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COPYRIGHT LAW: IMPLICATIONS OF NATIONAL AND INTERNATIONAL LEGISLATION FOR THE PUBLISHING INDUSTRY IN GHANA

*Anatu Mahama**

Abstract

This article presents an analysis of the impact of copyright law on the development of the Ghanaian publishing industry. It also explores the extent to which both Ghana's copyright law and international legislation have supported publishing development in the country. The article discusses the background to international copyright, the context for the variations in national copyright laws and the efforts by the World Intellectual Property Organization (WIPO) in harmonising the laws in different jurisdictions. It further presents an overview and analysis of Ghana's copyright law and explores its impact on the publishing industry in Ghana. The data for this research comprise legislation and recorded interviews, which were analysed through qualitative content analysis. Drawing on the interview data and content analysis of legislation, the article concludes that both national and international legislation have not sufficiently supported the development of the publishing industry as a result of the prevalence of copyright infingement, which has been attributed to ignorance of the law and a lack of resources to enforce copyright law. To address these conclusions requires copyright education for stakeholders in publishing including publishers, authors, printers, booksellers and the judiciary as well as the general public. Also, there is need to provide resources to the Copyright Office to execute its mandate.

Keywords

publishing, copyright law, copyright infringement, enforcement, Ghana

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Introduction

Copyright law is of interest to stakeholders in publishing for a number of reasons. Firstly, the business of publishing is a chain, which involves many stakeholders. At the heart of the book publishing chain is the author whose intellectual property is exploited. There is also the publisher who invests resources including financial, time and technical know-how to turn the author's intellectual property into a product, which can easily be copied (Jones and Benson, 2016), making a case for copyright law to protect authors' works as well as the publisher's investment.

Reflecting on the historical developments of copyright, it must not be forgotten that it developed in the middle of the 18th century in Europe, specifically Britain (1710), France and later across the Atlantic, in the USA (1790). International copyright law subsequently developed through bilateral agreements between individual countries and finally through a group of countries in 1886, which came together to sign a multilateral agreement that would 'establish minimum standards of copyright protection' (Owen, 2010, p. 5). However, not all countries, in particular the USA and the then Soviet Union (USSR), were able to sign the Berne Convention due to their domestic laws. For example, the USA, the USSR and developing countries considered the copyright term of life of author + 50 years an advantage to the economically strong and developed countries of the west (Joyce et al, 2016). The Universal Copyright Convention of 1952 was therefore formulated to offer international protection to authors in countries that would not become parties to the Berne Convention (UCC, 1952). It permitted the use of a prescribed notice to accommodate the USA(Joyce et al, 2016). The main difference between the Berne Convention and the UCC is the duration of copyright protection on works – whilst the Berne Convention provides life of author + 50 years, the UCC provides life of author + 25 years. To accommodate the USA, However, the principle of both treaties is based on national treatment, with contracting states required to protect works subject to copyright laws of signatory states within their own jurisdictions (Berne Convention, 1886; Universal Copyright Convention, 1952). Whilst the principle of reciprocal treatment sounds simple, it comes with challenges in practice.

The main problem lies in the enforcement of the law which has always been difficult. Authors sign agreements with publishers to have their works published. The agreement specifies the extent to which the author's work could be exploited. This means that a work may be reproduced in several other forms as specified in the agreement. Therefore the commercial exploitation of copyright works without permission from the copyright right owner is breaking the law and this act of exploitation is popularly known as piracy. Undoubtedly, piracy is common in many parts of the world, and even so with technological advancements, with so much

justification giving to the illegal reprinting of books, particularly in the third world countries (Mahama, 2012). The justification stems from a lack of access to academic materials. Hitherto, third world countries justify unauthorised copying and piracy of academic materials because of the two reasons of their adoption and dependence of the western form of education, and the lack of scientific and industrial ability to produce academic and scientific materials then. However, there is no longer need for this justification due to amendments to the Berne Convention in 1971 and the open-access Movement. Arguably, the open-access movement, which aims at making scholarly research literature freely available online without restrictions (Willinsky, 2005), would have improve access to scholarly research materials.

Furthermore, it would appear that the concerns and arguments made by third world countries were taken into consideration by first world countries, because a further significant development of relevance to copyright law for developing countries was introduced through the 1971 Paris Amendments to both the Berne Convention and the UCC (Berne Convention, 1971). The basic principle of the Paris Amendment is that a publisher in a developing country has the right to translate, broadcast or reproduce any work which is needed for educational purposes in that country (Berne Convention, 1971). Article IV of the appendix of the Berne Convention (Paris Amendments), sets out the procedure for publishers in developing countries to follow in order to obtain rights from copyright owners (Berne Convention, 1971). Firstly, member states of the Berne Convention were obliged to ratify their national laws in compliance with the Paris Amendments. The purpose of this is to enable them apply for compulsory or reprint licences in educational or academic works published by publishers from First World countries, thereby making educational materials accessible (Article 21 Berne Convention 1971). To acquire a compulsory licence, applicants must provide evidence of their inability to contact the copyright owner for an ordinary reprint licence or they have been refused a licence without adequate reason or even granted one on unfavourable terms (Berne Convention, 1971). There is indication that copyright owners of works of educational and academic materials in the more affluent countries are complying with the Paris Amendment. According to Owen (2010, p. 6), 'it is an undoubted fact that more voluntary licences have been granted to publishers in the developing countries since the introduction of these provisions', an indication of compliance to the Berne Convention by copyright owners.

In addition, technological advancements have led to new copyright treaties that would help to surmount the challenges that arise with these developments, and could also be interpreted as giving copyright owners more control. Although the Berne Convention has been revised

periodically over the years, it has become increasingly necessary for legislation to tackle the challenges of the digital environment. In 1996, the WIPO Copyright Treaty and the WIPO Performance and Phonograms Treaty were produced. The WIPO copyright treaty gives flexibility in terms of rights relating to reproduction, a workable right of communication to the public, including making available via digital networks as well as modern provisions on fair dealing exceptions and provision for liability of intermediaries such as communication companies and service providers. It further provides some agreement on anti-circumvention measures and remedies generally. Following on from the discussion of the development of international copyright law, this article analysis Ghana's copyright law and explores its impact on the publishing industry.

Methodology

The data for this research was mainly through interviews and documentary analysis. Thirteen partcipants across eighteen institutions were purposely selected for interviews. The institutions are the Copyright Office, Copy Ghana, Ghana Book Development Council, Ministry of Education, Ghana Universities Press, Department of Publishing Studies KNUST, Ghana Publishing Corporation, Ghana Book Publishers Association, Ghana Printers and Paper Convertors Association, Ghana Library Authority, Ghana Booksellers Association, National Union of Ghana Students and Ghana Association of writers. In line with the research aim, these stakeholders were selected because they were considered as 'well-placed articulate informats' who will advance the research better than a randomly chosen sample (Given, 2008, p. 1). Similarly, access to documents and legislation for analysis was sought through relevant institutions such as the Ghana Book Development Council and the Copyright Office as well as libraries, Lexis Nexis and the Internet for publicly available documents and legislation.

The Legislation, together with the interview transcripts was analysed through qualitative content analysis. The use of qualitative content analysis in this research has been appropriate as it allowed the examination of legislation and other supplementary documents that were found in relation to the research objectives. Interview data was used to corroborate annd augment evidence from the analysis of legislation.

Copyright Law in Ghana

Before the new Copyright Act 2005 was passed, two copyright laws were repealed. The Copyright Act 85 of 1961 was repealed and replaced by PNDC Law 110 in 1985. The enforcement of Act 85 of 1961 was beset with difficulties, including 'manipulation, abuse and misunderstanding of what it was all about' (Asamoah-Hassan and Bannerman, 2011), leading to its replacement with PNDC Law 110. Despite PNDC Law 110 making provisions for literary, artistic, musical works and other copyrighted works, rather interestingly, there was the contentious issue between the Musicians Union of Ghana (MUSIGA) and authors on the ownership of the Copyright Office. The Copyright Office of Ghana oversees the administration and compliance of copyright law. However, Asamoah-Hassan and Bannerman (2011) report that MUSIGA consequently took over the office, leaving out other copyright owners; the concept of copyright in the country became associated with musicians, portraying a lack of understanding of the law at that time. Consequently, PNDC Law 110 made no any positive impact on authors and publishers and books were pirated and openly sold on the streets (Adusei, Anyimadu-Antwi and Halm, 2009).

On the other hand, the passing of the Copyright Act 2005 (Act 690) might be considered timely. The indigenous publishing industry has seen considerable growth from the start of the 21st century. According to the Directory of the GBPA, there are 115 registered publishers in the country. This considerable growth of publishers could also be interpreted as growth in authorship for which the argument made by Samuelson (2010, p. 1176) below might benefit the book publishing industry in Ghana.

> A well-functioning copyright law carefully balances the interests of the public in access to expressive works and the sound advancement of knowledge and technology, with the interests of copyright owners being compensated for uses of their works and deterring infringers from making market-harmful appropriations of their work.

Copyright Act 2005 takes cognisance of the benefits of a well-balanced copyright system. It sought to provide sufficient protection of copyright works as well as being compliant with all international treaties the country has acceded to, including the 1886 Berne Convention, the 1996 WIPO Copyright Treaty and the WTO TRIPS Agreement. This has been achieved as result of consultations with stakeholders including the Attorney General's office, publishers, authors, WIPO and International Publishers Association (IPA). According to Asamoah-Hassan and Bannerman (2011, p. 2), Librarians were left out at initial consultation and were only invited

in to seek assistance 'in getting users to pay fees for making photocopies' of copyright works.

The focus of the law aligns with those of the common law traditions – the focus is on protecting the right owners of literary, artistic and musical works and the general provisions of the Act are consistent with all international treaties (Berne Convention, UCC, TRIPS and WCT). For the first time, Article 4 of Ghana's copyright law provides protection for expressions of folklore, which are also particular areas of knowledge in the country. Expressions of folkore are literary, artistic and scientific works such as the Kente cloth, Adinkra symbols, folksongs and folktales that form part of the cultural heritage of Ghana (National Commission of Culture). Further, Article 63 of the copyright act provides for the establishment of the national folklore board to document, preserve and monitor the use of expressions of folkore and to 'promote activities for the dissemination of expressions of folkore within the Republic and abroad (p. 27). Since the enactment of this law, there is no evidence so far to the effectiveness of protecting national folklore. Collaboration with publishers in terms of documentation and preservation of expressions of folkore could foster their dissemination as well as yield economic dividends for both publishers and Ghana.

One crucial provision for developing countries, which the Act did not consider is the provision for compulsory licence in the appendix of the Berne Convention (Berne Convention, 1971). The provision allows publishers in developing countries to acquire licences from publishers in the developed world to publish books that are required for educational purposes, which otherwise are not available on the market of that country. This is important as it might open up more publishing opportunities for Ghanaian publishers, either through collaboration or by acquiring licences.

Infringement and Enforcement Issues

Although Copyright law 2005, Act 690 provides stiffer penalties for copyright infringements than those that were provided in the previous laws including the provision for civil remedies such as damages, injunction, seizure and the destruction of infringing materials (Sections 25-27), Ghanaian publishers and the copyright office continue to battle with the problem of piracy and other copyright infringements such as photocopying. Although the Copyright Office, Copy Ghana and GBPA could not provide statistics to illustrate the volume of piracy and photocopying, educational materials such as books for higher education, Science, Maths, English, technical and vocational books for senior high

schools were cited by stakeholders as the most pirated. Although piracy is a global phenomenon, the situation is even more problematic for publishers in Ghana. While international publishers have other markets to supply their works to rather than just the home market, publishers in Ghana have only the home market because of the concentration of publishing for pre-tertiary education. In terms of general book publishing, it is worth mentioning that the situation is changing. Through the African Books Collective (ABC), which was established to strengthen publishing activities in Africa and to increase the visibility and accessibility of works of scholarship, works of Ghanaian and other African publishers have been marketed and distributed internationally (Bgoya and Jay, 2013). Bgoya and Jay (2013) add that ABC markets and distributes 2500 print titles from Africa; 800 of these are also ebooks, scholarly, literature and children's books. Its membership comprises 149 African publishers from 24 countries.

Aside from piracy, Copy Ghana bemoans the high level of unauthorised photocopying taking place on university campuses. According to Copy Ghana, the amount of photocopying taking place on university campuses is far in excess of permitted use under Article 19(1)(a) of Act 690. This was deemed by authors, publishers, the Copyright Office and Copy Ghana to undermine publishing activities for higher education. From the comments made by Publishers and Copy Ghana, their efforts to reduce mass photocopying and to collect fees that would be distributed to copyright owners have proved futile. Copy Ghana adds that it has been difficult encouraging university authorities in the country to accept blanket licences due to student agitations. The National Union of Ghana Students (NUGS) responded to the request of Copy Ghana to pay fees on photocopying in the Accra Daily Mail on 12th October 2005 "Yentuah, NUGS is in no mood to pay fees." Yentuah literally means "we won't pay." The arguments made by students for the refusal to pay fees was that the books they photocopy are not written by Ghanaian authors. This submission portrays a lack of, or little understanding of copyright law as works do not need to be written by Ghanaian authors to entitle them to copyright protection.

During the interview for this research with Copy Ghana, there was indication the situation has not change. According to Copy Ghana, they have had discussions with University authorities to consider other funding mechanisms such as incorporating fees in the fee structure of universities but have received no co-operation from authorities of higher education. Copy Ghana adds that the lack of co-operation with university authorities has made it difficult for them to collect and distribute royalties to authors. Authors and publishers interviewed for this research stated that "they are making losses due to piracy and mass photocopying on

university campuses." Another issue of concern of copyright infringment mentioned by both the Copyright Office and GBPA is the assumption that publishers in Ghana do not acquire licences to publish works of foreign publishers. According to both the Copyright Office and GBPA, some publishers rightfully acquire territorial rights to publish works of foreign authors in Ghana. When the Licencee starts reproducing the book, other publishers or printing houses that have no right to publish the books also start to do so with the assumption that the first publisher is reproducing a foreign work to make extra money (Copyright Office, GBPA). According to the Copyright Office, the infringers often use ignorance to justify their wrongdoing. That is, they expressed lack of knowledge that publisher X has acquired the rights from the publishers in the UK or US to publish the books in Ghana. Coordination among stakeholders - Copyright Office, Copy Ghana, GBPA, Ghana Printers and Paper Convertors Association (GPPCA), Booksellers Association and law enforcement agencies – therefore is required to ensure compliance with the law. Until then, it seems book publishing in Ghana will continue to suffer from copyright infringement.

Challenges of the Copyright Office and Related Issues

The Copyright Office recognises that it is responsible for the administration of copyright law in Ghana. According to the Copyright Administrator, who is the head of the Copyright Office, the office represents the country in international relations matters – deliberations on international treaties and developments in copyright, the results of which are used to update the national law and to ensure it conforms to relevant international treaties. The Copyright Administrator adds that the office also recognises that the public is ignorant of copyright law and that as part of its obligation, deemed it fit to embark on programmes that will build respect for copyright. The copyright administrator comments that, '… in order to achieve our objectives, we undertake several programmes, key among them is public education.'

The purpose of the education is to enlighten the public on copyright as an intellectual property right, which benefits society. Other programmes the office embarks on are, firstly, the mediation of copyright disputes. There was indication of the heavy use of mediation due to the cumbersome nature of the court system. The copyright office indicates that victims of copyright infringement find it difficult to go court due to the lengthy process of the system. The copyright office explained that, in most cases, victims could not afford to hire lawyers to represent them, which makes mediation the only option available to them. The GBPA in particular

expressed that the courts and the police are not well knowledgeable in copyright issues, making such cases to drag on for even longer periods of time. The general perception was that copyright offences are regarded as insignificant. The GBPA mentioned an instance where people pirated books and when they were reported, they were 'let off the hook' by the police. The secretary of the GBPA narrated an example of when a piracy incident was reported to the police and when the police arrested the pirate and had taken statements, the police officer was quoted to have said, 'wei de3 enye hwee, fa kye no, nny3 saa bio' meaning 'this is no problem, you just forgive him, he will not do that again.' These opinions expressed by the GBPA were not substantiated with the police or the courts but seem to suggest the need for copyright education for all stakeholders.

Another core activity the copyright office mentioned is that it embarks on enforcement activities such as anti-piracy raid exercises. This is done through the help of a police officer specifically positioned at the office. The office expressed that they are confronted with some challenges in executing their mandate. In line with the literature reviewed, the Copyright Office indicated that enforcement is expensive and involves liaising with police to embark on enforcement activities. The second point that was raised was difficulty in tracing infringers due to inadequate or scanty information. 'It is not just about the vendors who sell few copies; it is about picking intelligence to go to the source where the books are being made' (Copyright office).

Conclusion

In conclusion, it has long become evident that copyright law is necessary to create a conducive legal environment for the publishing industry to operate effectively. It is universal and the harmonisation and periodic revision of the law at the international level affords creators of the reward of their creativity and investment. However, it is concluded that the law, particularly Act 85 of 1961 and PNDC law 110 of 1985, has not been adequately beneficial to the publishing industry in ghana. Stakeholders in publishing are generally content with the current copyright law, Act 690, more clarity and compliance with the law will immensely benefit the publishing industry in Ghana.

