THE REPUBLIC OF UGANDA

IN THE HIGH COURT OF UGANDA HOLDEN AT KAMPALA

COMMERCIAL DIVISION

HIGH COURT CIVIL SUIT NO.0967 OF 2004

STELLA ATAL……...PLAINTIFF

VERSUS

ANN ABELS KIRUTA

T/A '97 AFRICA ARTS & CRAFTS ……..……...DEFENDANT

BEFORE THE HON. JUSTICE GEOFFREY KIRYABWIRE

JUDGMENT

The plaintiff Stella Atal brought this suit against the defendant, Ann Abels Kiruta for copyright infringement and conversion and for an injunction restraining the defendant from further infringement, an account in respect of such infringement, special, general and exemplary damages for infringement, and damages for conversion plus costs for the suit.

The brief facts of this case are that the plaintiff an artist authored various artistic works. That sometime between 2001 to 26th May 2003, the plaintiff was engaged in supplying the defendant with her artistic works for sale in her stores. It is the case for the plaintiff that about early May 2003, the plaintiff came to learn from her assistant, Mr. Andrew Morgan Aloka that the defendant had approached him with a view of engaging him to produce, reproduce and or fabricate the plaintiff's artistic works at a cheaper price, than what the plaintiff was selling them. Upon learning of the defendant's dealings, the plaintiff terminated all supply dealings of her artistic works to the defendant. It is the case for the plaintiff that after

termination of the dealings with the defendant, the plaintiff came to discover that the defendant was already engaged in the infringement of her work copyrights for her various artistic works by reproducing counterfeit copies and making duplicate reproductions of the plaintiff's best selling art pieces. The plaintiff therefore avers that the defendant has continuously infringed the copyrights of each of the plaintiff's artistic works by using the plaintiff's created and developed ideas without a license, approval or consent from the plaintiff and therefore was unlawfully publishing, producing, reproducing and distributing a selection of unauthorized copies of the plaintiff's artistic works.

The defendant, however, denies liability and avers that she engaged the plaintiff between 2001 and 2003 and employed the plaintiff to produce and offer for sale artistic works based on pre- existing African symbols, articles and pictographs. The defendant further avers that it was orally agreed by the two parties that the defendant was to cater for the plaintiff's accommodation and working space for as long as the contractual relationship subsisted. The defendant also averred that it was further agreed that the plaintiff was to produce particular artistic works for the defendant exclusively, during the period of the plaintiff's employment. The defendant contends that during the course of their relationship, the plaintiff made and sold similar art-crafts bearing the artistic works to other persons and businesses which at the time should have been produced exclusively for the defendant. The defendant therefore contends that she had to sever the relations with the plaintiff because of the foregoing reasons and because it was not viable to continue to do business in the said artistic works as the market was flooded with similar works.

The defendant in her defence raised a counter claim against the plaintiff seeking general damages for breach of contract of license and loss of income, a declaration that the defendant is the owner of the copyright in the artistic works made by the plaintiff during her employment with the defendant, detinue and

conversion, delivery up of artworks under license or copyright to the defendant or the payment of the market value thereof and costs for the suit.

The defendant/ counterclaimant contends that the plaintiff breached the license agreement for the copyrights in the artistic works. That during the existence of the said license, the plaintiff sold artistic works to various people and distribution businesses in Kampala and elsewhere contrary to the exclusivity term of the license agreement. The defendant/counterclaimant further averred that the plaintiff during her employment with the defendant/counterclaimant took various artistic works from the defendant and that she has ignored, refused and failed to return them despite the numerous remainders. It is the defendant/counterclaimant's case therefore that the proliferation of the market with similar products has caused a financial loss to the defendant's business and that as a result of the plaintiff's actions, the defendant/counterclaimant has been deprived of their use and purpose.

