

A REVIEW OF THE LEGAL AND
REGULATORY FRAMEWORK
SUPPORTING ANTI –
COUNTERFEITING AND ANTI
PIRACY- THE GHANAIAN
STATUS.

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Highlights

- Introduction
- Current Provisions Against Counterfeiting and Piracy
- Nature and Scope of Remedies (Civil & Criminal Sanctions)
- Way forward

Introduction

- The demand for intellectual property legislation after Ghana gained her independence occurred almost 47 years ago.
- The Copyright Act was enacted in 1961(Act 85) amended by the Copyright Law, 1985(PNDCL 110)
- The Merchandise Marks Regulations 1964,(Act 253) and the Merchandise Marks (Prohibited Goods) Regulations 32,1936
- Trademarks Act 1965 Act 270, Trademarks Regulations (L.I 667) of 1970.
- United Kingdom Designs (Protection)Ordinance 1951 (Cap 182)
- Textile Designs(Registration) Decree, 1973, (NRCD 213)
- Patent Law, 1992 (PNDCL 305A)
- Protocol on Patents and Industrial Designs within the Framework of Industrial Property Organization for English Speaking (ESARIPO) Ratification Law, 1985 (PNDCL137)

Introduction (cont'd)

- A cursory look at the legislative history reveals that , Ghana's maturation process in the use of I.P.R system was suddenly interrupted as a result of the December 1993 Uruguay Round negotiations of the General Agreement of Trade and Tariffs ("GATT")
- The World Trade Organization's ("WTO") Trade-Related Aspects of Intellectual Property Rights Agreement ("TRIPs") was created.
- TRIPs came into force in 1995.
- It sets minimum standards of protection for the various forms of intellectual property and required WTO members to provide for "effective enforcement" of intellectual property rights.

Introduction (cont'd)

- TRIPs also included detailed provisions on civil, criminal and border enforcement measures designed to protect intellectual property rights
- Members had to "rewrite their national laws to conform to internationally agreed norms for protecting" intellectual property.
- In 2000 to 2004, Ghana amended her intellectual property laws and also introduced new areas of protection.

Current Legislations Against Counterfeiting and Piracy.

- Statutory Provisions that have a Bearing on Counterfeiting and Piracy are;
- The Trademarks Act 2004, Act 664
- The Copyrights Acts,, 2005 Act 690
- The Industrial Designs Act , 2003 Act 660
- The Patents Act 2003, Act 657
- The Geographical Indications Act, 2003 Act 659
- The Layout Designs (topographies) of Integrated Circuits Act, 2004, Act 667
- Protection Against Unfair Competition Act, 2000 (Act 589)
- Criminal Code 1960, Act 30
- High Court (Civil Procedure Rules) 2004 (C.I 47)
- Food and Drugs Board (FDB) Act 1992 as amended
- Standard Board Decree 1973(NRCD 175) as amended
- Customs Excise and Preventive Service (Management Act) 1993 (PNDCL 330)

Current Legislation (cont'd)

- ***Trademarks; Act, 2004 , Act 664***
- In the Act a Trademark is defined as;
- any word, name, symbol, or device, or any combination thereof--(1) used by a person or an enterprise in commerce to identify and distinguish his or her goods/services, from those manufactured or sold by others
- Trademarks are "the currency of modern commerce "
- Section 3 of the Act provides that the registration of a trademark by any person confers an exclusive right to the use of the trademark on the person.
- Rights conferred by registration under Section 9, include, the exclusive use of the mark, institution of a court action against any person who infringes the mark by using it without permission, or performing acts likely to cause an infringement.
- Section 9(8) makes it an offence to infringe the rights of a registered trademark owner by using his mark without his consent.
- Part III of the Trademarks Act deals with Trade Descriptions and fraudulent marks.
- Section 23 (1) defines a trade description as a statement or any other indication direct or indirect which relates to the number, quality of any goods, mode of manufacturing etc.
- Under Section 23(2) of Act 664 a Trade description is false if it is likely to be misunderstood, or mistaken for an indication as to the same or some other matter which would be false or misleading in respect to the goods to which such a description is applied

Current Legislation (cont'd)

