

Sub-Saharan Africa

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Counterfeits are not produced to any significant degree in Africa; they are primarily manufactured in Asia, particularly China. However, a disproportionately high percentage of counterfeit shipments – where genuine products can be mixed with other goods, sometimes with false or incomplete transport documents – are destined for Africa, either directly or via ports such as Karachi, Dubai or Hong Kong, which are often used to re-route counterfeit products in order to disguise their origin.

Along with Dubai, the port of Djibouti has become a significant point of entry for counterfeit goods intended for sale in Africa, particularly since the Dubai Port Authority assumed management of it.

As China is the main exporter of counterfeit products into Africa, it is useful to focus attention on the main points of entry for products emanating from China – namely, Djibouti, Kenya, Tanzania,

Mozambique and Nigeria. South Africa is dealt with elsewhere in this publication.

Djibouti

Trademark protection was first introduced to Djibouti, formerly French Somaliland, on December 31 1981. Subsequently, the French Trademarks Act of December 31 1964 was introduced to Djibouti. Although this law is still in force, a Supreme Court order issued on November 17 1985 makes it necessary for rights holders to file trademark applications in Djibouti to secure protection there.

The Criminal Code makes counterfeiting a criminal offence; in particular, Articles 301 to 303 and 310 to 312 deal specifically with “the counterfeiting of manufacturers’ trademarks, commercial trademarks and service marks”. The requirements for instituting an action against counterfeiters are set out in Articles 301 to 303. In particular, the code defines the offence of ‘counterfeiting’ as including the following acts:

- reproducing, imitating, using, affixing, suppressing or modifying an individual

or collective mark, in violation of the rights conferred by its registration and the prohibitions which result therefrom;

- possessing, without legitimate grounds, products which are known to bear a counterfeit trademark, or knowingly selling, offering for sale, providing or offering to provide products or services under a counterfeit trademark; and
- supplying a product or providing a service other than that which was requested under a registered trademark.

Anyone found guilty of any of these offences can be punished with a fine or up to two years’ imprisonment.

Before instituting any proceedings for infringement, the claimant (ie, the trademark owner) usually applies to the president of the court of first instance for a seizure order. If the application is successful, the order is signed on the same day or soon thereafter following presentation of the petition by the lawyer acting for the trademark owner and without notice being given to the defendant.

Once granted, the seizure order is served by the bailiff on the person suspected of being in possession of counterfeit products. The bailiff will then draw up a report detailing the nature of the defendant's activities and the extent of the counterfeiting.

When the seizure order is granted, the president of the court sets a deadline within which the claimant must issue a summons against the defendant. Courts usually order that such summons be issued within two weeks to two months of the seizure order being granted.

The defendant may initiate urgent proceedings before a judge in chambers for an order to lift the seizure. This will be granted if it is apparent that the claimant has no valid trademark rights or that no counterfeiting is taking place.

There are no provisions authorizing Customs to seize counterfeits. Therefore, if suspect counterfeit products are about to enter the country, court proceedings must be initiated as outlined above. In order for those proceedings to be effective, full details of the shipment and the counterfeit goods' location will be necessary.

Kenya

The Anti-counterfeiting Act is a comprehensive anti-counterfeiting law, substantially similar to the equivalent South African act (see the chapter on South Africa). It provides that inspectors – which include police officers, customs officers and officers from the Bureau of Standards and the Weights and Measures Department – have the power to seize counterfeit goods without a warrant, although these goods will be destroyed only with the authority of a court. In particular, the act places an obligation on Customs to deal with applications by rights holders to seize and detain counterfeit goods within three days of receiving them. Crucially, officers are protected from personal liability and therefore should not be inhibited in carrying out their duties.

Tanzania

Until about two years ago, the only practical way of dealing with counterfeits in Tanzania was to identify the chief importers and institute civil proceedings against them for, among other things, an injunction, as well as the delivery up of such goods and their destruction. Those proceedings could be prohibitively expensive and inappropriate if the sellers of the counterfeits were located in informal markets (as they often are).

