

CHECKLIST OF ISSUES ON ENFORCEMENT¹

Responses from Namibia

Civil and Administrative Procedures and Remedies

(a) Civil judicial procedures and remedies

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

There are no additional or specialized courts created for IPR cases, hence Namibia's ordinary civil courts adjudicate upon matters involving the infringement of intellectual property rights.

Chapter 9 of the Namibian Constitution describes the Namibian court system:

Article 79 (2) of the Namibian Constitution describes the Namibian court system:

Article 79 (2) of the Namibian Constitution states that the Supreme Court "shall hear and adjudicate upon appeals emanating from the High Court, including appeals which involve the interpretation, implementation and upholding of this Constitution and the fundamental rights and freedoms guaranteed thereunder."

Article 81: "A decision of the Supreme Court shall be binding on all other courts of Namibia and all persons in Namibia, unless it is reversed by the Supreme Court itself or is contradicted by an Act of Parliament."

Article 80 (2): The High Court has "original jurisdiction to hear and adjudicate upon all civil disputes and criminal prosecutions, including cases which involve the interpretation, implementation and upholding of this Constitution and the fundamental rights and freedoms guaranteed thereunder." The High Court may also hear and adjudicate appeals from lower courts.

Article 83 (1): Lower courts shall be established by Act of Parliament and shall have the jurisdiction and adopt the procedures prescribed by such Act and regulations made thereunder."

The Act of Parliament establishing lower courts is the Magistrate Courts Act, 1944 (Act No.32 of 1944). Lower courts are composed of regional courts and magistrate's courts.

Section 29 (1) (f) of the Magistrate's Courts Act, 1944 stipulates that the limit to the jurisdiction of lower courts (which are not regional courts) with regard to causes of action (i.e. civil cases) shall be a claim not exceeding N\$25 000.

¹ Document IP/C/5.

In regional courts the limit with regard to causes of action is N\$100-000.

The plaintiff is the *dominus litis*, i.e. he or she may decide at which court to institute action.

Section 50 (1) allows the defendant to apply to court for the removal of an action to the High Court, if the claim in that action exceeds N\$5 000 (excluding interest and costs).

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?

Copyright and Neighbouring Rights Protection Act, 1994 (Act No. 6 of 1994):

- owners of copyright (section 30 {1});
- exclusive licensees or sublicensees (section 31 {1});
- author of work (in respect of moral rights, if he or she is not also the copyright owner) (section 25 {2});
- performers (section 47{1}).

Trade Marks in South West Africa Act, 1973 (Act No. 48 of 1973):

- Proprietor and registered user of a trademark (section 45).

Patents Act, 1978 (Act No. 57. Of 1978):

Right holders and right users (section 65):

- patentee (right holder);
- exclusive licensee or sublicensee (right user).

How may they be represented?

At all levels of the court system persons with standing to assert intellectual property rights may be represented by legal practitioners (as defined in Legal Practitioners Act, 1995 (Act No. of 1995) or present their case personally (Article 12 of Constitution).

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

Copyright and Neighbouring Rights Protection Act, 1994 (Act No. 6 of 1994): This Act does not contain any provision in this regard.

Trademarks in South West Africa Act, 1973 (Act No. 48 of 1973): This Act does not contain any provision in this regard.

Patents Act, 1978 (Act No. 57 of 1978): This Act does not contain any provision in this regard.

In absence of specific provisions in the relevant laws, court rules will apply:

- High Court Rule 38 (2): If the right holder is to give testimony as a witness, then the following applies: A witness must be examined orally (so that he or she may be cross-examined), but the court may for sufficient reason order that all or any part of the

evidence to be adduced at a trial be given on affidavit (unless the witness concerned is reasonably required for cross-examination by the other party)

- High Court Rule 38 (3)-(8): Evidence may be taken by a commissioner of the court in the presence of all parties before or during the trial, which evidence is to be used in the trial.

Interrogatories

Rule 6(1): motion proceedings in reapplication for interim orders (Provisional measures), affidavits may be used instead of oral evidence, unless court orders otherwise (rule 6/5/g).

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?

Patents 57/78: No provision.

Trademarks 48/73: No provision.

Copyright 4/94: No provision.

Copyright 4/94: No provision.

Rule 35(7) court order on application after notice to non-complying party was served requesting discovery.

Rule 35(11): court may during the proceedings *mero motu* order production by any party of tapes, documents in his or her power or control relating to the matter in question.

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

Evidence: privilege; without prejudice.

