

LEGAL FRAMEWORK OF INTELLECTUAL PROPERTY RIGHTS

**A FOCUS ON COPYRIGHTS, TRADEMARKS,
PATENTS**

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SCOPE OF IPRs

- UNIQUE DESIGNS FOR COMMERCIAL USE (INDUSTRIAL DESIGNS)
- SIGNS FOR GOODS WITH CHARACTERISTICS ARISING FROM THEIR GEOGRAPHIC ORIGIN (GEOGRAPHICAL INDICATIONS)
- DESIGNS RELATING TO ELECTRONIC COMPONENTS OF INTEGRATED CIRCUITS (CHIPS) (LAYOUT-DESIGNS (TOPOGRAPHIES) OF INTEGRATED CIRCUITS

INTELLECTUAL PROPERTY

- CREATIONS OF THE MIND
- OWNED AS PROPERTY
- PROVIDING BENEFITS PROTECTED BY LAW
- CARRYING OBLIGATIONS DEMANDED BY LAW
- TRANSFERABLE
- DURATION OF RIGHTS

WHY IPR?

- ARTICLE 27 – UNIVERSAL DECLARATION OF HUMAN RIGHTS
- ARTICLE 15 (c) – INTERNATIONAL COVENANT ON ECONOMIC, SOCIAL AND CULTURAL RIGHTS
- ARTICLE 31 – UN DECLARATION ON THE RIGHTS OF INDIGENOUS PEOPLES

SCOPE OF IPRs

- INVENTIONS (PATENTS)
- LITERARY AND ARTISTIC WORKS (COPYRIGHT)
- SYMBOLS, NAMES & IMAGES USED IN COMMERCE (TRADE MARKS)
- INFORMATION WITH COMMERCIAL VALUE (TRADE SECRETS/CONFIDENTIALITY)

WHY IPR?

- PARIS CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY 1883
- AGREEMENT ON TRADE RELATED ASPECTS OF INTELLECTUAL PROPERTY RIGHTS (TRIPS) 1994

WHY IPR REGIME?

- The innate human creativity and desire to distinguish and be distinguished compels creative resources. Progress of humanity through inventions
- Rules for development of Markets and fair competition within markets
- IP Regimes give rewards and create boundaries within these arena

RIGHTS IN COPYRIGHT

- **COPYRIGHT IS IN EXPRESSION!**
- Not dependent on registration (section 39)
- **ELIGIBLE WORKS - (SECTION 1)**
- Literary, artistic, musical, audio-visual, derivative, choreographic works, sound recordings, computer software or programmes, performer's rights, broadcaster's rights

GHANA LAW

- PATENT ACT 2003, ACT 657
- COPYRIGHT ACT 2005, ACT 690
- TRADE MARKS ACT 2004, ACT 664
- GEOGRAPHICAL INDICATIONS ACT, 2003 ACT 659
- PROTECTION AGAINST UNFAIR COMPETITION ACT 2000, ACT 589
- LAYOUT-DESIGNS (TOPOGRAPHIES) OF INTEGRATED CIRCUITS ACT 2004, ACT 667

• INELIGIBLE WORKS (SECTION 2)

- Ideas
- Concepts
- Procedures
- Methods
- Or things of a similar nature

COPYRIGHT

- COPYRIGHT ACT 2005, ACT 690
- BERNE CONVENTION FOR THE PROTECTION OF LITERARY AND ARTISTIC WORKS (1886)
- ROME CONVENTION FOR THE PROTECTION OF PERFORMERS, PRODUCERS OF PHONOGRAMS AND BROADCASTING ORGANISATIONS 1961
- WIPO COPYRIGHT TREATY 1996
- WIPO PERFORMANCES AND PHONOGRAMS TREATY 1996

COPYRIGHTABILITY

- (Section 1 (2))
- Original in character (product of independent effort of the author)
- fixed in a definite medium of expression
- Created by a citizen or person ordinarily resident in the Republic
- First published in the Republic

