



CHECKLIST OF ISSUES ON ENFORCEMENT¹

RESPONSES FROM SEYCHELLES

Civil and Administrative Procedures and Remedies

(a) Civil judicial procedures and remedies

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

1.1 The jurisdiction over IPR infringement cases is being conferred to the Supreme Court of Seychelles. In the event of an appeal, the Court of Appeal has jurisdiction.

Section 124 of the Industrial Property Act stipulates that the Supreme Court shall have jurisdiction in disputes relating to the application to this Act and the Regulations and in matters which under this act referred to the Court.

1.2 With regards to copyright, the law is not clear. However, it seems that both the Supreme Court and the Magistrates Court have jurisdiction.

Section 108 (3) states that: The Court may order cumulative remedies as it deems appropriate.

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?

2.1 Which persons have standing to assert IPRs?

The holder of industrial property rights or the person authorized by him or her has standing to assert IPRs.

2.2 How may they be represented?

It is the right holder or the person authorized by him/her who may assert their IPRs as per Section 108 (2) of the Industrial Property Act which states that:

"The holder of industrial property rights or the person authorized by him or her may seek for any or more or all of the remedies referred to in subsection (1)".

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

There are no mandatory requirements for appearances before the court by the right holder.

Section 107 - Chapter 1, under the General Provision paragraph (b) states that: the procedures shall not impose overly burdensome requirements concerning mandatory personal appearances.

¹ Document IP/C/5

[https://docs.wto.org/dol2fe/Pages/FE_Search/FE_S_S006.aspx?DataSource=Cat&query=@SymbolMatch="IP/C/5"+OR+"IP/C/5/*"&Language=English&Context=ScriptedSearches&languageUIChanged=true#](https://docs.wto.org/dol2fe/Pages/FE_Search/FE_S_S006.aspx?DataSource=Cat&query=@SymbolMatch=)

Section 107 paragraph (c) states that: Parties to a legal proceeding shall be allowed to be represented by independent legal counsel.

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 which lies within its control?

At the request of an opposing party, the Judicial Authorities may order banking, financial and commercial authority to produce evidence which lies within their control.

Section 110, paragraph (1) states that: The Court may, where a party has presented reasonably available evidence sufficient to support its claims and has specified evidence relevant to substantiation of the claims which lies in the control of the opposing party, order that this evidence be produced by the opposing party, subject, in appropriate cases, to conditions which ensure the protection of confidential information.

Section 110, paragraph (2) states that: Where infringement is committed in a commercial scale, the Court may, upon request of a party or when found appropriate, order the production of communication of banking, financial or commercial documents under the control of the opposing party, subject to the protection of confidential information.

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

Section 109, paragraph (3) states that: In ordering the production of evidence to the contrary, the Court shall take into account the legitimate interests of the alleged infringer in not disclosing his or her manufacturing and business secrets.

Section 110 (1) states that: The Court may, where a party has presented reasonably available evidence sufficient to support its claims and has specified evidence relevant to substantiation of the claims which lies in the control of the opposing party, order that this evidence be produced by the opposing party, subject, in appropriate cases, to conditions which ensure the protection of confidential information.

Section 110 (2) states that: Where infringement is committed in a commercial scale, the Court may, upon request of a party or when found appropriate, order the production of communication of banking, financial or commercial documents under the control of the opposing party, subject to the protection of confidential 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.**

Section 108 (1) states that: The remedies against infringement of industrial property rights, made available under this Act include —

- (a) Provisional measures;
- (b) Civil remedies; and
- (c) Criminal remedies.

Section 108 (2) further states that: The holder of industrial property rights or the person authorized by him or her may seek for any or more or all of the remedies referred to in subsection 1.

And Section 108 (3) states that: The Court may order cumulative remedies as it deems appropriate.

5.1 Damages: Section 112 (1) states that: The Court shall order the infringer, who knowingly, or with reasonable grounds to know, engaged in infringing activity, to pay damages adequate to compensate for the injury the rights holder has suffered because of an infringement of his or her industrial property right.

