners of chattel property, e.g. blank tape which was used to make the infringing copies, each of whom has had his right infringed.
4.9. Illustrative use of delivery up and destruction in copyright infringement

That the remedy of delivery up is a well-known remedy and in use in this country may easily be illustrated by decided cases. Thus, for example, in *Brooke Bond Kenya Ltd v. Chai Ltd.*, Spry, Ag P, ordered the defendant to “deliver up all packets of whatever size” similar to those of the plaintiff “to Brooke Bond for destruction”, and in case there was difficulty in implementing the order, there was liberty to either party to apply to the court.

In *Systems Africa Ltd v. Kalamazoo Ltd.*, the High Court ordered the issue of an injunction to restrain the defendant from reproducing or selling any of the twelve specified forms and cards, and ordered the defendant “to deliver up all plates used or intended to be used for the making of copies thereof, and all stocks of such copies”. Although on appeal the judgment was reversed on other points, the jurisdiction to grant this remedy and its availability in proper cases was not an issue.

In *Alternative Media Ltd v. Safaricom Ltd.*, the plaintiff was granted an injunction to restrain the defendant from infringing the copyright, and the defendant was ordered to destroy, upon oath, all infringing copies of the scratch cards.

Apparently, the courts either exercise the equitable jurisdiction to order destruction, or read that power into the statutory provision which talks of only “delivery up”.

4.10. A mop in the scheme of remedies in copyright cases

The illustrative cases seen in paragraph 4.9 above suffice to point to a conclusion that as a copyright enforcement measure, the remedy of delivery up or delivery up for destruction is often used as a mopping operation after other remedies granted. In those
cases delivery up, or delivery up for destruction, is an adjunct to a final injunction, damages or account of profits. It seems that the idea of the remedy after injunction and other remedies granted, is to ensure that the copyright infringer is not tempted to put the infringing copies or articles into circulation in breach of an injunction, or after payment of damages or disgorgement of profits.

4.11. Conclusion

Here is a twin jurisdiction: one twin thoroughly established in equity to direct delivery up for destruction, cancellation or obliteration; the other twin a creature of statute for delivery up to the plaintiff.

Delivery up is limited to what is necessary for the protection of the copyright of the plaintiff; it is not a hammer to punish the defendant.

From the decided cases seen and cited above, a copyright owner is normally not satisfied with a mere award of damages, or an injunction stopping further infringement, or an account of profits, when the infringing articles or tools of infringement remain in circulation and doing rounds. So, delivery up to the plaintiff, or delivery up for destruction helps to remove the offending things from the market.

Clearly useful. It expedites the final settlement of disputes, in that it saves the plaintiff from having to return to the court because the defendant is using old stock to violate the plaintiff’s rights. Upon delivery up or destruction, the defendant is denied the incentive to engage in further infringement. That way, the remedy is a very effective relief in combating copyright infringement.

This is not to suggest that there is no room for improvement. As noted above, the statutory delivery up seems limited to delivery up to the plaintiff even without warning to other persons who have interest in the infringing articles. This may have potential for other people afterwards laying claim against the plaintiff and thereby re-open litigation, thus defeating the overall objective of expeditious and efficient disposal of disputes. A
procedural requirement needs to be in place for bringing on board everyone interested in the infringement, so that appropriate apportionment of justice is made in respect of everybody once and for all.

As regards the equitable jurisdiction, it is a drawback to limit it to having destruction as the aim for delivery up. One hopes that the normal characteristic of equity as a system which champions flexibility to cater for individual situations will always be considered so that on final decree, the court may order destruction or other reasonable disposition of the infringing articles. Indeed, although destruction of the infringing articles is available as a remedy, it should not be the favoured solution. The court should more often choose other dispositions, such as ordering the articles sold or delivered to the plaintiff, to serve the ends of justice and avoid needless waste.

There is a need to clarify, either by definition or a separate provision, whether the statutory “delivery up” includes the power to destroy or dispose of in some other manner. The point has not been decided by the courts, but it is submitted that since Kenyan courts possess equitable jurisdiction as well as statutory and other jurisdiction, the statutory delivery up of infringing articles and infringing copies includes their delivery up for the purposes of destruction and disposal. It does not seem to be the intention of Parliament that in enacting section 35(4) (b) it intended to saddle the plaintiff with infringing matter on his laps for ever. It was to ensure that the infringing copies or articles are ultimately disposed of as the plaintiff may deem fit. But an express statutory provision saying so, or empowering the court to direct the fate of the copies and articles delivered up, is required.

