

**THE REPUBLIC OF UGANDA**  
**IN THE HIGH COURT OF UGANDA AT KAMPALA**  
**(COMMERCIAL DIVISION)**  
**CIVIL SUIT NO. 443 OF 2010**

**SYLVIA NABITEEKO KATENDE -----PLAINTIFF**

**VS**

**BANK OF UGANDA ----- DEFENDANT**

**BEFORE LADY JUSTICE FLAVIA SENOGA ANGLIN**

**JUDGMENT**

**Brief Facts:**

The Plaintiff an artist and lecturer at the School of Arts, Makerere University participated in a contest that had been advertised in the newspapers for the creation of a model which was to eventually be translated into a sculpture for Kampala City Council (KCC) Centenary Park. The Plaintiff was the successful contestant and she was duly paid the prize monies for the model by KCC.

Subsequently, in 1992, Shell Uganda Limited contracted a team, headed by Dr. Pilkington Ssengendo, who translated the model into architectural form as the sculpture for KCC Centenary Park.

The sculpture was completed in October, 1994, and Shell Uganda duly paid the agreed fee. The sculpture is on public display at KCC Centenary Park.

In the year 2010, the Defendant introduced new bank notes among which were the Uganda 20,000/- shilling note, that carries the design of the monument at KCC Centenary Park.

The Plaintiff brought this suit against the Defendant contending that the sculpture was built by Prof. Ssengendo without her knowledge or consent. That she used her sweat and skill to make the model and the Defendant and Prof. Ssengendo appropriated it without her knowledge and made money out of it.

Further that she the Plaintiff has never been remunerated or enjoyed economic benefit for her work. Instead the various parties have wantonly and whimsically infringed on her copyright with impunity, hence this suit where she seeks recognition of her copyright in the work, special and general damages, and punitive/aggravated damages for the infringement by the Defendant.

Declaratory orders set out in the plaint, damages and costs of the suit were also applied for.

In defence of the suit, the Defendant denied that the Plaintiff has any claim against the Bank, contending that when Shell Uganda commissioned a team headed by Dr.Ssengendo to translate the model into the sculpture, the Plaintiff was at all material times aware of the commissioning.

That when the sculpture was completed on 20<sup>th</sup> October, 1994, Shell Uganda Limited duly paid the agreed commissioning fee of Shs. 20,000,000/- And that the Plaintiff authorized the commissioning of the sculpture.

Later, Dr.Ssengendo clarified to the Editor of the New Vision the respective roles he and the Plaintiff played in the commissioning of the sculpture. He also wrote to Shell as the commissioning entity on 03<sup>rd</sup> December, 1996, indicating what the correct inscription on the plaque on the sculpture should read.

It is the Defendant's contention that under the provisions of S. 8(1) (b) of the Copyright and Neighbouring Rights At, 2006, the copyright in respect of the sculpture vests in Shell Uganda Limited which commissioned the sculpture and not in the Plaintiff or Dr.Ssengendo. And accordingly that the Plaintiff has no cause of action for infringement of copyright and the suit should be dismissed on that basis.

In addition that the suit is fatally flawed in law for the reason that, the sculpture is displayed in a public park and accordingly its reproduction in visual or graphic form on the Uganda Shs. 20,000/- currency note falls under the fair use of works defence under S. 15 (1) (g) of the Copyright and Neighbouring Rights Act,2006.

The Defendant prayed for the dismissal of the suit with costs.

The following were the agreed issues for determination:

1. Whether the plaintiff discloses a cause of action
2. Whether the Plaintiff is the owner of the copyright in respect of the sculpture on public display at KCC Centenary Park; if so,
3. Whether or not the Defendant infringed the Plaintiff's copyright through its use of the sculpture on the Uganda Shs. 20,000/- shilling note
4. What remedies are available to the Plaintiff, if any?

The issues will be dealt with in the order that they were set out.

### **Whether the plaintiff discloses a cause of action:**

It has been established by decided cases that to determine whether a plaintiff discloses a cause of action, ***"must be determined upon perusal of the plaintiff alone, together with anything***

*attached so as to form part of it, and upon assumption that any express or implied allegations of fact in it are true”. - See Jeraf Sharif Vs Chotai Fancy Stores [1960] EA 374 at p.375.*

This position was reiterated in the case of **Attorney General Vs Olwoch [192] EA 392** and **Ismail Serugo Vs Kampala City Council and Attorney General, Constitutional Appeal No. 02/1998**, where it was stated that *“one has to peruse the plaint on the assumption that the facts pleaded are true”*.

And *“if the plaint shows that a Plaintiff enjoyed a right, the right has been violated and the Defendant is liable, then a cause of action is disclosed”*- Refer to **Auto Garage Vs Motokov (N0.3) [1971] EA 514**

Looking at the plaint in the present case, it can be discerned from paragraph 4 that the Plaintiff contends that she is the author of the work in Exhibit P1 and that the Plaintiff utilized the copy right without her consent and further infringed on the same through circulation of the bank notes bearing the said work. Though the Defendant alleges that the artwork was by Shell (U) Ltd and that therefore the copyright belongs to Shell and not the Plaintiff, the issues raised by the Defendant can only be effectively determined when the evidence from both parties has been analyzed.