It is also concluded that the practice of the law is beset with two main challenges: piracy and illegal photococpying, and the difficulty in the enforcement of the law. The use of the excuses of lack of access to educational materials and ignorance must not be accepted as justification for copyright infringement. As the saying goes, ignorance is not an excuse

to breaking the law. There is need for both intensive public education and coordination among stakeholders to build respect for copyright law in the country. Arguably, piracy is difficult to defeat, however, dialogue and cooperation in enforcing the law and prosecuting perpetrators could minimise the problem, consequently leading to better developed publishing industry.

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THE PROTECTION OF TRADE SECRETS IN ZIMBABWE

*Christopher Munguma**

Abstract

Trade secrets are an important source of business information in many sectors of the economy. Trade secrets are recognised as intellectual property (IP) rights by international conventions such as the Paris Convention and the World Trade Organisation Agreement on Trade Related Rights of Intellectual Property. The protection of trade secrets around the world has recently seen an upsurge of statutory recognition of the right as an IP right. Unfortunately and despite its key role in industry and business, trade secrets protection in Zimbabwe is disjointed and fragmented since it is protected by the common law through various legal disciplines ranging from contract, delict and IP. It is argued in this article that this state of affairs in unsatisfactory for Zimbabwe. A more robust approach is called for in Zimbabwe.

Keywords

trade secrets, intellectual property, misappropriation, industrial property, law

Introduction

Intellectual property (IP), as creations of the mind, is protected through various methods. Depending on the nature of the creation it may be protected by patents, trademarks, industrial designs and copyright. The major form of protection afforded to IP is through registration in the case of industrial property and fixation in the case of copyright. Trade secrets are also a recognised form of IP but its manner of protection varies from jurisdiction to jurisdiction. Cornish and Llewelyn (2007, p.10) call trade secrets one of the late aspirants to the claim of IP. They state that:

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> Over much the same period, there have been claims to rights over secret business information – technological know-how (whether inventive or not) ideas for new products and markets, commercial information about customers, finance, employment and many other things. To this end, countries have responded in various ways some confining protection to general civil remedies affecting contract, tort, property and perhaps unjust enrichment… some (notably common law jurisdictions) generating a form of sui generis protection that is akin to but not quite a form of property right.

Ncube (2018) adds and agrees that trade secrets are generally less well known than other IP rights. He agrees that trade secrets have for years been in the shadows of other IP rights. He correctly observes that of late the subject is gaining traction as an effective way to protect IP rights. This observation is apposite and to the point. Indeed, there is a debate as to whether trade secrets are a form of property deserving of protection as IP. Gomulkiewicz, Nguyen and Conway (2011) assert that trade secrets are not property per se; rather they are rights in holder controlled information aimed at encouraging wealth creation through efficient management and use. Lemly (2008) sees trade secret law as a puzzle since courts and scholars disagree on why trade secrets are protected. The coverage of trade secret law is well known but where trade secret law comes from or how to fit it into the broader framework of legal doctrine is the major enigma.

The debates aside, there is no denying that trade secrets are a recognised form of IP and are protected variously in many jurisdictions of the world. In Zimbabwe trade secrets are protected by the law through various branches of law notably IP, contract, delict and unfair competition laws, among others. Trade secrets protect trade information, manufacturing information, know how, technical scientific information (such as designs and drawings), commercial information and financial information. See for example, *Townsend Production (Pty) Ltd v. Leech* 2001 (4) SA 33 (C), *Greendale Hardware & Electrical (Pvt) Ltd v Goodfellow Bangaba* SC 16/07 and *Waste Products Utilization (Pty) Ltd v Wilkes & Anor* 2003(2) SA515 (W). In essence contract and delict are used to protect trade secrets as a property right.

The Challenges and Benefits of Protecting Trade Secrets in Zimbabwe

Trade secrets are important to right holders, individuals and other stakeholders such as the State, business and the public. The government derives taxes from the exploitation of successful trade secrets such as the formula for Coca Cola beverage owned by the Coca Cola Company while the public obtains quality products and employment from companies with

products protected by IP systems such as trade secrets and other forms of IP. An analysis of this subject area is therefore necessary and imperative in an environment where some developed nations have recently enacted laws to promote the protection of trade secrets by corporates. This is pertinent in the field of law generally and IP in particular because of its fast changing nature. Laws have to continuously change in order to deal with society's challenges, needs, aspirations and new developments. If the law does not take into account new needs and new challenges, it will fail in its primary function of governing human conduct.

The challenge facing the law of trade secrets in Zimbabwe is not the lack of recognition of the concept, rather it is that Zimbabwe does not have a uniform or coherent trade secret regime. According to Lemly (2008) courts, lawyers, scholars, and treatise writers argue over whether trade secrets are a creature of contract, of tort, of property, or even of criminal law. After a thorough analysis of the position in the United States of America, Lemly proposes that trade secrets should be regarded not as ordinary property but as an IP right. The same challenge raised by Lemly in the United States of America faces the law of trade secrets in Zimbabwe. As a result of the multi-pronged protection, the development of the discipline has not been uniform in the various common law branches where it is protected. In this work a comparison between the treatment of the subject under the law of

International Framework for the Protection of Trade Secrets

Debates and disagreements among scholars delayed the world in coming up with the first comprehensive multilateral document dealing with trade secrets (Gomulkiewicz, Nguyen and Conway, 2011). Most international IP instruments with the exception of TRIPS touch the subject indirectly. While a good argument can be made that the Paris Convention for the Protection of Industrial Property alludes to trade secrets in article 10bis where it deals with unfair competition, the Convention does not address the subject in a holistic manner. Article 10bis (2) provides that, "any act of competition contrary to honest practices in industrial or commercial matters constitutes an act of unfair competition". An argument can be made that misappropriation of trade secrets amounts to an act contrary to honest practices in business. However, it is apparent that the subject is not directly tackled by the Convention. Dishonest business practices are too many to be equated to trade secrets misappropriation alone. What cannot be denied is that trade secret misappropriation is a form of unfair business practice.

By contrast, trade secrets are directly and unambiguously dealt with in the Agreement of Trade Related Aspects of Intellectual Property (TRIPS) of the World Trade Organisation. Article 39(1) of the agreement states, "In the course of ensuring effective protection against unfair competition as provided in Article 10*bis* of the Paris Convention (1967), Members shall protect undisclosed information in accordance with paragraph 2". The article proceeds to lay out a number of protections that should be afforded to trade secrets. Abbot, Cottier and Gurry (1999) note that the term undisclosed information is used in the TRIPS agreement to refer to the same kind of information that is embodied in the common law concept of trade secret. The term secret information is defined as information which "is not as body or in the precise configuration and assembly of its components, generally known or readily accessible to persons within the circles that normally deal with the kind of information in question". Paragraph 2 of article 39 then proceeds to set the conditions of protection for such information. These are that the information must have a confidential character, must have a commercial value because of its secrecy and the owner of the information must take reasonable steps to keep it secret.

It follows that the IP international framework recognises a trade secret as a distinct IP right. This framework compels member states to TRIPS, for example, to domesticate within their national systems appropriate laws for the protection of trade secrets as an IP right. TRIPS is however not prescriptive on the model that nations can use for protection of trade secrets. This can be by way of statutes, the common law or any other legal instruments.

Some Case Studies

Before analysing the Zimbabwean position, a brief analysis of two jurisdictions that have protected trade secrets through a statutory regime will be considered. These jurisdictions are the United States of America and the European Union as a bloc.

Protection of Trade Secrets in the United States of America

In May 2016 the United States of America adopted the Defend Trade Secrets Act (DTSA) as law. The Act provides a federal private right of action for trade secret protection. President Obama signed the DTSA on May 11, 2016 and the law took effect immediately. The DTSA arose from a desire to federalize trade secret protection, which had thus far been dominated by state law (Ridgway and Dvorkis, 2016). While certain federal protection previously existed in the form of the Economic

Espionage Act of 1996, the DTSA provides an individual the right to sue in the Federal Court, thus obviating the need to bring private actions in various state courts where procedures differ greatly.

The DTSA allows a trade secret owner to bring an action "if the trade secret is related to a product or service used in, or intended for use in, interstate or foreign commerce. (18 U.SC§1836 (b) (1). The DTSA in 18 U.S.C. §1839(3) contains a broad definition of "trade secret":

> means all forms and types of financial, business, scientific, technical, economic, or engineering information, including patterns, plans, compilations, program devices, formulas, designs, prototypes, processes, procedures, programs, or codes, whether intangible, and whether or how stored, compiled, or memorized physically, electronically, graphically, photographically, or in writing…..

The value of a trade secret consists of it not being known to others. Thus, "the right to exclude others is central to the very definition of the property interest. For "information" to qualify as a trade secret, the owner must have "taken reasonable measures to keep [the] information secret" and the information must have "independent economic value, actual or potential, from not being generally known to, and not being readily ascertainable through proper means by, another person who can obtain economic value from the disclosure or use of the information."(18 U.S.C. §1839(3)). Taking "reasonable measures" to maintain secrecy is the responsibility of the trade secret owner. However, the degree of measures taken does not necessarily have to be out of the world. In *Boston Scientific Corp. v. Dongchul Lee*, No. 1:13-cv-13156-DJC (D. Mass.) it was noted that, "It is not necessary that an 'impenetrable fortress' be erected to retain legal protection for a trade secret". Ultimately what is reasonable in a given case is a question of fact which depends on the circumstances of the case. Toren (2016) has correctly observed that what constitutes reasonable measures in one particular field of knowledge or industry may vary significantly from what is reasonable in another field or industry" and the owner of the information "must assess the value of the material it seeks to protect, the extent of theft, and the ease of theft in determining how extensive their protective measures should be."

Misappropriation under the DTSA requires that the trade secret be acquired by "improper means," which can include "theft, bribery, misrepresentation, breach or inducement of a breach of a duty to maintain secrecy, or espionage through electronic or other means". (18 U.S.C. §1839(6)). The DTSA allows a Court to issue an interdict "to prevent any actual or threatened misappropriation," but a Court may not "prevent a person from entering into an employment relationship" and any

"conditions placed on such employment shall be based on evidence of threatened misappropriation and not merely on the information the person knows." (18 U.S.C. §1836(b) (3) (A)(i)(I). In other words, the DTSA cannot be used to prevent an employee from joining a competitor unless there is evidence of threatened improper disclosure. Courts are also empowered to grant an order for payment of damages.

Trade Secrets Protection in the European Union

The European Parliament in April 2016 approved the Trade Secrets Directive which provides new rules for giving companies redress for theft or misuse of trade secrets. The Trade Secrets Directive requires all Member States to provide certain minimum standards for trade secret protection. Member States had two years to implement the provisions of the Directive into their own national laws. The EU Directive sought to harmonize the laws of the various member states by providing a consistent definition of what qualifies as a "trade secret." Additionally, the Directive addresses the remedies available to trade secret holders and the measures courts can use to prevent the disclosure of trade secrets in legal proceedings. The measure requires member states to ensure that companies whose trade secrets are misused can defend their rights in court and seek compensation.

The directive creates an EU-wide definition of "trade secret." A trade secrets is defined as information which is secret, has commercial value because it is secret, and has been subject to reasonable steps to keep it secret. Article 2 (1) of the directive provides that a trade secret is trade information which meets all of the following requirements:

a) it is secret in the sense that it is not, as a body or in the precise configuration and assembly of its components, generally known among or readily accessible to persons within the circles that normally deal with the kind of information in question;
b) it has commercial value because it is secret;
c) it has been subject to reasonable steps under the circumstances, by the person lawfully in control of the information, to keep it secret; One interesting point about this definition is that it is in line with paragraph 2 of article 39 of the TRIPS Agreement. This harmonisation of at the regional level of the TRIPS definition is a good development.

Article 3 of the Directive clarifies that reverse engineering, independent or parallel innovations are not illegal activities in relation to trade secrets. This arise from the fact that trade secrets are not a form of exclusive IP right. In terms of article 4 (2) the acquisition of a trade secret without the consent of the trade secret holder shall be considered unlawful, whenever carried

out by:a)unauthorised access to, appropriation of, or copying of any documents, objects, materials, substances or electronic files, lawfully under the control of the trade secret holder, containing the trade secret or from which the trade secret can be deduced;b)any other conduct which, under the circumstances, is considered contrary to honest commercial practices.Any acquisition of confidential information through unauthorised means or by conduct which is contrary to honest business practices shall be regarded as unlawful. This requirement is wide in its application and is meant to cover as many situations as possible. Without establishing criminal sanctions, the proposal harmonises the civil means through which victims of trade secret misappropriation can seek protection from the courts, such as:

- stopping the unlawful use and further disclosure of misappropriated trade secrets
- the removal from the market of goods that have been manufactured on the basis of a trade secret that has been illegally acquired
- the right to compensation for the damages caused by the unlawful use or disclosure of the misappropriated trade secret. (see Chapter iii section 2).

In line with the TRIPS requirement fairness to all parties in litigation is emphasised in the Directive. This is another positive factor in the Directive as a whole.

Trade Secrets Protection in Zimbabwe

Zimbabwe is a member of the World Trade Organisation (WTO) and a signatory to the TRIPS agreement. It is therefore bound by the provisions of the TRIPS agreement and has taken a number of strides in harmonizing its IP laws with the TRIPS agreement. Industrial property laws and copyright laws were improved around the mid-nineties in order to meet the requirements of TRIPS. Unfortunately, the same improvements were not done in the area of trade secret law. While trade secrets are protected in the country, they are protected through generalized common law civil remedies. The subject is still protected under a myriad of systems such as fair competition laws, contract, delict and IP law. Lemly, supra has noted that trade secrets are important in protecting value and helping in the dissemination of information. Unlike other IP rights, trade secrets as a method of protecting IP is inexpensive and easy to use for all sectors of the economy. All sectors of the economy from individuals, small to medium enterprises and large enterprises can easily and inexpensively use trade secrets in their operations. Gomulkiewicz, et al (2011) emphasize that "all

sectors of the modern economy make use of trade secrets….trade secrets supports capital investment, research and development and acquisition of licencing programmes around the world." With such economic potential trade secrets must therefore be regulated well for business to reap true benefits in Zimbabwe.

Analysis of Trade Secret Law in Zimbabwe

Based on case law, trade secrets law in Zimbabwe covers a range of subjects and protection is not limited to a fixed term as do most industrial property rights. This is one of the major advantages of trade secrets as compared to registered rights. For information to qualify as a trade secret, three requirements must be met:

- the information must relate to and be capable of application in trade or industry,
- it must be secret or confidential, and
- it must be of economic value to the proprietor (*Waste Products Utilization (Pty) Ltd v Wilkes & Anor* 2003(2) SA515 (W) at 573F-I).

The misappropriation of trade secrets is prima facie wrongful under the laws of Zimbabwe, see for example *Townsend Production (Pty) Ltd v. Leech* 2001 (4) SA 33 (C), *Greendale Hardware & Electrical (Pvt) Ltd v Goodfellow Bangaba* SC 16/07. In some jurisdictions the owner of a trade secret can only assert rights if he can show that he has taken reasonable steps to keep it secret. What is reasonable is a question of fact which varies from case to case. The common law of Zimbabwe does not have such a requirement for the protection of trade secrets.

To succeed in a claim for misappropriation of trade secrets a plaintiff in Zimbabwe must prove the following:

- The plaintiff must have an interest in the confidential information, which need not necessarily be ownership.
- The information must be of a confidential nature. There must exist a relationship between the parties which imposes a duty on the defendant to preserve the confidence of information imparted to him, which could be the relationship between the employer and employee, or the fact that he is a trade rival who has obtained information in an improper manner. The defendant must have knowingly appropriated the confidential information.
- The defendant must have made improper use of that information, whether as a springboard or otherwise, to obtain an unfair advantage for himself.

- Finally, the plaintiff must have suffered damage as a result *(Waste Products Utilization (Pty) Ltd v Wilkes & Anor* 2003(2) SA515 (W) at 573F-I).

The requirements in Zimbabwe do not depart in a material way from the requirements in many other jurisdictions of the world. What is key is that the information sought to be protected must have been kept secret/confidential and the use of that information by the other party is wrongful. See also *Strata Insurance Brokers CC v Leonora Goosen* ECD 2161/2014.

The owner of a trade secret has legal protection against a third party who improperly acquires, discloses or uses the secret information. In most cases (but not always) the third party bound by the secret are people who have a duty of confidentiality (such as employees), those bound by contractual provisions e.g. non-disclosure agreements and those who acquire a trade secret through improper means such as theft, industrial espionage or bribery. The owner of the right can have recourse against a third party falling in any of the categories mentioned above. See *Waste Products Utilization (Pty) Ltd* supra.

