

# Anti-Counterfeiting - Southern Africa



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patents • trade marks • copyright

# South Africa

## Legislative Framework

- Common Law Country (similar to the United Kingdom)
- Member of the Paris Union and TRIPS
- **Counterfeit Goods Act, 37 of 1997**
- Trade Marks Act No. 194 of 1993
- Copyright Act No. 98 of 1978



the dti

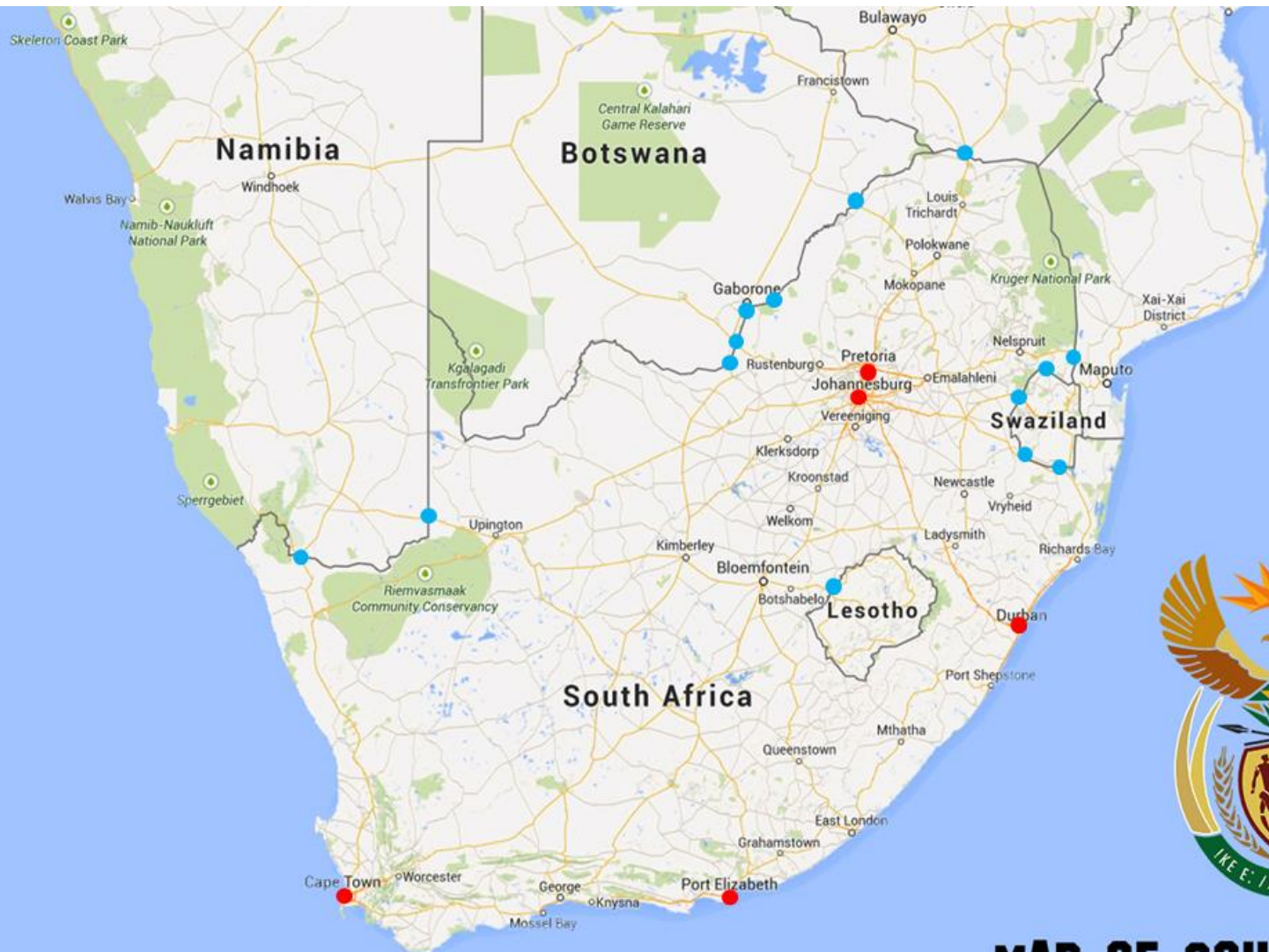
Department:  
Trade and Industry  
REPUBLIC OF SOUTH AFRICA



# Effective Measures

- **Border control:**
  - Customs: Section 15 of the Counterfeit Goods Act
  - Border Policing
- **Market Place enforcement**
  - SAPS & DTI: Conducting search and seizure operations

# Map of South Africa



- Major civic centres
- Ports of Entry



## MAP OF SOUTH AFRICA

# What can be enforced?

- “Protected goods”
  - Any goods in respect of which an IP right owner can in principle enforce his rights
- “Intellectual Property Rights”
  - Registered Trade Marks (Trade Marks Act)
  - Well-known trade marks
  - Copyright (Copyright Act)
  - Prohibited marks (Merchandise Marks Act)
- Excludes common law rights, patent and design rights.