Court finds that on the face of the Plaint, a cause of action is disclosed and therefore Counsel for the Defendant’s prayer for dismissal of the suit at this stage fails.

The next issue is **whether the Plaintiff is the owner of the copyright in respect of the sculpture on public display at KCC Centenary Park:**

To effectively answer this issue, court finds it necessary to explain what a copyright is, and also revisit the events that led to the creation of the sculpture on display at the KCC Centenary Park.

A copyright is broadly defined as *“an original work of authorship such as ...artistic work ...fixed in any tangible medium of expression, giving the holder “....the exclusive right to reproduce or authorize others to reproduce artistic, dramatic, literary, or musical works.”*- Refer to **Black’s Law Dictionary 7<sup>th</sup> Edition and Oxford Dictionary of Law**

Courts have described a copyright as, *“a natural right and creators are therefore entitled to the same protection anyone would be in regard to tangible and real property”*. And have emphasized that *“The proponents of this doctrine contended that creators had a perpetual right to control the publication of their work”*. Refer to **Stella Atal Vs Annabel Kiruta HCCS 0967/2004**

As a general rule, there is a copy right if skill or labour is employed in producing the particular form in which the work is expressed...

In the present case, the parties agree that the Plaintiff participated in and won a competition organized by Kampala City Council (KCC) and created a model sculpture to mark the 100 years of the Council's existence. The Plaintiff was paid Shs. 1,000,000/- for the model.

It is not disputed in this case that the model out of which the sculpture was eventually created was the original work of the Plaintiff. It was never copied from another persons' work. It was a product of her labour, skill and judgment.

However, as already indicated above, the model was created in the course of a competition organized by KCC. KCC advertised in the Newspapers seeking contestants to participate in a competition for the creation of a model that would be translated into a sculpture for construction of a monument. The parties agree that there was such an advertisement, although no copy was ever availed to court and therefore the exact terms of the advert are not known to court.

The Plaintiff participated in the competition and won the prize of shs. 1,000,000. Court finds therefore that the Plaintiff was **commissioned** by KCC to do a design for a sculpture. Meaning that the model design was made to the order of KCC. The work the Plaintiff produced was a drawing of the sculpture and not the sculpture.

It was also the testimony of the Plaintiff in this respect that there were no further agreements with KCC in respect of her artwork except that KCC wanted the model enlarged and executed in Kampala Centenary Park. And that no date was given when KCC was to enlarge the artwork.

With the Plaintiff's admission that there were no further agreements with KCC, Court finds that the Plaintiff did not acquire or retain copyright work in the drawing that was commissioned by KCC. The copyright now belongs to KCC, which commissioned the work and paid for it.

Court is fortified in its decision by the provisions of S.8 (1) (b) of the Copyright and Neighbouring Rights Act. The section provides that *"Where a person creates a work on commission by another person or body; **then in the absence of a contract to the contrary, the copyright in respect of that work shall vest in ... or the person or body that commissioned the work.**"*

The provision is mandatory.

Eventually, Prof. Ssengendo was commissioned by Shell (U) Ltd to turn the model/design into a sculpture. The model was accordingly enlarged and made into the sculpture when the Plaintiff was in the United States of America between 1992 -1995; by Prof. Ssengendo assisted by Sylvia Katende – Exhibit P111. The Plaintiff contends that her contact address was known to Makerere as being c/o the University of Pennsylvania. And that she was the one to put up the sculpture at the Park, after enlarging it with the help of Engineers.

The Plaintiff insists that she did not authorize Prof. Ssengendo to do the sculpture and there is no evidence that he ever acquired a license from her.

Court agrees with the submissions of Counsel for the Defendant that Prof. Ssengendo created the sculpture on the basis that the model design had been commissioned to belong to KCC under S. 8 (1) (b) of the Copyright Act. And as Counsel rightly asserted, in cross examination the Plaintiff agreed that it was not an agreed term of the contest that she would translate the model into architectural form as a sculpture, although that was the purpose for which the model was created.

It is therefore accepted that in those circumstances, it was open to KCC to commission any sculptor or sculptress of their choice to translate and create the sculpture for Centenary Park. Prof. Ssengendo was selected and was paid Shs. 20,000,000/- by Shell (U) Ltd for creating the sculpture. Prof. Ssengendo did not need the permission of the Plaintiff to do the sculpture or acquire a license from her for the purpose.

Court further observes that the design and the sculpture are two different works of art, albeit one is based on the other. A drawing is one form of artistic expression just as a sculpture is another form of artistic expression. The sculpture can be described as a derivative work of art, derived from the drawing.

The sculpture was contractually commissioned by KCC and paid for by Shell (U) Ltd. The copyright in the sculpture also belongs to KCC which also owns the Centenary Park where the sculpture is on display.

