



CHECKLIST OF ISSUES ON ENFORCEMENT¹

RESPONSES FROM SAMOA

Introduction

Civil and Administrative Procedures and Remedies

(a) *Civil judicial procedures and remedies*

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

- Supreme Court of Samoa. Refer to section 124, IP Act 2011.

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 proprietor of an IP right - owner (natural/legal persons, individual, joint/collective owners), successor, predecessor - licensee, assignee, agent etc.

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?

- Statutory. Refer to section 53(6), IP Act 2011.

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

- Statutory. Refer to section 125(4), IP Act 2011.

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.**

¹ Document [IP/C/5](#).

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- (a) Injunctions
 - use of misleading GIs, section 88(2), IP Act 2011;
 - prevention of an infringement or an unlawful act, section 125, IP Act 2011;
 - copyright infringements, section 25 of Copyright Act 1998
 - (b) damages, including recovery of profits, and expenses, including attorney's fees
 - use of misleading GIs, section 88, IP Act 2011;
 - prevention of an infringement or an unlawful act, section 125, IP Act 2011;
 - copyright infringements, sections 26 and 28, Copyright Act 1998
 - (c) destruction or other disposal of infringing goods and materials/implements for their production
 - Infringement of Copyright Act 1998 or IP Act 2011, section 314 Customs Act 2014
 - (d) any other remedies
 - Fines, section 135, IP Act 2011;
 - Imprisonment, section 135, IP Act 2011

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?

- Redress obtained through a civil claim.

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?

- Redress obtained through a civil claim.
- Civil Protection for the Registrar or delegate provided under s.127 of IP Act 2011 if he or she acted in good faith or acted under the authority of the Registrar.

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

- There is no specific provision. However from a number of infringement cases that have made it to Court, the average duration of proceedings is 3 days and costs awarded are usually less than 10,000 tala. That is about 4,000USD.

(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.

Length and cost of administrative proceedings:

- The process usually takes about 3 months and costs are minimal;
- The process usually involved the Office of the Registrar receiving a complaint which triggers an investigation and a visit to the location where accused is located upon reception of a warrant. Ministry officers, officers usually conduct investigation which includes the taking of evidence;
- Once confirmed then a letter cautioning the infringer is prepared. (*Most matters are resolved at this level*);
- If warning is not obeyed then the Registrar will proceed to prosecute the infringer through the Attorney General's Office pursuant to Copyright Act 1998 or IP Act 2011;
- At the border, the Registrar's Office works in collaboration with the Ministry for Revenue and Customs, the Attorney General's Office and the Ministry of Police to assess any

infringing goods detained by Customs. Upon confirmation of infringement then forfeited by Comptroller and disposed of pursuant to sections 313 and 314 of the Customs Act 2014;

- Any wrongful detention is compensated. Section 317, Customs Act 2014.

Provisional Measures

(a) Judicial measures

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

- Copyrighted Materials
 - Injunctions; and
 - Other remedies;
 - Impound copies of infringing works;
 - Impound tools used to make infringing works

See section 25 of Copyright Act 1998

- All other categories of IP under IP Act 2011.
 - Injunction;

See section 125 of IP Act 2011

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

- Under section 25(a) of the Copyright Act, it is to prohibit the committing or continuation of committing an infringement;
- Section 25(b) is issued so to impound infringing copies;
- Section 25(c) is issued to impound equipment used to produce infringing copies;
- Under section 125 of IP Act, it is to prevent infringement, imminent infringement or an unlawful act.

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.

- Proceedings for the recovery of IP are by way of action pursuant to Supreme Court Rule 11.
- Injunction may be obtained through an application for Interim Order pursuant to Supreme Court Rule 71 by an order for a writ of injunction through an action pursuant to Supreme Court Rule 196.
- Limitation Act 1975 - after 6 years from date which the cause of action accrued.

13. 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 legislative provisions which govern the length or cost of proceedings. The length of relevant proceedings is usually determined by the Court and costs by each law firm.