Indeed, delivery up need not be “to the plaintiff” as the Act states. It should be delivery up to the plaintiff or to someone else as the circumstances in the particular case may dictate, or as the court may see fit.

Again, the Act speaks of only copies or articles “in the possession of the defendant”. There is a need to include also infringing things in the custody or control of the defendant or certain third parties. And to remove doubt, the defendant must be having in his
possession, custody or control of infringing copies or articles in the course of business. These concerns may be answered by the provisions on what constitutes infringement; but these are stated in such disorganized arrangement that a short straight provision as suggested here would be salutary and make for clarity.

Despite these aspects which may need clarification, delivery up is a useful remedy. For instance, without this remedy, a stubborn infringer who earns vast profits from infringement and paying damages can as well find it lucrative paying damages for infringement of copyright, and so there would be no end to infringing the copyright.
CHAPTER 5
GENERAL CONCLUSIONS AND SUGGESTIONS

5.1. Key judicial civil remedies for copyright infringement and the procedure to get remedies

In world commercial intercourse today, the global desiderata, mood and effort are for efficient remedial and procedural justice in copyright protection, promotion and enforcement under effective judicial systems. To this end, most countries which subscribe to the Agreement on Trade Related Aspects of Intellectual Property Rights, 1994 are under an international obligation to have in their laws efficient procedures and remedies for the enforcement and promotion of intellectual property which include copyright. Kenya is a signatory to that agreement and in compliance to with that requirement, she enacted the Copyright Act, 2001.

The Copyright Act, 2001 lists injunctions, accounts and delivery up, among judicial civil remedies available to an owner of copyright in the event of copyright infringement. However, the Act does not set out the principles governing any of these remedies. It also fails to set out most of the procedural rules of court to be followed when one wishes to seek any of these remedies, or to defend copyright infringement suit. Yet the efficiency and effectiveness of remedies to prevent copyright infringements and to play the role of deterrence of further infringement are measured largely by the existence of sound underpinning principles and expeditious procedures to invoke judicial intervention to confer appropriate relief. Since the Act leaves these aspects blank, there is a need to take a close look at the underlying key principles and procedures that exist and should exist to overall objective of copyright regime in Kenya.

1 Article 41 of the Agreement requires that those procedures and remedies shall be fair and equitable, and are not to the unnecessarily complicated or costly, or entail unreasonable time limits or unwarranted delay. Listed as expeditious and effective procedures and remedies are injunctions (Article 44), destruction (Article 46) and An in Piller orders as one of the provisional measures which may be made inaudita altera parte (Article 50).
2 Act No 12 of 2001
The said overall objective of the copyright regime in Kenya formed the broad and fundamental assumption of this study. It also encompasses the more specific assumption of this effort. It is that social welfare is enhanced by conferring upon those who produce and disseminate creative information and products exclusive rights in their creative expression. It is that such creations are an embodiment of the creator's investment of a vast array of resources to enable them to produce and disseminate their creations. It is that such intellectual creations are both human rights and economic rights. They require proper protection and promotion by the law, and efficient procedures and remedies to vindicate them when infringed or threatened with infringement. So, when the legal system has set out the available procedures and remedies, it behooves us to take a close look at them and keep re-evaluating them in scholarly studies.

This study has undertaken to look at the selected civil remedies and procedures from the point of view of assessing whether they are efficient. Efficiency was tested by looking at the procedural regime governing going to law to search for an effective judicial civil remedy against copyright infringement. Efficiency was looked at from an angle of principles which apply to each of the remedies under the study. Efficiency was further examined by looking at aspects of each remedy which either enhance or inhibit the pace of getting the remedy. Eyes were open for any difficult areas in the law and practice, and for any window to usher in some invigorating air of improvement.

It was found, in the course of this effort, that in the absence of statutorily stated principles governing the granting or withholding of the civil remedies for copyright infringement, the courts have applied established principles developed in equity to decide questions of the remedies sought. Likewise, the general rules of court governing all civil litigation are applied to cases of copyright infringement. Further, the Act does not define the remedies, their nature and what they serve. The study went into all these things and this is what it has found.