More recently, the Merchandise Marks Act of 1963, which came into operation only

on April 8 2005, has proved useful in tackling counterfeiting. The act, among other things, makes it an offence to deal in or manufacture counterfeit goods. It also allows inspectors appointed under the act to enter without warrant and inspect any premises in which they have reason to believe that an offence against the act has been or is about to be committed. Inspectors may:

- examine goods and all books, accounts and documents relating thereto;
- take samples of any goods and copies of any books, accounts and documents as aforesaid, or part thereof;
- seize, remove and detain any goods which they have reasonable cause to believe may afford evidence of an offence against the act, and any containers, receptacles, books, accounts and documents relating thereto; and
- require any occupant of such premises to render such explanations and give such information relating to any goods therein as may be reasonably required by such inspector or officer in the performance of their duties.

In addition, the act gives the Fair Competition Commission the power to identify and seize counterfeit products once it is informed of their existence by Customs. After investigation, the commission has the power to destroy those products.

Mozambique

The relevant applicable laws in Mozambique as follows:

- the Industrial Property Code of 1999, now repealed and replaced by the Industrial Property Code of 2006, approved by Decree 4/2006 of February 28 2006, BR 15 of April 12;
- the Penal Code;
- the Paris Convention for the Protection of Industrial Property; and
- the Agreement on Trade-Related Aspects of Intellectual Property Rights.

It is a criminal offence to manufacture, sell or import counterfeit goods. The sale, manufacture or import of counterfeits is punishable by a fine of 112 times the minimum wage if the offender is an individual and 224 times the minimum wage if the offender is a corporate entity.

Article 194 of the Industrial Property Code deals with, among other things, the seizure of counterfeits by Customs and the Ministry of Industry and Trade's general inspectorate. In particular, it sets out that:

- products or merchandise that violate industrial property rights and are in the

process of being imported or exported shall be seized;

- seizures shall be carried out on the initiative of Customs, working together with the ministry's general inspectorate;
- seizures may also be carried out at the request of any party with a legitimate interest;
- Customs shall immediately give the interested party the opportunity to present evidence that an infringement of industrial property rights has been committed under the terms of this law;
- the interested party is entitled to request Customs to take such measures as are appropriate to safeguard the integrity of the seized goods;
- the interested party may lodge an appeal to the Customs Court against decisions taken pursuant to the provisions of this article; and
- the interested party may request the Customs Court to order such provisional remedies as are deemed appropriate to safeguard its rights.

Article 194 of the Industrial Property Code, in particular, empowers Customs to seize counterfeit goods passing through the borders of Mozambique. Customs can proactively seize counterfeit goods, without a court order, on notification by the trademark owner. However, the code states that Customs must coordinate its actions with the ministry's general inspectorate.

Where a trademark owner or its agent is aware that counterfeit products are about to enter Mozambique, it may notify Customs and should provide proof of registration of the trademark being infringed.

Nigeria

The relevant laws are as follows:

- the Trademarks Act;
- the Counterfeit Drugs (Miscellaneous Provisions) Act;
- the Counterfeit Currency (Special Provisions) Act;
- the Merchandise Marks Act; and
- the Customs and Excise Management (Disposal of Goods) Act.

Although administrative, civil and criminal remedies are available to IP rights holders, the most effective anti-counterfeiting agency in Nigeria is the National Agency for Food and Drug Administration and Control (NAFDAC).

NAFDAC

NAFDAC is a parastatal of the Federal Ministry of Health and was established on

“ The common perception is that counterfeiting is a harmless crime. While that view persists, the appetite and capacity for dealing with the problem will continue to be compromised ”

January 1 1994. According to the establishing legislation (Decree 15/1993), NAFDAC is vested with responsibility to “protect public health by promoting wholesomeness, quality, safety and efficiency of processed food, medicines, cosmetics, medical devices, chemicals and pre-packaged water through an effective quality assurance system, public enlightenment, in addition to inspectorate and enforcement activities as part of the nation’s efforts in emphasizing prevention of all illness in all residents in Nigeria”.