Over the years Zimbabwean courts have recognised various forms of information that can be categorised as trade secrets including the following:

- Customer lists (For example *Van Castricum v Theunissen* 1993 2 SA 726 (T).)
- Information received by an employee (or others bound by a fiduciary obligation) regarding business opportunities available to the employer (*Strata Insurance Brokers CC v Leonora Goosen* ECD 2161/2014)
- Information provided to an employee in confidence during the course of his employment. (*Harvey Tiling Co (Pty) Ltd v Rodomac* 1977 1 SA 316 (T).
- Information contained in stolen documents
- Publicly available information when gathered and compiled into a useful form through labor and skill and kept in limited confidence. (*Dun and Bradstreet (Pty) Ltd v SA Merchants Combined Credit Bureau (Cape) Ltd* 1968 1 SA 209 (C).
- Credit records (*Dun and Bradstreet (Pty) Ltd v SA Merchants Combined Credit Bureau (Cape) Ltd* 1968 1 SA 209 (C).
- Information that relates to the proposal for the name, design or conception of a new product. (*Stellenbosch Wine*

Trust Ltd v Oude Meester Group Ltd, Oude Meester Group Ltd v Stellenbosch Wine Trust Ltd 1972 3 SA 152 (C).

- A computer software (*Northern Office Micro Computers (Pty) Ltd v Rosenstein* 1981 (4) SA 123 (C).
- Information on the specifications of a product or manufacturing process obtained through skill and labor and kept confidential. (Such as in *Multi Tube Systems (Pty) Ltd v Ponting* 1984 3 SA 182 (D); *Harvey Tiling Co (Pty) Ltd v Rodomac* 1977 1 SA 316 (T).
- Tender prices (Cases like *Meter Systems Holdings Ltd v. Venter and Another* 1993 (1) SA 409, *Waste Products Utilization (Pty) Ltd v Wilkes & Anor* 2003(2) SA515 (W) at 573F-I

The confidentiality of any of the above-listed information is not always automatic, absolute, or permanent but depends on the circumstances of each given case. Thus trade secrets law does not confer an exclusive right as would a patent and cannot be enforced against anyone who independently discovers the secrets for example through reverse engineering, independent research or through getting it from public records. Likewise, lawful measures like a rival business walking in the shop of competitor to compare prices is not actionable under any ground of the common law. At the moment there is no formal definition of a trade secret in the statute books and as a result there is no restriction on the type of information that can constitute a trade secret. This open nature of the right is both a positive and a negative factor in that on the one hand the extent of the protected field is unlimited which can be an advantage to would be users. On the other hand, the fact that the field of the subject area is open has the potential of creating confusion and conflict, see, for example, the comparison between the treatment of trade secrets under the law of delict and contract below.

Protection of Trade Secrets under the Law of Contract

Contracts between one or more parties often impose obligations to respect trade secrets belonging to the other party. A good example is a contract of employment imposing a restraint of trade obligation on the employee in favour of the employer. Where parties stand in a contractual relationship, trade secrets may in the absence of express contractual terms protecting trade secrets, be protected by implied contractual terms. During the subsistence of a contract of service, there is an implied contractual obligation on the employee to preserve the secrecy of the employer's trade secrets. This obligation is a corollary of the employee's duty of good faith,

also called the duty of fidelity or the duty to further the employer's business interests. (*Alfred McAlpine & Son (Pty) Ltd v Transvaal Provincial Administration* 197 4 3 SA 506 (A). The unauthorised acquisition and use of a rival's trade secret is recognised as a form of unlawful and unfair competition in Zimbabwe.

More often employers who share trade secrets with their employees normally insist on the employee signing contracts with restraint of trade provisions. A restraint of trade is defined as an obligation voluntarily undertaken by the employee to refrain from the exercise of freedom of trade in favour of the employer in the exercise of freedom of contract. It is therefore prima facie valid and the onus is on the employee who seeks to resile from its burden to show that it is nonetheless against public interest and unenforceable. See *Magna Alloys and Research (SA) (Pty) Ltd v Ellis* 1984 (4) SA 874(A); *Book v Davidson* 1988(1) ZLR 365(S) at 385D. For example a former employee is not allowed to take advantage of any trade secrets that he learnt while employed by a previous employer. Likewise, a former employee cannot use any information that was given to him in secret by a previous employer. An example is that of a marketing person copying a customer list before leaving the employ of an employer for another. The customer list of employer X is a protected trade secret that an employee is not allowed by law to take to employer Y. Where that happens, an affected employer can seek an interdict from the courts stopping the employee from using the misappropriated customer list. Compare for example with *Basson v Chilwan* 1993 3 SA 742 (A).

To succeed in such a case, the affected employer only has to prove that he has a proprietary interest that deserves of protection from the courts. See *Greendale Hardware & Electrical (Pvt) Ltd v Goodfellow Bangaba* SC 16/07. The policy of the law does not allow an employer to enforce a restraint provision solely for the purpose of preventing competition in the market place. Preventing competition is contrary to public policy and therefore unlawful. In *Herbert Morris Limited v Saxelby* [1916] AC 688 at 710, Lord Parker said:

> The reason, and the only reason, for upholding such a restraint on the part of an employee is that the employer has some proprietary right, whether in the nature of trade connection, or in the nature of trade secrets for the protection of which such a restraint is ... having regard to the duties of the employee ... reasonably necessary.

In the Greendale case supra, the court found that to preclude a former employee from carrying on his natural trade in any part of the country on his own, or in association with others, was a very strong prohibition which required exceptional justification. The court found no exceptional circumstances in the case. The court noted that "the restraint sought to be

enforced by the appellant in this case is in effect a restraint against mere competition from the respondent in the use after termination of employment, of personal knowledge and skill in the trade in which he is involved, acquired during the period of employment with the appellant" (2007,4).

The decision in *Harvey Tiling Co (Pty) Ltd v Rodomac (Pty) Ltd* 1977 (1) SA 316 is a good illustration here. In this case an employee left the employ of his employer and – using a secret manufacturing process, the development of which he contributed to in the course of his employment - he started to manufacture roof tiles in competition with the former employer. The latter successfully applied for an interdict to restrain the former from using the secret. Following English law, the courts have held that a distinction must be made between the employer's trade secrets and the employee's general knowledge and skills acquired in the course of his or her employment. The former are protected while the latter are not.

Kitch (1992) suggested that trade secret law is coextensive with the law of contract. This is also echoed by Robinson (1983) who says contract plays a critical role in trade secret protection. The point being made is that trade secret law is very prominent in cases where the parties have a pre-existing contractual relationship such as employment, assignment, non-disclosure agreements, licence or franchise agreements. If one or more parties to contract misappropriate trade secrets acquired in the course of the agreement then enforcement of the improper conduct with the courts can be done.

In apparent attack to this approach Lemly (supra) observes a number of shortcomings in the contract theory. He notes that the law of contract cannot explain an important subset of trade secret cases: those determining legal rights between strangers. For example cases where trade secrets have been enforced and there was no privity of contract between the parties. This argument must however be understood in the context of the position in America.

Protection of Trade Secrets under the Law of Delict

The law of delict punishes conduct or acts that are wrongful and cause harm to another person. In Zimbabwe trade secret protection under the law of delict is based on the ancient Roman Lex Aquilia (Knobel, 2000; 1996). Aquilian liability is in principle recognised for the causing of any type of patrimonial loss, provided the plaintiff can establish five elements, namely an act, wrongfulness, fault, causation, and damage (*Dun and*

Bradstreet (Pty) Ltd v SA Merchants Combined Credit Bureau (Cape) (Pty) Ltd.) 1968 1 SA 209 (C). As a species of the Aquilian action it means that the law is elastic enough to cover any novel wrongful acts which may be committed in respect of trade secrets. (Knobel, 2000). This is a clear advantage that the law of delict possesses in dealing with trade secrets. See, for example, the following cases; *Atlas Organic Fertilizers (Pty) Ltd v Pikkewyn Ghwano (Pty)* Ltd 1981 2 SA 173 CD and *Easyfind International (SA) (Pty) Ltd v lnstaplan Holdings* 1983 3 SA 917 (W).

The treatment of trade secrets under the law of Delict has been attacked in the Roman Dutch context. The application of trade secrets under the law of delict has been called nebulous and the management of trade secrets is viewed with disdain by many companies (Olivier, 2013, Wilkof, 2013). Wilkof has gone to the extent of questioning the number of the shades of grey one has to count to uncover the subject matter (ibid). This is with justification.

In the context of trade secrets courts applying the tort/delict standard are effectively defining certain acts as "unfair competition" or "free riding." Lemly (supra, p.12) has a challenge with a "duty-based" theory of law of tort, or the maintenance of commercial morality. Who defines the morality is not clear. From the US context Lemly argues that there are some challenges in dealing with trade secrets under the law of delict. He says the law of delict presupposes a wrong without offering any substantive definition of what that wrong is. The concepts of free riding, commercial morality, acting improperly or free riding are open ended and not precise to the extent that the question of whether conduct amounts to free riding in a given case will be left to the discretion of a judge in a given case. This is not helpful. It has been argued:

> The problem of lack of substantive guidelines becomes more acute with the "improper means" prong of trade secret law. It is unhelpful for courts to say no more than that people cannot act "improperly" in acquiring information. If by "improper means" the law intends nothing more than that acts already illegal (hacking, trespass, theft) are illegal here as well, then it has the same problem as the breach of confidence prong: trade secret law adds nothing to existing doctrine. (Lemly, 2008, p.14)

This is a valid observation. Substantive and clear cut rules as to when conduct of a defendant in a given case should attract the law of delict should be available. This then creates the problem of the standard being open ended. The case of *E.I. Du Pont v Christopher* 431 F.2d 1012 (5th Cir. 1970) shows some of the challenges. The case involved photographers who had used a plane to take photographs of a chemical plant under construction as a way of getting the design of the plant and ultimately the

secrets of the chemical processes to be used. The photographers were found liable for improper conduct.

Unlike the American position discussed by Lemly in the preceding paragraph, under the Roman Dutch law used in Zimbabwe a claim under the law of delict has to meet the Aquilian requirements for liability. There is therefore substantive justification for a party to be found liable under a delictual claim in Zimbabwe. In short the defendant must has caused loss or damage to the plaintiff through an act, which is wrongful, must have acted with fault and the conduct of the defendant must been the proximate cause of the plaintiff's loss causation. See the Dun and Bradstreet case above.

Some Observations on the Treatment of Trade Secrets by the Law of Contract and Delict

In light of the discussion for the requirements of protection for trade secrets under the law of contract and the law of delict a distinction can be made of how the law approaches breach of trade secrets under the two branches of law. With respect to the law of delict, the claim is based on Aquilian liability which require proof of five elements. These are; an act, wrongfulness, fault, causation, and damage. This means that the defendant must have committed an act of conduct (or omission), which is wrongful, which had the effect of causing patrimonial damage or harm to the plaintiff. (*Atlas Organic Fertilizers (Pty) Ltd v Pikkewyn Ghwano (Pty) Ltd* 1981 2 SA 173 CD). The extent of coverage under the Aquilian action is open ended. With regard to the law of contract, the plaintiff must prove that the defendant breached an express duty provided by a contract (such as that of employment) or breached an implied duty of the contract such as the duty of good faith in employment contracts (*Harvey Tiling Co (Pty) Ltd v Rodomac (Pty) Ltd* (1977). The courts have held that contracts with restraint provisions can only be enforced if they are reasonable at the time they are being enforced and if the provisions are in the interests of the parties and the public generally (*Book v Davidson* 1988 (1) ZLR 365 (S) at 385D).

The two branches of the law (contract and delict) treat the subject matter of trade secrets differently and a plaintiff wishing to mount a case has to consider which branch of law applies to his or her circumstances. This has both some advantages and disadvantages particularly to business people who are supposed to use trade secrets. For example one disadvantage would be mounting a case under the wrong branch of law. The suit would be lost. The onus of proof also differs depending on the branch of law chosen by the plaintiff. Aquilian liability has five requirements while contract has three requirements.

Challenges of the Current Framework of Protection in Zimbabwe

As has been seen above, trade secrets are protected by a number of legal disciplines such as law of delict, contract and IP in Zimbabwe. In addition, there is no statutory framework that regulates this important field of law in place. The protection of trade secrets through various branches of the civil law creates a number of challenges for the development of the subject of law. For example litigants enforcing trade secrets are required to prove different requirements depending on the civil discipline they are basing their claim on. While TRIPS leaves it open for nations to decide the model for protection of trade secrets, judging by developments in other jurisdictions (the United States and the European Union bloc) a statutory framework may resolve this challenge easily. These movements towards a tangible statutory framework of protection of trade secrets by those two economic blocks clearly sends a clear message on the value of trade secrets as method of protecting IP. Trade secrets deserve protection systematically and statutorily in Zimbabwe for the better advancement of business, industry and commerce.

Trade secrets as a form of IP interface with the life of all people daily. It is not only businesses that take advantage of trade secrets but even local communities, schools and individuals carrying out a number of occupations. Maskus (2012, p. 237) points out that trade secrets, in principle, can play an important role in developing countries where they offer a readily available form of protection for incremental innovation for which patents may not be available, financially viable or profit maximising. It can be said that Zimbabwe is losing on this potential. The lack of proper recognition of trade secrets as a property right has retarded the growth of the subject. Unlike patents and other industrial property which requires registration of rights trade secrets do not require registration. This is a distinct advantage for developing nations with the abundant bio diversity and informal businesses such as Zimbabwe. The opportunities that exist in that context are boundless and just require tapping. Businesses, individuals and communities have certain knowledge and continue to create new knowledge which for strategic and technical reasons may not be properly protected as industrial property. Since this form of IP is not difficult or expensive to create, it stands to benefit many if there is a systematic and clear recognition of the concept in Zimbabwe.

Advantages and Disadvantages of Using Trade Secrets in Business

Adoption of trade secrets as a model for protection of any knowledge may depend on a number of factors such as economic, financial, and legal and technical ones. Trade secrets do have some advantages if properly maintained and kept under lock and key. Some of the advantages that trade secrets have over industrial property rights are analysed briefly below.

One of the major advantage of trade secrets is that they do not require any formal registration process and as such they do not require registration and maintenance budgets on the part of the owner. For patents and utility models on the other hand there is need for registration and maintenance fees. For a developing country such as Zimbabwe the absence of registration formalities create the distinct advantage that this is a form of IP that can easily be used by the small to medium scale sector industries, families and any other person who may not have resources to register and hire IP attorneys to register and enforce their rights. Lippoldt and Schultz (2014) assert that, empirical literature shows that European firms tend to rely heavily on trade secrets as opposed to patents, the preference being more pronounced among smaller firms. This may also be true to Zimbabwe where patent registrations by nationals are very low.

A corollary to the above is that registered rights expire after a given time while trade secrets have no life span. Because trade secrets are never published or registered they never fall into the public domain if they are kept as secret. This means that a trade secret can be enforced for a very long time unlike say a patent. The negative side is challenge of keeping a secret for a very long time in the face of working with contractors, employees and other third parties. This is not an easy task and requires astute strategies and approaches. The renowned case study given on the endurance of a trade secret as opposed to, say, a patent is that of the formula of the Coca Cola soft drink. Had the formula been protected by a patent it would have been on the public domain and open for use to anyone by now. Lippoldt and Schultz (2014, p.13) cautions that trade secrets offer the possibility of protection without a limitation on duration, though not against independent discovery by a competitor or inadvertent disclosure by the owner.

Trade secret protection is generally available for a broad range of commercial information that is useful and not widely known, but need not be novel. The broad scope covers subject matter that may not be patentable such as know-how. The protection of trade secret does not require a disclosure process as is required for a patent or a utility model. With a

patent there is a requirement to publish the application 18 months after filing. From that moment the information becomes public knowledge even though protected. When the term of protection lapses, competitors can start competing with the owner using information in the patent databases. In addition, the subject area of trade secret is very wide and open ended. As has been seen above, a trade secret can range from a process, a method, financial information and many other forms of information. For patents the subject matter is limited particularly by the requirements of patentability. The three requirements of patentability limits what can be patented and what may not. In fact, some areas such business methods and discoveries in nature are not patentable.

The down side of trade secrets as a way of protecting IP includes the fact that registered rights afford an exclusive right while a trade secret merely protects the owner against improper use of the right. In other words the owner of a trade secret cannot prevent others from independently coming up with their own processes or systems. This is a drawback as the law does not even stop a competitor from reverse engineering a product. This means that for industrial property, products and processes which are susceptible to reverse engineering are not best protected by trade secrets. This limits the usefulness of the method in protecting IP.

Related to this, is the fact that trade secrets are difficult to enforce. With a registered right, proof of the right is easy as all one has to show is the certificate of registration. For trade secrets reliance is generally oral evidence which then means more witnesses appearing before the court for trial. More witnesses translate to more hearing/trial time before the court. This has an implication on the costs that a party will incur in the trial of the case since legal practitioners charge in terms of the time spent handling a matter. Secondly, with more witnesses testifying chances of them ending up conflicting each other in some aspects would arise. This therefore requires heavy budgets for litigation of threatened or actual infringements.