The agreed facts are that:-

1. ***There was a working relationship between the plaintiff and the defendant in between 2001-2003.***
2. ***In that relationship the defendant was supplied artistic works by the plaintiff.***
3. ***The defendant has artistic works stores at Crested Towers, National Theatre, Crafts village and Makindye, opposite the American Recreational Club where the artistic goods are sold.***

At the commencement of the trial the following issues were framed.

1. ***Whether the plaintiff is the author of the various artistic works and owner of the copy rights there in if any.***
2. ***Whether the defendants infringed the plaintiffs copy right.***

3. ***Whether the plaintiff is liable under the counter claim.***
4. ***What remedies are available to the parties?***

Mr. Brian Kaggwa appeared for the Plaintiffs while Mr. Kiggundu Mugerwa appeared for the defendant. The plaintiff called two witnesses namely; Stella Atal, the plaintiff (PW1) and Aloka Andrew Morgan Paul (PW2). For the defendant Ann Abels Kiruta (DW1), Henk Jenker (DW2) and Vincent Kiganda (DW3) testified.

Issue 1: <u>whether the plaintiff is the author of the various artistic works and owner of the copy rights there in, if any</u>

Counsel for the plaintiff submitted that a copyright is conferred by law under section 4(1) of the Copyright Act cap 215 on every work eligible for copyright. He submitted that the requirements of section 3(2) (a) and the first schedule of the Copyright Act were fulfilled and that the plaintiff's artistic work in question is eligible for copyright since it is of original character and sufficient effort was expended by the plaintiff on making the work, a fact he submitted that was not denied by the defendant during her evidence.

It was counsel for the plaintiff's submission that Stella Atal led evidence showing her learning and background as an artist. She referred to a text entitled, "**A short history of African Art**," by **Werner Gillion** (marked exhibit P.2) with specific emphasis given to pages 76, 77, 80, 205 and 208 as an illustration of applying effort and skill to give an artistic expression of original character to images found in that book. She testified that the mask illustrated in that book (Exhibit P.2) was without colour. However she changed the shapes therein and gave them her own interpretation or artistic understanding to bring out origin artistic work with expression. She further exhibited various sketch books [marked Exhibit P.4 (1) and (2)] which she used to illustrate and express how she had developed her ideas. Counsel for the plaintiff further submitted that Stella Atal went into detail to explain how she created her original works long before the defendant's works.

He submitted that it is evidently clear that when one compares the plaintiff's items in issue as against the imitations of the defendant that it would leave no doubt in that person's mind that the defendant's imitations are identically similar to the plaintiff's original works. Counsel for the plaintiff further made reference to the testimony of Henk Jenker an artist who appeared for the defence but who testified that the plaintiff's work is specifically recognizable and described her work as abstract with elongated features and that she uses a lot of gold. It was counsel for the plaintiff's submission therefore that the defence witnesses knew very well about the plaintiff's art work in details and could also describe the work in detail at a technical level. That this therefore showed that the plaintiff's works were original, that she expends effort on creating the artworks and that she is the author and owner of the artistic works and copyrights.

Counsel for the defendant on the other hand submitted that the defendant does not dispute that the plaintiff is the author of various artistic works. He however submitted that what is in dispute is whether the said artistic works confer a copyright on the plaintiff. Counsel for the defendant referred court to section 3 (2) of the Copyright Act and submitted that for the artistic work to be eligible for copyright protection or to confer the author with a copyright, there has to be originality. Counsel for the defendant further made reference to the case of **C.A Systems Ltd .v. Kalamazoo Ltd [1974] E.A 21** where court held that protection under copyright law is only available if originality is proved. It was counsel for the defendant's submission that no evidence was led by the plaintiff to prove that her work was original and that she had exerted sufficient effort in creating the said works. On the contrary, Counsel submitted that the plaintiff had relied on a text in a book entitled **"A short history of African Art,"** by **Werner Gillion** (Exhibit P.2) from which she copied the masks and the lizard and improved on them by adding some few touches and then passing them on as an original. Counsel for the defendant further submitted that the plaintiff did not lead any evidence to prove that in actual fact her art pieces were created before the alleged infringing pieces. Counsel for the defendant therefore submitted that the art pieces exhibited do no bear out the originality as alleged by the plaintiff

and that the unique style attributed to the plaintiff's gold borders, black background and exaggerated body movements is a universal style to which no single person can claim exclusive ownership.

