

CHECKLIST OF ISSUES ON ENFORCEMENT¹

Responses from Dominica

Introductory Remarks

Dominica's legal system and jurisprudence is based on the Common Law of England. Its laws are found in the plethora of Statutes and the Common Law.

Dominica is also one of the nine Eastern Caribbean countries/jurisdictions of the Eastern Caribbean Supreme Court.

Civil and Administrative Procedures and Remedies

(a) *Civil judicial procedures and remedies*

1. Specify the courts which have jurisdiction over IPR infringement cases.

Jurisdiction over intellectual property rights is exercisable by The Eastern Caribbean Supreme Court, which is a superior Court of Record and comprises two divisions: the High Court, presided over by a single Judge and the Court of Appeal. Final appeals are to the Judicial Committee of the Privy Council in England.

2. Which persons have standing to assert IPRs? How may they be represented? Are there requirements for mandatory personal appearances before the court by the right holder?

Which persons have standing to assert IPRs?

In relation to trademarks/service marks, utility models, patents, industrial designs, plant varieties and layout-designs of integrated circuits, the registered owner of the rights or the registered licensee may assert that right.

In the case of geographical indications any interested person or group of interested persons or any group of consumers or any competent authority may institute proceedings in the High Court to prevent any unlawful act in respect of geographical indications.

Competent authority is not defined in the Geographical Indications Act, but this would normally be an institution which has standing in the particular matter, i.e. suffered loss or likely to suffer loss or is otherwise affected by an infringement. The institution would also need to have the capacity to sue and be sued.

¹ Document IP/C/5.

As to Copyright, it will be anyone claiming as owner of the copyright as a result of creation or assignment or other transmission rights, or an exclusive licensee. (See the draft Copyright Bill.)

How may they be represented?

An individual may be represented in person or by an Attorney-at-Law of his choice.

Are there requirements for mandatory personal appearances before the court by the right holder?

There are no mandatory requirements for personal appearances before the court. The Civil Procedure Rules allows the Court to hear a matter in the absence of one party. The rules also make provisions for an application for depositions to be taken before trial. This, of course, removes the opportunity for examination and/or cross-examination of a person during trial.

It is to be noted that the Court has power to strike out a matter where neither party appears. A party can act by a person to whom he has granted a legal power of attorney to do so.

3. What authority do the judicial authorities have to order, at the request of an opposing party, a party to a proceeding to produce evidence that lies within its control?

The Civil Procedure Rules give the Court authority to require a party to disclose and inspect documentary evidence before trial, and to produce such evidence at the trial. Generally in requiring production of evidence, the Court must take into account the legitimate interest of the defendant in not disclosing his manufacturing and business secrets.

The Court may also on application grant an interim injunction for preservation of evidence if there is a legitimate fear of such evidence being destroyed.

The Eastern Caribbean Supreme Court Act (Dominica) gives the Court of Appeal the power to order the production of evidence if this is necessary for determining a case before it.

4. What means exist to identify and protect confidential information brought forward as evidence?

There are no statutory provisions respecting the identity and protection of confidential information. The Court may in its discretion treat as confidential any information produced as evidence. An application may be made to the court for such information to be treated as confidential. The Court has discretion whether or not to grant the application.

The general practice is that trials are held in open Court, i.e. open to the public. Interlocutory proceedings, including case management conferences and pre-trial reviews are however held "in chambers", i.e. closed to the public. The court may in its discretion hear any matter *in camera*, i.e. closed to the public if it considers it expedient to do so.

5. Describe the remedies that may be ordered by the judicial authorities and criteria, legislative or jurisprudential, for their use;

- **injunctions;**
- **damages, including recovery of profits, and expenses, including attorney's fees;**
- **destruction or other disposal of infringing goods and materials/implements for their production;**
- **any other remedies.**

The following remedies may be ordered by the judicial authorities:

- damages;
- injunctions;
- seizure, forfeiture and destruction or disposal of infringing goods and material and implements used for their production;
- other remedies provided for in law, e.g. Declaration including Declarative Injunction.