In relation to counterfeit food products and drugs, NAFDAC has the power to raid suspect premises, seize and destroy infringing products and prosecute those responsible for the sale and import of such products. NAFDAC has had substantial success in combating the import and sale of counterfeit pharmaceuticals in Nigeria. However, there is still a long way to go to rid Nigeria of the scourge of dangerous counterfeit drugs.

Civil remedies

The requirements for instituting civil action against counterfeit products vary depending on the action to be taken. If the counterfeit goods bear a mark that is confusingly similar to the plaintiff’s registered trademark, the plaintiff may institute a trademark infringement action against the counterfeiter or against the importers and retailers of the counterfeit goods. The action should be filed at the Federal High Court of Nigeria.

Urgent interim relief

Interim or interlocutory injunctions can be obtained to restrain the defendant from importing, manufacturing, selling or generally dealing in counterfeit goods pending the conclusion of the main suit. As the substantive action is unlikely to be heard for at least 12 to 14 months, and will not be concluded for 12 to 18 months, it is important to obtain an interim injunction to stop the defendant from continuing to

manufacture, import or sell the offending goods during the period between the complaint being filed and the suit being determined. Such orders are entirely at the discretion of the courts, which in general are unsympathetic to injunction applications where the applicants have delayed seeking such remedies.

The Federal High Court will issue an Anton Piller order as an interim remedy if an application for such an order is made. Usually such an application is made jointly with an interim injunction application.

Criminal remedies

The Merchandise Marks Act empowers the police to conduct raids for the search and seizure of suspected counterfeit products. Usually, after investigations, the police obtain a search warrant from the magistrate before raiding the suspect premises.

Once the raid has been completed and the suspected counterfeit goods have been seized, the police should prosecute the offenders in the appropriate magistrates court. However, in practice, due largely to a lack of resources or corruption, raids performed in this way are seldom successful; even when they are, criminal actions are rarely concluded successfully. That said, there can be advantages to commencing a criminal action, particularly in terms of the Merchandise Marks Act, because criminal raids are quicker to conduct and are useful for ‘mopping up’ the market (ie, periodically ridding the market of counterfeits), since they can be carried out against all persons found to be dealing in counterfeit products. As a matter of strategy, based on the experiences of local counsel, it is advisable for criminal raids to be carried out in conjunction with civil actions instituted in the Federal High Court.

Customs

Under the Customs and Excise Management (Disposal of Goods) Act, Customs’ right to

seize goods is limited. In particular, Section 1(1) of the act provides as follows: “If any goods to which this act relates are or shall be imported into Nigeria in contravention of any regulations or orders made under the Customs & Excise Management Act, or have been seized or detained before the commencement of this act by the board, such goods shall be forfeited, or as the case may be, be deemed to be forfeited.”

Despite the contents of Section 1(1), Customs has no power to seize counterfeit goods without a court order. Therefore, it follows that Customs has no *ex officio* power to seize counterfeit products unless those counterfeit goods are otherwise prohibited or restricted.

Conclusion

The import of counterfeits into Africa continues to grow at an alarming rate. While the governments of many countries have procedures to deal with counterfeits, more still needs to be done.

Clearly, there is not sufficient capacity to deal with enforcement; while lack of awareness is often an issue, it is not the most important one. Africa has many of the poorest countries in the world and is faced with far more serious socio-political problems. The common perception is that counterfeiting is a harmless crime. While that view persists, the appetite and capacity for dealing with the problem will continue to be compromised. Indications are, though, that governments and enforcement officials in many countries now understand that counterfeiting is not only an infringement of an IP right, but also a fraud against the public. [WTR](#)

Biographies

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