I have perused the evidence before court on this issue and the submissions of both Counsels. According to **Halsbury's Laws of England 4th Edition vol. 9(2) page 10 para. 3,** a copyright is defined as follows:-

> *"**A Copyright is the exclusive right to do, and to authorise others to do… certain acts in relation to literary, dramatic and musical works, in relation to artistic works and in relation to sound recordings, films, broadcasts, cable programmes and published editions of works. The acts concerned vary according to the subject matter; in general, the existence of the copyright protects the maker of a work from the appropriation of his labours by another."***

Copyright is a natural right and creators are therefore entitled to the same protections as anyone would be in regard to tangible and real property. The proponents of this doctrine contended that creators had a perpetual right to control the publication of their work. For one to be eligible for a copyright for artistic work there are certain factors that have to be taken into account.

Section 1 of The Copyrights Act (cap 215) provides that artistic work means

"…irrespective of artistic quality, any of the following or works similar to them

(i) Paintings, drawings, etchings, lithographs, woodcuts engravings and prints… (The rest are not relevant to this case)"

Furthermore under section 3(1) and the 1st schedule an artistic work is eligible for copyright protection**.** Section 3(2) of the same Act provides inter alia that artistic work shall not be eligible for copyright unless sufficient effort has been expended on making the work to give it an original character*;* and the work has been written down, recorded or otherwise reduced to material form whether with or without consent.

To get an understanding of what an original work is, in the case of

Emerson v Davies (1845) 3 Story 768 at 778–779 court held that;

'The question is not, whether the materials which are used are entirely new, and have never been used before; or even that they have never been used before for the same purpose. The true question is, whether the same plan, arrangement, and combination of materials have been used before for the same purpose or for any other purpose. If they have not, then the plaintiff is entitled to a copy-right, although he may have gathered hints for his plan and arrangement, or parts of his plan and arrangement, from existing and known sources. He may have borrowed much of his materials from others, but if they are combined in a different manner from what was in use before… he is entitled to a copy-right … It is true, that he does not thereby acquire the right to appropriate to himself the materials which were common to all persons before, so as to exclude those persons from a future use of such materials; but then they have no right to use such materials with his improvements superadded, whether they consist in plan, arrangement or illustrations, or combinations; for these are strictly his own.'

It is therefore possible to create a personal copyright from preexisting materials provided what is created is different from what has been was in use before.

Furthermore in the case of **British Northrop Ltd v Texteam Blackburn Ltd [1974] RPC 57 at 68** the principle was conveniently summarised by **Megarry J** as follows:

> ***'Copyright is concerned not with any originality of ideas but with their form of expression, and it is in that expression that originality is requisite. That expression need not be original or novel in form, but it must originate with the author and not be copied from another work … A drawing which is simply traced from another drawing is not an original artistic work: a drawing which is made without any copying from anything originates with the artist.'***

It can therefore be said that copyright protection extends to expressions and not ideas.

Another important factor to take into account is that the original work must have been reduced into some material form or tangible medium of expression. Once these factors have been established then under section 7 (1) of the copyright the author of the artistic works shall have the exclusive right to control the doing in Uganda or any other country of

- the distribution of the copies
- the public performance for payment
- the broadcasting

of the whole or a substantial part of the work either in its original form or in a form recognizably derived from the original. For an artist this important to

ensure that his/her work is not reproduced, distorted, mutilated and or distributed in a manner that is prejudicial to his honour and or reputation.