Account of profits is a restitutionary remedy. The purpose of this remedy in a copyright infringement case is to prevent an unjust enrichment of the defendant. Injunctions are
remedies *in personam* and flexible. Delivery up is to remove infringing articles from circulation in the market. Continued circulation of infringing copies or articles tends to defeat the effects of injunctions or damages or account of profits.

If they are carefully studied and some anomalies, unnecessary procedural shackles and strictures removed, and invigorating thoughts and interpretation infused into their perception, these three remedies are some of the best anti-piracy measures that the courts can take in the protection of copyright owners.

This study has focused on the three important and related procedural aspects in respect of each of them, out of the wide range of reliefs provided by our civil courts for the protection of property in general, and copyright in particular. It begins with highlighting some of the key procedural and jurisdictional issues affecting the quest for any of the remedies for copyright infringement. Each one of these remedies has been defined in familiar, rather orthodox, vocabulary to avoid the dreadful risk of error in nomenclature, and to ensure that the entities beneath the names are perceived to their fullest possible extent in the context of judicial civil redress of copyright infringement in Kenya.

**5.2 Procedural and jurisdictional questions in seeking civil remedies for copyright infringement**

This study opened with a survey of some of the key procedural and jurisdictional questions which an intending litigant or his legal adviser must consider before embarking on a lawsuit to get a judicial civil remedy for copyright infringement in Kenya.

It was found that some of these issues are provided for in the Copyright Act, 2001, while others are in different other legislations. It was also found that the overall procedural rules applying to suits to claim any of the three civil remedies studied in this thesis are the Civil Procedure Rules.

In general, the same courts which process all civil litigation are the ones in which suits for infringement of copyright are filed and determined. In Nairobi civil remedies for
copyright infringement are sought in an *ad hoc* Commercial Division of the High Court, but that Division operates under the rules of procedure which apply to any civil court. The same formalism and delays in the conclusion of cases obtains in that Division as elsewhere. Any judge can deal with any case, including cases of copyright infringement.

On these findings, it is suggested that with regard to suits to get the civil remedies for copyright infringement, there should be:

(a) special copyright civil courts, dealing with either exclusively copyright infringement cases, or in addition to some or all intellectual property infringement claims;

(b) judges specialised, trained and experienced in intellectual property cases in general, and copyright litigation in particular;

(c) simplified rules of practice and procedure specially designed to regulate the practice and procedure in copyright infringement disputes;

(d) severe limits on interlocutory applications and appeals in copyright infringement claims;

(e) greatly enhanced and felt at every stage of litigation in copyright infringement lawsuits, the role of the court in the control of the pace of litigation and framing of issues for determination;

(f) effective discovery, inspection and carefully framed search and seizure procedures in copyright infringement cases;

(g) early announcement of the decisions of the courts determining copyright infringement claims; and, of course,
(h) clear conflict of laws rules governing cases of copyright infringement which have a foreign element or nexus.

There are other areas of worry raised in the respective parts of the first Chapter, such as questions of parties, and they should be addressed as there suggested. The aim is to achieve speed, cheapness, informality under such procedural innovations. This is necessary because the impact of copyright infringement is commonly immediate and its harmful effects extensive and crippling.

5.3. Account of profits for copyright infringement

Account of profits was considered next, in Chapter 2. It was seen that in copyright cases the remedy consists of a two stage process which gives the procedural remedy "a duality". As shown in that Chapter, those two aspects render this remedy and the procedure for seeking relief laborious and expensive. The process of reckoning may be complex and the outcome uncertain. It has been observed:

"Attractive though an account of profits might appear, there are likely to be great practical difficulties in determining what the profit was in relation to the infringement, and it may be well nigh impossible to isolate this profit from the other profits made concurrently by the defendant in other, legitimate dealings." ³

The remedy is also infrequently resorted to, because in copyright cases, where a plaintiff opts for an account of profits, he misses out on damages, and he will be shut out from claiming even exemplary damages in a situation where such damages would have been appropriate. ⁴

Another drawback of the remedy is its restriction to net profits. By definition account of profits is a remedy by which the defendant is required to draw up an account of, and then to pay over, the net profits he has acquired by infringing another's copyright. There appears to be no reference to an account of profits measured by the expense saved by the infringement. It would enhance the effectiveness of the remedy if profits earned by

saving on expense, such as by producing cheaply, were also included in what is recoverable.