*(b) Administrative measures***14. Reply to the above questions in relation to any administrative provisional measures.**

- Copyright Act provides for injunctive relief and any other remedies deemed fit for infringement of folklore and for the enforcement of copyright rights. See sections 25 and 30 of the Copyright Act 1998.
- The Intellectual Property Act 2011, provides for injunction as a remedy and any other remedies the Court deems fit for the use of misleading geographical indication pursuant to section 88; and as a preventative measure against infringement, an imminent infringement or an unlawful act as per Act.

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?

- Materials that infringe copyright, trade marks, registered designs.

See section 308 of Customs Act 2014

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?

- A person who is the owner of an IP right may give notice to the Comptroller stating that he or she is the owner of such IP right and to suspend the customs clearance procedure of any such goods that are suspected to infringe the owner's IP rights. See section 307 of the Customs Act 2014;
- Comptroller may suspend the clearance of certain goods if he or she has reasonable grounds to suspect that such goods infringe the IP rights of the person who gave notice;
- Comptroller may request a security from the person who gave notice, see section 309, Customs Act 2014;
- Comptroller must give notification to claimant and importer of the suspended customs clearance, see section 310 Customs Act 2014;
- Comptroller must allow claimant and importer to inspect and examine detained goods, see section 311, Customs Act 2014;
- Goods detained must be kept in a secure place until Comptroller:
 - Revokes the notice upon review;
 - Receives an order of the Court to release goods;
 - Abandonment of infringement proceedings;
 - 10 days has lapsed since notification given under s. 310 and no notice of infringement proceedings have been served to the Comptroller.
- Where detained goods are forfeited by consent or after proceedings pursuant to sections 314 and 315 of Customs Act 2014, forfeited goods are to be disposed of outside the channels of commerce in a manner to avoid harm to owner of IP right;
- If detention of goods is wrongful then importer is compensated, section 317 of Customs Act 2014.

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?

- See sections 307 to 317 of the Customs Act 2014. These provisions provide for the length of time and process regarding the treatment of suspected goods. That is upon an application by an interested party such goods may be detained for 10 days and a further 10 days upon application and satisfaction of the Comptroller that it is necessary. Goods however may be released to the importer upon the lapse of the first 10 days if claimant fails to serve the Comptroller with a notice of infringement proceedings. This can be extended.

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?

- No. Action of Comptroller triggered by a notification by a claimant. See sections 307 and 308 of Customs Act 2014.

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

- The Comptroller has the power to suspend customs clearance procedure;
- Demand a security from the claimant before suspending customs clearance;
- Release detained good after 10 days if not served with a notice of infringement proceedings.
- Forfeit goods by consent of importer;
- Destroy infringing goods or dispose them through channels outside of the commercial channels harmful to the claimant; and
- Order claimant to compensate an importer for wrongful detention.

See sections 307 to 317 of Customs Act 2014.

Criminal Procedures

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

- Supreme Court of Samoa. See section 2 of the Copyright Act 1998 and Section 2 of the Intellectual Property Act 2011.

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

- All types of infringements - Copyrighted Materials see section 25(2) of Copyright Act 1998;
- Misleading Geographical Indications see section 102(a) of IP Act;
- Violation of rights of Patent owner see section 125(3) of IP Act;
- Violation of right of innovative patent owner see section 125(3) of IP Act;
- Making false statements - All intellectual properties to be registered under IP Act see section 134;

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?

- Attorney General or prosecutor acting under the direction of the Attorney General, a constable or a private person. See section 2 of the Crimes Act 2013.

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

- Yes, see section 2 of the Crimes Act 2013 and section 2 of the Criminal Procedure Act 1972 where the definition of prosecutor includes a private or local body.

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.**

- imprisonment
 - All categories see section 125 IP Act 2011;

- monetary fines
 - All categories see section 125 IP Act 2011;

- seizure, forfeiture and destruction of infringing goods and materials and implements for their production
 - All categories may be seized by the police under sections 30 and 31 of the Police Powers Act 2007 and section 61 of the Police Service Act 2009;

- other.

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

- There are no specific legislative provisions governing the length and cost of proceedings. But from practice it can take about 6 months. Costs are determined independently by law firms. Government prosecutions born by Government budget.
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