I am satisfied that the Plaintiff is the author of certain artistic works for which she has copyright protection over. This is because the art pieces she produced to Court as evidence of her artistic works meet the legal criteria outlined above for copyright protection. The plaintiff has satisfactorily proved that she had dispensed an amount of effort to produce the work and even adduced evidence to show how she developed her work produced out of her sketch book and the books she read. Be as it may the plaintiff cannot claim copyright with regard to the ideas she has nor the colours of gold and black and the use of stick people as figures in her work as she claimed in her testimony. Any copyright protection to her would extend to the expression of her ideas that are original in nature. In the event, I am satisfied that the plaintiff's works are original and sufficient effort has been expended on making it.

Issue 2: <u>Whether the defendants infringed the plaintiffs copy right.</u>

Counsel for the plaintiff in his submissions referred court to section 13 (1) of the Copyright Act which provides that:

> ***"A copy right is infringed by any person who does, or causes any other person to do an act falling within the license of the person in whom is vested either the whole of the copyright…."***

He submitted that this section appropriates liability on "*where a person does"* and *"where a person causes any person to do".* Stella Atal in her evidence referred court to an album marked Exhibit P.5 which had 2 women coming from a water well she testified that defendant copied this artwork on the cover of a note book (marked Exhibit P.6) also made out of recycled paper showing women

coming from the well carrying pots and having the same posture, the black colour and the gold finishing. She further referred court to African Motif collection which has the symbols like masks, lizards and fish marked Exhibit. P3. She testified that these are African symbols on a different background with gold and a black border which were copied in the same colours and portions of detail on a calabash marked exhibit P7, on an album (Exhibit P.8), a wall hanging (Exhibit P.9), a plate (Exhibit p.10).

The next category of artworks included a lamp shed (Exhibit P.12) and calabash Marked Exhibit P.13. Stella Atal testified that these infringed her Bushmen wall hanging that was marked exhibit P. 11. It was her testimony that the defendants used the same colours, same figures and the same details plus the gold. The plaintiff also exhibited a seasonal card marked Exhibit .P14 she compared this card with wall hanging marked Exhibit P.15 which she claimed was a copy of her work. The plaintiff testified that the artwork on the wall hanging (Exhibit P.15) has the same black boundary, same gold line on the border, same colour of background, that the defendant used the same colourful cloths, that is; blue, brown, green and red. The plaintiff further testified that the same gold lines on the arms and the legs, that they were also dressed in necklaces, and carrying the same baskets and pots.

The plaintiff also exhibited a seasonal card with a fertility doll marked Exhibit P16, a blue seasonal card marked Exhibit P18, a seasonal card made in 2003 Marked Exhibit P.20 that shows men drinking a local brew and a wall hanging Marked Exhibit P.22 with three Karamajong women half dressed and she testified that these were copied by the defendant and infringed upon in card marked Exhibit P.17, a blue canvass with two adults and a child marked Exhibit P19, a piece of bark cloth P.21 and wall hanging Marked Exhibit P.23 respectively.

Counsel for the Plaintiff submitted that the defendant is guilty of copyright infringement in the first place by her conduct in refusing to permit the plaintiff

and the bailiff, acting on the authority of an Anton Pillar order made by Court, as an officer of the court entry into her residence at Wakaligga which raised suspicion that she had something to hide. Secondly there is the unchallenged testimony of Ms. Stella Atal about the defendant's unsolicited approaches to Aloka Andrew (PW2) about the creation of imitations or replicas of the plaintiffs work. Counsel for the plaintiff further referred court to section 7(1) of the same Act that provides for the actions that are exclusively reserved for the owner of the copy right which among others includes Control of distribution and Broad casting of the whole or substantial part of the work either in its original form or any form recognizably derived from the original. It was counsel for the plaintiff's submission that the items obtained as a result of the Anton Pillar order and the exhibits P.27 and P.28 (1, 2, 3) duly purchased by Aloka Andrew from the defendant's shop all showed evidence of infringement.