- Section 24(5) states that a person falsely applies a trademark to goods if without the consent of the owner of the mark, applied a mark that resembles the original as to be likely to deceive.
 - Under Section 25 a person forges a trademark if that person ;
 - without the consent of the owner of the mark or a mark so nearly resembling that mark as to be likely to deceive
 - falsifies a genuine trademark , whether by alteration, addition or otherwise.
- Section 25 (2) places the burden of proving the consent of the owner on the defendant in a prosecution for forgery.
- Section 26 of Act 664 sets out the offences relating to trademarks and trade descriptions , which include applying false trade description, forging a mark, possess an article to forge a mark, or cause an infringement to a mark.
- Whoever commits an offence under this section is liable on a summary conviction to a fine not exceeding five hundred penalty units(6,000 Ghana cedis) (L.I 1813, Fines Instrument of 2005) or to a term of imprisonment not exceeding 2 years or to both or a fine.
 - Whoever commits this offence is liable on summary conviction to a fine not exceeding 250(3,000 Ghana cedis) penalty units or a term of imprisonment not exceeding 1 year or to both.
- Section 28 provides a mechanism to notify the Commissioner of customs administration swiftly, in a clear way about specific information concerning suspected counterfeit goods to detain same.
- This covers goods in transit as well as transhipped goods.

Current Legislation (cont'd)

- **Copyright Act , 2005, Act 690**
- Copyright law provides protection for a bundle of rights, the enjoyment of which prevents the unauthorised use or exploitation of other peoples creative works.
- Rights accruing to creators exist in two forms (economic and moral)
- Economic rights enable the author to reap the financial benefit of his/her creative efforts for a reasonable period of time
- Moral rights protect the personality or reputation of the author and exist in perpetuity
- Section 1 list works eligible for copyright protection. (literary, scientific, and artistic works)
- Section 26 of Act 690 empowers an officer of CEPS to detain imported sound recording or other copyright work unless satisfied that the products are not pirated.
- Section 42 sets down a list of acts that constitute offences, such as reproduction , duplication, distribution , manufacturing and sale for commercial purposes
- Under Section 43, a person who commits an offence under the Act is liable on summary conviction, to a fine not less than 500 penalty units (6000 Ghana cedis) and not exceeding 1000 penalty units. Or to a term of imprisonment . of not more than 3years or to both.
- Section 47 provides for Civil remedies and entitles a person whose rights are in imminent danger of being infringed to initiate proceedings in Court, for
 - an injunction,
 - order requiring CEPS to detain goods
 - for recovery of damages for infringement

Current Legislation (cont'd)

- *Industrial Designs Act, 2003 ,Act 660*
- Section 1 defines an industrial design as the ornamental aspect of an article
- Criteria for registration are novelty and originality
- Registration confers the exclusive right to make , sell import or otherwise export for commercial purpose articles embodying a design.
- Section 22 entitles an IPR holder to institute a court action for an injunction to prevent an infringement, award damages and grant any other remedies
- Section 22(3) any person who commits an offence is liable to a summary conviction and a fine not exceeding 2000 penalty units(24,000 Ghana Cedis) or to a term of imprisonment not exceeding two years or to both.

Current legislation (cont'd)

- **Patent Act 2003, Act 657**
 - Section 1 provides the definition of a patent
 - Section 11 deals with the rights conferred by a patent
 - Protection is for a period of 20 years
 - The Act empowers right holders to initiate court action for the grant of injunctions, award damages and any other relief provided for in the general law.
 - Any person who make , import , export , offer for sale, selling and using the product or process without the consent of the owner constitutes an infringement
 - Section 37, a person who commits an offence is liable to a fine not exceeding 2000 penalty units (24,000 Ghana Cedis) or to a term of imprisonment not exceeding two years
- **Geographical Indication Act, 2003 Act 659**
 - Section 1 empowers any interested person to institute an action in court to prevent the use of designation likely to mislead the public as to the true origins of products , use which constitute unfair competition within the meaning of the Protection Against Unfair Competition Act,2000, etc
 - Offences are spelt out under Section 5. Any person who knowingly uses a misleading designation commits an offence and is liable on summary conviction to a fine not exceeding two thousand penalty units(24,000 Ghana cedis) or to a term of imprisonment not exceeding two years or to both
 - Section 5 (2) states that where a person is convicted the goods and things used at the discretion of Court to be forfeited to the republic

Current legislation (cont'd)

