



The Anti-counterfeiting & piracy Crusade

An International Problem
Come to Ghana





**Legal and Regulatory Enabling
Framework Supporting Anti-
Counterfeiting and Piracy**

Table of Contents

- PREFACE 5
- EXECUTIVE SUMMARY 6
- KEY FINDINGS & RECOMMENDATIONS 7
- Introduction 10
- Some Definitions of Counterfeiting and Piracy 12
- **1. Current Legislation on I.P. and Provisions Relating to Counterfeiting & Piracy Existing in Other Laws in Ghana: 13**
- A. Trade Marks Act, 2004 (Act 664) 13
- B. Industrial Designs Act, 2003 (Act 660) 15
- C. Copyright Act, 2005 (Act 690) 16
- D. Patents Act, 2003 (Act 657) 17
- E. Geographical Indications Act, 2003 (Act 659) 18

Table of Contents Continued

- F. Layout-Designs (Topographies) of Integrated Circuits Act, 2004 (Act 667) 18
- G. High Court (Civil Procedure Rules), 2004 (C.I. 47) 19
- H. Criminal Code 19
- I. Food and Drugs Board (FDB) Act, 1992 as amended 19
- J. Standards Decree, 1973 (NRCD 173) as amended by Standards (Amendment) Decree, 1979 (AFRCD 44) 19
- K. Customs Excise and Preventive Services (Management Act), 1993 (PNDCL 330) 20
- L. Protection Against Unfair Competition Act, 2000 (Act 589) 20

Table of Contents

- **2. International Norms on Enforcement of Intellectual Property Rights, Counterfeiting & Piracy; National Efforts Against Counterfeiting and Piracy** **21**
- A. The World Trade Organization (WTO) Agreement on Trade-related Aspects of Intellectual Property Rights (the TRIPS Agreement); World Customs Organization (WCO) & World Health Organization (WHO) 21
- B. World Customs Organization 21
- C. World Health Organization (WHO) 21
- D. Regional Initiatives / Harmonization within the European Union 22
- E. South Africa: The Counterfeit Goods Act No. 37 of 1997 24
- F. United Kingdom: The Trademarks Act, 1994 24
- G. Counterfeit and Fake Drugs and Unwholesome Processed Foods (Miscellaneous Provisions) Decree No. 25 of 1999 Nigeria 26
- H. International Governmental Organisations and Non Governmental Organisations (NGOs) 27

Table of Contents

- **3. Ghanaian Ministries, Departments & Agencies (MDAs) and Their Mandates and Operations** **27**
- A. Registrar-General's Department (RGD) 27
- B. The Copyright Office (CO) 27
- C. The Customs, Excise and Preventative Service (CEPS) 28
- D. Ghana Police Service (GPS) 28
- E. The Food and Drugs Board (FDB) 28
- F. The Ghana Standards Board (GSB) 29
- G. Courts (Civil remedies and Criminal sanctions) 29
- **4. Private Sector Stakeholders and Owners of IPRs** **30**
- **5. Level of Awareness in MDAs and in the Public Regarding Counterfeiting and Piracy** **30**
- 6. Combating Counterfeiting and Piracy in Ghana - Weaknesses and Gaps 31
- A. Appraisal 31
- B. Absence of institutionalised surveillance of market place; delays, etc., in regulatory agencies 33
- C. Addressing shortfalls in the system 33

Table of Contents

- **7. Recommendations** **35**
- A. Legal and Regulatory Recommendations: 35
- B. Awareness-raising Recommendations 36
- C. Capacity Building Recommendations 37
- D. Inter-action with Officials from Jurisdictions with Experience in Combating Counterfeiting and Piracy 37
- E. Institutional Recommendations – see IP Crime Taskforce and Roadmap Details 38
- F. POSSIBLE SOURCES OF PRECEDENTS (Non- Exhaustive List) 38

Some Definitions of Counterfeiting and Piracy

The TRIPS Agreement, in a footnote to its Article 51, provides the following definition for counterfeit trademark goods and pirated copyright goods:

- a) "counterfeit trademark goods" shall mean any goods, including packaging, bearing without authorization a trademark which is identical to the trademark validly registered in respect of such goods, or which cannot be distinguished in its essential aspects from such a trademark, and which thereby infringes the rights of the owner of the trademark in question under the law of the country of importation;

b) "pirated copyright goods" shall mean any goods which are copies made without the consent of the right holder or person duly authorized by the right holder in the country of production and which are made directly or indirectly from an article where the making of that copy would have constituted an infringement of a copyright or a related right under the law of the country of importation.