COPYRIGHTABILITY

- **Published within 30 days of its publication outside the Republic**
- **Work in respect of which the Republic has an obligation under an international treaty to grant protection**
- **Not affected by artistic quality, purpose of the author in creating it, or by the manner or form of its expression**

TYPES OF RIGHTS

- **Distribution of originals or copies by way of first sales or other first transfer of ownership**
- **Commercial rental to the public of originals or copies of the work**
- **In the absence of any contract to the contrary, economic right vests in employer or commissioner of the works. (section 7)**

TYPES OF RIGHTS

- **ECONOMIC RIGHTS (SECTION 5)**
- **reproduction of the work in any manner or form**
- **Translation, adaptation, arrangement or any other transformation of the work**
- **Public performance, broadcasting and communication of the work**
- **Distribution of originals or copies by way of first sales or other first transfer of ownership**
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MORAL RIGHTS

- **To claim authorship of the work and demand mention whenever used**
- **Object to and seek relief in connection with any distortion, mutilation or other modification prejudicial to the reputation of the author or discrediting of the work**

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RELATED RIGHTS

- **RIGHTS OF PERFORMERS (ACTORS, MUSICIANS) IN THEIR PERFORMANCES**
- **PRODUCERS' RIGHTS (IN THEIR SOUND RECORDINGS)**
- **BROADCASTERS' RIGHTS IN RADIO AND TELEVISION PROGRAMS**

RELATED RIGHTS

- Shall state name of author, and main performers, proper names of choir leaders or members, title of the work, year of first production, name or distinguishing mark of the producer
- Reservation of producers rights

Duration of Rights

- Life plus seventy years after death
- Life plus seventy years after last surviving joint author
- Seventy years from date of creation or publication by corporate bodies
- Seventy years from date of creation or first publication by anonymous author

PUBLIC WORKS (Sec 8)

- Enactments
- judgments of courts.
- Reports of commissions of enquiry
- News by public media

Duration of Rights

- Seventy years after publication of a sound recording or fixation
- Seventy years after end of year of fixation or performance
- Vested in President in perpetuity for folklore
- MORAL RIGHTS EXIST IN PERPETUITY

JOINT AUTHORSHIP

- Joint consent for contracts, assignment etc
- Consent issues to be referred to Copyright Administrators – and high court for review

PERMITTED USES

- Exclusive personal use of an individual
- Quotations with an indication of the source and the name of the author
- Utilisation by way of illustration in publications, broadcasts of sound or visual recordings for teaching (to the extent justified for the purpose)
- Communication for teaching purposes and in educational institutions
- Utilisation for professional training or public education

- **Reproduction to the public with acknowledgment of source unless expressly prohibited**
- **Use of pictures as references during fresh reporting**
- **Use of works of art or architecture in television and cinema or broadcast provided they are permanently located in public place, used only for background or as incidental to essential matters**
- **Political, legal speeches, lecture, address, sermon or work of a similar nature delivered in public exclusively for the purpose of reporting fresh events or new information**

INFRINGEMENT & OFFENCES

- **Any act contrary to rights of authors, performers, broadcasting organisations.**
- **Offences include reproduction, duplication, extracts, imitation, importation (except for private use), distribution, exhibition in public place, removal or altering of electronic rights management information, circumvents technological protection measure, rents or lends to the public – when it infringes copy rights and the person knew**

- **Single copies for libraries**
- **Must be compatible with fair practice, must not exceed what is justified for the purpose of the work in which the quotations are used, moral rights of acknowledgment must always be honoured**
- **19 (6) – temporary reproduction in order to make a digitally stored work perceptible or in the process of a digital transmission**

OFFENCES RELATED TO FOLKLORE

- **Selling or distributing works of folklore made in or outside the republic**
- **Translations, adaptations, arrangements of folklore made outside the republic without the permission in writing of the National Folklore Board**

PUBLIC DOMAIN

- **Works with expired protection**
- **Works of authors who have renounced their rights**
- **Foreign works that do not enjoy protection in the republic**
- **A note on folklore**

REMEDIES

- **For Offences – Compensation, Forfeiture or destruction of offending material**
- **For Infringement – Order 63 of CI 47, Injunction, Order for detention by CEPS, Damages for infringement, Destruction of goods and implements, Anton Pillar Orders, Seizure, Detention**