It is on record that when the Plaintiff returned to Uganda in 1995, and discovered that the plaque (commemorative inscription) on the sculpture indicated her as an assistant and Prof. Ssengendo as the designer; she complained to Prof. Ssengendo who agreed to change the plaque; and which he did by writing to Shell (U) Ltd and KCC. - Exhibit P4. The Prof. indicated that the plaque and its inscriptions would be replaced to read as follows: ***“Designed by sculptress Sylvia Nakitende; Executed by artists Ssengendo; Contractors IOTA Consultants Consulting Engineers and Planners”***.

It is the argument of the Plaintiff that Prof. Ssengendo accepted to have the changes made since he appreciated the copyright legal implications.

Despite the Plaintiff’s arguments, it is significant that she brought no action against KCC or Professor Ssengendo; possibly because she knew that no such action would have succeeded. It clear that the Plaintiff was cognizant of the purpose of the drawing she made and to what use it was to be put. And she rightly insisted that her role as designer of the drawing from which the sculpture was derived be recognized and from her evidence, Prof. Ssengendo took steps to have that done.

And as pointed out by Counsel for the Defendant and rightly so, proper inscription ought to be placed on the plaque as indicated in Exhibit P4, crediting the Plaintiff for the design and

Ssengendo for executing the translation. In the circumstances, that is all the Plaintiff was entitled to. But even then the inscription does not make either the Plaintiff or Prof. Ssengendo the owner of the copyright in the sculpture or even in the model as the copyright in both vests in KCC which commissioned and paid for both items.

The submissions of Counsel for the Plaintiff relating to Ss. 5, 14 (1) (a) and 35 of the Copyright Act are not applicable in this case.

The other issue framed for courts determination is **whether or not the Defendant infringed on the Plaintiff's copyright through its use of the sculpture on the UG. 20,000/ Shs. note.**

I wish to point out from the outset that, having found that the Plaintiff did not own the copyright in either the model design or the sculpture derived there from, this issue is answered in the negative. Nonetheless, court will make some comments in respect of the arguments raised by both Counsel.

The Plaintiff contends that no permission was given to the Defendant to copy the sculptural monument that was reproduced on the note. While the Defendant relies on the exception under S. 15 (1) (g) of the Copyright Act, to argue that the reproduction of the sculpture on the 20,000/- Shs. note did not require consent as it is situated in a public place and its use therefore amounted to fair use.

It is true the Defendant Bank used a picture of the sculpture in the midst of a public park, that is, KCC Centenary Park; and printed a photograph of the same onto the 20,000/- shilling currency note. Consequently, no action is made out against the Bank given that the Plaintiff does not obtain a copyright in the design she produced. And all the subsequent works, that is, the sculpture or the photographs of the same in a public setting are not her works. As earlier indicated, these are derivative works and the authors are different. The Defendant Bank did not need the permission of the Plaintiff to print the photograph of the sculpture on the currency note. The Defendant did not infringe any right of the Plaintiff as she had none, or the right of the owner of the copyright KCC.

Under S. 15 (1) of the Copyright Act, the fair use of a protected work in its original language or **in a translation** shall not be an infringement of the right of the author and shall not require the consent of the owner of the copyright where-

(g) Any work of art or architecture **in a photograph** ..... is reproduced and communicated to the public where the **work is permanently located in a public place** or is included by way of background or is otherwise incidental to the main object represented in the photograph.....

**Remedies available to the Plaintiff, if any:**

The Plaintiff sought remedies set out in paragraph 7 of the plaint. To wit: A declaration that the intellectual design belongs to the her; a declaration that the Defendant breached the intellectual property rights of the Plaintiff; an inquiry as to damages for infringement of copyright or, at the option of the Plaintiff, an account of profits; an order for the payment of all sums found to be due to the Plaintiff upon taking of such an inquiry or account; general damages; interest on the sums due and on general damages at commercial rate and Costs of the suit.

If Court had found that the Plaintiff held a copyright in the initial design work; what she would be entitled to would be explored, but in the circumstances, it is not necessary to do so. The remedies sought by the plaintiff are not available to her.

The Plaintiff would only have been entitled to the remedies, including damages if court had found her to be the owner of the copyright. S. 45 (4) of the Copyright Act provides for damages to a person whose copyright has been infringed from the person responsible for the infringement.

One of the indicators/guides court would have taken into account in awarding damages is **“the profit”** the Defendant Bank would have made as a result of the infringement. But in this case, it cannot be said that the Bank of Uganda has made any profit out of reproducing a photograph of a sculpture in a public park on a currency note. The bank notes are supposed to feature recognizable icons of society. While the Bank of Uganda makes profits, they cannot be said to be profits made from the use of such a photograph.

Consequently, the action brought by the Plaintiff fails for all the reasons set out in this judgment and is dismissed.

Each party should bear its own costs.

**FLAVIA SENOGA ANGLIN**

**JUDGE**

**28.01.15**