The World Health Organisation (WHO), within the framework of its **International Medical Products Anti-Counterfeiting Task Force (IMPACT)** has, currently, the following definition of counterfeit medicine:

a counterfeit medicine is “a medicine, which is deliberately and fraudulently mislabelled with respect to identity and/or source. Counterfeiting can apply to both branded and generic products and counterfeit products may include products with the correct ingredients or with the wrong ingredients, without active ingredients, with insufficient active ingredients or with fake packaging”.

The World Customs Organization (WCO) Model Law provides the following definition of goods infringing IPRs:

Goods Infringing Intellectual Property Rights shall mean:

Any goods, which are made, reproduced, put into circulation or otherwise used in breach of the intellectual property laws and without the consent of the right holder or a person duly authorised to do so by the right holder. If such making, reproduction, use or putting into circulation of the goods took place outside [the country] the goods are deemed to be infringing if the acts would have constituted an infringement in [the country] had they been undertaken in the country.

For the purposes of this law goods protected with copyright or related rights with respect to which the rights management information they may incorporate has been removed, altered, or added without the right holders' authorisation shall be deemed to be goods infringing the said intellectual property rights.

Offences

Trade Marks Act, 2004

- GHC 6,000 or two years imprisonment or both
- GHC 3000 or one year or both

Industrial Designs Act, 2003

- GHC 24,000 or two years or both

Copyright Act, 2005

- GHC 6,000 –GHC 12,000 or maximum three years or both

Patents Act, 2003

- GHC 24,000 or maximum two years

Geographical Indications Act, 2003

- GHC 24,000 or two years maximum or both

Recommendations

Criminal penalties exist in each of the intellectual property laws. Civil remedies are provided for. However, they need amplification in setting out expressly the remedies available (see UK Trade Marks Act).

Criminal offences need to be categorised into the serious and less serious offences and provision made for offences triable summarily and those triable on indictment, with corresponding penalties for each category.

Recommendations Continued

That said, what arises is the question of implementation and, in this regard, reference is made to the suggested Round Table on enforcement and examples contained in the Best Practice Study. Against this background and the information contained in the Stakeholders Needs Assessment and in the Socio-Economic Survey, the recommendations, below, are submitted.

Legal and Regulatory Recommendations

- I. Enact piecemeal amendments to the existing laws or enact a law specifically dealing with counterfeiting and piracy.

- II. Include definition of “counterfeiting” and “piracy” as criminal offences embracing all categories of persons involved and providing for increased penalties (if a separate law on counterfeiting and piracy is adopted).

Legal and Regulatory Recommendations Continued

- III. Provide for different categories of offences and establish offences triable summarily and those triable on indictment.
- IV. Update and complete existing IP laws (Promulgation of Regulations, Schedule of Fees and Forms).
- V. Incorporate provisions found in the Copyright Act and in the Trade Marks Act in relation to notice by IPR holders to the Commissioner of CEPS to prevent importation or export of goods infringing all IPRs.

Legal and Regulatory Recommendations Continued

- VI.** Incorporate the infringement, forfeiture of counterfeit goods and the criminal sanctions provisions, as contained in the UK Trade Marks Act, in all IP laws.
- VII.** Introduce punitive criminal sanctions for the unauthorised use (forgery) of the Ghana Standards Board logo.
- VII.** Introduce incentives for prevention of importation and sale of counterfeit & pirated goods by holding landlords liable for such goods sold on their premises or markets (including District and Metropolitan Assemblies), and holding Clearing Agents liable where the importer/consignee of counterfeit and pirated goods cannot be found and requiring shipping lines to provide information on consignors of such goods where the consignee cannot be found.

Legal and Regulatory Recommendations Continued

- IX.** Provide for the issuance of search warrants and for seizure and destruction of counterfeit and pirated goods.
- X.** Adopt measures in respect of C&P goods in transit.
- XI.** Enact proceeds of IP crime legislation that will provide for confiscation of the proceeds of IP crime.
- XII.** Include packaging in the definitions of infringement and offences.
- XIII.** Enable authorities to require persons found to be dealing in counterfeit goods to provide information on the origin of the goods and distribution channels.

XIV. Establish, in each regulatory agency, procedures/roadmaps/notices for dealing with C&P complaints, including timelines involved, to ensure speedy action regarding seizure, detention and destruction of goods; examination & testing of goods to determine whether they are counterfeit or pirated goods; and conducting raids and arrests, etc.