Injunctions

The Intellectual Property (IP) Statutes provide for the granting of injunctive relief for infringement of an IP right. The Court will grant an interim injunction only if the matter is urgent or it is necessary to do so in the interest of justice and damages would not be an adequate remedy in the circumstances. The applicant for an interim injunction is required to give an undertaking to compensate the respondent if it is later determined that the granting of the injunction was not justified.

Damages

Damages generally include the recovery of commercial losses occasioned by the infringement. In determining damages, the Court must take into account reasonable royalty which may have been payable by a licensee. Further damages, such as aggravated damages may be awarded if the circumstances in which the infringement was committed was so scandalous as to merit such award. An order for damages is normally accompanied by an order for payment of legal cost to the successful party who is generally entitled to such costs.

Seizure, forfeiture and destruction

Under the Intellectual Property (IP) Statutes (including a draft Copyright Bill) the Court has power to make an order on the application of the intellectual property right holder for the seizure, forfeiture or destruction of infringing products or articles.

Any other remedies

The Intellectual Property Statutes also allow a right holder, as an alternative to seeking an award of damages, to seek an account of profits. The Court in such circumstances is required to make an assessment of the profits gained by infringer consequent on the infringement and to pay this over to the right holder.

- 6. In what circumstances, if any, do judicial authorities have the authority to order the infringer to inform the right holder of the identity of third persons involved in the production and distribution of the goods of services found to be infringing and of their channels of distribution?**

Although this is not expressly provided by Statute the Court can under its inherent jurisdiction order a person who has infringed an intellectual property right to provide the court with information identifying any person who has supplied to him infringing articles, or the means by which these articles have been made, provided that the supplier had the knowledge or reasonable belief that the particular instrument was used to make infringing copies.

- 7. Describe provisions relating to the indemnification of defendants wrongfully enjoined. To what extent are public authorities and/or officials liable in such a situation and what "remedial measures" are applicable to them?**

Describe provisions relating to the indemnification of defendants wrongfully enjoined

The Court has the power to award damages or order the payment of compensation in favour of a party which has been wrongfully enjoined as a party.

To what extent are public authorities and/or officials liable in such a situation and what "remedial measures" are applicable to them?

Judges of our Court are by common law immune from suit in the event that their decisions are overturned by the Court of Appeal.

Under the State Proceedings Act, the State is vicariously liable for the act or omission of a public officer in the exercise of his duties as such.

- 8. Describe provisions governing the length and cost of proceedings. Provide any available data on the actual duration of proceedings and their cost.**

Describe provisions governing the length and cost of proceedings

There are no statutory provisions governing the length and cost of proceedings. The Civil Procedure Rules stipulate periods within which pre-trial matters or proceedings must take place. The Rules do not encourage extensions, and are strict as to agreements between parties for extension of time and the granting of such extensions by the Court.

Provide any available data on the actual duration of proceedings and their cost

There is no available data on the duration of proceedings and their cost. The length and cost of proceedings will depend on their nature and complexity.

(b) Administrative procedures and remedies

- 9. Reply to the above questions in relation to any administrative procedures on the merits and remedies that may result from these procedures.**

There are no provisions for dealing with infringements administratively.

Provisional Measures

(a) *Judicial measures*

10. Describe the types of provisional measures that judicial authorities may order, and the legal basis for such authority.

Part 17 of the Civil Procedure Rules, 2000 lists the interim remedies which may be granted by the Court. These include:

- interim injunctions;
- interim declarations;
- orders for the detention, custody or inspection of relevant property;
- orders to deliver up goods;
- freezing orders;
- orders to provide information about property or assets subject of a freezing order;
- search orders;
- order for interim payment;
- any other interim order as dictated by the circumstances of the case.

11. In what circumstances may such measures be ordered *inaudita altera parte*?

The High Court, in cases of urgency, will grant an *ex parte* injunction, i.e. *inaudita altera parte*. However, the Court will only do so if it is satisfied that the matter is urgent and not doing so would defeat the purpose of the application. An *ex parte* injunction order may only be granted for a maximum period of 28 days. A returnable date must be fixed on the granting of the order when both parties will return at *inter partes* hearing. At such hearing both parties are heard and the Court may either discharge the injunction or order its continuance.

