

**CHECKLIST OF ISSUES ON ENFORCEMENT<sup>1</sup>**

Responses from Fiji

**Introduction**

Fiji's Copyright Act 1999 came into force in full on 1 July 2000 and is administered by the Attorney-General's Chambers. Industrial property is administered by the Ministry of Justice.

Prior to the new legislation coming into force, the Fiji law effectively remained the Copyright Act 1956 of the United Kingdom as modified and applied to Fiji by the Copyright (Fiji) Order 1961.

**COPYRIGHT**

**Civil and Administrative Procedures and Remedies**

(a) *Civil judicial procedures and remedies*

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

The High Court of Fiji as originally established under the Supreme Court Act – Cap. 13, has been responsible for dealing with most intellectual property right matters under its general jurisdiction as vested under s3(2) of the said Act.

The applicable rules governing proceedings are the High Court Rules 1988, which came into force on 31 March 1988 (Legal Notice No. 37 of 1988), and govern pleadings, practice and procedure in the High Court, for the dispatch of civil business.

The Magistrates Court pursuant to s122 of the Copyright Act 1999 has a role in the issue of search warrants necessary for the investigation of copyright infringement complaints. Further, pursuant to s230 of the said Act proceedings for an offence under it may be heard and determined by a resident Magistrate and a maximum sentence under the Act may be imposed notwithstanding limitations on a magistrate's jurisdiction under the Magistrates Courts (Civil Jurisdiction) Decree 1988, to awards of \$15,000.00.

**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?**

The right holder is the person best to assert rights in infringement proceedings.

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<sup>1</sup> Document IP/C/5.

Section 109 (1) of the Copyright Act 1999 stipulates,

"(1) An infringement of copyright is actionable by the copyright owner."

Right holders may be represented by a counsel as in any other proceedings.

There are no mandatory requirements for personal appearances as such, but the situation may arise where personal attendance is necessary. For example pursuant to s126, at the trial of a cause under Part VII (Remedies for Infringement) or a prosecution for an offence under the Copyright Act, proof of the subsistence of copyright may be given by *affidavit*, however, s126(2) stipulates that if a party to a cause expresses an intention to cross-examine the deponent with regard to matters raised in the *affidavit*, the *affidavit* will not be used unless the deponent appears as a witness for such cross-examination. Ultimately, the discretion vests with the court as to the necessity of the deponent appearing personally.

**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?**

Sections 111 and 123 of the Copyright Act cover orders for delivery up that a court may issue against a party in civil and criminal proceedings, respectively. Section 111 applicable to civil proceedings stipulates:

"(1) If a person ...

- (a) has an infringing copy of a work in the person's possession, custody or control in the course of business; or
- (b) has in the person's possession, custody or control an object specifically designed or adapted for making copies of a particular copyright work, knowing or having reason to believe that the object has been or is to be used to make infringing copies,

the owner of the copyright in the work may apply to a court for an order that the infringing copy or object be delivered up to the copyright owner or any other person the court directs.

(2) ...

(3) ...

- (4) Notwithstanding any rule of court, and even of other proceedings for infringements of copyright have not been commenced, an order may be made under this section on an *ex parte* application by the copyright owner, if service of the notice of the application would cause undue delay or other serious detriment to the copyright owner."

Similar provisions for delivery up exist also for performers rights, in sections 192 and 195 of Part X of the Copyright Act.

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

Pursuant to s222 of the Copyright Act, any rights and privileges existing under other statutory enactments or at common law including the operation of any rule of equity relating to breaches of trust or confidence (s222(1)(a)) are not affected by its operation (the Copyright Act).

**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.**

Injunctions

Pursuant to s109(2) of the Copyright Act, the same relief by way of damages, injunctions, accounts or otherwise is available to the plaintiff as is available in respect of the infringement of any other property right.

Procedurally, this means that the general procedure for applying for injunctions contained in Order 29(1) of the High Court Rules by way of motion or summons, applies.

Damages (including recovery of profits and expenses)

As indicated, s109(2) of the Act allows relief by way of damages to the plaintiff as is available in respect of infringement of any other property right.

In short, damages will be available as of right to the plaintiff if he can establish infringement of copyright. If there is no provision made in the judgement for the assessment of damages, the damages shall be subject to Order 37 Rule 1 of the High Court Rules 1988 and assessed by the court.

Section 114(4) of the Copyright Act states that in assessing damages the court must take account of the terms of the licence and any pecuniary reward already awarded to the copyright owner or exclusive licensee in respect of the infringement. Section 114(4)(b) states that an account of profits must not be directed if an award of damages has been made or an account of profits has been directed.

Pursuant to s114(4)(c) the Court must, if an account of profits is directed, apportion the profits between the copyright owner and the exclusive licensee fairly.

Destruction or disposal of infringing goods

As stated earlier, sections 111 and 123 deal with the powers of the court to order delivery up of infringing copies of works in civil and criminal proceedings, respectively.

