

COPYRIGHT INFRINGEMENT ARTICLE

LEGALITY OF IMPLIED CONSENT IN COPYRIGHT LAW; THE IMPLICATION OF THE DECISION IN ANNETTE NAJJEMBA V MK PUBLISHERS LTD (CIVIL SUIT NO. 508 OF 2016).

The High Court delivered a landmark decision on cross boarder copyright enforcement in the case of **Annette Najjemba vs MK Publishers Ltd (Civil Suit No. 508 of 2016)**.

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Abstract

The case concerned Annette Najjemba, an author of short children stories titled “Our folktales”, who submitted her work to MK Publishers Limited, a publishing house, for publication. MK publishers went ahead to, without any written consent, adapt, alter, reproduce as audio stories and sell the abridged version of the short children’s stories as part of MK Audio Stories for Rwandan primary schools while claiming and attributing authorship to itself. MK Publishers contested the claim on grounds that Najjemba has given an “implied consent” and the company offered a royalty of 10% in accordance with its policy which was available for collection.

The court was tasked to determine whether the above actions and omissions of MK Publishers tantamount to infringement of author’s copyright in the short children’s stories and violation of moral rights.

The court found that the Plaintiff is the author of the short children’s stories and she was automatically entitled to protection under copyright law. The court also further ruled that the acts of MK Publishers violated the author’s economic rights including, reproduction, distribution and sale of her works for commercial gain. The court further decided that MK Publishers failed to acknowledge Najjemba as the Author of the short children’s stories and falsely attributed the authorship to it thereby violating her moral rights. The court was

was categorical in deciding that a written consent is mandatory for assignment or transfer of economic rights and an implied license or assignment is insufficient.

Factual Background

In 2010, Annette Najjemba, (hereinafter called the Plaintiff), an author and owner of an original literary work titled, “Our Folktales”, produced a manuscript containing six short children’s stories that is; **the Gooseberry triplets, Mukoijo the Glutton, the Cruel Step Mother, Muvubi and his Fish friends; Kaleku and the enormous Beast and the Snake and the Beautiful Girl.**

In 2012, the Plaintiff submitted a tweaked abridged manuscript of the said stories to MK Publishers (hereinafter called the Defendant) for the purpose of publishing.

However, in 2013, she learnt that the Defendant, without any license from her, published the stories as part of a collection of audio stories for Primary Five and Primary Six school curriculum in Rwanda, availed and sold the same to the Government of the Republic of Rwanda.

Further, the Plaintiff also learnt that the Defendant had adapted and reproduced the said audio stories in compact discs and the jackets of the said compact discs bear the insignia of the Defendant and the Government of the Republic of Rwanda hence attributing the same to them without

obtaining a license from her.

Furthermore, that the branded compact disc included four of her stories that is; **Mukojo the Glutton, the Cruel Step Mother, Muvubi and his Fish Friends and Kaleku and the enormous beast** which has been altered to suit the Rwanda culture. The Plaintiff therefore contended that the Defendant, not being the owner of the copyright in the Plaintiff's manuscript and without a license, reproduced and further authorized the reproduction of substantial parts of the Plaintiff's literary work to the general public in Rwanda.

On the other hand, the Defendant denied the Plaintiff's claim and averred that the Plaintiff duly submitted her work for publishing and marketing and the same was duly edited and reproduced, with the Plaintiff's knowledge and consent, in an agreeable version that meets the standards as set by the Government of the Republic of Rwanda's policies for purposes of publishing and obtaining a market in Rwanda.

That the Plaintiff was informed that her work was finally sold in Rwanda and that she is entitled to some revenue in form of royalties of 10% in accordance with the Defendant's company policy.

Consequently, the two main issues for determination before the High Court of Uganda were framed as follows;

1. **Whether the Defendant infringed on the Plaintiff's copyright?**
2. **What remedies are available to the parties?**

The Court in determination of the above issues before it, reaffirmed several principles of copyright law in Uganda.

Decision of the Court

Test for copyright infringement

The Court, while resolving the first issue of whether there was infringement of copyright, adopted a two-tier test in the case of **Zeenode Limited v. The Attorney General & 2 Others (HCMA No. 347 of 2021)**, of whether there is ownership of a valid copyright; and Copying of the protected work by the alleged infringer.

From the facts, the court made a finding that the Plaintiff had a valid copyright in respect of literary work titled, "Our Folktales" a manuscript containing five short children's stories namely; The Gooseberry triplets, Muvubi and his Fish Friends, Mukojo the Glutton, Kaleku and the enormous Beast and The Cruel Step Mother.

The court examined the evidence before it and concluded that the Defendant infringed on the Plaintiff's economic rights in respect of her literary work namely; Muvubi and his Fish Friends, Mukojo the Glutton, Kaleku and the enormous beast and The Cruel Step Mother when it altered, reproduced and sold them to the Government of the Republic of Rwanda as audio series without her authorization, licence, written assignment and transfer.

On the issue of violation of moral rights, the court also found a clear infringement as the CD jackets falsely attributed authorship solely to the defendant, omitting the plaintiff's name.

The court observed that such misattribution prejudiced the plaintiff's honor and reputation, transforming her original work into a derivative product marketed as the defendant's own.

Legality of implied consent

The court analysed the trust of the Defendant's defence that the Plaintiff gave an implied consent to the reproduction, sale and distribution of her work to the Government of Rwanda and decided that while Section 13(4) of the Copyright and Neighbouring Rights Act Cap 222 permits oral or inferred licenses from conduct, the defence evidence showed that there wasn't explicit permission sought from the Plaintiff before reproduction of her work. The court further held that the defendant's "gentleman's agreement" claim lacked evidentiary support under the writing requirement for assignments or transfers in Section 13(3) of the Copyright and Neighbouring Rights Act Cap 222. Therefore, a written authorization is mandatory for transfer of economic rights.

Reliefs in a copyright infringement claim

The court then proceeded to make a declaration that Plaintiff's copyright and moral rights were infringed, awarded royalty Fees of 30% of profits from the sale of the audio stories, with 24% annual interest from the date of infringement until full payment, permanent Injunction to bar the Defendant from further use or distribution of the Plaintiff's work, general damages of UGX. 70,000,000, exemplary damages of UGX 30,000,000, Interest of 6% per annum on damages from the date of judgment until full payment and Costs of the suit.

Relevance of the decision

1. This decision reflects the readiness of the Ugandan courts to enforce copyright protection in cases of cross-border infringement. Once it is shown that the works subject to copyright have been reduced in to material form, protection is automatically granted.
2. The courts are also beginning to start enforcement of moral rights as distinct from the economic rights. Publishers shall be held liable for infringement of moral rights for failure to acknowledge the author.
3. The court has also provided guidance on interpretation of section 13 of the Copyright and Neighbouring Rights Act Cap 222 by clarifying that whereas license can be implied from the conduct of the parties or the circumstances, an oral or implied license cannot substitute the requirement for written consent for core economic rights under section 13(3) of the Act. Publishers and other users of copyrightable materials are therefore advised to ensure that there is a written consent, or license or assignment before using such works to avoid liability.

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Please feel free to reach out to KTA Advocates at partners@ktaadvocates.com to discuss your specific needs.



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