It must also be noted that maintaining or keeping a secret in an organisation can be a challenge at a time where employee mobility has increased and organisations are relying more and more on contractors to outsource certain services. Employees, contractors and trusted insiders may be sources of trade secret breaches in companies and organisations. Commenting on the situation in the United States of America McCabe and Lee (2016) stated that eighty-five to ninety percent of trade secret misappropriation is due to the actions of employees and business partners. They further noted that every year, trade secret misappropriation costs the US economy more than $300 billion and 2.1 million jobs. Strong and consistent strategies are therefore a must to reduce the risk of secret leaks. Companies therefore need to take reasonable steps in protecting their confidential information to prevent breaches.

In the final analysis despite some real drawbacks as discussed above, trade secrets still pose a viable option for Zimbabwe in protecting valuable proprietary secret information. Ncube (2018) has noted that for Zimbabwe trade secrets can be potentially as valuable as patents, if they are protected diligently and used strategically. What needs to be done is to raise awareness on IP matters in general and the prospects of trade secrets as an IP subject area.

Conclusion

Recent developments in the EU and the United States of America have clearly sounded a clarion call for the fuller development of our law on trade secrets in Zimbabwe. Despite the high numbers of patent registrations in the EU and the USA, those two regions have seen it fit to improve their law on trade secrets. It is high time that Zimbabwe follows suit so that it can benefit its people. The current situation in Zimbabwe on the law of trade secrets is not the best where trade secrets are protected by a number of legal disciplines such as law of delict, contract and IP. The Aquilian action used under the law of delict, while adaptable and enduring, is an ancient principle which may not cope with the demands of modern day business. The absence of a statutory framework that regulates this important field of law is a major drawback to IP law. Outside the framework provided by the various civil law disciplines such as contract and delict, the concept of trade secrets as an IP right is not very developed in Zimbabwe. It is submitted that IP subject areas such as Trade Secrets, Geographical Indications and Utility Models which do not require high levels of innovation such as novelty may be the leeway for industrial transformation for Zimbabwe. Opening up these other fields of IP may be an impetus for improved interface for the public with the IP system.

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Treaties and Conventions

Paris Convention for the Protection of Industrial Property
Agreement of Trade Related Aspects of Intellectual Property (TRIPS) of the World Trade Organisation

IDEA-EXPRESSION DICHOTOMY DAY IN THE GHANAIAN COURT: REVIEW OF THE SUPREME COURT CASE OF PEARSON EDUCATION LIMITED vs. MORGAN ADZEI

*Richard Dua-Ansah**

Abstract

The protection accorded by copyright law to eligible work is not to the idea behind the work but the manner of the expression of the idea. The Copyright Act of Ghana specifically stipulates in Section 2 that copyright does not extend to ideas, concepts, procedures, methods or other things of a similar nature. This is clearly in furtherance of the balancing role of the copyright regime to prevent the grant of an apparent monopoly over ideas which are said to be as free as air. The law thus draws a careful distinction between the work and the idea behind the work, to the point that the summary of an author's novel has been held as not infringing copyright in the story which was summarised. This was the central holding in the Supreme Court case of Pearson Education Limited v Morgan Adzei. The court placed an interpretation on section 2 of the Copyright Act and concluded that the summary of the novel contained in another work did not infringe the novel. This article examines the scope of Section 2 of the Copyright Act and the application of the idea-expression dichotomy in the aforementioned case. The article reviews the concept of idea-expression dichotomy as applied in cases in other jurisdictions, analyses the case under review and concludes that if the court had adequately construed the nature and effect of the summary, it would have come to a different conclusion, to wit, that the summary amounted to infringement.

Keywords

copyright infringement, idea-expression dichotomy, derivative work, permitted use, Ghana

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Introduction

In order to promote creativity and advance the frontiers of knowledge creation and dissemination, the balancing role of the copyright regime cannot be overemphasised. Copyright law does not only grant protection to right holders but also permits certain uses of such protected works to be put without the necessity of securing permission from the right holder. Since permitted uses relate to protected works, any act which does not touch and concern a protected work does not infringe any copyright. Thus, a work or an aspect thereof is either protected by copyright or it is not. It is only where the work is protected that infringement can occur, and it is then that any defence of permitted use under the law may be countenanced. Where the work or an aspect thereof is not protected, the question of infringement does not arise in respect thereto, and any discussion of permitted use of an unprotected work becomes redundant.

One such aspect of a work which is not protected by copyright is the idea behind the work. Copyright protects the expression of an idea and not the idea itself. This principle, popularly referred to in copyright law as the idea-expression dichotomy and which has been applied in a myriad of cases around the world, has found manifestation in the Copyright Act of Ghana. The Act provides that copyright does not extend to ideas, concepts, procedures, methods or other things of a similar nature.[1] It therefore presents to a defendant in a copyright infringement suit a defence that the alleged infringing work only borrowed from the idea behind the plaintiff's work and to that extent, the question of infringement does not arise as the idea is not protected by copyright.

It is worth noting that the enjoyment of copyright by way of protection and enforcement in Ghana and in many other jurisdictions is not dependent on any formal registration of the work. Thus, copyright work attracts automatic protection upon its creation. The regime of automatic protection is traceable to the Berne Convention which provides, *inter alia*, that the enjoyment and the exercise of copyright shall not be subject to any formality.[2] To be eligible for copyright protection in Ghana, the work must have been fixed in any definite medium of expression now known or later to be developed with the result that the work can either directly or with the aid of any machine or device be perceived, reproduced or otherwise communicated.[3] Consequently, once the work has thus been expressed, the law accords to it those rights such as the reproduction of the work, translation, adaptation, arrangement or any other transformation of the work, communication of the work to the public, and the commercial rental to the public of originals or copies of the work among others.[4] The cases suggest that it is only the creative expression of such ideas and facts that is

rewarded by law, by conferring a privilege to exclusively exploit such expression for a limited time.

The case under review, *Pearson Education Limited v. Morgan Adzei*,[5] presents a situation where the publication of the summary of a novel was held to have only borrowed from the idea in the novel and therefore not infringing. This brings into sharp focus the scope of the idea-expression dichotomy as enshrined in section 2 of the Copyright Act which the court interpreted in connection with the case under review. The central thesis of this article is that if the court had construed the summary as a derivative work within the meaning of the Act, the court would have probably come to a different conclusion. Moreover, the thin line between the idea and its expression is made thinner where an alleged infringing work relates to a derivative work. This leads me to conclude that the interpretation of section 2 of the Act without any construction of the concept of derivative work as provided for under the Act did not do substantial justice to the parties in the case under review.

The rest of the article considers the theoretical framework within which this article is situate by looking at the historical development of the concept of idea-expression dichotomy and its application in other jurisdictions notably the United States, India, England and South Africa. It will proceed to analyse the case under review as it touches and concerns the application of the idea-expression dichotomy in literary works, discuss the possibility of construing the acts complained of as amounting to a derivative work, and conclude that the court could have come to a different conclusion if it had construed the summary as a derivative work which required the consent of the author of the novel.

Theoretical Framework

Understanding the concept

The concept of idea-expression dichotomy is said to be the cornerstone upon which copyright law rests. This is partly due to the fact that the duration of copyright protection can be as long as 70 years after the death of the author, as is the case in Ghana. Indeed the Berne Convention provides for the minimum duration of 50 years after the death of the author. Since ideas are as free as air, it is important that an author is not granted monopoly over a particular idea, in which case knowledge dissemination and diversification may be stultified. The law thus carefully distinguishes between the expression of an idea and the idea itself, protecting the former and leaving the latter unprotected to be explored by others to further the progress of science and humanity. In this light, the statement of Lindley L.J. in *Hollinrake v. Truswell* becomes instructive when

he said that "copyright does not extend to ideas… it is confined to their expression; and if their expression is not copied the copyright is not infringed".[6]

The concept of idea-expression dichotomy appears to have been mooted in the Berne Convention of 1886 when it provided in Article 2 (2) that it shall be a matter for legislation in the countries of the Union to prescribe that works in general or any specified categories of works shall not be protected unless they have been fixed in some material form. The protection is thus accorded to the form of expression of the work. The Guidance Notes[7] to the Berne Convention clarifies the principle when it provided that ideas, as such, are not protected by copyright; and that subject to patent protection:

> A person who has made his idea public has no means of stopping others using it. But once that idea has been elaborated and expressed, copyright protection exists for the words, notes, drawings, etc., in which it is clothed. In other words, it is the form of expression which is capable of protection and not the idea itself.[8]

Article 9(2) of the TRIPS Agreement[9] also provides that copyright protection shall extend to expressions and not to ideas, procedures, methods of operation or mathematical concepts as such, thereby reinforcing the concept as provided for in the Berne Convention. The practice now is that national legislation would normally provide that copyright extends to the expression of an idea and not the idea itself.

The concept as reflected in the Berne Convention and the TRIPS Agreement and as provided for in national legislation appears to be quite straight forward in the sense that once the expression is detached form the idea, protection is accorded to the expressed work but not the idea. However, the application of the concept in cases can sometimes present some challenges. Drawing the line between the idea and its expression can be challenging for instance where there are limited or no other ways of expressing a particular idea than the way the author has expressed it. In such a case, the courts would not enforce the expression since doing so would, in effect, be giving monopoly to the idea as that medium of expression is the only way to actualize the idea. Here, the idea and the expression are said to have merged. This has led to what has become known in copyright law as the merger doctrine.

The merger doctrine was applied in the Indian case of *Mattel Inc. v. Jayant Agarwalla*[10] relating to the famous board game 'SCRABBLE'. The plaintiffs' claim to copyright was in respect of the three game-boards, with the diagonal criss-cross design with placement of the double word, triple word, double and triple letter values, as well as rules of the game. In

refusing to grant the copyright claim of the plaintiff in relation to the colour scheme and the rules of the game, the court noted that

The application of the doctrine of merger would mean that the colour scheme on such a board can be expressed only in a limited number of ways; if the plaintiffs' arrangement were to be avoided, it is not known whether the idea of such a word game could be played at all… If these rules - which form the only method of expressing the underlying idea are to be subject to copyright, the idea in the game would be given monopoly: a result not intended by the lawmakers, who only wanted expression of ideas to be protected.[11]

The merger doctrine had earlier been applied in the *Baker v. Seldon*[12] case where the United States Supreme Court took the view that "where the art it teaches cannot be used without employing the methods and diagrams used to illustrate the book… such methods and diagrams are to be considered as necessary incidents to the art, and given therewith to the public".[13]

Some criticisms of the concept

A number of criticisms have been levelled against the concept under review by both jurists and academics. Perhaps the difficulty encountered by courts seized of copyright infringement cases bordering on the idea-expression dichotomy brings to light the 'near prophesy' given by Judge Learned Hand when he remarked in the United States of American case of *Nichols v. Universal Pictures*[14] in relation to the distinction between the idea and its expression, that nobody has ever been able to fix that boundary, and nobody ever can. Sankar and Nikhil (2008) have for instance observed that although the idea/expression dichotomy is such a time-honoured doctrine, 'it has long been subject to fierce criticisms for its failure to provide practical guidelines underneath its metaphysical surface.' Jones (1990) had earlier argued that the traditional distinction between idea and expression is misguided and irrelevant since no expressionless idea exists and, at least, in any meaningful writing, it makes no sense to speak of an idealess expression. The concept has however been useful in its application in selected copyright infringement cases, a brief excursion into which is considered apposite at this stage.

The concept as applied by courts in other jurisdictions

A convenient starting point is the decision of the United States Supreme Court in the case of *Baker v. Seldon* which, in spite of its limited scope of application and alleged obsolescence, has continued to remain relevant as a *locus classicus* that set the tone for what has now become known as the idea-expression dichotomy in copyright law. In this case, the plaintiff owned copyright in a series of books that explained a bookkeeping system

annexed with certain forms consisting of ruled lines and headings, illustrating the system. The defendant was accused of copyright infringement because it made and used account books arranged on substantially the same system, employing forms with slightly different columns and headings. Indeed it was found that the defendant's book was more useful and easier to use as an accounting system. The Supreme Court held that there is a clear distinction between the books, as such, and the art which they intended to illustrate. The description of the art in a book (which will be the expression of the idea), though entitled to the benefit of copyright, lays no foundation for an exclusive claim to the art (which is the idea) that it illustrates. There was thus no infringement found.

The application of the idea-expression dichotomy in cases relating to infringement in computer programmes or software have rather proven difficult, but the courts have always found a way out.[15] After analyzing the application of the concept in a number of computer programmes cases in the UK, Jain (2012) has inferred from the said cases that where certain ideas expressed by a copyright work are not original, they are not entitled to copyright protection as the borrowing of such idea would not constitute the taking of a substantial part of the work. It is further inferred from the cases that a mere contemplation of an idea similar to the objective sought to be achieved by the computer programme, does not fall within the purview of appropriating skill, labour and judgment essential to constitute infringement.

The quest to draw the line between the idea and its expression, for the purpose of according protection to the latter, has also found its relevance in cases bordering on television and radio programmes. In the Danish high court case of *Celador Productions Ltd v. Danmarks Radio*[16] the court held that TV formats were not protectable subject matter under the copyright law, in effect of which the use of the idea of a particular TV format will not amount to infringement. In this case, the plaintiff had conceived the idea of the quiz programme "who wants to be a millionaire?" in which participants were given the option of four multiple choice answers, three aids known as "lifelines" and were allowed the assistance of any one of five friends. Even though the right to reproduce and broadcast local versions of the programme had been licensed in many countries including the US, Australia, New Zealand and Denmark, the plaintiff's action based on copyright infringement failed.

In India, the courts have applied the traditional conception of the idea-expression dichotomy in a number of cases, beginning with the Supreme Court case of *R.G. Anand v. Deluxe Films.*[17] In this case, the plaintiff who had written and produced a play, brought an action against the defendant for infringing his said play by producing a movie modeled on the plot of his

play. The Supreme Court of India was invited to determine whether the defendant's movie infringed the plaintiff's play. Even though the common theme that run through both works are the evils of provincialism and the horrors of parochialism, the court in applying the idea-expression dichotomy held that no such infringement had been occasioned as there can be no copyright in an idea, subject matter, themes, plots or historical or legendary facts. In the view of the court, even though there were some similarities and coincidences in the two works, those were insignificant and therefore insufficient to have raised an inference of colourable imitation. Further, the dissimilarities between the movie and the play were so material that it was not possible to say that the plaintiff's copyright had been infringed. The court set out some seven guiding principles in determining the lines to be drawn between the idea and its expression. The present author does not find those principles necessary for the purpose of this work save the excerpts made therefrom. Suffice it to state, however, that those principles are said to have been applied in a number of Indian high court cases and discussed by Jain (2012) in a comparative analysis of the concept under review.

In England, the statement of Farewell J in *Donoghue v. Allied Newspaper*[18] is relevant to the present discussion. In determining whether the plaintiff whose racing career had been the subject of some publications done by the defendant publisher could claim authorship or joint authorship with the defendant company, His Lordship declared as follows:

> [It] is clear beyond all question, that there is no copyright in an idea, or in ideas. A person may have a brilliant idea for a story, or for a picture, or for a play, and one which appears to him to be original; but if he communicates that idea to an author or an artist or a playwright, the production which is the result of the communication of the idea… is the copyright of the person who clothed the idea in form, whether by means of a picture, play, or a book, and the owner of the idea has no right in that product.[19]

It is clear that copyright protection is accorded to the expression of the idea and not the idea itself. The English case of *Ravenscroft v. Hebert and New English Library Limited*[20] is also apposite in the context of the discussion under review. In this case, the plaintiff had published a non-fiction book which detailed the history of a spear; the spear which was, among others, traced back through time to be the spear which pierced the side of Christ at the crucifixion. This spear was further identified as that which was used by many legendary historical personages including being identified as the source of inspiration for Hitler's Germany. The first defendant who had read plaintiff's book and got fascinated by it, authored various works of

fiction. In his work of fiction about the post-war fate of the spear which was divided into sections, each section was began with a prologue containing portions of the plaintiff's work. The first defendant admitted using the plaintiff's work as a source but denied copying such a substantial part as to amount to infringement of copyright. The second defendants were the publishers of the first defendant's novel.

In holding that the defendants' work constitute an infringement of plaintiff's book, Brightman J. noted that in writing the prologues for his work, the first defendant had copied the plaintiff's work to a substantial extent as there was much language copying; there were the same characters, incidents, and interpretation of the significance of events in both the plaintiff's and the first defendant's works. In response to the claim by first defendant that plaintiff's book was the only possible source of certain of the facts relied on, it being a historical work, the court took the view that the paucity of sources of information could not prevent the first defendant from taking the trouble of assembling his own information and making his own selection of material. And if that was impracticable, he could have applied for a licence from the plaintiff.

Closer to home in the South African case of *Galago Publishers & Another v. Erasmus*[21] in which the central issue was whether in reproducing and publishing the book entitled Selous Scout - Pictorial Account (Pictorial Account), the appellants reproduced Selous Scout Top Secret War (Top Secret War), thereby infringing same. In this case, the original manuscript of Top Secret War was authored by Reid Dally from largely subjective and experiential form, and reworked by the first appellant and published by second appellant. The respondent was eventually the assignee of copyright in Top Secret War. The first appellant caused Pictorial Account to be published with a good deal of similarities in content with Top Secret War. The appellants had contended, *inter alia*, that they borrowed from the idea and historical facts recounted in Top Secret War and to that extent, had not infringed same since copyright does not protect ideas and historical facts. The question thus turned on the extent of objective similarity between the two works.

