

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

Responses from Ghana

**Introductory Remarks**

Ghana has a legal system which is heavily influenced by the Anglo-American common law model. It is through this pluralistic system that all rights are enforced. Intellectual property rights are private rights and consequently the onus of enforcing those rights lies primarily with the right holder.

**Civil and Administrative Procedures and Remedies**

*(a) Civil judicial procedures and remedies*

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

The Superior Court of Judicature, headed by the Chief Justice, comprises the High Court of Justice, the Court of Appeal and the Supreme Court, the court of last resort. Presently, the Chief Justice has directed that all cases involving intellectual property rights should be initiated at the fast-track High Court, that is in the High Courts that are fully mechanised and wired. Section 44 of the Copyright Law 1985, PNDCL 110, stipulates that civil remedies shall commence at the High Court.

**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?

The proprietor of intellectual property rights or a licensee may assert his rights through civil proceedings. In the case of trademarks, patents and textile designs, the registered proprietor of the right or the registered licensee may assert that right. Published copyright works are registered under the law to provide *prima facie* proof of ownership of a work. However, all owners of unpublished works may also assert intellectual property rights.

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

In relation to enforcement of copyright, neighbouring rights and textile designs, proceedings may be brought by anyone claiming to be the owner either as a result of creation, of subsequent operation of the law or by virtue of assignment or other transmission of the right(s). Enforcement proceedings can also be brought (except against the owner) by an exclusive licensee.

A person who asserts infringement of intellectual property rights may appear in person or through another person who has been lawfully authorised. Appearance may be with or without the aid of a counsel admitted to practise law in the Republic.

How may they be represented?

A natural person may appear in person and represent himself. However, most people are represented by a counsel, that is a legal practitioner who has been duly enrolled at the Bar. Corporate or foreign entities must be represented by a counsel.

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

There are no such requirements. It suffices to be represented by an individual who has a power of attorney.

**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 courts have the authority under the Constitution of the Republic and of the various applicable rules of courts to order the production of documents in court. A party to a litigation has an obligation (either automatically or upon order of the court) to give discovery of such documents which it may have in its custody, possession or power which relate to the issues in the litigation. The court has also power to make orders at the start of proceedings for the protection of evidence in those proceedings if there is a legitimate fear of such evidence being destroyed. The court can make an order for the preservation of the evidence and for the necessary evidence to be forwarded to the custody of the court.

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

There are no statutory directives given to the court regarding confidentiality and it is entirely in the court's discretion as to how they will deal with confidential information brought forward as evidence. The discretion is exercised under normal common law principles. The onus lies on the party claiming confidentiality of information to apply to the court for directions as to confidentiality. If, in the exercise of its discretion, the court determines that the confidentiality of that information needs protection, it would order terms and conditions for its protection. Judicial proceedings are enjoined to be conducted normally in public. However, some preliminary proceedings may be held in chambers. The court also has the power to sit *in camera* where it is satisfied that it is necessary to do so to protect legitimate secret information.

**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

Under their inherent jurisdiction, the rules of court and statutory provisions of the various intellectual property laws, the courts may grant relief for infringement in the form of interim, interlocutory or perpetual injunction and, at the option of the plaintiff, either damages or an account of profits. The courts are empowered to order an unsuccessful party to pay the costs of the successful party.

The courts may grant injunctive relief under the following circumstances:

- that there is a serious issue to be tried;
- that the successful party may not be adequately compensated in monetary terms;
- to prevent the infringement;
- to prohibit the continuation of the infringement;
- a perpetual injunction may be granted where the plaintiff establishes infringement at the end of a case.

Damages, recovery of profits and expenses, including attorney's fees

Under their inherent jurisdiction and under the provisions of the various intellectual property laws, the courts have wide powers to award damages for infringement, or if the plaintiff prefers, an account of profits. Damages are normally awarded to compensate the innocent party and place him at a place he would have been if the other party had not committed the infringing act. Punitive damages may also be granted by the courts to serve as deterrent to others. Costs are normally awarded against the defendant. In practice, costs are awarded taking into consideration the length of the litigation. This normally includes the cost of litigation and the legal fees. The practice, however, is that a successful party will, in actuality, probably recover only some but not the actual costs expended.

As an alternative to an award of damages, the owners of intellectual property rights, upon a finding of infringement of their rights, may elect to seek instead of damages, an account of profits. This requires the court to assess the profits which the infringer has made as a result of his infringing acts and to pay these over to the right holder.

Destruction or other disposal of infringing goods and materials/implements for their production

The courts have power to order defendants to deliver up infringing works, goods and copies as well as materials/implements for their production. The courts may order the seizure of infringing goods or copies, and, the equipment used for making them, including delivery of the goods, copies or equipment to the right owner, the exclusive licensee or the performer, or their destruction. The courts

have made such orders in several copyright infringement cases to the effect that the infringed goods be destroyed, sold and directed either that the proceeds be given to the right holders or be destroyed by the Copyright Office.