Counsel for the defendant on the other hand submitted the plaintiff did not posses any copyright in the artistic pieces exhibited and therefore there was no infringement of any copy right. Counsel for the defendant further submitted that through the evidence of the defence witnesses it was shown that the style that the plaintiff alleged is uniquely hers is a universal style that was prevalent on the open market.

I have addressed my mind to the evidence before court on the issue of infringement and the submissions of both Counsels. Copyright infringement by definition is the unauthorized use of material that is covered by copyright law, in a manner that violates one of the copyright owner's exclusive rights, such as the right to reproduce or perform the copyrighted work, or to make derivative works.

As discussed above, section 7 (1) of the Copyrights Act provides for exclusive control by the author over protected artistic work. However the legal protection accorded to artists by copyright is not always easy to enforce. The authors Jeremy Philips and Alison Firth in their book an **Introduction to Intellectual**

Property Law 3rd Edition Butterworth at 221 observe that the legal protection accorded to the artist in his intellectual creations has sometimes been criticized for it inadequacy. This is because the law of copyright as originally conceived was for the protection of unlawful publication and reproduction of books before it was extended to art works. Furthermore the manner in which authors of books and art works derive financial benefit from their works is different. The author of the book principally gets revenue from the reproduction of copies of his work while the artist is largely limited sale of the work that he or she has personally created. Furthermore reproduction of original art works rarely gets a higher value unless it is reproduced on greeting cards souvenirs, calendars and similar materials which can be protected like books.

In **Interlego AG .v. Tyco Industries Inc and others (1988) 3 ALLER 949 Lord Oliver of Aylmerton** held that the essence of artistic work is that which is visually significant.

Court therefore has to inquire into what is in the defendant's drawings that is visually significant and which was contained in and directly copied from the plaintiff's drawings?

To address this issue Court reviewed the various art pieces that were taken into custody when the Anton pillar order was made against the defendants. The plaintiff also made available to the court several original pieces of her artwork that she alleged had had been infringed by the defendant. It is not in doubt that the defendant herself did not produce the art work she sold as she described herself as a business woman. Her method of work was that she facilitated other artists to produce the artwork that she sold. She testified that when she fell out with the plaintiff she got work from other artists who she named as Peter Otim and Kiganda. These artists however did not come to give evidence so Court will take her as the beneficial owner (but not author) of the art pieces that the

plaintiff alleges infringed on her work. I will refer to the pieces the plaintiff by category and compare them with those alleged to have been infringed.

Women from the well

Ms. Atal testified that she made an album marked exhibit P5 in 2004 out of recycled paper showing women coming from the well. It was her testimony that she considered it as her original work because of the slender body, and the finishing in gold, the black that she uses and the movement of the people. She further testified that this piece was copied on the cover of a note book made by the defendant and marked exhibit P6. She further testified that the comparison to her work lies in the fact that the ladies on the cover of the note book have the same slender legs, are carrying pots and have the same posture and the black colour that she uses to show the pride of being an African and the gold finishing.

On a close look at these two pieces the idea was the same but the expressions were significantly different. The plaintiff's album had two ladies dressed in orange tops and brown wrappers whilst the defendants had three ladies carrying pots dressed in purple, black and red dresses respectively and are of a different size and body shape from the plaintiff's. I therefore find that there was a significant variation between the two pieces. There is therefore no infringement here.

African motif collection

Ms. Atal presented to court her work of a wall hanging which was marked Exhibit P3 and had several motifs of the tortoise, the lizard, the mask, and the fish. She identified several pieces from the defendant that she alleges had been copied from her work. One was the calabash Exhibit P.7 which had a mask with the same gold finishing. The lines in face and dots are the same and was put against a colourful background and using the same black boundary like the boundary on the wall hanging. I find that the mask drawn by the defendant is substantially the original form of Mask done by the plaintiff and or a recognized form derived from the plaintiffs work. This therefore in my finding is a copied work from the plaintiff.