# Definition

- “Counterfeiting:
  - Protected goods are imitated to such a degree that those goods are substantially identical copies of the protected goods -Copyright piracy
  - Colourable imitation of intellectual property right so that the other goods are calculated to be confused with or be taken as being the protected goods- Trade Mark counterfeiting.
  - Intellectual property right must be infringed



# Who can file a complaint

- Any person who has interest in protected goods
- Who has an interest?
  - “Owner” or “Licensee”
  - “Importer”; “Exporter” or Distributor; or
  - Duly authorised agent or Representative; or
  - Attorney of all the above

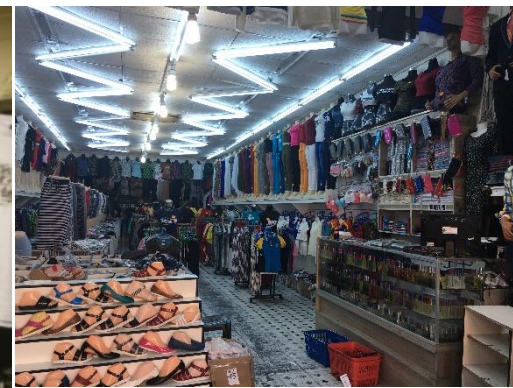
# Complaint

- Filed by “complainant”
  - by way of allegations in an affidavit
  - legal representative can depose to affidavit
- Allegations in affidavit
  - Complainant’s title or interest
  - Subsistence of IP right
  - Infringement of IP right
  - Counterfeit nature of goods (expert analysis)
  - Address of suspect
  - Request to obtain warrant & execute



# Dealing in Counterfeit Goods: Prohibited Acts

- Possession/control
- Sold, hired out, bartered, exchanged or offered
- Exhibited in public for purposes of trade
- Disposed in course of trade
- Distributed for purposes of trade or whereby brand holder suffers prejudiced



# Prohibited Acts

- Manufactured, produced or made (Except)