**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?**

The courts are vested with power to make such orders, even (in an appropriate case) prior to a finding of infringement.

**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

An interlocutory injunction which is usually ordered on an *ex parte* basis will usually only be ordered by a court for a limited period on the basis of the plaintiff giving an undertaking to the court that, if the defendant is subsequently found to have been wrongfully enjoined, the plaintiff will pay damages to the defendant. The court can require security for such an undertaking to be given, by way of a deposit of money in the court or by providing a guarantee from a bank or other reliable source of funds, and will normally do so in the case of a plaintiff resident outside the jurisdiction. In all situations where an injunction has been granted by the court, the person who is wrongfully enjoined may as of right bring an action for damages.

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

Judges are immune from litigation in the conduct of their judicial office. The Registrar of Patents, Trademarks, Designs and the Copyright Administrator are public officials who are generally immune from liability resulting from the performance of their statutory duties.

**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

The Rules of Court stipulate periods for dealing with various pre-trial matters, which periods can usually be extended by agreement between the parties, without application to the court. However, at any stage, a party may apply to the court for a specific order that the litigation against the defaulting party be dismissed or for an order requiring the opposing party to take some steps within a defined period.

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

There is no useful data available since the duration and cost of proceedings for enforcement of intellectual property rights depend on the complexity of the particular case and whether (and if so at what stages) settlement is reached before the trial of the substantive issues. Intellectual property cases are now heard by the fast-track courts where the judicial processes are fully automated and thus expedited. However, since the fast-track system was only instituted in 2001, we have not been in a position so far to collect data on the actual duration of cases.

The plaintiff pays an amount equal to one percent (1%) of the claim made to the court as filing fees.

(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.**

Ghana's intellectual property rights legislation does not have provisions for administrative procedures that deal with infringement. Administrative determinations are related to registration rather than infringement. Opposition proceedings in trademark legislation do not deal with issues of infringement.

Under section 49 of the Copyright Law, the Copyright Administrator is empowered to hear disputes between authors in an alternative dispute resolution mediation or pre-court settlement procedure. However, the relevant implementing legislation is yet to be drawn up to regulate these procedures but there have been numerous interim orders made under this provision by the Copyright Administrator, which, because of the inexpensive, informal and expeditious nature of the process, have ensured to the benefit of right holders.

**Provisional Measures**

(a) *Judicial measures*

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

Under the common law, the High Court has the following powers:

- The Court, which has power to adjudicate enforcement of intellectual property rights, can take provisional measures before full trial on the merits of a case, including the grant of interlocutory injunctions.
- The Court may also grant reliefs under the Anton Piller orders. These orders (also contained under section 44 of the Copyright Law) enable a surprise entry upon premises where there is good ground to suspect the carrying on of copyright infringing activity for the purpose of inspecting, and where necessary, removing materials relating to the infringing activity. The defendant is required to make an affidavit disclosing the source of the articles. The material thereby obtained is then to be preserved as evidence for future civil and criminal action.
- The Court can also grant a Mareva injunction, which is an order blocking bank accounts and other assets of the defendant pending review of these by the court.
- A further provisional measure, rarely applied, is the issue of the writ *ne exeat regno*. Under this, a party is forbidden to leave the country until further order of the court. As with the Mareva injunction, this writ will normally only be used when it is feared that a defendant will leave the jurisdiction of the court before damages awarded by the court have been paid.

- Another provisional measure is an application to the court for an interim award of damages. To obtain this, the plaintiff must show to the court that it is likely that at full trial the court will award substantial damages and that, pending the assessment of these at trial, it is just that there should be an interim payment. The court may make it a condition of such a payment that the defendant will take steps to preserve the sum for reparation (with interest) should the court at trial award the plaintiff no damages, or a lesser sum than the interim payment.

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

In cases of exceptional urgency, the High Court will order an injunction on an *ex parte* basis, that is *inaudita altera parte*, for a limited period, generally a few days only. Thereafter, the plaintiff must then return to the court at a time when the defendant can also be present and then seek a renewal of the injunction.

**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.**

There must be first of all a proceeding before the court, i.e. a writ of summons has been issued, prior to applying for provisional measures. An *ex parte* injunction may be issued upon affidavit testimony.

On the return hearing, the general principles governing interlocutory injunctions will be applied and also key measures in affording protection to the defendant against damages that he may incur in the event that the provisional measure is proved to be unjustified. These could include undertakings by the plaintiff supported by bond to secure the payment of damages or less commonly by a payment of money into court.

**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

There are no provisions which govern the length or costs of proceedings for provisional measures. Provided that a request for provisional measures is made promptly, the court will then stipulate for further procedure and a hearing date will be fixed. Since a provisional relief is usually requested because of the threat of imminent damage to the interests of the plaintiff, both the High and Appeal Courts will expedite hearing.

The normal rules with respect to costs explained in the answer to question 5 above also apply to applications for provisional measures. However, the usual order for costs awarded in respect of applications for provisional relief is that these only take effect at the end of substantive trial.