Section 112 (2) states that: In determining the amount of damages awarded to the rights holder, the Court may consider –

- (a) The value of the infringed-on goods or service, measured by the suggested retail price or other legitimate measure of value submitted by the right holder;
- (b) The loss of earnings incurred by the rights holder;
- (c) The unfair profits made by the infringer;
- (d) The royalties or fees which would have been due if the infringer had requested authorization to use the industrial property right in question; and
- (e) Where appropriate, any moral damages caused to the right holders.

Section 112 (3) states that: The Court shall order the infringer to pay the rights holder's expenses, which may include appropriate attorney's fees.

Section 112 (4) states that: The Court may, where appropriate, order recovery of profits where the infringer did not knowingly, or with reasonable grounds to know, engage in infringing activity.

5.2 Destruction: Section 113 (3) states that: The Court may, whenever this is considered adequate under the circumstances to create an effective deterrent to further infringement, taking due account of the need for proportionality between the seriousness of the infringement and the remedies and the legitimate interests of third parties, order that the infringing goods be destroyed, or be disposed of outside the channels of commerce, without compensation of any sort, in such a manner as to avoid any harm caused to the rights holder.

5.3 Other Remedies: Section 113 (1) states that: The Court may, upon the request of the applicant, order that goods, materials and implements the predominant use of which has been in the creation of the infringing goods be, without compensation of any sort, disposed of outside the channels of commerce in such a manner as to minimize the risks of further infringements.

Section 113 (2) states that: In considering such requests, the need for proportionality between the seriousness of the infringement and the remedies ordered and the interests of third parties shall be taken into account.

Section 113 (4) states that: In respect of counterfeit goods, the simple removal of the mark or geographical indication unlawfully affixed shall not be sufficient, other than in exceptional cases, to permit release of the goods into the channels of commerce.

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 or services found to be infringing and of their channels of distribution?

The judicial authorities have the authority to order the infringer to inform the rights holder of the identity of third persons involved in the production and distribution of the infringing goods or

rendering of services and of their channels of distribution unless this would be out of proportion to the seriousness of the infringement.

Section 114 states that: The Court shall order the infringer to inform the rights holder of the identity of third persons involved in the production and distribution of the infringing goods or rendering of services and of their channels of distribution unless this would be out of proportion to the seriousness of the 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?

7.1 Provisions relating to the indemnification of defendants wrongfully enjoined.

In cases where a defendant has been wrongfully enjoined or restrained, adequate compensations should be provided for the injury suffered because of such abuse.

Section 115 (1) states that: The Court shall order an applicant, at whose request measures were taken and who has abused enforcement procedures, to provide to a defendant wrongfully enjoined or restrained adequate compensation for the injury suffered because of such abuse.

Section 115 (2) states that: The Court shall order the applicant to pay the defendant expenses, which may include appropriate attorney's fees.

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

Public authorities are exempted from liability to appropriate remedial measures where actions were taken and/or intended in good faith.

Section 115 (3) states that: The public authorities and officials shall be exempted from liability to appropriate remedial measures where actions were taken or intended in good faith in the course of the administration of any law pertaining to the protection or enforcement of industrial property rights.

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

8.1 Length of proceedings

Any civil proceedings shall be initiated within 5 years from the date on which the rights holder knew or had reasons to know the infringing acts, except in case of infringing use of distinctive signs in based faith or for unfair competition purposes, for which there shall be no time to initiate the proceedings.

8.2 Cost of proceedings

(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.

Administratively based on the order of the Court, depending on the type of order from the Court, relevant stakeholders (Ministries, Agencies, Authorities, Departments, etc...) will have to act upon the Court Order.

Any decision by the Court in infringement proceedings shall be subject to an appeal in the Court of Appeal. The appeal shall be filed within 60 days from the date of the decision.

Section 116 (1) states that: Any decision by the Court in infringement proceedings shall be subject to an appeal to the Court of Appeal.

Section 116 (2) states that: The appeal shall be filed within 60 days from the date of the decision.