OTHERS

- Collective Administration societies
- Copyright monitoring team
- Copyright Tribunal
- National Folklore Board
- Copyright Office/Copyright Administrator

- **AUTHORSHIP**
- Creator of copyrightable material
- Archibold v. CFAO 1964 GLR
- The skill, labor and judgment in the copyrightable material must originate from the author
- Paul Oliver v. Boateng & Another (2012)
- **JOINT AUTHORSHIP**
- - There must be significant contribution/significant creative input which is original to the creation of the work
- Joseph Abio Nartey v. Reverend Amankwah Addo (2008)

SOME JUDICIAL CONSIDERATIONS

- No copyright in ideas / Idea – Expression dichotomy- Pearson Education Ltd v. Morgan Adzei 2011 2 SCGLR 864
- Original – Does not mean 'original in thought' but 'independent effort to express an idea, through skill, judgment, labour, selection and experience in the creation of the work'. Joseph Abio Nartey v. Reverend Amankwah Addo (2008)

TRADEMARKS

- 'Any sign, or combination of signs capable of distinguishing the goods or services of one undertaking from the goods or services of other undertakings including personal names, letters, numerals and figurative elements
- (Audible sounds – Nokia, Skype? Fragrances - Perfumes? Colors - UPS?)
- PROTECTION IS FOR 10 years and renewable for ten year periods

- Feist Publications Inc. Rural Telephone Service Co, 499 US 340 (1991) '...independently created by the author and it possesses at least some minimal degree of creativity' Sweat of the brow/skill, labour, judgment/ originates from author
- Ellis v. Donkor 1993-94 2 GLR 17 ' original means....conspicuously different from the original work and should reveal originality or innovation by the musician in adapting the original work'

REGISTRABILITY

- Distinguish source of products
- Must be capable of distinguishing source of goods. Cannot be generic, descriptive. But must be suggestive, arbitrary, fanciful.
- Descriptive/generic is registrable only if it has achieved secondary meaning for the source of the goods (UPS)
- Cannot be similar to an existing mark for the same or similar goods
- Not deceptive, or contrary to law or morality or public order
- Registration is prima facie evidence of validity

INELIGIBILITY

- Trade Names (of an enterprise)
- Contrary to public order or morality
- Likely to mislead as regards the geographical origin or characteristics of the goods or services
- Identical to national emblem, flag, official sign, IGO
- Marks identical or confusingly similar to a well-known trademark

INVALIDATION OF A TRADE MARK

- If it can be proved that it is not capable of distinguishing source of products
- Genericide (where through acts or inactivity, it becomes the common name in the trade for goods or services)
- May be removed for non use for a period of five years or more (subject to proof of special circumstances or non-abandonment)

INELIGIBILITY

- Not identical to a well-known trademark, but the use of which will indicate a connection with the goods and services of a well-known trademark
- Marks so closely identical to a registered trademark that it is likely to deceive or cause confusion
- Trade Mark may be invalidated if it is incapable of distinguishing the source of the product

COLLECTIVE MARKS

- 'A visible sign capable of distinguishing the origin or any other common characteristic including the quality of goods or services of different enterprises which use the sign under the control of a registered owner from the goods or services of other enterprises.

(ACCA, ICOSA etc)

RIGHTS

- Exclusive use of the trademark
- To object to use of similar marks in relation to goods or services similar to the registered mark where confusion may arise in the public
- Same right for applicant when the application is published as would have from time of registration (6:7)
- License agreements valid against third parties only from date of registration

JUDICIAL CONSIDERATIONS

- SIMILARITY – Appenteng & Co Ltd v. Alpro Industries Ltd 1971 2 GLR – determining similarity which may lead to likelihood of confusion is a matter of fact with multiple considerations – sight, sound, meaning, type of goods, type of customers.
- See also Socomex Ghana v. Geo Medico (Consolidated suits) (2014) Consideration is not when put side by side, but impression left with consumer when considering the two at any time