The next is the album Exhibit P.8 which had marks of gold against different colours in the background. The expression of the mask on the album is the same idea but is significantly different from that on the wall hanging. There is therefore no infringement here.

Next is a wall hanging Exhibit P.9 with motifs like fish, tortoise, mask and lizard with details in gold with different colours of background and having the same black border. The expression of the mask, fish, tortoise and lizard on this wall hanging (Exhibit P.9) was significantly different from that on the wall hanging (Exhibit P.3). There is therefore no infringement here.

Bushmen

In this category Ms. Atal presented a wall hanging that was marked Exhibit P.11 with the black slender figures/stick people who have gold lines to show the sashes they use while dancing, the details the gold in the drums, the skirts and the eyes in the animals plus the use of the same black to bring out the figures.

She compared this piece with a lamp shed Exhibit P.12 and a calabash Mark it Exhibit P.13 where she testified that the defendant used the same black to bring out the figures, the same details in gold and the same details in the instruments using gold lines and the same sashes in gold. In this instance, the idea was the same however the expression is different. There is therefore no infringement here.

Masai collection

Ms. Atal PW1 produced before court a season card marked Exhibit P.14 which she compared this card with wall hanging marked Exhibit P.15. Upon comparison of the two it is my finding that the details in the face showing the eyes, the nose, mouth and gold lines on the legs and arms were the same as the gold lines on the legs and on the arm showing the bracelets. Also they are carrying water in pots

and food in the baskets and had the same exact people, wearing the same colourful cloths and design as well as same orange colour for the background. Here I find that the idea and the expression are substantially the same and therefore there is infringement of the plaintiff's copyright.

Fertility doll

The plaintiff presented a fertility doll which she painted on a seasonal card in 2002 Marked Exhibit P.16 with her style of a black boundary and gold details and the bright background. She compared it with the defendants card marked Exhibit P.17. I find the two are significantly different the bottom of the plaintiff's doll is straight while that of the defendant's is curved. There is therefore no infringement here.

Neighborhood

Next the plaintiff presented a blue seasonal card marked Exhibit P.18 illustrating a neighborhood which had three adults and a child. She compared this with the defendant's card that had a blue canvass with two adults and a child marked Exhibit P19. Comparing the two I find that the idea is the same but the expression is different. There is therefore no infringement here.

Moran Pombe

The plaintiff also presented a seasonal card made in 2003 Marked Exhibit P.20 that shows men drinking a local brew, she compared it with the defendant's piece marked Exhibit P.21 that was on a piece of bark cloth that had one man drinking from the local straw, sitting on a stool. I find the idea and expression in the defendant's work to be different. There is therefore no infringement here.

Karamajong Women

The plaintiff then presented a piece is a wall hanging Marked Exhibit P.22 with three Karamajong women half dressed with many chain necklaces, golden bracelets on their legs and arms, the hear rings and a black border. The plaintiff

compared it with the defendant's wall hanging Marked Exhibit P. 23 which had two women dancing with hands on their heads against an orange background. The idea may have been the same however the expression is different. There is therefore no infringement here.

Copyright offers legal protection to the fruits of human creativity so that both the creator and the public as a whole may benefit from it. Copyright protection however is limited to the expression of the author but if there is no skill or labour employed in producing the particular form in which the work is expressed there will be no Copyright protection over it.

All in all based on the evidence in court and the legitimate inferences made from the comparisons made between the artistic works of the plaintiff and those of the defendants and the evidence on record on this matter, I have found that of all the works that the plaintiff presented before this court as being infringed upon by the defendant there were only two pieces that were actually infringed upon.

I accordingly find that the defendant infringed the plaintiff's copyright on the artworks of the mask on the wall hanging marked Exhibit P.3 and the Masai collection marked Exhibit P. 14.