Provisional Measures

(a) *Judicial measures*

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

Section 111 states that: The Court shall have power to order prompt and effective provisional measures, to —

- (a) Prevent an infringement of a right from occurring, in particular to prevent the entry into channels of commerce, imported goods after completing customs formalities; and
- (b) Preserve relevant evidence in regard to the alleged infringement.

(2) The Court shall have power to order provisional measures, without giving the other party an opportunity of being heard, where appropriate, in particular where any delay is likely to cause irreparable harm to the rights holder, or where there is a demonstrable risk of evidence being destroyed.

(3) The Court may, before making a decision under subsection (2), require the applicant to provide any reasonably available evidence in order to satisfy it with a sufficient degree of certainty that the applicant is the rights holder and that the applicant's right is being infringed or that such infringement is imminent, and order the applicant to provide a security or equivalent assurance sufficient to protect the defendant and to prevent abuse.

(4) Where provisional measures have been ordered without giving the other party an opportunity of being heard, the defendant may file a request for review with the Court within 2 weeks from the date of receipt of the decision.

(5) In the review proceedings, the Court shall give the parties concerned an opportunity of being heard and shall confirm, modify or revoke the decision within a reasonable period.

(6) The applicant may be required to supply other information necessary for the identification of the goods concerned by the authority that will execute the provisional measures.

(7) Where the applicant does not initiate proceedings in the Court leading to a decision on the merits of the case within 20 working days or 31 calendar days, whichever is longer, from the date of receipt of the decision ordering provisional measures or within any other reasonable period determined by the Court in the decision, the Court shall revoke the provisional measures upon request of the defendant.

(8) Where the provisional measures are revoked or where they lapse due to any act or omission by the applicant, or where it is subsequently found that there has been no infringement or threat of infringement of an industrial property right, the Court shall order the applicant, upon request of the defendant, to provide the defendant appropriate compensation for any injury caused by these measures.

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

Where any delay is likely to cause irreparable harm to the rights holder, or where there is a demonstrable risk of evidence being destroyed.

Section 111 (2) states that: The Court shall have power to order provisional measures, without giving the other party an opportunity of being heard, where appropriate, in particular where any

delay is likely to cause irreparable harm to the rights holder, or where there is a demonstrable risk of evidence being destroyed.

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.

Section 111 (3) states that: The Court may, before making a decision under subsection (2), require the applicant to provide any reasonably available evidence in order to satisfy it with a sufficient degree of certainty that the applicant is the rights holder and that the applicant's right is being infringed or that such infringement is imminent, and order the applicant to provide a security or equivalent assurance sufficient to protect the defendant and to prevent abuse.

Section 111 (6) states that: The applicant may be required to supply other information necessary for the identification of the goods concerned by the authority that will execute the provisional measures.

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

Section 111 (4) states that: Where provisional measures have been ordered without giving the other party an opportunity of being heard, the defendant may file a request for review with the Court within 2 weeks from the date of receipt of the decision.

Section 111 (5) states that: In the review proceedings, the Court shall give the parties concerned an opportunity of being heard and shall confirm, modify or revoke the decision within a reasonable period.

Section 111 (7) states that: Where the applicant does not initiate proceedings in the Court leading to a decision on the merits of the case within 20 working days or 31 calendar days, whichever is longer, from the date of receipt of the decision ordering provisional measures or within any other reasonable period determined by the Court in the decision, the Court shall revoke the provisional measures upon request of the defendant.

(b) Administrative measures

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

Section 111 (8) states that: Where the provisional measures are revoked or where they lapse due to any act or omission by the applicant, or where it is subsequently found that there has been no infringement or threat of infringement of an industrial property right, the Court shall order the applicant, upon request of the defendant, to provide the defendant appropriate compensation for any injury caused by these measures.

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?

Regulation 77 (1) of Customs Management Regulations, 2014 (S. I. 42 of 2014) states that: A rights holder may submit an application to Customs, in accordance with the procedures and under the conditions set out in this Chapter, for the suspension of customs clearance of imported goods that are suspected of being infringing goods.

Regulation 78 (1) further states that Customs shall suspend clearance of the goods if satisfied that the goods are infringing goods covered by the application allowed under Regulation 77 (3).