Since the profits to be awarded are those factually caused by the infringing act, it seems that in assessing the sum to be awarded under an account of profits process for copyright infringement, no sum should be awarded if no profits (but only losses) were made (even if the losses would have been greater but for the copyright infringement). In justice one who saved (i.e. cut down) his losses by infringing another’s copyright should not be let off the hook with such ease.

This remedy will, at any rate, for some time, need time and the “civic” education of the people in this country for it to be commonly resorted to. This is so, because the culture of keeping accounts in business is not yet deep-rooted and routinely practised, judges and lawyers engaged in court work will need specialisation or the services of specialists in the field of accounting will have to be hired. Courts will have to take into consideration the practical consequences of ordering this kind of relief. For instance, the remedy is readily granted where there has been deliberate and knowing infringement, but not where infringement was entirely innocent and for no fault of the defendant, or where discussions between the parties might have made proceedings unnecessary but for the unreasonableness of the plaintiff.

As a restitutionary measure, the court uses account as the nearest approximation which it can make to justice, and takes the infringer’s ill-gotten profits he has made by his piracy, and gives them to the owner of the copyright. If this is a central purpose of the remedy, it should extend to matters not quantifiable as “profits”, such as the acquisition of an enhanced position in the market, that is, where through infringing copyright, an infringer has gained “fame” bringing him undeserved prosperity he might not have acquired had he not turned to piracy.

A serious handicap lies in one aspect of the requirement that the copyright owner, as a plaintiff, has to elect between damages and an account. The copyright owner should be
allowed to keep his options open by seeking an account of profits and damages as alternatives, and if he succeeds at trial he makes his election. He should be at liberty to ask for relevant information on which to base his choice.

A good procedure is to allow the copyright owner to keep his options open by seeking an account of profits and damages as alternatives, and if he succeeds at trial he makes his election. He should be at liberty to ask for relevant information on which to base his choice. In this regard, the defendant should be required to supply affidavit evidence setting out sufficient information to allow the copyright owner to make an informed decision.

Another procedural aspect to be re-evaluated with a view to simplifying and aiming for cutting down on the cost of pursuing this form of relief is to work towards a fusion of the “duality”, or omitting one of the stages in the process. The necessity for the two aspects of the remedy of account can be done away with under the Occam’s razor, i.e. the maxim that “it is vain to do with more what can be done with fewer”, which means, “Entities are not to be multiplied without necessity.”

It is suggested, in summary, upon some of these findings:

(a) that the remedy of account of profits may be made more attractive by simplifying the procedure around it by removing its dual process which entails extra expenses;

(b) that either specialists in matters of examining and reporting on accounts be attached to courts dealing with infringement of copyright, or appropriate court personnel, such as deputy registrars in courts hearing and determining issues of civil remedies for copyright infringement, be suitably trained and be allowed to gain good experience in examining and reporting on accounts;

(d) that the putting of the plaintiff to an election between damages and account of profits, and to require him to make a choice before he is in possession of full information is as unfair as it is unnecessary, and should be abolished;

(e) that there is no sound justification for limiting the remedy to recapturing only profits made from infringing the copyright, and no recovery of profits earned by expenses saved by infringing copyright. It is suggested that the latter, too, should be recovered;

(f) that there should be no allowance for the defendant’s own skill and effort in making concurrent profits, as to allow for this complicates the effort of the copyright owner to ascertain the line between copying and exercise of the defendant’s creativity;

(g) that profits earned by the defendant following his enhanced position or fame and prosperity in the market, gained through infringement of the plaintiff’s work, should be added to what the plaintiff recovers from the defendant.

These suggested measures, if taken, would contribute to effect measures of protecting copyright in Kenya against infringement. The remedy should be more opted for than it is now because of its rather relative mystique which drives suitors to pick on the better known but often inadequate damages.