- **Ameen Sangari Industries Ltd v. P. Z. Cussans Industries (GH) Ltd** 2003-2005 2 GLR 625
- **Proof of registration of trademark raises presumption of infringement in favor of registered owner**
- **Robert Ashie Katei Ventures v. Sadat Car Accessories ent & Another** [2009] – **Infringement**
- **Determining descriptiveness, suggestiveness etc Socomex Ghana v. Geo Medicores** (Consolidated suits) [2014]

- **3. Act that misleads or is likely to mislead the public, with respect to an enterprise or its activities, goods or services** eg. The manufacturing process, suitability of a product or service for a particular purpose, quality or quantity or other characteristic of the product, geographical origin of the product, conditions on which it is offered, the price or the manner in which the price is calculated

- **DOCTRINE OF EXHAUSTION – Implex Projects Ltd v. Oware Wiafe & Another** (Suit No OCC/31/08 – Exhaustion of rights after first sale is inapplicable where there is infringement of trademark
- **Invalidation of Registered Trade Mark on account of priority of dealing in the brand in the territory by the defendant/ Failure of distinctive test– Pulsart Impex v. Dart Hills Limited** [2008]

- **4. false or unjustifiable allegation in the course of industrial or commercial activities that discredit or likely to discredit another person's enterprise, products or services**

- UNFAIR COMPETITION**
- **PROTECTION Against Unfair Competition Act** 2000 ACT 589 –Six Arenas
 - 1) **Acts likely to cause confusion with respect to a trade mark, (registered or not), trade name, business identifier, presentation of a product or service, celebrity or well-known fictional character**
 - 2) **Act that damages or likely to damage the goodwill or reputation, whether or not it causes confusion**

- **5. disclosure, acquisition or use of secret information without the consent of the rightful owner of that information and in a manner contrary to honest commercial practice – must have commercial value, not generally known in the relevant circles, has been subject to reasonable steps by the rightful owner to keep it secret**

- **Breach of Ghanaian law or international obligation to which a person engaged in business or commercial activity in Ghana is subject and in a manner contrary to honest business practices**

PATENTS

- Title granted to protect an invention – an idea which permits in practice the solution to a specific problem in the field of technology
- May be a product or process

SOME CASES

- **PASSING Off** – *Western House Electric Corporation v. Gibrin Ibrahim Adam* (2006) **AGAINST** the property protected in an action of passing off is goodwill and reputation between the trader and its customer which the mark, get up etc help to sustain
- *Societe Industrial de Parfumerie v C. A. Asmah Enterprise and Another* 2003 – 2005 GLR 202
- *Baaba Maison v Basaran Makina* (2010)
- For confusion to be likely, there must be association of the mark, get up with its reputation; similarity between opposing products in the get up, name etc, it should lead to reduction in distinctiveness because of association with the defendant's mark, get up etc.

INELIGIBILITY

**DISCOVERIES, SCIENTIFIC THEORIES AND MATHEMATICAL METHODS
SCHEMES, RULES OR METHODS FOR DOING BUSINESS, PERFORMING PURELY MENTAL ACTS OR PLAYING GAMES
METHODS FOR TREATMENT BY SURGERY OR THERAPY AS WELL AS DIAGNOSTIC METHODS**

- **When there is similarity between get-up but not trade mark**
- *Menkish Impex Limited v. White Unicorn* (2010)
- - Proof of deception or the likelihood of deception is essential in a passing off action
- *Socomex v. Geo Pharmacy* (2014) – Action for trade mark infringement unsustainable where get up was similar but trade marks dissimilar but defendant was the originator of the get up and the get up did not form part of the trade mark

INELIGIBILITY

**INVENTIONS NECESSARY TO PROTECT PUBLIC ORDER, MORALITY, HUMAN, ANIMAL OR PLANT LIFE
PLANTS OR ANIMALS OTHER THAN MICRO-ORGANISMS
BIOLOGICAL PROCESSES AND PLANT VARIETIES**

PATENTABILITY

**INVENTIVE STEP, NEW, INDUSTRIALLY
APPLICABLE**

NOT ANTICIPATED BY A PRIOR ART