# Prohibited Acts

- Imported or exported

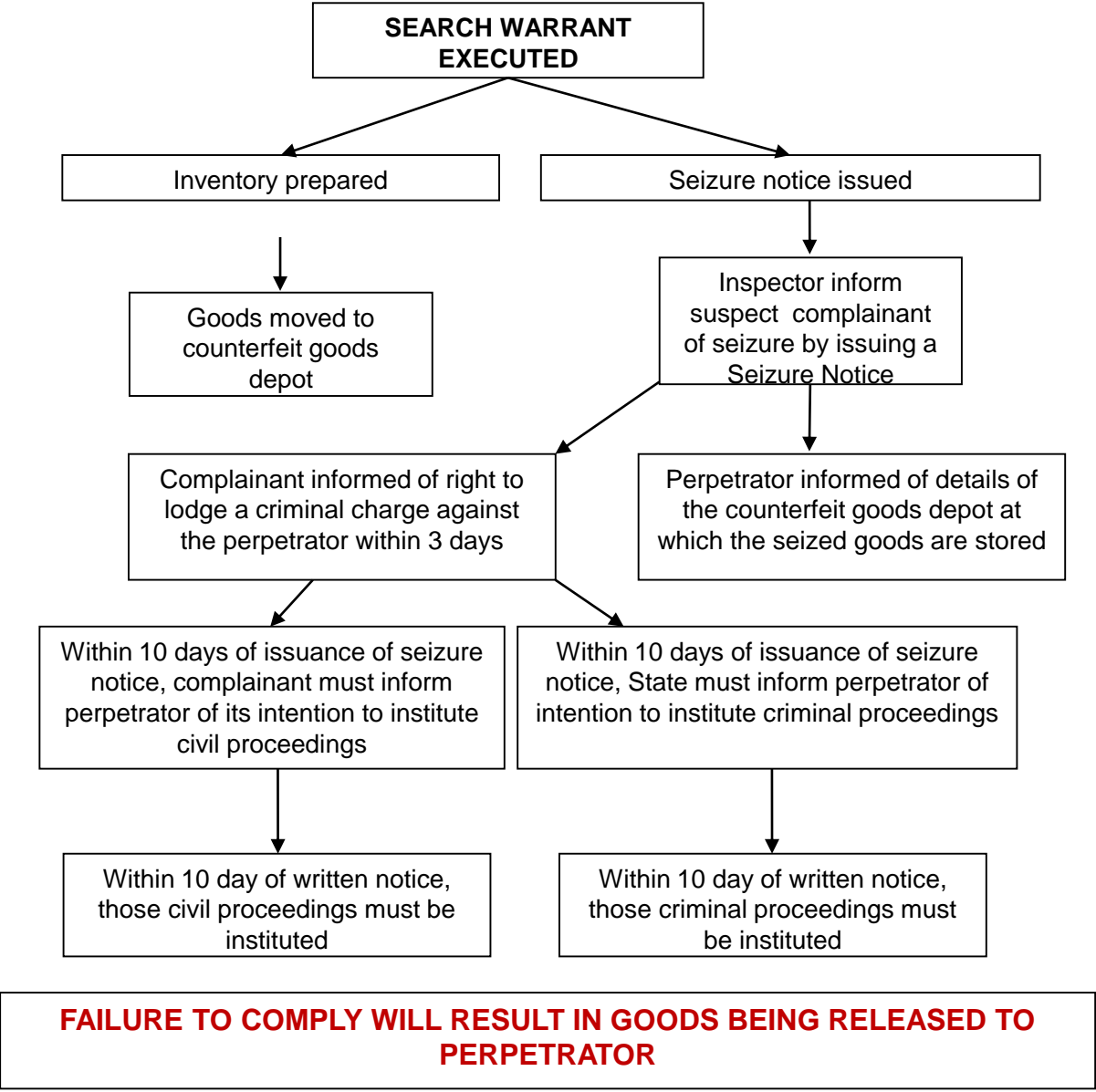


# Offence

- Dealing in counterfeit goods is an offence
- It is necessary to prove that the perpetrator:
  - knew or had reason to suspect that the goods are counterfeit;  
or
  - failed to take reasonable steps to avoid act/conduct



# Post Raid



# Criminal Penalties

- Order for destruction of goods
- Disclosure of source of counterfeit goods.
- First conviction:
  - fine of R5000 per article or imprisonment not exceeding 3 years  
or both
- Second /subsequent conviction:
  - fine of R10 000 per article or imprisonment not exceeding 5  
years or both

# Civil Relief

- An interdict/injunction against the Defendant;
- Declaration that the seized goods are counterfeit goods;
- Delivery up of the counterfeit goods to the owner of the IP right;
- Disclosure by the Defendant of the source/s & identity of persons involved in the importation and/or distribution;
- Damages and costs, including legal, storage and destruction costs.