5.4. Injunctions against copyright infringement

In copyright actions, in common with actions in the protection of other intellectual property rights, speed is of the essence. Infringement can be instant and injury on a large-scale. Without a rapid, and sometimes stealthy, response, it may sometimes be bolting the stable door after the horse has bolted.
Not infrequently, once a plaintiff obtains a temporary injunction, the defendant has little incentive to contest the action further. He prefers to seek a way out and cut down on his losses, by choosing a different and non-infringing course of action, and reach a settlement. As a result, a lot of copyright infringement actions are settled at the pre-trial stage following any of the forms of temporary injunctions. On the other hand, a permanent injunction after success for the plaintiff at the trial, saves the plaintiff from dwelling in court with a multiplicity of suits.

Advantages such as these, and those adumbrated to in the survey of the nature, jurisdiction and principles, of the remedy, make injunctions the most important remedy for infringement of copyright. As what is primarily desired by most right-owners generally, and copyright owners in particular, is the cessation of the infringement of copyright, an injunction is the most commonly sought remedy, either of itself or with other remedies to do complete and effective justice, or as an aid affording provisional protection of rights and achieving a fair balance as rights await determination.

On the whole, copyright injunctions obey much the same principles as those which govern injunctions in other areas of law. However, because of the peculiarly suitable nature of injunctions in copyright cases, the discretion is normally exercised in favour of a plaintiff who succeeds at the trial even though no quantifiable damage has been suffered.

Normal as injunctive relief is in copyright infringement, there are some practical problems which arise. One concerns the form of injunction: how broad or how narrow should they be framed in copyright cases? In the English case of Coflexip SA v. Stolt Comex Seaway MS, Ltd., Laddie, J, did not favour final injunctions in intellectual property actions which are broadly drawn to restrain all future infringements of the plaintiff’s rights by the defendant. He suggested a “narrow form” injunction restraining the repetition only of the infringing act for which the defendant has been found liable.

6 [1999] 2 All ER 596.
However, in *Microsoft Corp v. Electro-Wide, Ltd.* the English House of Lords had earlier taken a broad approach, granting an injunction to restrain the defendant from reproducing part of *any* operating system software in which the plaintiff had copyright (not just the software the defendant had already infringed), because the defendant was interested in copying *whatever operating systems* software was currently saleable. Both approaches have advantages: the narrow one has the advantage of certainty for the defendant where the scope of the protected right may not always be entirely clear; the broad form has the advantage of saving the plaintiff from keeping eternal vigil and returning to court from time to time a new infringement is sensed. Kenyan courts are as yet to rule on the matter.

The procedural provision that an *ex parte* temporary injunction may be granted only once for not more than fourteen days and shall not be extended thereafter is at variance with the spirit of the *Anton Piller* order under the Copyright Act, 2001, and at any rate in practice it is generally as redundant as the offence of bigamy is on our statute book, and totally out of touch with reality on the ground.

There is one restriction on the granting of injunctions which is a blanket bar to the remedy without leaving a safety valve. It is provided that where infringing work is a work of architecture an injunction is out of question in so far as it is sought to pull down a building or to prevent its completion. There is no word as to what a holder of copyright in the drawings pirated to build can do to protect himself. It is suggested that a way out may be to allow the copyright owner to register a caution against dealings in the land on which the offending building or structure is erected. Such a measure may be useful in the case of a building constructed or being put up for sale, which is alleged to infringe the copyright in architect’s drawings. Registering a caution may focus the alleged infringer’s mind, and buyers might at least be askance and wary.

*Anton Piller* orders will require very careful shepherding, and be restricted to what they were designed to do, namely the preservation of vulnerable evidence. The procedure was

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invented to combat frauds, piracies or other wrongs committed in secret, and to catch
defendants who have in their possession papers or things, and if forewarned they will
dispose of them and tell a pack of lies after the horse has rapidly left the stable. These
orders should strictly be limited to cases where it is essential that the plaintiff should have
inspection so that justice can be done between the parties; and in the enforcement of the
orders the plaintiff must act with due circumspection. Guidelines need to be drawn up for
the profession, providing due safeguards against abuse. The salutary procedure should
not be mistaken for a chance for search warrants, for prying into a rival’s legitimate
business or personal affairs, or for embarking on a deep sea fishing expedition, or
otherwise violate the constitutional right to privacy or guarantees against expropriation of
private property.