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.**

Copyright

Interdicts, damages, delivery of infringing goods (section 30 (1)], additional damages 30/6

Performers rights: destruction (section 53)

Criteria: legislative

-Section 30/2 basis is reasonable royalty which would have been payable by a licensee or sublicensee in re patent concerned

-/3:

-/5

-/6

-/7

-Section 32 onus of proof.

Patents: section 65 (3)

Interdict, delivery up of infringe product or any article or product of which the infringe product forms an inseparable part, damages.

Section 70 (1): declaration in re groundless threats.

Criteria:

Section 65/6 basis is reasonable royalty which would have been payable by a licensee or sublicensee in re patent concerned

-66/1: presence of knowledge of illegality

-/2: restrictions on recovery of damages/onus of proof on plaintiff to produce no. of patent if requested by other party.

Trademarks

Section 43: indirectly pointing to damages.

No provision for criteria.

In all cases prayer as to costs to be included in prayer to court, attorney's fees.

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?**

Evidence: privilege.

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?**

No provision in Acts.

Rule 6/15 order as to costs if scandalous allegations.

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

Time limits in re pleadings Rules 17-29.

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

Copyright: tribunal.

Patents: no provision.

Trademarks: no provision.

Provisional Measures

(a) *Judicial measures*

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

Interlocutory interdicts may be ordered whenever a person needs protection against an unlawful interference or threatened interference with his or her rights and it is available, among other purposes, to prohibit the commission of a delict or crime or to restrain the breach of a statutory provision.

Legal basis for interim interdict – Magistrate’s court Act and rules (based on Roman-duch law).

Requisites for an interlocutory interdict:

- *prima facie* right to be established on a balance of probabilities that the respondent has invaded the right or threatens to do so.
- A well-grounded apprehension of irreparable harm, if the relief is not granted and ultimate relief is eventually granted.
- A balance of convenience in favour of the granting of the interim relief, and
- The absence of any other satisfactory relief lesser degree of proof than for final interdict i.e. only *prima facie* or clear right must be established.

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

Rule 6/5/c: if application is unopposed (i.e. if the respondent fails to notify the applicant on or before the day mentioned in the notice of motion of his or her intention to oppose the application), applicant may place matter on roll for hearing.

Rule 56:

- Ex parte procedure if urgency requires (no giving notice to party to be affected by order necessary, normally *ex parte* only if question of law to be determined in re applicant)
- Ex parte if giving of notice would defeat the object of the application then applicant must state these reasons on oath in his/her *affidavit*.

In re trial: rule 40 (1), 40 (2) default judgement (defendant does not appear at trial), 40 (3) absolution from the instance (plaintiff does not appear).

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.

Initiation of provisional judicial measures

Rule 6 (1) and (2): notice of motion supported by *affidavit* as to the facts upon which the applicant relies for relief addressed to respondent (and all interested parties likely to be affected by court order) and registrar of High Court 6 (5): copies of notice and annexures to be served on all affected parties .

Respondent may oppose application or bring counter-application.

Ordering of provisional judicial measures

Rule 6/5/g: Court may dismiss application, if it cannot be properly decided on *affidavit*.

May direct that oral evidence be adduced or party to appear personally on specified issues in re questions of fact.

Make order necessary to ensure just and expeditious decision refer matter to trial with appropriate directions as to pleadings or definition of issues or otherwise.

Rule 6/6: court may instead of making an order (unless it is an order in re costs) grant leave to the applicant to renew application on the same papers supplemented by such further affidavits as the case may require.

Rule 6/12: in re urgent applications court may dispense with the forms and service provided for in rules and may dispose of application, as it seems meet.

Rule 6/15: court may on application order to be struck out from any *affidavit* any scandalous, vexatious or irrelevant matter maintaining in force of provisional judicial measures (time limits, and safeguards to protect legitimate interests of defendant):

Rule 6 (5) (b),c,d,e:

- 5 days' notice to respondent of application to respond by giving notice of intention to oppose the application;
- 14 days for of notifying notice to oppose deliver answering affidavit;
- applicant may within 7 days of receiving answering affidavit (upon service) deliver replying *affidavit*.

If respondent intends to raise a question of law s/he must give notice of that intention within 15 days after notice to oppose:

- 4 days after receipt of answering affidavit or after delivering replying *affidavit*, applicant may apply to registrar for allocation of date for hearing of the application/if applicant doesn't, respondent may;

- if no notice to oppose set down for hearing 7 days after notice of motion given to respondent.

In HC - if material facts are in dispute final order generally sought by way of action; in MC hearing of oral evidence in order to resolve factual disputes for final order.

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

No response provided.

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

No response provided.

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?

Which goods in re application for suspension of release possible

- Prohibited goods: infringing copies of copyright, section 34 read with 123 (1) and (b) in particular in respect of copyright;
- Trademarks;
- Patents.