Pursuant to s125 of the Act, an application may be made to the court that an infringing copy delivered up pursuant to s111 or 123 be either forfeited to the copyright owner (s125(1)(a)) or destroyed or dealt with as the court thinks fit (s125(1)(b)).

Any other remedies

Pursuant to s112 of the Act, a copyright owner may seize or detain infringing copies of his work which are found exposed or available for sale or hire subject to the following requirements:

- the infringing copies are those which could have been the subject of an order for delivery up (s111);

- before anything is seized, notice of the time and place of the proposed seizure must be given to the local police station;
- a notice in the prescribed form containing the particulars as to the person by whom or on whose authority the seizure is made and the grounds on which it is made must be left at the time and place of seizure.

The said seizure will be subject to a decision of the court as discussed earlier under s125, where it would either be left with the copyright owner (forfeited) or destroyed or dealt with as the court thinks fit.

**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?**

Pursuant to s111(b), for example, as part of the order for delivery up in civil proceedings, the copyright owner may apply to the court for an order that an object specifically designed or adapted for making copies of a particular copyright work (knowing or having reason to believe that the object has been or is to be used to make infringing copies) be delivered to the copyright owner.

The person to whom the copy or object is delivered will hold it pending the making of an order pursuant to s125 of the Act.

**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?**

Pursuant to s120 of the Act, if a person brings proceedings alleging an infringement of copyright, a court may, on the application of any person against whom the proceedings are brought,

- make a declaration that the bringing of the proceedings was unjustified, and
- make an order for the payment of damages for any loss suffered by the person against whom the proceedings are brought.

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

There are no specific provisions contained in the Act governing the length and cost of proceedings, given that few matters have arisen under the current legislation and its predecessor, the United Kingdom Copyright Act 1956, and dealt with within the general jurisdiction of the High Court of Fiji.

Proceedings and their cost have been dealt with as with any other civil proceedings governed by the High Court Rules 1988.

(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.**

No regulations have as yet been formulated, although Draft Copyright (Border Protection) Regulations is being considered.

The elected government after the national elections to be held in August 2001 will probably deal with this issue expeditiously.

**Provisional Measures**

(a) *Judicial measures*

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

Some of the measures have been discussed previously and would be merely itemized here.

- Interlocutory Injunction, Interim Preservation of Property - Order 29 – High Court Rules 1988.
- Orders for Delivery Up - s111, 123, 192, 195 – Copyright Act 1999.
- Right to seize infringing copies - s112 (together with s125) – Copyright Act 1999.

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

All the measures described in the answer to question 10 above, can be applied for *ex parte* if necessity demands it. For example, s111(4) stipulates:

"(4) Notwithstanding any rule of court, and even if other proceedings for infringement of copyright have not been commenced, an order may be made under this section on an *ex parte* application by the copyright owner, if service of the notice of the application would cause undue delay or other serious detriment to the copyright owner."

**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.**

As intellectual property right matters are dealt with by the High Court under its general jurisdiction, the main procedure for the maintenance of provisional measures would probably be the same for application for interlocutory injunctions, by way of motions or summons as governed by Order 29 of the High Court Rules.

Where the matter is one of urgency (as averred to in s111(4) of the Copyright Act), the application may be made *ex parte* on *affidavit* (O.29,r1(2)).

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

Most interlocutory proceedings, particularly those seeking *interim* measures will be dealt with expeditiously.

An application for interlocutory injunction was made in a recent proceeding pertaining to the Copyright Act 1999, *Fiji Video Library Association vs. A-G and Ors* – Civil Action No. 310/2000, in which an interlocutory injunction was granted *ex parte* to the plaintiff/applicant on 10 August 2000 by the High Court to continue until 15 August 2000. An application to extend the injunction for 3 months until 15 November 2000 was heard on 14 August 2000, and a decision was delivered on 30 August 2000, dismissing the application.

Interlocutory proceedings took about 20 days from initiation to dismissal.

Costs/fees are negotiated between counsels and clients.

(b) *Administrative procedures*

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

Comment on relevant administrative provisional measures will await the formulation of appropriate regulations.

**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?**

We can only discuss border protection measures as contained in Part VIII of the Copyright Act, which deals with pirated copy defined in s127(a) as generally the making of a copy of a copyright work without the licence of the person who owns the copyright in the work.

Pirated copy includes:

- copy of a copyright work that is a literary, dramatic, musical or artistic, or of the typographical arrangement of a published edition, or of a sound recording or of an audio visual work (s127(a));
- includes any illicit recording, and illicit recording that is a copyright work in a country other than Fiji.

**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?**

Pursuant to s128(1) of the Act, a copyright owner may issue a notice to the Comptroller of Customs requesting him to detain any pirated copies of the item which he owns copyright in and which comes into the control of Customs.

The notice may be in force for a period of 5 years, or where applicable during the duration of the period for which copyright lasts, if less than 5 years.