Flexible, discretionary, nimble and adroit in emergencies, impelling in effect, and precise
in targeting, injunctions are the most expeditious and effective civil remedies and
procedures against infringement of copyright in Kenya. But the principles governing the
remedy as rendered by our courts, particularly in the context of temporary injunctions,
are so truncated and overburdened with over-generalisations that in the field of copyright,
they require a second look and proper qualification in this particular area made. For
instance, given the speed with which copyright disputes have sometimes to be decided
and immediate protection given, insisting on crossing the *prima facie* case with a
probability of success threshold is better observed by lip service than by practical
application. Rather, balance of convenience and irreparable injury, after the
establishment of an arguable case, and exacting appropriate undertakings in damages is
what is evident in actual practice.

It is suggested that many areas of injunction law in copyright infringement cases require
re-examination and guidance. The following aspects are included:

(a) there should be practice guidelines on how broad or narrow the form of
injunctions should take. In doing so, care must be taken to ensure that there is
certainty of what a defendant is required to do in order to comply with the
injunction, and at the same time, it should be broad enough to save the plaintiff from having to engage in repeated litigation;

(b) the limiting statutory rule on *ex parte* temporary injunctions should be reconsidered in the light of experience that (i) it is more broken than observed, and (ii) it is inimical to secrecy where secrecy may be crucial in copyright infringement litigation;

(c) the Copyright Act, 2001, should provide a remedy against buildings or structures constructed using infringing building plans, e.g., allow the copyright owner to lodge a caution on the land where the building is constructed, to warn would-be purchasers of such a building;

(d) *Anton Piller* orders are still relatively a new introduction in Kenya’s legal practice, and guidelines on them are required, especially with regard to how such orders should be reconciled with certain constitutional guarantees, or certain rules of evidence as to confidentiality, privileged communication, or safeguards against self-incrimination;

(e) the so-called “the conditions” for granting temporary injunctions in copyright infringement cases should be re-considered so that they do not remain as if they were inflexible. They are misleadingly terse. The rule in copyright infringement cases should be, aim at holding the scales of justice balanced till final determination or other order;

(f) in particular, the requirement of establishing a *prima facie* case with a probability of success is rarely met, and it depends on individuality of a judge;

(g) in protecting copyright owners against infringement, courts should not be fetish about rules, and the approach should be simplicity, cheapness and informality, provided that no one suffers prejudice and injustice;
(h) the broad approach should be that preventive justice excels over money compensation recovery in copyright infringement cases where awesome or irreparable harm can easily be suffered.

For the reasons already seen, however, injunctions in copyright infringement in Kenya remain the most common remedies, either of their own or coupled with a request for some other remedy like damages, account of profits or delivery up. "Most of the time, the prevailing plaintiff in a copyright action obtains an injunction" although it has been cautioned "that injunctions are not automatic." 8

5.5. Delivery up of copyright infringing copies or articles

If damages and an account of profits "are comparatively underused in intellectual property actions", as observed in one study, delivery up counts as one of "the main remedies in intellectual property cases".9 It serves to further strengthen the effectiveness of injunctive relief. It is normally an adjunct to a perpetual injunction,10 although this is not to say that unless an injunction is granted delivery up cannot be ordered.

The primary function of the remedy is to prevent acts infringing the plaintiff's rights. It denies him a choice as to what to do with the infringing matter already in his hands: As such, the remedies of delivery up or delivery up and destruction, "go one step beyond, and protect the plaintiff even more effectively than, a prohibitory injunction."11

The Copyright Act, 2001 does not set out any guidelines as to when an order or decree for delivery up, or destruction, may be made. Similarly, there is no guidance on how to invoke either or both of the statutory as well as the inherent equitable jurisdiction to grant

9 Davis, supra, note 4, para 1.24, at p. 13.
the respective reliefs under any of those systems of law. But as ours is a fused system of
law where the same courts administer both law and equity, unless expressly excluded by
statute, the principles developed in equity apply *mutatis mutandis* on aspects which fall
within both jurisdictions.

The position of a co-owner is not properly addressed. It would be useful to have a clear
rule on the matter, such as one making it mandatory that a co-owner can only obtain
delivery up orders with the written authority of all other owners, unless such authority is
unreasonably withheld.