The court found that the twelve relevant chapters of Pictorial Account constituted an abridged version of what appears in Top Secret War, with extensive language copying. At paragraph 37 of the judgment, the court noted that the Pictorial Account version is much briefer, less discursive; but nevertheless part-sentences and phrases in Top Secret War, and went ahead to cite examples. The similarities, the court remarked, were too marked, too many and in too many instances inexplicable except on the basis of copying. The court disagreed with contention that Top Secret War narrated historical facts and the use of same did not infringe copyright. It

was held that in writing Pictorial Account the second appellant not only used the general idea underlying Top Secret War, but went much further by reproducing facts selected by the author of Top Secret War to portray the history of the Selous Scout, virtually down to the last detail. The court concluded that the difference between the two works as regards content and language are mainly due to the fact that Pictorial Account was written as an abridgement of Top Secret War with a considerable amount of colourable alterations.

It is against the foregoing background that a review of the Ghanaian Supreme Court case of *Pearson Education Limited v. Morgan Adzei*[22]is undertaken. Indeed this is the first and only reported case, so far as my research in the reported cases has found, that the highest court of the land has made a definite pronouncement on the scope and application of the idea-expression dichotomy.

THE CASE OF *PEARSON EDUCATION LIMITED VRS. MORGAN ADZEI*

The Facts and Decision

In this case, the plaintiff, Morgan Adzei, authored a novel entitled "Woes of the African Mother" (hereinafter referred to as "Woes") which was first published in August 1982. This novel was selected by the West African Examination Council (WAEC) as one of the prescribed texts for prose in the English Language paper for the academic years 2004 to 2006 for the Basic Education Certificate Examination (BECE). The plaintiff contended that as a result of this decision of WAEC and following a meeting of Directors of Ghana Education Service, it was decided that Junior Secondary 1 pupils should be examined for prose in, *inter alia*, the plaintiff's novel. A recommendation was therefore made that 450,000 copies of the Plaintiff's novel be ordered. The defendant published a book entitled "Gateway to English for Junior Secondary Schools Pupil's Book 3" (hereinafter referred to as "Gateway") which included a summary of the plaintiff's novel. The plaintiff thus brought an action against the defendant for copyright infringement.

The Commercial Division of the High Court found that the defendant had infringed the plaintiff's novel and ordered damages among other relief. The Court of Appeal affirmed the decision of the High Court. A further appeal by the defendant to the Supreme Court was successful on the primary ground that the summary of plaintiff's novel in defendant's book is excepted under section 2 of the Copyright Act. The said provision states that copyright shall not extend to ideas, concepts, procedures, methods or other things of a similar nature. The court noted that there would have

been infringement if the defendant's work contained the substance of a detailed pattern of the idea in the plaintiff's novel.

Discussion

The legal issue

The court, in my view, raised the critical issue as to how to characterize the summary of *Woes* published in *Gateway*. This characterization was crucial in construing whether the work can be said to be an extension of the plaintiff's work or a work permitted by the copyright law. Indeed the summary contained in *Gateway* was a complete work deserving of copyright protection so long as it is original, but should it happen to have been a 'colourable imitation' of the novel, a different conclusion was bound to have been reached. This is where this article disagrees with the court in its characterization of the summary, and it is submitted that the summary ought to have been characterized as a derivative work from the novel.

Section 1(1)(g) of the Copyright Act of Ghana puts it beyond doubt that a derivative work is a work entitled to copyright protection. Section 76, which is the interpretation section of the Act, defines a derivative work to mean a work resulting from adaptation, translation or other transformation of an original work in so far as it constitutes an independent creation. It is therefore not in doubt that a derivative work must have emanated from an underlying work prior to such adaptation or translation or transformation. It is also instructive to note that Section 5 of the Act reserves to the author the right to do or authorize the translation, adaptation, rearrangement or any other transformation of the work. To summarise a novel is, no doubt, a certain transformation of the underlying work.

From the case under review, there is no denying the fact that the publishers of *Gateway* set out to summarise the novel. The summary contained in *Gateway* is entitled "Summary of the plot" and begins with the following words: "Fundamentally this novel is the story of a Ghanaian named Foli…". The summary contained the names of the characters in the novel and, even though it was a summary of a 106-paged novel, everything about the summary indicates that it was in reference to the novel. It is instructive to note that none of the cases discussed earlier related to a summary of another work per se. What comes close is the South African case of *Galago Publishers & Another v. Erasmus* (supra) in which the court construed Pictorial Account as a form of abridgement of Top Secret War due to its brevity and less discursive nature. The court however concluded that the author of Pictorial Account did not just borrow the idea and historical facts contained in Top secret war but 'went much further by reproducing facts

selected by the author of Top Secret War to portray the history of the Selous Scout'. This, the court intimated, required consent of the author or assignee as the case was. Just as it was observed by Brightman J. in the case of *Ravenscroft v. Hebert and New English Library Limited* (supra), one either goes through the pain of mobilizing his original work or seek consent of author to deal in the author's work. This, I submit, ought to have been told the author of *Gateway* in the case under review.

Moreover, unlike the Indian case of *R.G. Anand v. Deluxe Films* in which the court found material dissimilarities as against the few similarities and coincidences, the case under review presents no such difficulties regarding similarities since the main characters were the same. Indeed in *R.G. Anand v. Deluxe Films* the defendant set out to produce a movie based on the idea of provincialism, while in the *Pearson Education Limited v. Morgan Adzei* there is no doubt that the defendant set out to summarise the plaintiff's work. The present author is therefore unable to agree with the view of the court that the summary does not constitute such a detailed pattern of ideas so as to take it out of the scope of the section 2 exclusion. At the risk of sounding repetitive, none of the cases in the other jurisdictions discussed above relate to a derivative work *per se*.

The "permitted use" argument

As indicated earlier, one consequence of the balancing role of the copyright regime is to permit certain uses to which a protected work may be put without the necessity to get a licence from the right holder. Under the Copyright Act, provision has been made for the permitted reproduction of a literary work where such reproduction is for exclusive personal use, permitted use for educational purpose, review or criticism, and reporting of fresh events subject to the dictates of fair dealing, among other permitted uses.[23] This discussion has become relevant to the extent that the court in the *Pearson* case sought to, in another breath, justify its decision on the basis that the use to which the defendant had put the plaintiffs' work was excepted by fair dealing. The court noted at page 879 that it cannot be desirable or practical that each time a novel is being subjected to literary criticism or discussion and the general idea it embodies is summarised, leave has to be sought before embarking on such summary.

Like common law and equity, even though the concept of idea-expression dichotomy and permitted uses of copyright might pass through the same copyright stream, their waters do not and should not mix. In its simplest form, it cannot be said in one breath that the author of *Woes* does not own copyright in the idea or theme or plot, while in another breath saying that the use to which the author of the summary put the work is excepted by fair dealing. It is respectfully submitted that this is the trap that the Supreme

Court of Ghana fell into when it held on one hand that the author of *Woes* had no copyright in the idea behind her novel but held on the other hand that what the publishers of *Gateway* did amounted to permitted use of *Woes*. To the extent that what was done in relation to the novel can be construed as a derivative work, section 5 of the Copyright Act requires that consent of the author of the novel ought to have been sought.

Assuming that the summary is to be taken as being excepted under fair dealing, the cases suggest that what amounts to fair dealing is a question of degree. And as suggested by Lord Denning in *Hubbard v. Vosper*,[24] the extent of the quotation, the use made of them, the proportion of the work taken, and other considerations may come to mind. As regards the question of substantiality for the purpose of determining infringement, it has been held in *Ladbroke (Football) Ltd. v. William Hill (Football) Ltd*[25] that it is a matter of quality and not the quantity; and that there must be a sufficient resemblance between the copyright work and the alleged infringement. The summary under review was done as part of a series of books published to be sold to students - a clear commercial purpose. In the light of the fact that the novel had been selected by WAEC as one of the prescribed texts for prose in the English Language paper for the academic years 2004 to 2006 for the BECE, there can be no fair dealing by the author of the summary to have included this in his work which he set out to publish for no other purpose that for sale. The Supreme Court of Canada has suggested in *Law Society of Upper Canada v. CCH Canadian Ltd* that fair dealing should not be given a restrictive interpretation, and that the manner of dealing might be relevant. Indeed the Ghanaian court itself recognized this when it stated that 'it is important that the concept of "general idea" outlined above is not defined or calibrated too narrowly'. It is humbly submitted that the court rather fell for the trap of narrow and restrictive interpretation of section 2 of the Copyright Act and the concept of fair dealing.

Conclusion

In what has become famously known to as the "abstractions test" as a guide in determining the distinction between an idea and its expression, Judge Hand in *Nichols v. Universal Pictures* observed that:

> Upon any work, and especially upon a play, a great number of patterns of increasing generality will fit equally well, as more and more of the incident is left out. The last may be no more than the most general statement of what the play is about, and at times might consist only of its title; but there is a point in this series of abstractions where they are no longer protected, since otherwise the playwright could prevent the use of his ideas…

In terms of Judge Hand's series of abstraction mooted in *Nichols v. Universal Pictures*, the Supreme Court of Ghana can be said to have found that the summary in relation to the novel was at a point in this series of abstractions where they are no longer protected. The determination of the point in this series of abstraction at which the expression is lost to the idea is crucial. The court in the case under review for instance was right in noting the significance of the distinction between a general idea which was intended to be included in section 2 of the Copyright Act (and so not protected) and a detailed sequence of ideas the reproduction of which will amount to infringement. It is however submitted that failure to consider the work of the defendant as a derivative work did not afford the court an opportunity to explore the extent to which the plaintiff's right in a derivative work could be protected.

It has thus been argued that the court could have probably come to a different conclusion had it construed the defendant's work, the summary, as a derivative work. Moreover, a sufficient discussion of the doctrine of fair dealing as well as the application of the three-step test would have inured to the benefit of the plaintiff in the case under review. The ultimate effect of the foregoing discussion is that in the first case bordering on the concept of the idea-expression dichotomy and the interpretation of section 2 of the Copyright Act of Ghana, the apex court cannot be said to have done substantial justice to the parties in the case under review.

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Notes

[1]Section 2 of the Copyright Act, 2005 (Act 690)
[2] Article 5(2) of the Berne Convention for the Protection of Literary and Artistic Works, 1886 as revised
[3]Section 1(2)(b) of Act 690
[4]Section 5 of Act 690 which provides for the economic rights of the author while section 6 provides for the moral rights of the author
[5] [2011] 2 SCGLR 864
[6] (1894) 3 Ch. D 420 . per @427
[7] Guide to the Berne Convention for the Protection of Literary and Artistic Works (Paris Act, 1971) published by WIPO in 1978 per WIPO Publication No. 615 (E)
[8] Paragraph 2.2 of the Guidance Notes supra
[9]Agreement on Trade Related Aspects of Intellectual Property Rights concluded at the end of the Uruguay round of trade negotiations in 1994 within the GATT/World Trade Organization, setting out minimum standards for the regulations of intellectual property rights
[10] (2008) 153 DLT 548
[11]Supra at paragraph 27 of the judgment
[12]101 US 99 (1879)
[13]Supra at 103
[14] 45 F.2d 119 (2d Cir 1930)
[15] As seen in such cases as *Apple Computer, Inc. v. Franklin Computer Corp.*; *Ibcos Computers Ltd.* v. *Barclays Finance Ltd.; Navitaire Inc.* v. *Easyjet Airline Company* which quoted the Ibcos case with approval*; Lotus Development Corporation v. Borland International Inc.*, and the principle was widened in *Computer Associates International Inc. v. Altai Inc*
[16] [2000] ECDR 158
[17] (1978) 4 SCC 118; AIR 1978 SC 1613
[18][1938] Ch 106
[19] Supra @109
[20] [1980] RPC 193
[21][1989] SA 276 (AD)
[22]Supra at note …
[23] See sections 19 to 23 of the Copyright Act of Ghana (Act 690) for the entire provisions relating to permitted uses
[24] [1972] 2 QB 84
[25] [1964] WLR 273

AN ANALYSIS OF THE ZIMBABWE NATIONAL INTELLECTUAL PROPERTY POLICY AND IMPLEMENTATION STRATEGY (2018-2022)

*Ramsay Shonge**

Abstract

The Zimbabwe National Intellectual Property Policy and Implementation Strategy (ZNIPPIS) 2018-2022 is a policy document that aims to enhance economic, social and cultural development. The overall purpose of these policy interventions is, to ensure that Zimbabwe identifies and optimally utilizes its diverse IP assets, which have a clear bearing on the growth prospects of the several sectors and the economy. The Government of Zimbabwe through the Ministry of Justice Legal and Parliamentary Affairs has pledged to promote interactions between innovators and researchers on the one hand, and industry on the other hand, through a functional innovation system The policy seeks to promote Zimbabwean innovators in the pharmaceuticals industry by proactively "preventing leakages of patentable research results". It also recognises the role of SME's, value of Indigenous Knowledge Systems as key activities that will be "protecting and leveraging the knowledge and intellectual traditions of the indigenous peoples of Zimbabwe, by developing a national IKS, which effectively protects and facilitates the commercialisation of Traditional Knowledge (TK)". Promoting innovation has emerged as a key policy priority, as part of the national strategy to foster economic recovery, diversification and competitiveness. This paper critically looks at the ZNIPPIS 2018-2022, its content as well as the possible National IP strategy to operationalise this policy.

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Keywords

national intellectual property policy; ZNIPPIS; economics of IPR data; evidence based decision making

Background to the Zimbabwe National IP Policy

The Zimbabwe National Intellectual Property Policy and Implementation Strategy (ZNIPPIS) (2018-2022) process and stakeholder engagement began in 2014 and after an initial false start, a lengthy but all-encompassing participatory approach to ensure stakeholder buy-in was adopted which resulted in its finalization and subsequent cabinet approval in 2017. ZNIPPIS 2018-2022 is a result of massive cross sectoral stakeholder consultations "with the private and public sector, civil society organizations, UN Agencies and development partners" after realizing the cross cutting nature of IP (Government of Zimbabwe, 2018). WIPO international Consultant Professor Francis A. S. T. Matambalya developed the Policy. This technical assistance from The WIPO was provided under the framework of the WIPO Development Agenda. Nyikadzino (2018) reports that on the 28th of June 2018 the ZNIPPIS 2018-2022 was formally launched by the Justice, Legal and Parliamentary Affairs minister Mr. Ziyambi Ziyambi to spur innovation and creativity in various sectors of the economy.

The Justice, Legal and Parliamentary Affairs minister Ziyambi Ziyambi whilst speaking at the launch said the thrust of the policy "shall be to increase the international competitiveness of Zimbabwean industry and products". The honourable minister opined that, "this shall be through the application of science, technology and innovation and creativity as well as incentive for the investing in research and development" (Muchenjekwa & Mutacha, 2018). This policy interventions recognises and seeks to harness the role of SMEs, which in Zimbabwe - as in literally all other countries across the world - evidently contribute significantly to the economy through innovations, investments, contribution to Gross Domestic Product (GDP), contribution to trade, and contribution to employment and professional skills development.

It is recognised that while the government is the largest formal employer, currently SMEs employ about 70-80 percent of the work force in Zimbabwe and they contribute at least 50 percent of GDP notwithstanding 85 percent of MSMEs are unregistered and unregulated (Ministry of Finance and Economic Development, 2016). Kanyenze, Chitambara and Tyson (2017) discuss how the Zimbabwean economy has undergone a significant structural degeneration, which they argue should not be simplified to just

be an underperforming in relation to economic growth on a comparative basis with other countries in the region. The economic performance characterised by the "inflation of commodity prices" which has essentially led to an "increased dependence on primary commodities". There is an urgent need for out of the box thinking and IP might be a catalyst to the much-needed economic activity.

The National IP Policy also takes cognisance of Zimbabwe Agenda for Sustainable Socio-Economic Transformation (ZIMASSET) – the country's national economic blueprint. Zimbabwe ZIM ASSET is a visionary and well-crafted cluster based national blue print for economic recovery, underpinned and guided by the Results Based Management (RBM) System (Government of Zimbabwe, 2013-2018, p. 110). The economic blueprint is intended to foster sustainable development and social equity anchored on indigenization, empowerment and employment creation. Intellectual property is mentioned explicitly in the Value Addition and Beneficiation Cluster, one of the cluster outcomes is listed as "Increased Indigenous Intellectual property, registration and promotion of indigenous knowledge system", and two cluster outputs listed namely "Intellectual property rights registered" and "Indigenous knowledge systems promoted."