# Border Control



Cape Town Harbour



Durban Harbour



# Borders with Botswana



Groblers  
Bridge  
Border Post



# Mozambique



Lebombo  
Border Post



# Zimbabwe

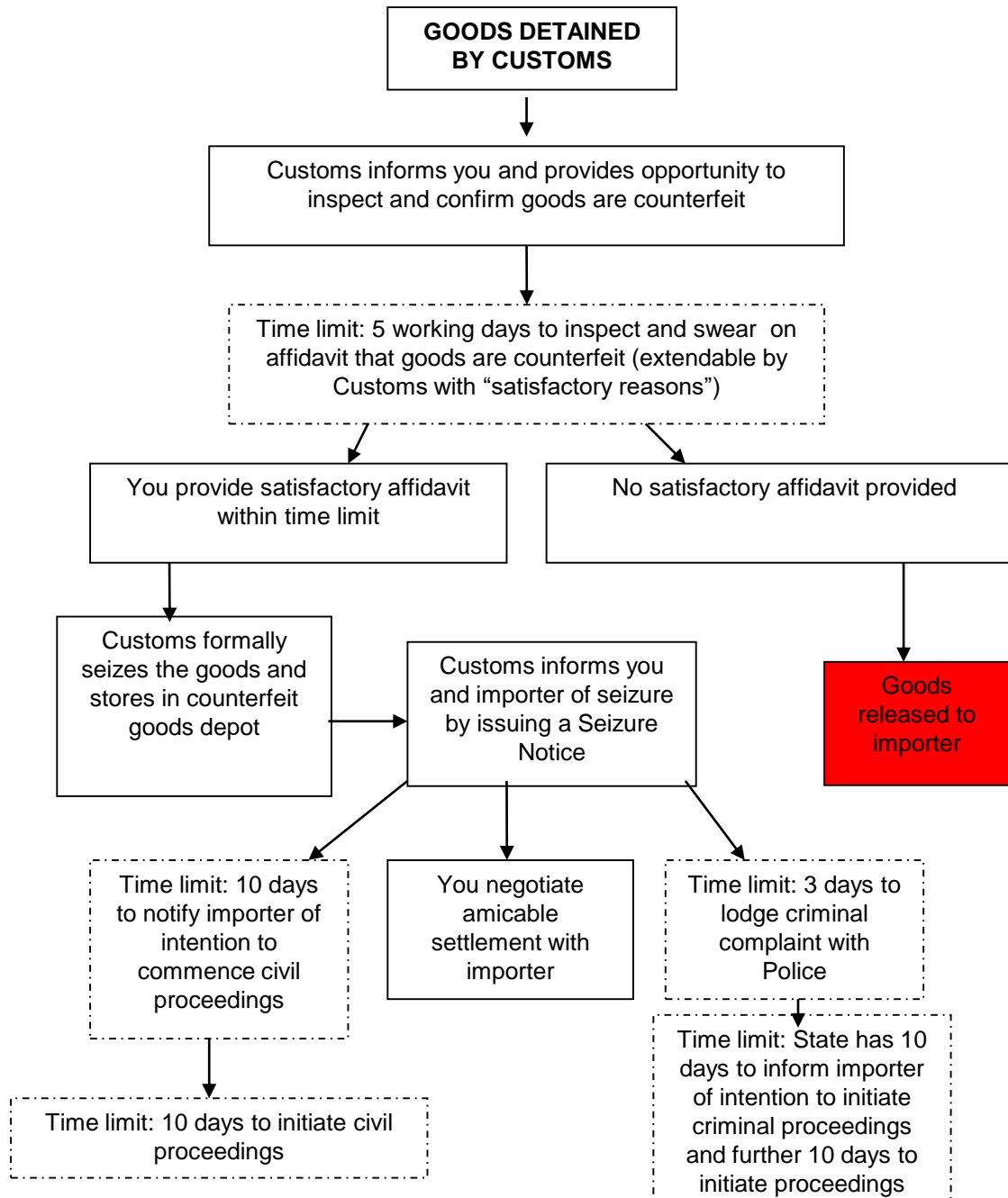


Beitbridge  
Border Post



# Border Control

- **Necessary** for IP Right owner for file a Section 15 application (Customs watch notice) with the office of the Commissioner of Customs;
- Furnish customs with details of IP rights and request that suspected counterfeit goods are detained;
- Must be filed in the name of the IP Right owner;
- Indemnity (serves as security);
- Power of Attorney;
- Inform Customs of authorized importers;



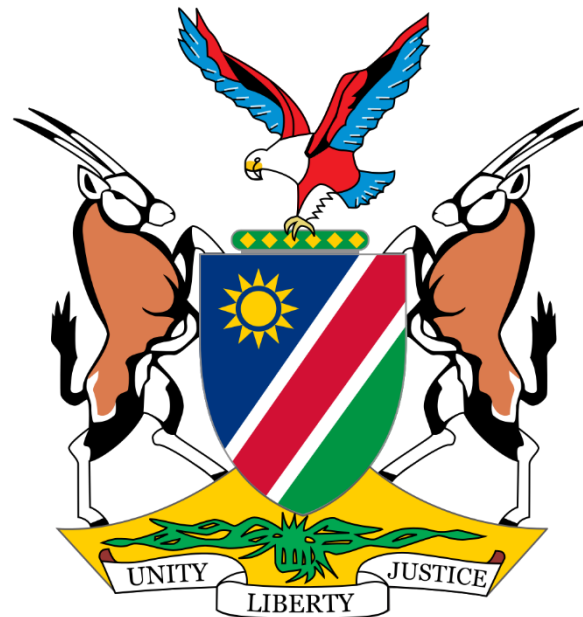
# Market Place Enforcement

- Voluntary surrender approach:
  - Informal market;
  - Low quantities of goods;
  - Information gathering;
  - Focus on removal of counterfeit goods from the market place.