Issue 3: **whether the plaintiff is liable under the counter claim**

Defendant raised a counterclaim in their defence for general damages, for breach of contract of license, declaration that the defendant is the owner of the copyrights in the artistic works made by the plaintiff in her employment with the defendant, general damages for loss of income. Detinue and conversion, delivery up of art works under license or copyright to the defendant or the payment of market value thereof, infringement of copyright and costs of the suit. Counsel for the plaintiff submitted that there was no truth in the defendant's counterclaim because it was not supported by any evidence. He further submitted that the

defendant in his view had abandoned the counterclaim in its entirety when she testified that the plaintiff was neither her employee nor did they have such relationship and that she failed to adduce in evidence the purported written license or assignment.

Counsel for the plaintiff therefore submitted that the defendant does not have any claim for loss of income, detinue and conversion and thus the requirement for the delivery up and costs for the suit.

I agree with the Submissions of Counsel for the plaintiff that during the trial the defendant did not adduce any evidence of the existence of this contractual relationship and neither did Counsel for the defendant submit upon it. On the contrary both parties in their testimonies made it clear to court that the plaintiff was not under the direct employment of the defendant. Court therefore finds that there is no justification for the counterclaim and it is hereby dismissed with costs to the plaintiff.

Issue 4: **What remedies are available to the parties**

The plaintiff prayed for an injunction restraining the defendant from further infringement, an account in respect of such infringement, special, general and exemplary damages for infringement, and damages for conversion plus costs for the suit.

Prayer for damages

Counsel for the plaintiff prayed for damages for infringement and conversion of the plaintiffs designs. Counsel for the plaintiff referred Court to the authority of **Claydon Architectural Metalwork Ltd .v. DJ Higgins and sons [1997] FSR 475** where it was held that the normal measure of damages for copyright infringement is the amount by which the value of copyright as a chose in action

has been depreciated. The plaintiff adduced evidence to show that her sales were greatly reduced by virtue of the fact that the defendant was duplicating her works. It was the submission of counsel for the plaintiff that after the defendants stopped selling the plaintiff's products consequent to this action and the Anton pillar order, the plaintiff's sells went up by 63% in the first half of 2005 and up by 31.5% generally in 2005.

Counsel for the defendant on the other hand submitted that plaintiff did not produce any evidence to show how the alleged infringement affected her sales.

As already stated above there are only two pieces that were infringing on the plaintiffs works. Section 13(2) of the Copyright Act provides that damages awarded shall be limited to the loss, if any, incurred by reason of the infringement, together with such additional sum as may be just having regard to the flagrancy of the infringement, the benefit, if any, gained by the infringer and such other matters as may be relevant.

The plaintiff was unable to prove that all the impounded items except two were infringed upon by the defendant. The scope of duplication or flagrancy of these infringed art pieces was not shown to court in evidence and nor was their retail price or benefit to the defendant made known to Court. However there is evidence to show that the defendant benefited from the ideas of the defendant and on two occasions went as far as copying them without the consent of the plaintiff. This deprived the plaintiff of the fruits of her originality because the defendant was selling these works without any financial benefit to the plaintiff. In this regard I would award Ug.Shs.5,000,000/= (five million shillings) as general damages.

As regards the award of exemplary damages counsel for the plaintiff submitted that the defendant deliberately infringed on the plaintiff's art works in various ways as particularized in paragraph 5 (g) of the plaint. He prayed that the award would make the defendant an example to others.

Since intellectual property rights in Uganda are not well observed an award in exemplary damages would send a clear signal to the perpetrators of this practice as a caution to end such behavior. The defendant's mask on the pot, lantern and calabash was the same exact mask that the plaintiff had on the wall hanging marked exhibit P3. The defendant in this case was clearly found in possession of art pieces similar to those made by the plaintiff. Given the limited scope of remuneration available to authors of artworks I find that an additional amount by way of exemplary damages of 5,000,000/= as against the defendant is in order and I so award it.