While the Zimbabwe National Intellectual Property Policy and Implementation Strategy (2018-2022) does not directly reference the Interim Poverty Reduction Strategy Paper (IPRSP), the two are aligned in their efforts of poverty reduction. IPRSP indicates how the country intends to promote broad-based and inclusive growth for poverty reduction through improved policies and public spending. The IPRSP document discusses what needs to be done however; it does not adequately discuss a strategy of how to get out of poverty. Pillar III of the IPRSP for example talks about "private sector development, focusing on manufacturing, micro, small and medium enterprise development, mining, tourism and inclusive banking" (Ministry of Finance and Economic Development, 2016).

Key Objectives of the ZNIPPIS, 2018-2022

Zimbabwe National Intellectual Property Policy and Implementation Strategy (2018-2022) has several interrelated specific objectives, which include:

- Raising and consolidating IP awareness and knowledge available to public. This will be accomplished through a number of initiatives such as early education on IP, targeting both primary and secondary schools;

- Informing and sensitizing the stakeholders about the economic benefits of IP. This will be done through specialized foundation IP knowledge; practical professional IP skills; as well as "awareness raising and sensitisation through specialized advocacy and outreach programmes, targeting stakeholders in public sector, private sectors, and civil society".
- Enhancing IP knowledge and professional skills capacities in the country. In recognising the need to grow the small pool of IP professions which include but are not limited to Patent and Trademark Attorneys, IP managers, Technology transfer and licensing experts, IP enforcement agents and Judges the ZNIPPIS 2018-2022 seeks to build national capacity.
- Encouraging IP mobilisation through acquisitions and own creations which may including frugal innovations and appropriate technology; protecting as well as enforcing IP rights;
- Encouraging, inspiring and facilitating IP commercialisation.
- Lastly the policy seek to enhance IP trade mediation capacities; as well as undertaking general education reforms, to ascertain the inculcation of innovative and creative culture from early education onwards.

Additionally, there is a deliberate and well-calculated agenda to promote Zimbabwean innovators in the pharmaceuticals industry by proactively "preventing leakages of patentable research results". Such a move thereby incentivising R&D activities in that sector to be able to "contribute to the improvement of the national and international healthcare systems, and ultimately the quality of life for Zimbabweans and humanity in general". This is in line with SDG Goal 3: Good health and well-being as medieval diseases like typhoid and cholera need to be eradicated in Zimbabwe. The Sustainable Development Goals "make a bold commitment to end the epidemics of AIDS, tuberculosis, malaria and other communicable diseases by 2030" (UNDP, 2017).

The researcher is excited that the GoZ in the policy has pledged to promote interactions between innovators and researchers on the one hand, and industry on the other hand, through a functional innovation system. Information and communication technologies (ICTs) are key in the Promoting, development and commercialisation of IP as such innovative e-commerce tools should be used to gain competitive advantages in a global market digital economy. Such an investment in infrastructure and

innovation are crucial drivers of economic growth and development and key to achieving Goal 9 of the Sustainable development goals that centres

Key Sectors Identified in the ZNIPPIS, 2018-2022

Nine specific sectors have been prioritised in the IP policy that are considered key to the growth of the economy namely agriculture; industry; health; environment; art, culture and heritage; tourism; trade; and small and medium-scale enterprises. The policy has the following listed in its sectoral focus:

i. Agriculture
   Recognising the significance of Geographical Indications such as Tanganda, Mazoe; Plant Breeders Rights; and medicinal properties of plants and genetic resources that are part of the Indigenous Knowledge Systems (IKS).
ii. Industry
   A vibrant industry is key in enhancing the generation, protection and commercialisation of various goods and services that have value addition intrinsic in them and the subsequent IPRs will see local industries gain and maintain a competitive regional and global market position.
iii. Health Sector
   Through this Policy, the GoZ intends to promote access to medicines at affordable costs, by exploiting the TRIPs flexibilities, which include but are not limited to compulsory licensing. The GoZ seeks to build the institutional capacities of domestic pharmaceutical companies to be able to "exploit the various available opportunities, and to competitively produce pharmaceutical products locally";
iv. Education, training and professional skills development
   The policy is envisages that "all levels of education, training, and professional development) shall form the fulcrum of IP knowledge generation and professional skills development".
v. Environment
   Informed by issues of climate change as well as The Convention on Biodiversity (CBD) and The Nagoya Protocol, which Zimbabwe is a signatory, the policy will ensure that process of harnessing IPR "for socio-economic transformation does not come in conflict with the need to preserve Zimbabwe's environment for the current and future generations"

vi. Art, culture and heritage

To promote country's economic empowerment and development protecting and leveraging Zimbabwe's three areas have been identified namely: cultural heritage, including Indigenous Knowledge Systems, as a central element of the country's portfolio of IP assets; GIs as integral elements of the country's portfolio of IP assets and Products of the creative industry.

vii. Trade

ZNIPPIS 2018-2022 shall ensure that the use of IPR's in the export and importation of goods shall be applied effectively by: Rigorously applying border measures to protect economic entities operating in the domestic Zimbabwean market (be they locally or and internationally owned businesses), and thereby creating a conducive investment environment; Ensuring that the application of border measures do not deprive citizens of their rights.

viii. Tourism

The industry is encouraged to identify and leverage IP assets, which include but are not limited to Service Marks, Certification marks that can distinctively position their market offer linking them to expected quality. GIs, which can be used to promote rurally focused and agri-driven tourism. While IKS will be a catalyst to cultural diffusion and exchange cultures in the form of arts and crafts, language, religion, music, traditions, folklore, etc.);

ix. Small and medium scale enterprises

With respect to the Small and Medium scale Enterprises (SMEs), ZNIPPIS 2018-2022 shall focus on appropriate legislation, to enable them to utilize IP for growth, targeting inter alia:

Utility Models; Other potential areas, such as Collective Marks, and GIs.

Analysis of the ZNIPPIS

According to (Musiza, 2018) "the National IP Policy and Implementation Strategy presents an opportunity for Zimbabwe to begin the process of adjusting its IP laws to address its development objectives and institutional capacity". Zimbabwe has made significant strides in protection, administration, management, and deployment of IP. The legislative framework used for IP administration is largely influenced by Roman Dutch law from the Cape Colony. Some of the Statutes relating to

IP in Zimbabwe which have influenced the ZNIPPIS 2018-2022 include, but are not limited to:

- The Integrated Circuits Layout-Designs Act, Chapter 26:07 (2004)
- The Industrial Designs Act Chapter 26:02 (2001)
- The Patents Acts Chapter 26:03 as amended up to Act No. 14/2002
- The Trademarks Acts Chapter 26:04 (2001)
- The Copyright and Neighbouring rights Act Chapter 26:05 (2004)
- The Armorial Bearings, Names, Uniforms and Badges Act Chapter 10:01
- The Geographical Indications Act Chapter 26:06 (2001)

According to (Government of Zimbabwe, 2018, p. 7) in part II of the ZNIPPIS 2014-2918 specifically section 2.3.1 titled the General Objections it is stated that:

> The overall objective of the Zimbabwe National Intellectual Property Policy and Implementation Strategy 2018-2022 (henceforth: ZNIPPIS 2018-2022) is to ensure that the entire intellectual property governance framework (i.e., diverse laws and regulations, strategies, action plans, treaties, protocols, practices, etc., with a bearing on intellectual property) leverages the country's IP potential for inclusive and sustainable economic growth and development.

The question then posed is that how then will Zimbabwe ensure that the entire intellectual property governance framework in the absence of such key laws. According to the former Director Technical of the African Regional Intellectual Property Organization the current status quo in Africa and Zimbabwe specifically is that, there is a low level of patenting by nationals and or residents (Kiige, 2014). From the Harare Protocol statistics provide by the ARIPO secretariat it is enlightening and exciting to note the figures for filed and granted inventions and Utility models also known as petty patent applications. The table below shows that Zimbabwean inventors tend to file petty patents rather than invention patents. This may be due cost and perhaps the less stringent requirements. The table that follows shows data obtained by the researcher from the ARIPO Secretariat in which he was seeking information about the Harare Protocol systems and the top five countries where applicants come from. These countries in order of most filed applications are Zimbabwe, Kenya, South Africa, Swaziland and Sweden.

Table 1 : ARIPO Polite+ Utility Model Rankings by Country of Origin Up to 2017

Ranking	Applicant Country	No of Applications
1st	Zimbabwe	81
2nd	Kenya	10
3rd	South Africa	4
4th	Swaziland	2
5th	Sweden	2

Statistically there is relatively higher success and usage of the Utility Model system to protect inventions in domestic markets largely because very few patent applications from small or indigenous inventors normally meet the patentability criteria. Where possible non-patentable subject matter maybe filed as Utility models and government grants be made available to help worthy companies and individuals commercialize their inventions. It might be more prudent to encourage local inventors in Zimbabwe to lodge utility model applications, which could later be converted into patent applications if requirements for industrial applicability, novelty and inventive step are deemed to have been met. Of great concern to the researcher is that in spite of this great achievement there is presently no Sui Generis system for Utility Models in Zimbabwe. The table that follows shows the ranking of fields of innovation or technology covered by most of the Utility Models.

Table 2: ARIPO Polite+ Utility Model Rankings by IPC Classification

Ranking	International Patent	Field of Innovation or Technology
1st	F	Mechanical Engineering; Lighting; Heating; Weapons; Blasting
2nd	H	Electricity
3rd	B	Performing Operations; Transporting
4th	N/A	

The top ten filers of patents in the Zimbabwe territory for the period 2013-2017 in order are United States of America, South Africa, India, United Kingdom, France, Japan, Switzerland, Germany, Australia and China. The respective numbers of applications are listed in the table that follows.

Table 3: Five Year Analysis of Top10 Patent Applicants filing in Zimbabwe 2013-2017

Ranking	*Applicant Country*	*No of Patent Applications*
1st	United States	508
2nd	South Africa	129
3rd	India	88
4th	China	75
5th	United Kingdom	65
6th	Japan	59
7th	Switzerland	56
8th	Germany	52
9th	Australia	51
10th	China	47

Zimbabwe appears in the bottom ten of the top twenty filers of patents in the territory of Zimbabwe for the period 2013-2017. Higher and Tertiary Education, Science and Technology Development Minister, Professor Amon Murwira cognisant of these dynamics announced in July 2018 that Government of Zimbabwe has availed $15 million for the construction of innovation hubs in six universities and infrastructural overhaul of the Higher and Tertiary Education sector. These universities are namely National University of Science and Technology, Midlands State University, University of Zimbabwe, Harare Institute of Technology, Zimbabwe Defence University and Chinhoyi University of Technology (Musiiwa, 2018). The respective numbers of applications are listed in the table that follows:

Table 4: Five Year Analysis of Top10 Patent Applicants filing in Zimbabwe 2013-2017

Ranking	**Applicant Country**	**No of Patent Applications**
11th	Zimbabwe	45
12th	Canada	26
13th	The Netherlands	26
14th	Sweden	19
15th	Israel	18
16th	Italy	17
17th	Ireland	17
18th	Denmark	15
19th	Finland	13
20th	Singapore	12

Implementation of ZNIPIS

In Part 3 of the policy a plan is outlined for the Implementation Strategy of Zimbabwe National Intellectual Property Policy. One of the key activities outlined is to strengthen the national IP office. The GOZ is creating a separate IP department with a structure that will make it a more viable, visible and a focal institution in the technology, creativity and innovation cycles. The GOZ seeks to increase efficiency and effectiveness of the institution in managing rights of nationals and foreigners at the highest level. Operations at what is now known as the Zimbabwe Intellectual Property Office (ZIPO) started in the colonial era on the 7th of May 1894, as an extended functionary of the Deeds Office under the Attorney General's Office and it was a section within the Department of Deeds, Companies and Intellectual Property (DCIP). Today DCIP falls under the Ministry of Justice, Legal and Parliamentary Affairs (MoJLPA) and is headed by the Controller of Patents, Trademarks and Industrial Designs and it is the government office with the sole mandate to grant/register and duly publish accepted and lapsed IPRs in the territory of Zimbabwe. ZIPO is the sole custodian of all records, books, drawings, specifications, documents, and other papers and items relating to intellectual property rights applications filed in the pre-colonial and post-independence Zimbabwe era.

As custodian of IPR data, ZIPO is strategically placed to conduct primary hearings on contested IPR's (Government of Zimbabwe, 2018). The table below shows trademark filings for the period 2013-2017.

Table 5: Zimbabwe Trademark Filing Trends 2013-2017

Application Types	2013	2014	2015	2016	2017	Total Applications
Individuals (ZW)	67	54	59	40	40	260
Trusts (ZW)	7	5	3		2	17
Associations (ZW)	0	7	1	4		12
Government (ZW)	0	0	3	4	4	11
Church Related (ZW)	35	67	1	6		109
Partnerships (ZW)	1	0	0	4	1	6
Companies (ZW)	276	317	257	424	282	1,556
Foundations (ZW)	0	13	2	6		21
Political Parties (ZW)	0	0	0	1		1
R&D Institutions (ZW)	0	0	0		12	12
Local Applications (ZW)	386	463	326	489	341	2,005
Total Applications	1,790	1,993	2,137	2,452	2,512	10,884
Foreign Applications	1,404	1,530	1,811	1,963	2,171	8,879

ZIPO is mandated to oversee the regular publication of an IP journal composed of IPR applications received, registered or amended. It is disappointing to note that 82 percent of trademark applications are by foreign applicants with Zimbabwean companies and entities only contributing 18 percent of the total trademark filings. This could suggest that the current pricing regime is discriminatory and unaffordable to Zimbabweans. The registration process would also need be decentralized and the services currently offered by ZIPO in Harare alone should also be available in Bulawayo, Gweru and Mutare other regions of the country. ZIPO is also supposed, "to coordinate with other government agencies, offices and the private sector efforts to formulate and implement plans and policies to strengthen the protection of intellectual property rights in the country" (Mudzvatangi, 2015). Another key mandate of the ZIPO office is "examining and processing IPR applications, promoting the use of patent information as a tool for technology development as well as making national intellectual property registers accessible to the public where necessary".

Arguments for Autonomy

General consensus amongst IP professionals is that the traditional institutional and often bureaucratic setup of most Intellectual Property offices in Africa poses various challenges to the competence of the IP Office. It has been argued that a competent IPO is that which moves from mere registration to becoming the focal point of all IP issues Autonomy is associated with and often translates to competence as well as professionalism and thus being autonomous or even semi-autonomous strengthens the administration and management of IP. A study by Shonge (2018) probed whether ZIPO is sufficiently staffed to provide an efficient service to its stakeholders, all respondents from ZIPO responded in the negative. It emerged that the Staff compliment is too thin owing to the economic downturn government, which is the biggest employer, has placed a freeze on all posts. ZIPO does not have any patent examiners or a department skilled to help clients to draft patent claims the examiners that exist mainly focus on trademarks and industrial designs only and the examiners who have left have not been replaced.

This recruitment policy affects data capture, verification, validation and general quality checks and work processes ZIPO needs to do data validation to ensure that the information captured is accurate, the subsequent administrative or legal cost of resolving errors at a later stage can be significant. All the respondents from ZIPO in the above-mentioned study cited at least one of the following as the leading reason for low levels of IP awareness:

- bureaucratic process to release IP information and statistics to the press;
- non-publishing of IP articles by ZIPO management and staff who are the authorities and custodians of IP and IP data respectively;
- lack of financial and human resources for outreach programs;
- absence of the ZIPO journal on the DCIP or the ARIPO website;

The activities being carried out at ZIPO would have more impact if carried out by autonomous and semi-autonomous parastatal similar to what has recently happened in Namibia and Botswana with the establishment of Business and Intellectual Property Authority (BIPA) and Companies and Intellectual Property Authority (CIPA) respectively through Acts of Parliament. This study probed whether ZIPO is sufficiently staffed to provide an efficient service to its stakeholders, all respondents from ZIPO responded in the negative. It is apparent that the Staff compliment is too thin owing to the economic downturn, government is the biggest employer, but it has placed a freeze on all posts. This policy affects not only data capture, verification, validation and general quality checks and work processes but also ultimately the implementation of the ZNIPPIS 2018-2022.

Shortcomings of the ZNIPPIS

ZNIPPIS 2018-2022 is supposed to guide and give direction as to how the nation can economically exploit IP and align to the development plans of the country. While the Policy a defines the concepts of 'intellectual property' and 'IPRs' and places specific emphasis on the need to protect trade secrets and traditional knowledge, One of the key issues not addressed in the Zimbabwe National Intellectual Property Policy and Implementation Strategy 2018-2022 is the issue of ever greening of patents (Hill, 2014). Section 3.4.3 which talks about Enhance IP domestic governance framework. Failure to tackle the issue of ever-greening stifle competition as the government will not be able to mitigate against adverse use of IPR to stifle innovation, creativity, productivity and information dissemination in the market and will adversely affect the market dynamics. It is recognised that innovation in pharmaceuticals is an expensive and risky investment, whereas replication need not be (Mondal & Pingali, 2017).