Exclusion of goods from customs measures

Copyright: no exclusion in re imports.

Sec. 40 of customs: subject to a written permission importer may import the following goods from the common customs area without making an entry of such goods:

Containers temporarily imported; human remains; goods which in the opinion of the Commissioner are of no commercial value; goods imported under an international carnet; or goods of a value for duty purposes not exceeding N\$500 and on which no duty is payable in terms of Schedule 1.

Sec. 84 (1) (b) goods for home consumption.

(Sec 15-24 – if goods subject to exceptions listed and falling under “fair dealing” BUT these are acts done in Namibia)

Trademarks: No specific provisions.

Patents: No specific provisions.

Sec 123 of Customs Act.

- 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?**

Copyright: Section 34 in re 1. Restriction on importation on request by copyright owner none in 2,3,6.

Patents: none.

Trademarks: none.

Customs has provision re intellectual property rights in re 1-6: sections 14, 93,97,98, 123/1 and /4.

- 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 Customs and Excise Act has no specific provision to this effect.

- 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?**

Yes. Customs and Excise Act 20 of 1998, Section 123.

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

No response.

Criminal Procedures

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

Same as civil, Magistrates court jurisdiction is N\$20 000 or 5 years.

Regional N\$100 000 or 20 years.

A case may be dealt with at Magistrate's court and then referred to regional court for sentencing.

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

Trademarks

Section 70: false entry in register or making, producing or tendering false copy 200 or 12 months or both.

Section 71: making false statements in order to deceive register or other officer 200 or 12 months or both.

Section 72: falsely representing a trademark as registered. N\$100.

Patents

Section 81 (same as 70 of trademarks) max. N\$1 000 or 12 months or to both, 82 same as 71 or trademarks, same penalties.

Section 83: trafficking of patents by employees or officers in patent office N\$500 no imprisonment.

Section 84: improper use of the words “patent office”: 100 or 3 months or to both.

Section 85: certain false representations e.g. that product is a patent 1000 or 12 months or both.

Copyright

Section 33, Sub (1):

- making for sale or hire;
- selling or letting or by way of trade offering or exposing for sale or hire;
- by way of trade exhibits in public;
- importing into Namibia for a purpose other than for his or her private or domestic use;
- distributing for purposes of trade;
- distributing for any other purpose to such an extent that the owner of the copyright is prejudicially affected,

any article which he or she knows to be an infringing copy of the work.

Section 33, Sub (2):

- causing a literary or musical work to be performed in public, knowing that copyright subsists in the work and that such performance constitutes an infringement of the copyright;
- causing a broadcast to be rebroadcast or transmitted in a diffusion service, knowing that copyright subsists in the broadcast and that such rebroadcast or transmission constitutes an infringement of the copyright;

- causing programme-carrying signals to be distributed by a distributor for whom they were not intended, knowing that copyright subsists in the signals and that such distribution constitutes an infringement of 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?

Section 8 of cpa 51/1977: private prosecution under statutory right person on whom right to prosecute expressly conferred by law may institute and conduct prosecution in re of those offences.

Police, customs, agencies administering and implementing the relevant legislation (they may be complainants in criminal proceedings):

- They may initiate criminal proceedings on their own or in response to owner of rights under the laws concerned notifying them of infringement/making a complaint (initiating meaning "laying a charge").

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

Right owners and section 7: anyone with a substantial and peculiar interest in the issue of the trial arising out of some injury which he or she individually suffered in consequence of the commission of the offence cpa for all acts.

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, trademarks, and patents: impose monetary fines and imprisonment; Seizure, forfeiture of infringing goods and implements for their production are authorized by the Criminal Procedure Act, 1977 (Act No. 51 of 1977) which applies to all criminal cases instituted under the laws concerned.

Destruction under Criminal Procedures Act, 1977, under section 31 (1) (b).

Copyright: section 53 – destruction.

Section 33: copyright infringement, all types – N\$12 000 or 3 years or both for first conviction.

N\$ 20 000 or 5 years or both for any subsequent conviction.

Section 51 (performers): same.

Other penalties

Not specified.

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.

Article 12 (1)(b) of the Namibian Constitution requires that judicial proceedings take place within a reasonable time, failing which the accused shall be released; the duration of criminal proceedings varies greatly.

Factors contributing to delays are, among other things: a backlog of cases due to a lack of prosecutors, magistrates, police vehicles to carry out investigations, non-availability of lawyers in reasonably short time (in light of article 12 (1) (e) adequate time and facilities to prepare and present defense, including right to legal representation).

No data.