As regards Special Damages, the general rule is that special damages must be specifically pleaded and strictly proved. In **Jivanji v Sanyo co. ltd [2003] EA 84** court held that;

> ***"Its trite law that special damages must be pleaded and then strictly proved in order for a plaintiff to succeed on a claim for specific damages."***

Counsel for the plaintiff did not submit on this prayer neither did he adduce evidence to prove special damages that had been prayed for. In that regard I decline to award them. Given the difficulty of proving damages in intellectual properties cases perhaps the time has come for our legislators to follow the example of some States in USA where it is possible for the court to award Statutory damages in the alternative.

Account of profits

During the trial there was no discovery made as to the sales and profits made from the infringement of the artworks. Furthermore Counsel for the plaintiff did not submit on this claim either. Probably this is not surprising given the quality of

business record keeping in Uganda that makes this remedy hard to pursue and prove.

Injunction

Counsel for the plaintiff relied on the text **COPINGER & SKONE JAMES ON COPY RIGHT 13th edition London, sweet and Maxwell 1991 at page 339** where it is stated that if the plaintiff succeeds at the trial and establishes infringement of copyright he will normally be entitled to a permanent injunction to restrain future infringements. Counsel avers that the plaintiff through the evidence has already established infringement of her copy right by the defendant.

Basing on my earlier findings majorly based on the comparisons made between the plaintiff and defendants pieces and on the balance of probabilities I grant an injunction against the defendant from continuing to infringe the copyright of the plaintiff.

Delivery up

The plaintiff prayed for all copies of unauthorized materials which are in the defendant's possession to be delivered up. Counsel referred me to **BULLEN & LEAKE& JACOBS at page 1004** where it is stated that the remedy of delivery up is available where a person;

a) Has an infringing copy of the work in his possession ,custody or control in the course of business, or
b) Has in his possession, custody, or control an article specifically designed or adapted for making copies of a particular copyright work knowing or having reason to believe that it has been or is able to be used to make infringing copies.

Counsel for the plaintiff further submitted that much as there were offending works that were obtained from the defendants business at the time of executing the Anton pillar order, the defendant blocked the search of her residence.

Section 13(2) (c) of the Copyright Act specifically provides for this remedy as follows

> ***"An injunction requiring the delivery up to court and the destruction or other disposal, as the court may direct, of copies of the work in question or other articles which may otherwise be used for the purposes of infringement."***

Based on my findings I order that exhibits seized with the Anton pillar order of this court from the business premises of the defendants and yet do not have her copyright shall be returned to the defendant while the exhibits and impounded artistic works with the infringing mask (pot, the calabashes and the lamp shed) and the Masai collection which has the wall hanging be destroyed by fire under the supervision of court bailiff. The court bailiff should file a certificate of destruction with the registrar on carrying out this order.

Costs

The plaintiff has prayed for costs. However, since the plaintiff was unable to prove that all the impounded art works infringed upon her art works, I accordingly award half the costs claimed.

In conclusion judgment is entered in favour of the plaintiff against the defendant for;

1. **Ug.Shs.5,000,000/= for general damages and interest there on 8% p.a. from the date filing until payment in full**

2. **Ug. Shs. 5,000,000/= is paid by the defendant to the plaintiff as exemplary damages with interest at 8% p.a. from the date of payment until payment in full for breach of copy right of the art pieces.**
3. **A permanent injunction restraining the defendant or her agents or servants from reproducing, assembling and distributing artistic copies of the plaintiff's copy right works**
4. **The destruction of the infringing works but the rest may be returned to the defendant.**
5. **Having succeeded in part in the suit I award half of the costs of the suit to be paid by the defendant.**
6. **The counterclaim is dismissed with costs.**

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Geoffrey Kiryabwire

JUDGE

Date: 11/12/2009