The policy recognises the value of Indigenous Knowledge Systems (IKS) as key activities that will be "protecting and leveraging the knowledge and

intellectual traditions of the indigenous peoples of Zimbabwe, by developing a national IKS, which effectively protects and facilitates the commercialisation of Traditional Knowledge (TK)". Questions immediately arise including how ideal are traditional IPR systems in dealing with TK and IKS, which has a communal ownership and is kept in trust and passed from generation to generation whether traditional IP protection is suitable, or perhaps a sui generis system should be designed (Ncube, 2013). Moreover, when an entire community is involved in the evolution of traditional knowledge, how does one identify the inventor? TK and IKS includes know-how, practices and skill, innovation which resulting from intellectual activity in a traditional context ultimately this forms part of the traditional lifestyles of communities. How does the ZNIPPIS 2018-2022 deal with patents that are based on TK and IKS bearing in mind that this knowledge has been in the public domain of the community and therefore fails to meet the non-obviousness criteria of a patent. In the researchers opinion ZNIPPIS 2018-2022 has not addressed how to curb or prevent bio piracy and ensure benefit sharing with communities for IP attributed to TK and IKS in Zimbabwe.

One of the shortcoming of the Policy as seen in Part I of the Zimbabwe National Intellectual Property Policy and Implementation Strategy (2018-2022) is that it assumes that innovation only occurs in formal setups in Universities, polytechnics and R&D institutions. However often innovation occurs in the context of chance or luck most of the case studies on African innovation seem to suggest that innovation occurs mainly in the informal sector and is not heavily reliant on "conventional means, knowledge governance and appropriation" (UNECA, 2017). The researcher is of the opinion that though ZNIPPPIS 2018-2022 defines and identifies intellectual property that more should be said about issues of commercialisation of Intellectual Property and creation of Technology Transfer Offices in the country that established companies, SME and SMME can have access to. It is also unclear who owns IP in cases of public funded institutions and public funded research what maybe what's needed is the equivalence of the South Africa Intellectual Property Rights from Publicly Financed Research and Development Act 51 of 2008 or the United States Bayh-Dole Act (Barratt, 2010). The ZNIPPIS 2018-2022 alludes to implementation however, it does not clearly outline the implementation roadmap or how progress or success will be measured. The researcher also notes that the ZNIPPIS 2018-2022 does not discuss pertinent issues of data, research data, open access, data management more comprehensive policy requirements Research data management policy.

Conclusion

The novelty of the Zimbabwe National Intellectual Policy and Implementation Strategy ZNIPPIS 2018-2022 as a much needed and first ever IP Policy in Zimbabwe is undisputed. However, there is an urgent need to create a coordinated approach to raising and creating awareness about IP among the Zimbabwean populace. The policy needs to balance IP creation, IP Protection and IP commercialisation with a particular emphasis on creation of a system for protection of traditional knowledge, which will guard against misappropriation and exploitation of traditional knowledge and indigenous knowledge. While the promotion of international best-practices is noble there is a need to maintain a competitive advantage and to leverage our strengths in IP that align with Zimbabwe's development objectives and to protect nationally-owned IP that is related to indigenous resources, traditional innovation and traditional knowledge. It is prudent to promote further research and development into products and services based on traditional knowledge.

While appropriate, in most regards ZNIPPIS 2018-2022 will need to be reviewed to have a more robust consideration of each type of IP in any future policy improvement or re-formulation. As alluded to by (Ross, Msiman, & Scorer, 2018) "it is therefore prudent that appropriate measures and strategies are put in place to ensure that IPRs are efficiently protected and used to enhance such development." The launch of ZNIPPIS 2018-2022 requires a competent and professional entity to oversee and be the focal point of all IP and IPR issues in Zimbabwe without the staffing and budgetary constraints that ZIPO presently has. There is an urgent need to setup Technology Transfer Offices nationwide that should be in a position to identify frugal, radical and lean innovations and inventions worthy of public funding. Zimbabwe will need a specialised, competent and autonomous authority on IP and IPR issues to operationalise ZNIPPIS 2018-2022 as well as to coordinate all IP at a national level and advice policy makers on policy gaps and emerging issues. Zimbabwe's over-reliance on extractive industries with no beneficiation and value addition particularly in the mining sector has become a growing policy concern. Improving the Zimbabwe Intellectual Property (IP) system and ecosystem can positively contribute to this agenda (OECD, 2016).

The ZNIPPIS 2018-2022 coupled with revitalised industry, value addition of primary products has the potential to leverage Zimbabwe's competitive and comparative advantage to advance the recovery and transformation of the Zimbabwe economy into a middle-income country by 2030. To achieve this however there is need for an indicative national budget, a comprehensive action plan, results-based monitoring and independent evaluation framework in order for the Policy to be deemed complete and

ready for implementation. Without the aforementioned ZNIPPIS 2018-2022 like other brilliant policy documents in Zimbabwe will only contribute to our national library of amazing literary works that were never implemented.

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THE DIGITAL ENVIRONMENT AND COPYRIGHT INFRINGEMENT IN MALAWI

*William Maulidi**

Abstract

The widespread use of digital technology has allowed consumers to reproduce digital versions of copyrighted materials with negligible costs. It is worth pointing out that of all the industries that have been revolutionized by the rise of digital technology and the global internet few have been hit as hard as the music industry. The global music industry which was quite successful during the 1990 is currently facing significant challenges due to the technological advances which are changing the ways the music is recorded, stored and transmitted to consumers. As people are always catching up with innovation and technological advancements, new ways of pirating music are also emerging. Deliberate infringement of copyrighted material is rampant on the internet as copy and paste functionality makes it simple to lift digitized information. It is against this background that this study was conducted to assess the extent to which digital technology has contributed to music piracy and copyright infringement in Malawi. It also explored the practicability of the measures that have been put in place to enforce copyrighted works in the digital environment in Malawi.

Keywords

digital technology, internet, copyright, piracy, infringement

Introduction

The breakthrough of technologies has changed the world to be digital. With the increase in numbers of users, the internet plays an important role

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as never before. The new technologies have allowed people to transfer information in various formats with negligible cost. Ham and Atkinson (2008) observed that of all the industries that have been revolutionised by the rise of digital technology and the global internet few have been hit as hard as the content industries, that is to say, the producers of music, movies, television programs, interactive software, books, photos and periodicals. For instance, the global music industry was quite successful during the 1990, but today, the industry is currently facing significant challenges due to these technological advances which are changing the ways the music is recorded, stored and transmitted to consumers (Fleming and Hughes, 2002). These technological landscapes have caused gradual changes in consumer listening and audio spending behavior. It is worth pointing out that whilst piracy of music has always been an issue, the widespread use of internet based music distribution has been a huge setback to owners of copyrighted works. As Robert (2009) points out 'while scholars often treat digital piracy as a behaviour that needs to be prevented or punished, user's decision about how to acquire a digital product involves more than the piracy option'. The blatant infringement of copyrighted material is rampant on the internet as copy and paste functionality makes it simple to lift digitized information. With technology at the highest peak, people can share music in the blink of an eye.

A number of studies have been carried out on the impact of technological advancement on music industry. However, little literature is available on the extent to which the digital environment has caused music piracy in Africa, especially in Least Developed Countries (LDCs). It is against this background that this study was conducted to assess the extent to which digital environment has contributed to music piracy and copyright infringement in Malawi. The study also examined factors that influence users to pirate copyrighted works. Finally, it also explored measures that had been taken to enforce copyrighted works in the digital environment in Malawi.

Methodology

The study was conducted in the four cities of Malawi, namely Blantyre, Lilongwe, Zomba and Mzuzu. The rationale behind the choice of the four cities was based on the assumption that the majority of the copyright owners especially musicians lived and conducted their business transactions in these places. Moreover, being urban areas, it was assumed that the likelihood of people to engage in piracy could be high. The study involved selected musicians, users of copyrighted works, law enforcement bodies such as High Court of Malawi, Copyright Society of Malawi (COSOMA) and the musicians body Musicians Association of Malawi

(MAM). The philosophy for involving these respondents was based on the fact that some of them were copyright holders, or they use copyrighted materials, or else they work or deal with copyright holders. As such, they were better placed to provide data necessary for this study. Secondary data was collected from the review of existing literature in related domain. Simple random sampling and purposive sampling techniques were employed to sample out study population. Moreover, questionnaires and interviews were the main data collection instruments for the study. The study also adopted a cross-sectional design as data was collected from the respondents once and over a short period of time.

Literature Review

It is of significant importance to mention from the onset that the advent of digital technology has faced mixed receptions worldwide. While it is true that users as well as rights holders of creative works celebrated the birth of the new era, it is also pertinent to say that the two parties celebrated it in different styles. At one end of the spectrum the users welcome the digital age as a platform where they can freely access, download, copy, and swap or share the digital information without necessarily paying for it. And at the other end, the rights holders hold the views that the digital environment provides a forum for making their information available to the public within the shortest period of time than was the case in the analog environment. Similarly, the rights holders feel that their rights of reproduction and distribution are being taken away by the users in the digital environment, whereas the users espouse an ideology that denies the legitimacy of the concept of copyright preferring instead to think information cannot be property (Ham and Atkinson, 2008).

It is in this respect that some analysts predicted a battle between the two groups emanating from their differences and misunderstandings vis-à-vis digital environment. Gantz (2007), observed that the war over intellectual property is being fought everywhere on earth between media conglomerates and computer wielding teenagers, between billion-dollar technology companies and billion-dollar content companies, between artists and artists, nations and nations. Gantz's observation is echoed by Taylor (2009) who points out that the battle between the recording industry and those illegal sharing music over the internet has gripped headlines over the last few years like few other related to the digital age.

It is worth mentioning that many rights holders contend that the digital environment, despite bringing in modern ways of disseminating information to the public, has a serious down side for them. They note that one major problem that has arisen with the rapid advancement of

technology is the on-going discussion of digital content piracy. For instance, the new techniques of printing, recording and fixation of broadcast or recorded programs have emerged with the advent of technology, making it easier for the pirates to carry on their illegal activities. Furthermore, the 2008 Digital Music Report compiled by the International Federation of Phonographic Industry (IFPI) indicated that music piracy was fragmenting into new forms as technology enables many new forms of illegal file sharing, including sharing via instant messenger, blog, local network sharing, Bluetooth mobile sharing and e-mail sharing.

Nevertheless, Fleming and Hughes (2002) argued that there are a number of distinct areas where technological innovations have revolutionized the music industry. Amongst the important ones are the new method of distribution of the products, protection of intellectual property through digital rights management, new means of revenue collection, inexpensive electronic communication, data collection and market testing and new play back devices.

Forms in Which Digital Content Is Pirated

There are various ways in which content such as music is pirated. As Chimwaza (2017) pointed out, illegal downloading and distribution of music on the internet is a newer form of piracy even in developed countries like the Unites States. Most people typically avoid paying for legal music downloads from sites like iTunes, opting instead to find free or cheaper illegal downloads. According to www. latimes.com, Apple's biggest rival when it launched its $10-a-month streaming music service in 2015 was not Spotify or Tidal, but piracy. About a fifth of internet users around the world continue to regularly access sites offering copyright infringing music, according to the International Federation of the Phonographic Industry.

In the United States alone, 20 million people still get music through peer-to-peer file-sharing networks, according to research firm MusicWatch. And newer methods have emerged, such as mobile apps and software that rips audio from YouTube. This observation is also echoed by Ham and Atkinson (2008) who pointed out that the internet has made global distribution of content easier than ever. For instance, the digital content may be copied, modified and distributed all over the globe to more than half a billion users connected to the internet at virtually no cost. They also observed that once one copy of a song or film is created free of copy protection measures it can multiply like a virus until it is widely available. Content is particularly vulnerable in the digital environment because an infinite number of perfect copies can be made from just one original and

because those copies can be distributed cheaply around the globe using the internet. Likewise, Kennedy (2008) alluded that the 2007 Research conducted by the Recording Industry Association of Japan (RIAJ) found out that mobile piracy was already becoming a very significant problem in Japan. The research highlighted that more than 40 percent of mobile internet users frequently obtained illegal music via their mobile phones. The figure rises to 65 per cent among the younger demography. Moreover, nearly 400 million illegal music files are downloaded in a year.

In Malawi, a new form of piracy supported by memory cards weaved its way in 2013, thus twisting the focus away from CD burning. As Sharra (2014) observed, most people are preferring memory cards to CD because they like a variety of songs uploaded in the memory cards. For instance, one buyer reported that a music CD costs K1 000 (USD 1.30) and seldom are all songs good. As such it was better for him to buy a loaded memory card and listen to a variety of songs, which is usually a selection of best hits.

It should also be clearly stated that in the past, analog recording technologies such as audio and video cassettes had a built in check on widespread piracy. The quality of the recording degenerated significantly with each new generation. But this is not the case in the digital era. For example, each copy of a digital audio or video file is exactly as good as the original from which it was made. In most cases, the audio and video CDs and DVDs that are prone to ripping or burning are the ones that are created free of copy protection technical measures.

Famous Cases of Copyright Infringement

In the first place it is worth mentioning that piracy is not a massive criminal conspiracy but rather the collective actions of millions of otherwise law-abiding internet users of all ages who have grown accustomed to the culture of free content. A number of networks and services that take advantage of the internet as a platform for downloading, sharing, swapping and distributing music and film files emerged towards the end of 20th century. One of the world's biggest music and film file sharing network that terrorized the music and recording industries at the beginning of the 21st century was Napster. According to the Time Magazine of October 2, 2000, Napster was cofounded by Sean Parker and Shawn Fanning and operated between June 1999 and July 2001. Napster technology allowed people to easily copy and distribute MP3 files among each other, bypassing the established market for songs and thus leading to music industries accusations of massive copyright violation. In 2000, the Recording Industry Association of America (RIAA) along with other musical groups heard about Napster. RIAA believed that Napster should be held accountable for copyright infringement because its services

enabled millions of people to share music for free thereby depriving artists of revenue they were entitled to their copyright. In this connection, in January 2001, the 9th US Circuit Court of Appeals ruled that Napster would be forced to stop its millions of users from downloading copyrighted files. In February that year, Napster offered a US$ 1 billion settlement to the music industry in exchange for working towards building a file sharing service where users pay a monthly fee to access it.

Another p2p music file sharing service that became a global icon for violation of copyright on the internet was a Swedish-based group known as Pirate Bay. Many people believed that Pirate Bay was the world's biggest engine of copyright infringement that enabled millions of users to download illegal copies of music, film and other content. It is very important to stress that no copyright material was stored on Pirate Bay's service and no swapping of files actually took place there. Rather, Pirate Bay located a file on the internet and acted as a directory of so called torrent files (Rainstorm, 2008). The torrent files downloadable from Pirate Bay contained information needed to download film or music files from others. On 27th April, 2009, the Swedish Court jailed Gottfrid Svartholm Warg, Peter Sunde, Fredrik Neij and Carl Lundstrom for a year each for running and funding The Pirate Bay. They were also ordered to pay damages of 30m Kronor (£2.4m). Similarly, the film, music and video bosses had sought 120m Kronor (9.6m) in damages and interest for losses incurred from the tens of millions of illegal downloads facilitated by the site (skynews.com, 27th April, 2009).

In recent years there have been other famous cases of online copyright violations such as Viacom Int. vs You Tube, Universal Music Group vs MySpace and the Motion Picture Association vs Newzbin. In 2013, Viacom Int., commonly known as Viacom sued You Tube, an online video sharing service for direct and secondary copyright infringement based on the public performance, display, and reproduction of about 79,000 audiovisual clips shown on the YouTube website. Of course the district court determined that YouTube came within the Section 512 of the Digital Millennium Copyright Act (DMCA), primarily as it had insufficient notice of the particular infringements in suit as required by the statute. Similarly, in 2006, Universal Music Group sued MySpace.com for infringing on the copyrights of thousands of songs and videos through its social network site. Universal also accused MySpace of aiding copyright infringement by reformatting clips so users can transfer them to friends or post them to other sites. Likewise, in 2011, the Motion Picture Association and member motion picture studios brought a successful claim for copyright infringement against Newzbin, Ltd., which operated Newzbin1 at www.newzbin.com, a website that distributed commercial content without permission from the copyright owners. After the injunction was

awarded, the Newzbin1 website ceased operating and an almost identical website, Newzbin2, commenced operation at the same location (Sweeney, 2011).

The Situation of Music Piracy in Malawi

According to the article written by Mathilda Chimwaza in The Times online of 7th January, 2017, Malawi's music industry experienced what seemed like the start of something new as music genres and studios mushroomed in the late 2000s. There was a variety of music genres available for the consumer, and the products were not just available in CDS or tapes but also memory cards and flash disks. However, since people are always catching up with innovation and technological advancements, new ways of pirating music have also emerged. Digital piracy has climaxed not only in Malawi but across the globe. The present study found out that there have been quite a number of issues of copyright infringement in Malawi and most of them have been to do with downloading, uploading, coping and sharing of copyrighted music files. For instance, sixty five percent (65 percent) of the musicians who were involved in the study moaned that their music is pirated through coping and sharing of an electronic copy of their music whereas thirty five percent (35 percent) of the musicians involved complained that their music is uploaded and downloaded from the internet without their consent. The study also found out that the coping and sharing of music activities take place everywhere in Malawi, for instance, in homes, workplace, streets and marketplaces. The study also established that there are quite a number of WhatsApp groups which have been formed specifically to upload and share music among group members.