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

Refer to the answer to question 13 above.

(b) *Administrative measures*

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

There are no provisions whereby provisional relief can be given by an administrative body, save as regards border measures discussed in the answers to questions 15 to 19 below.

**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)

Procedures exist under the inherent jurisdiction of the High Court that enable a right holder who has valid grounds for suspecting that the importation of goods infringe any intellectual property right to apply to the court for an order for the suspension by the Customs Authorities of the release into free circulation of such goods. Existing judicial procedures cover the evidence required to be furnished, security or equivalent assurance, notice to all interested persons, duration of suspension, indemnification of the importer and of the owner of the goods.

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?

The Copyright Office has entered into an informal enforcement arrangement with the Customs, Excise and Preventive Service (CEPS) to seize large quantities of imports of sound recordings (where there is reasonable belief that the goods might be pirated or infringing copies). The goods are then released by the Customs, Excise and Preventive Service to the Copyright Office Monitoring Team of policemen who, after ascertaining that the copies emanate from a valid source release them to the original owner. The owners of these goods are then permitted to purchase the banderole or authentication stamp which must be affixed on all sound recordings in internal circulation in the country. The Copyright Bill, awaiting enactment by Parliament, formalises this arrangement.

- 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?**

The customs authorities have the general power to seize goods under their own law (Customs Excise and Preventive Service Management Law 1993, PNDCL 330) if they suspect or are appraised that the goods may be prohibited or illegal (such as counterfeit or pirated). There are no provisions in the existing intellectual property legislation, with the exception of the Copyright Law, which make importation of infringing copies an infringement. However, the Customs Law makes provision for judicial proceedings to take precedence over all other civil procedures.

- 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?**

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

Judicial measures may be applied in border situations and in this regard the answer to question 8 above, is applicable.

How long is the validity of decisions by the competent authorities for the suspension of the release of goods into free circulation?

It is desirable that in such cases the right owner should bring infringement proceedings in relation to the seized goods.

- 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 own initiative and, if so, in what circumstances?

There is no provision requiring *ex officio* action by Customs Authorities except in the case of the copyright office's banderole arrangements as described in the answer to question 15 above.

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

No, 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 upon a court order. All such decisions are made by the courts.



## **Criminal Procedures**

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

The superior or inferior courts have jurisdiction over criminal acts of infringement depending on the seriousness of the offence.

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

Presently, criminal sanctions are provided for under sections 45, 46,47 and 48 of the Copyright Law for the following acts which constitute infringement of protected works:

- reproduction, duplication, extraction;
- importation, distribution, exhibition;
- sale, offer for sale.

Under section 72 of the Patents Law, any intentional infringement of a patent or utility certificate constitutes an offence punishable by a fine or by a two-year imprisonment term or both.

### **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 Police and the Attorney-General's Department of the Ministry of Justice are the relevant public authorities for initiating criminal proceedings. They act on complaints since intellectual property rights are essentially private rights. The Attorney General's Department is responsible for initiating criminal proceedings. However, the Police Service may conduct prosecutions on behalf of the Attorney General in cases involving misdemeanours.

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

Private prosecutions are not permitted. All criminal proceedings have to be initiated at the instance of the State. Private persons initiate criminal proceedings by lodging the relevant complaint on which the prosecution is founded.

### **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**

- Imprisonment: term of imprisonment not exceeding two (2) years.
- Monetary fines: ¢10,000 to 1,000,000.00; continuing offences are liable to ¢5,000 to 50,000 for each day that the offence continues.

- Seizure, forfeiture and destruction: judges may order seizure, forfeiture and destruction of infringing items under the Copyright Law. It has happened in several cases.
- Others: section 48 of the Copyright Law also gives the courts the power to order the offender to account to the right holder for any money paid to him as a result of the infringement. The court is also given the power to dispose of reproductions, duplications, extracts, imitations and other material involved in the infringement as well as all implements used in the infringement.
- Trademarks
  - Imprisonment: term of imprisonment does not exceed three months.
  - Monetary fines: the monetary fines specified are archaic since the law was passed almost forty years ago. The new Trademarks Bill sets realistic fines.
  - Seizure, forfeiture and destruction: the courts may direct search and seizure and other remedies to be effected.
- Textile designs
  - Imprisonment: term of imprisonment not exceeding five years are applicable for making false entries in the Register.
  - Monetary fines: monetary fines are archaic since the law was passed in 1973 but they apply to false representation that the design is registered.
  - Seizure, forfeiture and destruction: the courts may direct search, seizure and other remedies to be effected.
- Patents
  - Imprisonment: term of imprisonment for intentional infringement not to exceed two (2) years
  - Monetary fines: fine not to exceed €2 million.

**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.**

Criminal proceedings are normally faster than civil proceedings; right holders do not incur any cost as prosecutions are conducted by public authorities. Depending on the witnesses to be called, a criminal trial may last between a day and a week.

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