Chapter 13 of the Customs Management Regulations, 2014, covering Border Measures for Protection of Intellectual Property Rights, does not provide any information about 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). The aforementioned Regulations also do not provide information about such procedures in regards 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.

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?

According to Regulation 78 (1) of the Customs Management Regulations, 2014, the suspension of clearance of goods shall be effective for 90 days unless the rights holder -

- (a) Requested a shorter period; or
- (b) Applied for action in cases of specific shipments.

Regulation 78 (3) stipulates that Customs shall refuse to suspend clearance of goods unless the rights holder furnishes to Customs a security in the manner and amount that Customs may reasonably require to indemnify itself against any liability that may be incurred pursuant to such suspension, and to cover any expenses that may be incurred in effecting the suspension.

Regulation 78 (4) further states that Customs shall inform all Customs offices immediately of the suspension with full particulars to enable them to act in accordance with the terms of the suspension.

(5) The Customs shall immediately inform the following persons of the suspension of the clearance of the goods and the reason therefore in writing —

- (a) The importer, exporter, consignee or the consignor where their identity is known to Customs; and
- (b) The applicant.

(6) The rights holder shall inform Customs when his intellectual property right ceases to be valid or if he ceases to be the owner of the right for any reason whatsoever, in which event the application or suspension shall lapse.

In terms of application issues, Regulation 79 states that: A decision taken by Customs on refusal of the application shall be subject to the appeal in accordance section 32 of the Act.

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?

There are no specific provisions detailing the length and cost of proceedings. This is determined on a case-by-case basis.

In light of the fact that to date there has not been any case relating to infringement of border measures we currently do not have data on the duration of such proceedings.

According to Regulation 78 (2) of the Customs Management Regulations, 2014 "the suspension of clearance of goods Shall be effective for 90 days unless the rights holder —

- (a) requested a shorter period; or
- (b) applied for action in cases of specific shipments."

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. Competent authorities may act upon their own initiatives in respect of which it has acquired *prima facie* evidence that the goods are infringing goods; or where there are reasonable grounds to suspect that the goods are infringing goods.

Section 80 (1) states that: The Customs may, on its own initiative, suspend the clearance of goods —

- (a) In respect of which it has acquired *prima facie* evidence that the goods are infringing goods; or
- (b) Where there are reasonable grounds to suspect that the goods are infringing goods.

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

Section 81 (1) states that: Where Customs determines that goods are infringing goods, Customs may, upon the request by the rights holder, order that the goods be forfeited and destroyed, where the rights holder has provided adequate evidence to the satisfaction of Customs that the goods are infringing goods, and -

- (a) the importer, the exporter, the consignee, the consignor, the owner of the goods, or the declarant who has been served by Customs with a notice of suspension, has been informed about the possibility of confiscation and destruction or disposal of goods and does not oppose the measure within 60 days after having been served the notice; or
- (b) if after reasonable efforts by Customs the importer, exporter, consignee, consignor, the owner of the goods, or the declarant has not been identified, Customs may, without a court order and without the request of the rights holder, forfeit and destroy or dispose of the goods.

(2) The Customs shall, while making an order under sub regulation (1), take the following into consideration —

- (a) disposal shall be outside the normal channels of commerce and in such a manner so as to minimize the risks of further infringements, and without detriment to the rights of the rights holder;
- (b) the rights holder's proposed manner of destruction or disposal; and
- (c) the effect on the environment of the manner of destruction.

(3) The Customs may, with the consent of the rights holder, retain samples of the infringing goods for the purpose of training or education of Customs officials.

Criminal Procedures

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

The Supreme Court has jurisdiction over criminal acts of infringement of IPRs and, in the event of an appeal, the Court of Appeal has jurisdiction.

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

Criminal procedures and penalties are available when:

1. Any person, who except under justifiable circumstances provided under the Act, without consent of a patent or utility model right holder, wilfully and on commercial scale, as defined under Section 118 (1) paragraph (a), (b); (c) and (d); and
2. Any person who, except under justifiable circumstances provided under this Act, without the authorization of a registered industrial design rights holder, wilfully and on a commercial scale, as defined under Section 118 (2) paragraph (a); (b) and (d); and
3. Any person who, without the authorization of registered mark rights holder, wilfully and on a commercial scale, as defined under Section 118 (3) paragraph (a); (b) and (c) and Section 118 (4) paragraph (a) and (b), commits an offence.