12. Describe the main procedures for the initiation, ordering and maintenance in force of provisional measures, in particular relevant time-limits and safeguards to protect the legitimate interests of the defendant.

Before application is made for provisional measures, i.e. interim injunction, a claimant must commence legal proceedings by filing a Claim Form and Statement of Claim. An *ex parte* injunction may be granted upon an undertaking by the claimant to issue and serve the Claim Form by a specified date.

A claim for an interim injunction can be made at any time, including before judgment, if the matter is urgent or necessary in the interest of justice and after judgment. An Application for an interim injunction must be supported by evidence on *affidavit*. Where the application is made *ex parte* the reasons for so doing must be given in the *affidavit*.

An applicant for an interim order must undertake to abide by the order of the Court as to damages caused by the granting of the injunction or extension of it. A defendant may apply for interim order but he may not do so before filing an acknowledgement of service to the claim.

An interim order must be served by the claimant on the defendant. The order on an *ex parte* application must be served by the claimant together with the application for the interim order, the *affidavit* in support and notice of the date and time for the *inter partes* hearing.

- 13. Describe provisions governing the length and cost of proceedings. Provide any available data on the actual duration of proceedings and their cost.**

Describe provisions governing the length and cost of proceedings

See the answer to question 8 above.

Provide any available data on the actual duration of proceedings and their cost

See the answer to question 8 above.

(b) *Administrative measures*

- 14. Reply to the above questions in relation to any administrative provisional measures.**

There are no provisions in the laws of Dominica where provisional relief can be given by an administrative body.

Special Requirements Related to Border Measures

- 15. Indicate for which goods it is possible to apply for the suspension by the customs authorities of the release into free circulation, in particular whether these procedures are available also in respect of goods which involve infringements of intellectual property rights other than counterfeit trademark or pirated copyright goods as defined in the TRIPS Agreement (footnote to Article 51). Specify, together with relevant criteria, any imports excluded from the application of such procedures (such as goods from another member of a customs union, goods in transit or *de minimis imports*). Do the procedures apply to imports of goods put on the market in another country by or with the consent of the right holder and to goods destined for exportation?**

Indicate for which goods it is possible to apply for the suspension by the customs authorities of the release into free circulation, in particular whether these procedures are available also in respect of goods which involve infringements of intellectual property rights other than counterfeit trademark or pirated copyright goods as defined in the TRIPS Agreement (footnote to Article 51)

Part IX, section 99-102 of the Draft Copyright Bill, deals with border protection measures and provides for the person who owns the copyright to write a notice to the Comptroller of Customs requesting him to detain any such pirated copy as may come into the control or custody of the Customs. There are no similar provisions in the legislation dealing with trade marks or any other intellectual property right legislation.

Specify, together with relevant criteria, any imports excluded from the application of such procedures (such as goods from another member of a customs union, goods in transit or *de minimis imports*). Do the procedures apply to imports of goods put on the market in another country by or with the consent of the right holder and to goods destined for exportation?

In the Draft Copyright Bill there is no provision for the exclusion of any imports from the procedures of Part IX. The existing intellectual property legislation does not make any provision for procedures with respect to the import of goods put on the market in another country.

- 16. Provide a description of the main elements of the procedures relating to the suspension of the release of goods by customs authorities, in particular the competent authorities (Article 51), the requirements for an application (Article 52) and various requirements related to the duration of suspension (Article 55). How have Articles 53 (security or equivalent assurance), 56 (indemnification of the importer and of the owner of the goods) and 57 (right of inspection and information) been implemented?**

Under section 99 of the Draft Copyright Bill the competent authority to suspend the release of goods is the Comptroller of Customs.

To initiate the seizure of copies or counterfeited goods the copyright owner or exclusive licensee must provide written notice of objection to importation to the Comptroller of Customs together with any prescribed documents. A notice remains in force for a specified period not exceeding five years from the day of which the notice is given.