- **Layout Designs (Topographies)of Integrated Circuits of Integrated Circuits Act 2004, Act 667.**
- In accordance with section 4 any act committed without the consent of the right holder constitutes an infringement.
- Section 14- Court may grant an injunction, award damages and grant any other damages
- Section 15- Any person who knowingly infringes a right commits an offence and is liable on summary conviction to a fine of 2000 penalty units (24,000 GH cedis) or to a term of imprisonment for two years.
- Court has the discretion to order seizure, forfeiture and destruction of the layout designs or articles used in the commission of the offence

Current legislation (cont'd)

- **FDB Act, 1992 as amended**
- Section 3 makes it an offence to manufacture, label package, sell or advertise any food or drug or other chemical substances in a manner that is false, misleading or deceptive, in relation to the character, nature, value quality, composition, substance merit and safety.
- A person who commits such the offence is liable on conviction to a fine not exceeding 500 penalty units (6,000GH Cedis) or to a term of imprisonment not exceeding two years or to both.
- **The Criminal Code 1960 (Act 30)**
- Section 161- states a person commits a misdemeanour if he forges a document or counterfeits a trademark goods or anything in connection in or about the sale or offer of a sale of goods.
- **The Standard Decree 1973**
- Section 21 makes it an offence to make any representation, whether in writing or not , use any mark, which conveys the impression that any goods, process or practice complies with a standard specification when it does not do so.
- **The High Court (Civil Procedure Rules**
- Order 63(4) entitles holders to apply to the Court for an order of seizure, or detention of goods by CEPS.
- Court may order the defendant to disclose to the plaintiff the identity of other persons involved in the production and distribution of infringing goods/services
- It provides for forfeiture or destruction of offending goods
- **Protection Against Unfair Competition Act ,**
- Section 8 provides for Civil remedies, and any person who considers that he is likely to be damaged or damaged by an act of unfair competition may institute an action for an order of injunction, award of damages and any other remedy the court consider fit.
- Mandates of Agencies varied and different
- Implementing regulations for IPR's not yet passed.

Nature and Scope of Sanctions

- Various Agencies have provisions in their Acts against the act of counterfeiting and Piracy .
- Civil and Criminal Sanctions
- Civil Remedies-
- provide for sanctions against infringement, including injunctions, forfeiture, seizure and destruction of all counterfeit and pirated merchandise.
- Civil remedies catered for in all the IP laws except Trademark Act
- Statutory laws do not obliterate common law protection on I.P related matters under the law of torts and passing off.
- Company's have become proactive in the fight against Trademark infringement
- *Westinghouse Electric Corporation .v. Gibrin Ibrahim Adam* (Suit No CCC02/05)
- Companies have stopped relying solely on the law to provide remedies for infringement.
- - In the case of the *Marlboro* Trademarks infringement(*Philip Morris Products S.A*)

Nature and Scope of Sanctions

- **Criminal Sanctions**
- IP laws have provisions on Criminal sanctions.
- Inconsistencies between the provisions applying to different I.P offences, sanctions differ from one Act to the other, (eg. Trademarks fine not exceeding 250 penalty units/ term of imprisonment 1 year , in I.D fine is 2000 penalty units/ term of imprisonment 2 years, Copyright fine of 500 penalty units and not exceeding 1000 units, a term of imprisonment 3years.
- Criminal sanctions not being aggressively enforced.
(*Marlboro trademark infringement*)

Way forward

- Provide greater legislative transparency to assist enforcers by bringing into line penalties for IPR offences
- Establish a hierarchy of criminal offences in the Acts (eg a stiffer sanction for the head of a counterfeit distribution ring and decreasing penalties for small time sellers on the street)
- IPR laws could include powers of arrest in cases for making illegal goods for sale
- Clarify rules for civil sanctions in all IPRs by specifying provisions in clear and simple language(eg, for obtaining Court orders, request forms to CEPS. Etc.)
- Provision of the definition: counterfeiting and piracy

Conclusion

- Modern product counterfeiting has evolved significantly in the last couple of years. Given that different I.P regimes are more appropriate at different stages of national development, it is important that the nation adapts the I.P regimes in a manner most applicable to our situation.
- The IP laws have attempted to keep pace with counterfeiting and piracy trends, our legislative history reflects the efforts to stay abreast with trends and sometimes our inability to do so.
- The problem of trafficking in counterfeit and pirated goods must be addressed before it escalates to a point where consumers will have no confidence in products they purchase.