If the notice has been accepted and the Comptroller forms the opinion that a pirated item to which the notice relates has come into the control of the Customs the following procedures will be followed:

- The Comptroller may conduct an investigation to establish whether the item is a pirated copy to which the notice relates, to which he has wide powers requiring any interested person to supply information (s129(2)).
- The Comptroller must within a reasonable period form an opinion as to whether or not the item is a pirated copy to which the notice relates (s129(3)).
- Written notice of the Comptroller's opinion or determination must as soon as practicable be served on the claimant or any other person having an interest in the item (s131).
- If the Comptroller forms the opinion that the imported item is a pirated copy, the item must be detained in custody (s132) until (s132(1)(a) – (e)),
  - the notice is discharged;
  - an order is served that the item be released;
  - a determination is made that the item is not a pirated copy;
  - proceedings are abandoned;
  - 10 working days have elapsed and the Comptroller has not been served with a notice of proceedings by a person other than the importer or consignee.
- Any person may apply to a court for a decision whether or not an item which is the subject of a determination is a pirated copy that has been imported other than for private and domestic use (s133(3)).
- If in proceedings a court decides that the item is a pirated copy that has been imported other than for private or domestic use, the court may order the item be,
  - forfeited;
  - destroyed;
  - dealt with as the court thinks fit.

- If in such proceedings the court decides that the item is not a pirated copy, the court may order any person who is a party to the proceedings to pay compensation to the importer, consignee or owner of the item, as the court thinks fit (s134(4)).
- The Comptroller of Customs must in respect of any item that is the subject of notice, investigation or proceeding allow any person claiming to have an interest in the item to inspect the item (s135(1), (2), (3)).

**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 relevant provisions are:

- s129(2) - Information required for the investigation of the item must be provided within 10 working days of it being required.
- s132(1) - An item determined to be a pirated copy must be released if after 10 working days the Comptroller has not been served with a notice of proceedings. It may be extended to 20 working days (s132(2)).

Otherwise proceedings are determined by the interested person actively pursuing the making of necessary orders pursuant to s133(1), (2), (3) or pursuant to s134.

**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?**

There are no special provisions in the Act, however, the Comptroller of Customs may, pursuant to a notice issued under s128, have a considerable discretion to investigate any item that has been imported which in his opinion is a pirated copy, during the duration of the notice, which may last for 5 years, as discussed earlier.

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

These have been generally discussed in the response to question 16 above.

**Criminal Procedures**

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

Copyright infringements may be dealt with both in the High Court and the Magistrates Court as governed by s230 of the Act.

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

Insofar as the Copyright Act is concerned, the primary matters for which criminal offences attach are the making of or dealing with infringing objects.



Section 121(1) specifies "that a person who other than pursuant to a copyright licence;

- (a) makes for sale or hire
- (b) imports into the Fiji Islands other than for private and domestic use
- (c) possesses in the course of business with a view to committing any act infringing the copyright
- (d) in the course of business,
  - offers or exposes for sale or hire
  - exhibits in public
  - distributes
- (e) sells or lets for hire (in the course of business or otherwise)
- (f) distributes in the course of business to an extent that it prejudicially affects the copyright owner,

an object that the person knows is an infringing copy of a copyright work, commits an offence."

Sections 121(2) and (3) of the Act also create specific offences for persons who know or ought to have reasonably known,

- "(2) that an object in his possession specifically designed or adapted to make infringing copies for sale or use in the course of business or
- (3) who cause a literary, dramatic, musical work of sound recording or film to be performed knowing or ought reasonably to have known that doing so infringes copyright."

**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?**

It is the Police who initiate criminal proceedings as a response to complaints. In certain instances the Office of the Direction of Public Prosecutions may be asked by the Police to advise on the initiation of criminal proceedings.

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

It is not specified in the Act whether a person can initiate criminal proceedings.

Due to the comprehensive nature of the remedies in the Act (Part VII), it is probably not envisaged to have much scope, as civil remedies are adequate.

Division 5 which covers offences under the Act, creates specific search powers for the Police and innovative orders (delivery up) which would seem to discourage private proceedings.

**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.**

Pursuant to s121(5) of the Copyright Act, a person who commits an offence under it is liable on conviction,

- "(a) in the case of an offence under s121(1) to a fine of \$5,000 for every infringing copy to which the offence relates but not exceeding \$50,000 in respect of the same transaction and to imprisonment for 12 months;
- (b) in the case of an offence under subsections 121(2) and (3), a fine of \$50,000 and to imprisonment for 12 months;
- (c) in the case of a second or subsequent offence against sections 121(2) or (3), a fine of \$100,000 and to imprisonment for 2 years.

Pursuant to s125, an item seized pursuant to an order for delivery up in criminal proceedings may be forfeited to the copyright owner or destroyed or otherwise dealt with as the court thinks fit.

**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.**

See the response to question 13 above.

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