Awareness-raising Recommendations

- I. Promote initiatives to raise public awareness about the impact of counterfeiting such as the loss of foreign investment and technology transfer, risks to health, links with organized crime, loss of tax revenue, etc.).
- II. Make use of WIPO Guide to I.P Outreach (WIPO SME Division) and materials from other agencies e.g. WCO.
- III. Adapt and translate WIPO documents and other available promotional material into local Ghanaian languages (as was the strategy in the recent currency re-denomination exercise).

Awareness-raising Recommendations Continued

- IV. Establish and maintain a website providing information on anti-counterfeiting and anti-piracy measures and activities
- V. Provision of practical IP advice to companies and SMEs by the IP Office on how to register and use IP rights for firms registering with the Registrar-General's Dept, the Copyright Office, Ghana Investment Promotion Centre, Ghana Chamber of Commerce and Association of Ghana Industries.

Capacity Building Recommendations

- I. Establishment of training programmes in enforcement of intellectual property rights: The Industrial Property Office under the Registrar-General's Department and the Copyright Office should consult with the Judicial Training Institute to determine their needs and challenges in respect of IP law and the training needs of judges.
- II. Develop training modules for prosecutors, customs, police officers and investigators on IP crime issues.

Inter-action with Officials from Jurisdictions with Experience in Combating Counterfeiting and Piracy

- I. Share experiences with and adopt measures utilized in success stories from countries such as the UK Customs, Trading Standards Institute, Crown Prosecution Office, and the Judiciary (Round Table on enforcement and combating counterfeiting and piracy).
- II. Utilisation of anti-C&P measures and facilities established at the international level.
- III. Information-sharing with international organization and among MDAs and establishment of electronic databases accessible to other MDAs engaged in combating C&P.

Inter-action with Officials from Jurisdictions with Experience in
Combating Counterfeiting and Piracy Continued

- I. Adopt measures and strategies established at the international level and best practices (WCO) Interpol etc, (set out in Best Practices Study).
- II. Building-up links and cooperative mechanisms with ECOWAS and within ECOWAS countries in combating C&P; linking into the ECOWAS representative in Ghana for same.

Institutional Recommendations – see IP Crime Taskforce and Roadmap Details

- To facilitate and drive-forward the above, adoption and creation of an [National] Intellectual Property Crime Taskforce, overseeing the design, implementation and sustainability of an IP Crime Strategy and Annual Plans.
- Such a Taskforce should include the more formalized participation of government, private sector, and MDAs, should revolve around the establishment of an oversight body, should highlight the identification of areas of particular concern, and should result in the publication of a yearly IP Crime Report, and the establishment of an intelligence network to assist enforcement agencies.

POSSIBLE SOURCES OF PRECEDENTS

(Non- Exhaustive List)

1. Copyright, Designs and Patents Act 1988 (as amended by numerous Acts) UK
2. Trademarks Act 1994 UK (as amended by:
 - The Trade Marks (EC Measures Relating to Counterfeit Goods) Regulations 1995 (SI 1995/1444) (*1st July 1995*);
 - Section 13 of the Olympic Symbol etc (Protection) Act 1995 (*21st September 1995*);
 - Part IV of the Patents and Trade Marks (World Trade Organization) Regulations 1999 (SI 1999/1899) (*29th July 1999*);

2. Trademarks Act 1994 U.K

Continued

- Section 6 of the Copyright, etc. and the Trade Marks (Offences and Enforcement) Act 2002(*20th November 2002*);
- The Trade Marks (Proof of Use, etc.) Regulations 2004(S.I 2004/946) (*5th May 2004*);
- The Trade Marks (International Registrations Designating the European Community, etc.) Regulations 2004 (SI 2004/2332) (*1st October 2004*);
- The Serious Organized Crime and Police Act 2005 (*19th April 2005*) and;
- The Intellectual Property (Enforcement, etc.) Regulations 2006(SI 2006 / 1028) (*29th April 2006*)

POSSIBLE SOURCES OF PRECEDENTS

Continued

3. Counterfeit Goods Act. No 37 of 1997 Republic of South Africa
4. Counterfeit and Fake Drugs and Unwholesome Processed Foods (Miscellaneous Provisions) Decree No. 25 Of 1999 Nigeria
 - Additional Sources are contained in the Comparative Best Practices Study

The National Crusade Against Counterfeiting Products Project Ghana

**A Roadmap for the Crusade Against
Counterfeiting and Piracy in Ghana**

A Roadmap for the Crusade Against Counterfeiting and Piracy in Ghana

This Roadmap consolidates and summarizes the main findings, and proposes a set of goals and suggests practical means for achieving them over the short (12 months) medium (24 months) and long (24+ months) terms



Thank
You