- 17. Describe provisions governing the length and cost of proceedings. Provide any available data on the actual duration of proceedings and their cost. How long is the validity of decisions by the competent authorities for the suspension of the release of goods into free circulation?**

The draft Copyright Bill is yet to be laid before Parliament and as yet does not have any regulations.

- 18. Are competent authorities required to act upon their own initiative and, if so, in what circumstances? Are there any special provisions applicable to *ex officio* action?**

Are competent authorities required to act upon their own initiative and, if so, in what circumstances?

There is no provision requiring *ex officio* action by Customs officials. All actions must be initiated by the copyright owner or exclusive licensee or by the owner (or authorised user) of the industrial property right. Under the draft Copyright Bill the Comptroller may only seize copies if the copyright owner or licensee gives notice of objection to the importation of the copies.

Are there any special provisions applicable to *ex officio* action?

There are no such provisions.

- 19. Describe the remedies that the competent authorities have the authority to order and any criteria regulating their use.**

The Customs authority is not empowered to order remedies for infringement. They can seize infringing copies of counterfeit goods and dispose of those copies or goods if they are forfeited by the importer. All remedies are decided by the courts.

Criminal Procedures

- 20. Specify the courts which have jurisdiction over criminal acts of infringement of IPRs.**

The Magistrate's Court with respect to summary offences, the High Court with respect to indictable offences and, on appeal, the Court of Appeal have jurisdiction over criminal acts of infringement. Final appeal lies to the Judicial Committee of the Privy Council.

21. In respect of which infringements of which intellectual property rights are criminal procedures and penalties available?

The following sections of the legislation listed below detail the infringements for which criminal offences are specified and the penalties associated with each.

Protection of Layout-Designs (Topographies) of Integrated Circuits: Section 25.

Trade Marks (Marks, Collective Marks and Trade Names Act): Sections 17(3), 18, 28 and 29.

Patents: Sections 33, 36, 40 and 63.

Geographical Indications: Sections 13 and 23.

Industrial Designs: Sections 24(5) and 25.

Protection of Plant Varieties: Section 45.

22. Which public authorities are responsible for initiating criminal proceedings? Are they required to do this on their own initiative and/or in response to complaints?

The Commonwealth of Dominica Police Force is responsible for initiating criminal proceedings in matters and also in the case of intellectual property. The action to prosecute for an offence is one for the Director of Public Prosecutions. In the vast majority of cases the action taken by the police results from complaints being brought. However, an individual is not precluded from bringing a private prosecution for these offences.

23. Do private persons have standing to initiate criminal proceedings and, if so, who?

Persons do have the right to initiate to bring a prosecution. A *fiat* from the Director of Public Prosecutions is necessary in such a case.

24. Specify, by category of IPR and type of infringement where necessary, the penalties and other remedies that may be imposed:

- **imprisonment;**
- **monetary fines;**
- **seizure, forfeiture and destruction of infringing goods and materials and implements for their production;**
- **other.**

Copyright

Sections 51-62 of the draft Copyright Bill establish offences for acts stated therein and provide the penalties that would be imposed.

Trademarks

Section 29 of the Marks, Collective Marks and Trade Names Act establishes offences for acts stated in sections 17(3), 18 and 28, and provides the penalties that may be imposed.

Patents

Section 63 of the Patents Act establishes offences for acts stated in section 40 and provides the penalties that may be imposed.

Industrial designs

Sections 24(5) and 25 of the Industrial Designs Act establish offences for acts stated therein and provides the penalties that may be imposed.

Layout-designs

Section 25 of the Protection of Layout-Designs (Topographies) of Integrated Circuits Act establishes offences for acts therein and provides the penalties that may be imposed.

Geographical indications

Section 23 of the Geographical Indications Act establishes offences for acts stated in section 13 and provides the penalties that may be imposed.

Plant varieties

Section 45 of the Protection of Plant Varieties Act establishes offences for acts stated therein and provides the penalties that may be imposed.

25. Describe provisions governing the length and any cost of proceedings. Provide any available data on the actual duration of proceedings and their cost, if any.

There are no provisions governing length and cost of proceedings.