Section 119 (1) states that: Whoever intentionally commits an offence under Section 118, shall on conviction be liable to imprisonment for a term not exceeding 5 years or a fine not exceeding SCR500,000 or with both such imprisonment and fine.

Section 119 (2) further states that: Except where higher penalty is provided in any other written law, whoever by negligence violates a right protected under this Act shall on conviction be liable to imprisonment for a term not exceeding 3 years or a fine not exceeding SCR500,000 or with both such imprisonment and fine.

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 authorized officers or authorities have the power to investigate a complaint or on its initiative investigate into possible infringement(s). However, it is the Attorney General's Office that has the power to initiate/institute any criminal proceedings as per Section 76(4) (a) of the Constitution of Seychelles which stipulates that:

- "4. The Attorney General shall be the principal legal adviser to the Government and, subject to clause (11), shall have power, in any case in which the Attorney General considers it desirable so to do -
 - a). to institute and undertake criminal proceedings against any person before any court in respect of any offence alleged to have been committed by that person;"

In addition, Section 60 of the Criminal Procedure Code states that:

- "60. (1) The Attorney General is vested with the right of prosecuting all crimes and offences over which the Courts of Seychelles have jurisdiction.
- (2) The right and power of prosecuting vested in the Attorney General is absolutely under his management and control and any officer who may be appointed a public prosecutor under section 63 shall be under the control of the Attorney General and be bound to conform to any direction which shall or may be given to him by the Attorney General."

Section 120 of the Industrial Property Act states that:

- (1) A police officer may arrest without warrant any person who, in any street or public place -
 - (a) sells, exposes or offers for sale or hire; or

- (b) has, or is reasonably suspected of having, in his or her possession for the purpose of selling or letting for hire, any product that infringes industrial property rights protected in Seychelles.
- (2) Any authorized officer may, at any time, without a warrant —
- (a) stop, search and board, whether forcibly or otherwise, any conveyance in which he or she reasonably suspects that there is any infringing product; and
- (b) seize, remove or detain such infringing product and anything which appears to him or her to be or to contain; or to be likely to contain, evidence of an offence under this Act.
- (3) In the exercise of his or her power under subsection (2), an authorized officer may order the person in charge of a vehicle —
- (a) to stop and not to proceed until so authorized; or
- (b) to bring the vehicle to any police station.

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

A private person may institute criminal proceedings but they have to have permission from the president as per Section 66 (1) of the Criminal Procedure Code which states that:

"The Judge or any Magistrate inquiring into or trying any case may permit the prosecution to be conducted by any person, but no person other than a public prosecutor or other officer generally or specially authorised by the President in this behalf shall be entitled to do so without permission. With the like permission, any manager or employee may prosecute for an offence committed to the prejudice of his principal or employer."

As per Section 68 of the Criminal Procedure Code, a person may institute proceedings by making a complaint to a Judicial Officer (in the context of Seychelles a Judicial Officer is namely, Judge, Master, a senior Magistrate, a Magistrate, a Justice of the Peace or the Registrar).

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.**

In cases of wilful trademark counterfeiting or copyright piracy on a commercial scale, penalties and remedies such as imprisonment, monetary fines, seizure is applicable.

Any type of infringement pertaining to "Certification mark"; "collective mark"; any product under the patented invention, protect by utility model certificate; "counterfeit goods"; "goods infringing industrial property rights"; "industrial design"; "integrated circuit"; "invention"; and "layout-design" is liable to imprisonment, monetary fines, seizure, forfeiture and destruction of infringing goods and materials and implements for their production.

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.

The length of proceedings is not governed by any law, as this is left to the discretion of the court and will depend on a case-by-case basis depending on the severity of the case.

In a criminal case the cost will be borne by the state as it will be the state prosecuting against an accused.