# Namibia

- Legislation
  - Industrial Property Act, 2012 (Regulations not enacted)
  - Trade Mark Act, 1973
  - Merchandise Marks Amendment Act, 1987

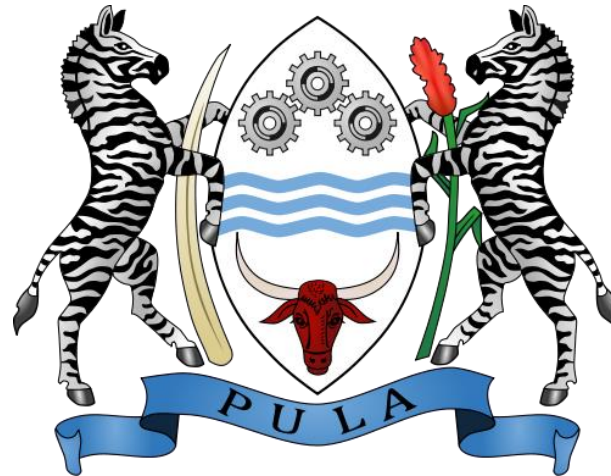




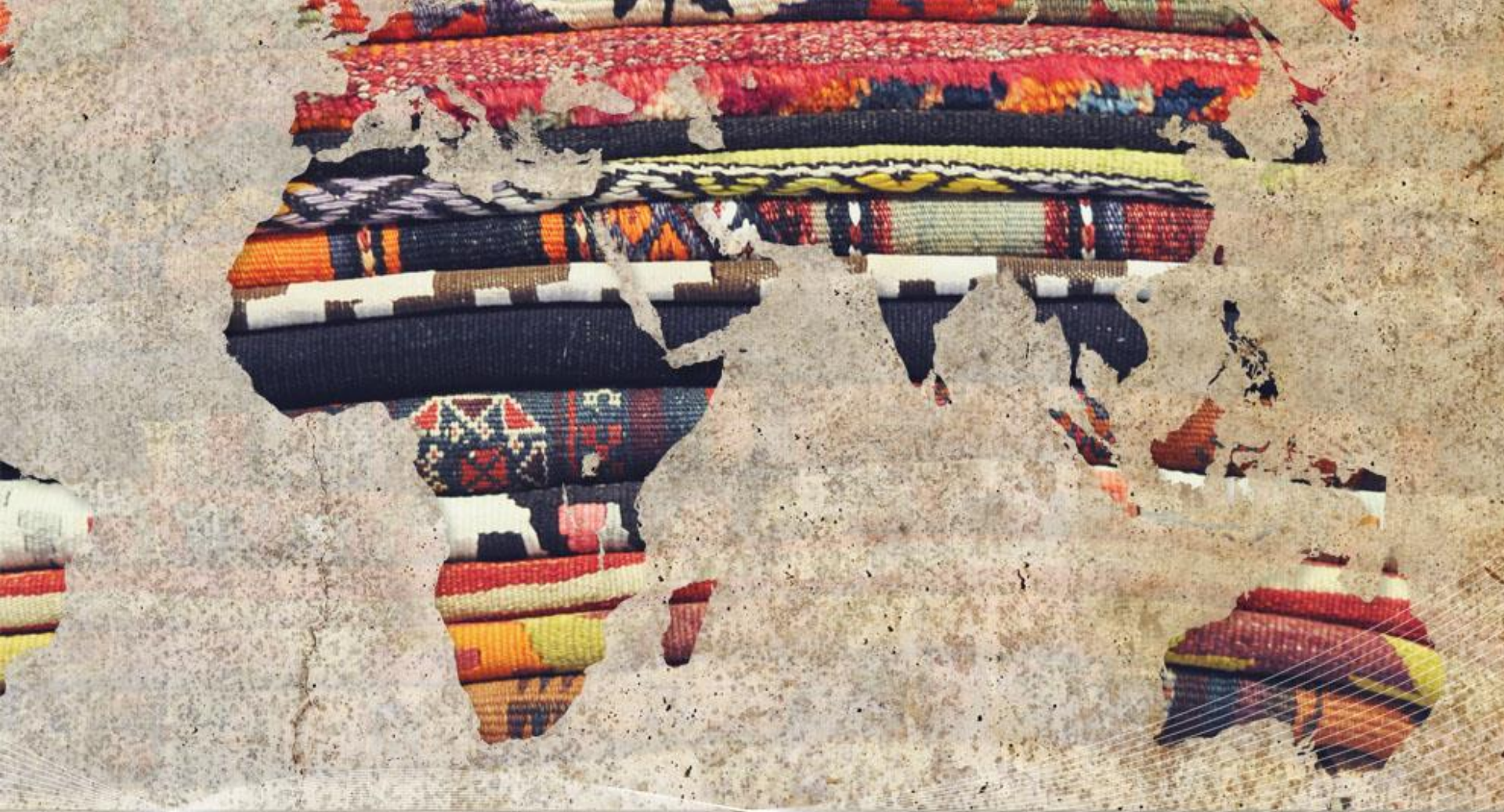


# Botswana

- Legislation
  - Industrial Property Act, 2010







Thank You



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