By requiring delivery up of only articles “in the possession of the defendant”, the Act
leaves a lacuna in respect of third parties who have come into possession of infringing
articles, and even with regard to articles not in the defendant’s possession, but in the
possession of someone else but who is under the control of the defendant.

Moreover, unless one imports into this statutory provision general principles of law, or
unless one also reads into it the savings with regard to exclusion from infringement
articles for “private and domestic use”, or “for the purposes of scientific research,
criticism or review, or reporting of current events subject to acknowledgement of the
source”, or for “systematic instructional activities of school or university”, and other
provisions, reading the provisions on available reliefs in isolation would not limit the
availability of the remedy to cases where a person has infringing articles in his possession
“in the course of business”. And yet this seems to be the tenor and thrust of the
legislation. It would make for clarity if this intenctment was expressly made plain in the
relevant provisions.

There are aspects of the remedy of delivery up which, it is suggested, require
reconsideration with a view to improvement with regard to infringement of copyright.
For instance, it is suggested:

(a) that the right of all co-owners of a copyright which is infringed to give
    consent to seeking delivery up needs to be addressed, to remove possible
conflicts between co-owners, or avoid the possibility of one or some of the owners being prejudiced by the granting of the remedy;

(b) that the concern with infringing copies or articles only “in the possession of the defendant” is inexplicably restrictive and leaves out a large category of infringing material, such as copies or articles not in the defendant’s “possession” but are under his custody or control. These, too, should be a subject of a delivery up order;

(c) that although this may be implicit in the broader provisions defining what kind of dealing amounts to infringement of copyright, it should be expressly stated in section 35(4) (b) that the possession of infringing copies or articles for purposes of granting the remedy of delivery up is possession in the course of trade. This is too important a point to be left for implication only.

When all is said and done, however, the remedy of delivery up in the field of copyright is an important one. If it may not be as expeditious as an injunction, it will in fact “go one step beyond, and protect the plaintiff even more effectively than a prohibitory injunction.” The only precaution to take is to ensure that it is not disproportionate.

5.6. The last word

The remedies of account, injunctions, and delivery up, and their procedural milieu, in the judicial enforcement of copyright are especially appropriate and suited in copyright protection. In the law’s remedial armoury they are the weapons of first choice in the combat against piracy and all forms of copyright infringement. Sometimes issuing surreptitiously, appropriately couched, always coercive, nimble, restitutionary or nihilist where need be, these remedies and the procedures which make them possible within the constitutional framework, are truly expeditious and effective as civil remedies for copyright infringement in Kenya, and they only require eternal vigilance to ensure a
steady balance of justice. However, certain aspects of procedure and concepts require simplification redefinition and re-thinking.

Copyright is important as an intellectual property because it provides a necessary incentive to create, disseminate, and commercialise works of authorship. This right can be strengthened or weakened by the system of remedies available to a copyright owner. The remedies available for infringement of copyright in certain respects drive the whole copyright system. Without efficient and effective remedies for their enforcement, rights under the Copyright Act, 2001 are worthless. “Inattention to remedies, in other words, can undermine the whole system, no matter how much careful thought and analysis have gone into devising the rules of substantive law.”¹²

Many of the suggested measures set out in this dissertation touch on matters of policy and require legislative measures. Others call for specialisation by actors. But others only need a robust and discerning Bench, a serious Bar, and keen scholarship. At all times there should be in place regular re-evaluation and reform programmes, clear implementation and enforcement agenda, to enhance and sustain efficient civil procedures and remedies for copyright infringement in Kenya.

To achieve an efficient civil procedural and remedial regime in Kenya’s judicial system for copyright enforcement, at least a three-pronged approach is called for. At the level of the general legal framework, there is need for an established law and institutional reform programme. At the level of practice and procedure, there must be an out-and-out move from fetish pedantry to substance and realism. At the level of the operators and executants of the legal system and the legal services providers, there has to be a fundamental move from the generalist to the specialist. That way, efficient civil remedies and procedures against copyright infringement in Kenya will find fertile soil in a general legal and institutional environment in which to take root and have sustainable growth. That should be the general legal and judicial setting in which the remedies of account, ¹² Blair & Cotter, supra, note 8, at p. 2
injunctions and delivery up can be optimal and efficient antidotes against copyright infringement in Kenya.
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