Furthermore, the study revealed that thirty five percent (35 percent) of the musicians involved in the study reported their cases of copyright infringement to Copyright Society of Malawi (COSOMA), while twenty seven (27 percent) percent reported their cases to Police, sixteen percent (16 percent) of them resolved the matter on their own and finally twenty two percent (22 percent) did not take any action at all despite having knowledge that their music was being pirated. However, eighty-eight percent (88 percent) of the musicians who reported their cases to COSOMA and to Police indicated that they were not happy and satisfied with the feedback they were received from the two law enforcing bodies. The study established that lack of specialized courts to handle Intellectual Property cases such as the ones reported by the rights holders in Malawi was one of the major reasons for the discontentedness of victims of copyright infringement such as musicians. As such, most copyright cases in Malawi have been settled out of court.

Why Individuals Pirate Music

The study went further to establish factors that influence individuals to pirate copyrighted music. The data showed that reasons for indulging in piracy varied from one pirate to another. For instance, some users of copyrighted music involved in the study indicated that they copy and download music files to save money. No matter how much the pirates actually earn, they feel justified in pirating data because they think that original media is overpriced. Likewise other users explained that they found it more convenient to gain access to pirated music than find the originals as it is relatively easy to digitally pirate content. And once copied the quality of the copy itself is not significantly reduced. Furthermore, most of the users answered that they expected the internet to provide content for free that would be paid for in the offline environment such as newspapers and magazines. The study also established that users pirate local music because of poverty, ignorance, attitude problem relating to respect for intellectual property and non-deterrent punitive provisions in the old Copyright Act of Malawi. Likewise, the 2014 Report on the Access to and the Use of Information Communication ICT services conducted by the National Statistical Office (NSO) in 2013 showed that 72 percent of Malawians owning a mobile phone were in urban areas. The report also showed that about 8 percent of individuals in Malawi had ever used mobile money services, majority of these were in urban areas at twenty seven percent (27 percent) compared to five percent (5 percent) in rural areas. The increase of affordable and cheap mobile phones in urban areas may therefore increase potential pirates who may subconsciously share copyright works via different social media platforms.

The Impact of Piracy on Music and Recording Industries

Many research findings have shown that rampant piracy has serious economic implications reaching far beyond the lost revenue of the stealing itself. For example, the Institute of policy Innovation study projected losses from illegal downloading worldwide to US recording companies at US$3.7 billion by August, 2007 (Kennedy, 2008). The Record Industry Association of America (RIIA) proved the effects of technology on the music industry by showing on their website the fall in the overall size of the sound recording industry in the last 10 years. For instance, in 1999, its size was $14,584.5 billion and in 2008, it was only $8,480.2 billion. Moreover, between 2004 and 2009, it is said that 30 billion songs have been illegally downloaded. Therefore, the Record Industry Association of America estimates that piracy causes an annual harm of $12.5 billion in losses to the United States only. Moreover, the Institute for Policy Innovation pegs

more than 70,000 lost jobs and $2 billion in lost wages to American workers (Dleck,

In Malawi as well as in most LDCs, there are no statistical data to establish the economic impact of technology advancement on piracy. However, the musicians involved in the present lamented that their music had suffered a great loss of money due to pirate activities such as coping, downloading, sharing and uploading of their music on the internet. As such they found it hard to pay their band members, producers of their sounds and other stakeholders involved in the production and distribution of their music resulting from failure to recoup investment made for the production of their music due to piracy. It is sad to report that some musicians had threatened to quit the music saying they were making losses and could not withstand the heat of piracy and it had reduced the incentive to continue to create new expressions. For instance a certain musician revealed that he bought a car and a house using proceeds from his first album which he released in 1995 but cannot achieve the same today, despite growth in the number of customers. And some musicians explained that they had remained in music industry because they were pressured by their fans and that they had no any alternatives other than maximizing their income potentials through live shows. Like army worms in the field of maize, piracy has not only pushed musicians out of business but also music distributors. For example, the only reliable music distributor in the country, O.G. Issa quit the business succumbing to piracy. He also revealed that instead of the usual ninety thousand music CDs he used to sell, he only sold eight thousand (CDs in 2013.

On a positive note, it is of significant importance to mention that Malawi has a new Copyright Act which brings the country's copyright law into line with current international intellectual property standards. The law introduces new provisions on online licensing to ensure that artists are paid for the expanding use of their creative works, including, for example, in ringtones, and online platforms (Jewell, 2017). It is hoped that once the new Act would provide solutions to some of the challenges faced by rights holders in Malawi.

Measures Taken by Some Governments so Meet the Challenges of Digital Piracy in the Digital Environment

In recent years more countries have introduced provisions on enforcement and Internet Service Provider's (ISP) liability in their national laws. The recent ones include the following: Firstly, there are Graduated Responses

that lead to suspension of accounts with repeated infringements. This model is current in force in France, United Kingdom, New Zealand, Taiwan and South Korea. Secondly, In the United States, the Centre for Copyright Information (CCI), an industry body comprised of representatives of rights holders and ISPs, established by a voluntary industry agreement called the Copyright Alert System. The Copyright Alert System is a scheme where rights holders send notices of alleged copyright infringement to participating ISPs. The ISP matches the allegedly infringing internet protocol (IP) address with the relevant subscriber and sends the subscriber the appropriate copyright alert (Kimberly, 2010).

The United Kingdom adopted a similar approach called Creative Content UK In July 2014. This is an industry agreement between rights holders and ISPs to forward educational notices to internet users whose accounts are being used for online copyright infringement. It is a campaign to inform and educate the public about copyright issues and the notices will focus on educating consumers about how they can access legitimate content.

Although it has been discussed in the afore-mentioned paragraphs that the rampant problems of music piracy have emerged due to technological development, Borland (2010) argued that the same new technology could help to squelch music piracy. Ham and Atkinson (2008) highlighted that several industry consortiums, including the Copy Protection Technical working Group (CPTWG), the Digital Video Broadcasting Project (DVB), the Moving Pictures Experts Group (MPEG), and many others were actively working on effective content protection technology for a variety of media. Such cooperative efforts were a key part of making piracy more difficult. Some of the copy protection measures include encryption, watermarking and spoofing. For instance, most countries in Europe, North America and Asia have adopted the Digital Rights Management (DRM) systems to prevent pirates from making unauthorized copies. DRM ensures that complete uncrackability is neither achievable nor necessary. Of course this requires cooperation between the content and the technology industries. However, some people, especially researchers and educators have argued that locking up content behind airtight technological walls would make those legitimate use much more difficult and anger consumers who have come to expect through decades of use that they will be allowed to make copies under certain circumstances (Fair Use Doctrine). In addition, such measures tend to raise the price of content for law-abiding consumers (ibid).

In Malawi, COSOMA and MAM have not been left behind in the combat against piracy. The findings of the present research have shown that MAM usually advises its members to get registered with COSOMA so that they

could enjoy the benefits of the hologram that the Society fixes on original CDs of the registered Malawian artists. Likewise, the Association discourages its members from duplicating original CDs unnecessarily. The findings have also shown that COSOMA had put in place a number of strategies in a bid to combat piracy in Malawi. In addition to the aforementioned measures, the law enforcement body had launched a public awareness program on copyright issues, mounting piracy raids, prosecuting of infringers, training of law enforcement agents and review of copyright laws just to mention a few. Furthermore, the study has shown that the Society works hand in hand with MAM as well as producers of sound phonogram. MAM works as the whistle blowers and participate in some of the strategies to combat piracy.

In a positive development, the last decade has seen the birth of some private-owned online stores which promote Malawian music by encouraging users to legally purchase Malawian Music. One good example of such a store is the one launched by the Malawi Arts Production and Marketing Cooperative (APMC). APMC launched an online digital arts store for buying and selling of digital music, literature, photos, video, games and applications. The Store was established to provide alternative distribution for artistic products thus curbing piracy in the process. It also provides a means for artists to generate income (Nyondo, 2018). Another example of an online music store is Music from Malawi. On this platform, artists across the country legally submit their songs so that users can download, stream or buy their music according to their listening pleasure. The two websites work hand in hand with COSOMA and MUM to promote Malawi culture and artistry across the globe (www.malawi-music.com). Similarly, the producers are involved in funding anti-piracy activities as well as in testifying in court. Lastly, thriving piracy racket in Malawi has forced musicians to pursue other forms of getting their product to the buyer. For example, a new trend has developed in Malawi that has seen more and more musicians cutting out the middle man and selling their CD on the street. The new strategy seems to have been working for most artists because cutting out the middle man has brought the price of the CD down and the appeal of buying the product directly from the musician has driven street sales. City authorities, however, have been expressing concern about noise pollution as the musicians use loudspeakers to advertise.

Conclusion

The discussion has shown that the rampant problem of digital piracy has not spared copyrighted works in Malawi and that music industry is the one that has been hit the hardest. The vexing part is that pirates trade

peacefully without blame. The growth of download and sharing of music are key to the decrease of music sales in Malawi since the advent of digital technology. This behavior has led to the decrease in the sales of CDs on the market. Moreover, the internet has changed the logic of consumption and the process of producing music in the country. Likewise, the study has revealed that even though the majority of the pirates may subconsciously share copyrighted musical files, there are also others who are aware of the implications of their behavior especially on the growth of the music industry in Malawi. For instance, they are aware that musicians whose music have been hit by piracy suffer a great loss and fail to recoup the expenses incurred before, during and after the production of their works. In the long run, it is the nation which is affected economically and culturally as most musicians become discouraged and seek greener pastures elsewhere. The discussion has also shown that measures employed by COSOMA and other stakeholders are not well enough to fight music piracy which has become blatant in Malawi. The study suggests anti-piracy measures that can help to effectively enforce copyright in the digital environment. For example, intellectual property courses should be introduced in institutions of higher learning and secondary schools so that users should learn and appreciate the importance of copyrights. In the long run, they will learn to respect literary and artistic works at a tender age. Secondly, the government should also take its stand in a war to fight against piracy in Malawi by supporting some anti-piracy groups materially or financially. In that way the war against piracy will be won. Likewise, Malawian artists should embrace the new copyright law which sets the scene for Malawi's creative sector to take full advantage of the opportunities of the digital age, bringing the country's copyright law into line with current international intellectual property standards. Lastly, the African Regional Intellectual Property Organization (ARIPO) should adopt Demand Side Anti-Piracy Policies and Supply Side Anti-Piracy Policies as practiced in Sweden and Belgium respectively as well also the Notice Take Down and Graduates Responses approaches as practiced in United States and in Europe respectively in order to effectively enforce online copyright infringements. Demand Side Anti-Piracy Policies are those that focus on enforcement by targeting individuals engaged in illegally downloading copyrighted works either with penalties for said illegal behavior or with positive incentives for legal consumption. Supply Side Anti-Piracy Policies on the other hand involve targeting sites or protocols that supply access to pirated content. In this view, sources of copyright infringing files can either be shut down entirely or blocked in a given region (Danaher, 2015).

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THE SCOPE OF ECONOMIC RIGHTS IN CASE OF ASSIGNMENT OF A WORK OF VISUAL ART: CASE LAW COMMENT

*Francois Xavier Kalinda**

Abstract

The issue of assignment of economic rights in a work of visual art has drawn attention of Rwandan artists following the decision of the Supreme Court of Rwanda in Bushayija v. COGEBANQUE SA (SCR, 06/08/2010, R.COM.A 0014/08/CS). This is the first case of intellectual property held by the Supreme Court of Rwanda since its creation in 1963. This case law seeks to provide a useful and effective way to exploit a work of visual art and prevent others from taking undue advantage of the copyright owner's investment. The case explores specifically the scope of economic rights of a copyright holder especially in case of assignment of a work of visual art. The issue of originality of copyright is approached from a comparative perspective to reflect different conceptions of copyright. The question of the property right in a copy of work and the copyright in that work, especially a work of visual art is also addressed. Also, the issue of normal exploitation of the work that doesn't prejudice the legitimate interests of the right holder is considered.

Keywords

intellectual property, copyright, originality, economic rights, work of visual art

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Introduction

The issue of assignment of economic rights in a work of visual art has drawn attention of Rwandan artists following the decision of the Supreme Court of Rwanda in *Bushayija v. COGEBANQUE SA (*SCR, *06/08/2010,* R.COM.A 0014/08/CS). Although Rwandan courts have already ruled on some cases of intellectual property before, this is the first case of intellectual property held by the Supreme Court of Rwanda since its creation in 1963.

This may look surprising but the lack of case law in intellectual property law during all these years can be explained by the fact that Rwanda, like many other developing countries, has little experience in intellectual property protection. Although Rwanda has had some legal texts on intellectual property during post-colonial times, these texts were not appropriate to effectively protect owners of intellectual property rig hts and were not in line with international agreements and conventions to which Rwanda is a signatory. As of now Rwanda is a signatory to the following international and regional legal instruments in the field of intellectual Property: the Berne Convention for the Protection of Literary and Artistic Works, the Paris Convention for the Protection of Industrial Property, the Convention establishing the World Intellectual Property Organization(1967), the Agreement establishing in the World Trade Organization (WTO) and the Agreement on Trade-Related Aspects of Intellectual Property (TRIPS Agreement), the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, the Hague Agreement Concerning the International Registration of Industrial Designs, the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, the Lusaka Agreement on the Creation of the African Regional Intellectual Property Organization (ARIPO), and the Harare Protocol on Patents and Industrial Designs Within the Framework of the African Regional Industrial Property Organization (ARIPO).

In recent times, the Government of Rwanda has embarked on a major reform of its business laws to create a more favourable environment for business. It is in this context that a comprehensive law on intellectual property was passed in 2009, i.e. the Law n° 31/2009 of 26/10/2009 on the protection of intellectual property (*OG* no 50 *bis* of 14/12/2009). This law constitutes the primary source for judges to handle issues of intellectual property. The case that is subject to the following comment was decided during the previous Law No 27/1983 of November 15, 1983 governing Copyright (OG 1984) before it was repealed and replaced by the Law No 31/2009 governing intellectual property. The case is identified in this article as *Bushayija v. COGEBANQUE SA.*

Facts and Procedure

This case commenced in the Commercial High Court in 2007 where Mr. Bushayija was suing CONGEBANQUE SA for infringing his copyright in an artistic work, that is a visual art in the field of painting. CONGEBANQUE SA, a commercial bank registered in Rwanda ordered from HOME DESIGN SARL, a company dealing in artistic works, a work of visual art meant to be displayed in the office of the Chief Executive Officer (CEO). HOME DESIGN SARL hired Mr Bushayija, a renowned artist in Kigali to realize this work of art. Few days after delivery of the ordered work Mr. Bushayija came to realise that COGEBANQUE SA was using the artistic work not only as an office decoration, but also has copied the work in its chequebooks and diaries for distribution to its customers. Mr. Bushayija who was not happy that COGEBANQUE SA was using the artistic work contrary to the initial agreement filed a case in the Commercial High Court to obtain an injunction to stop the act of illegal reproduction of his work and seek for compensation.

In its ruling, the Commercial High Court held that, by reproducing the artistic work in its chequebooks and diaries for distribution to its customers without the consent of the author, the respondent has violated the copyright recognised to the author of the work. The Commercial High Court ordered COGEBANQUE SA to stop the act of reproduction and pay to the applicant an amount of Rwf 30 million as a compensation for the prejudice suffered.

The Commercial High Court's ruling was appealed to the Supreme Court; the latter [Supreme Court] was asked whether the plaintiff's work was original; whether the author retains ownership of the work after having sold it; whether COGEBANQUE SA had used the work for commercial purpose and whether the compensation was justified.

The Issue of Originality in Copyright

The Supreme Court held that the plaintiff's work was original because article 1 of the law No 27/1983 of November 15, 1983 governing Copyright (OG 1984) defines “original work” as a work which, in its characteristic features and in its shape, or in its shape only, allows to individualize its author.

The Court recognised the ownership of the work to Mr. Bushayija basing on article 34 of the above-mentioned law according to which the person whose name or pseudonym is indicated on the work in a manner that leaves no doubt as to his/her identity is the author. Since the work in question bears the name Bushayija in its lower right corner, there's no doubt about the identity of its author, according to the court.

It should be noted that this criterion of originality is derived from the French concept of originality according to which, the original work must bear the imprint of the personality (l'empreinte de la personnalité) of the author. Nevertheless, the concept of originality may differ from country to country.

In the common law countries like the UK, the copyright protection is based on how much labour and diligence it took to create a work, rather than how original a work is. In this perspective the criterion of protection is relatively low; it is enough that the author has expended "skill, judgement and labour" in creating the work (Jon Holyoak and Paul Torremans, 1995). Therefore, originality presupposes the exercise of substantial independent skill, labour, judgment and so forth (Bridgeman Art Library, Ltd. v. Corel Corp. (1999)). In the UK, courts have long since decided that it is sufficient that the work is not copied and originates from the author (Ladbroke (Football) v William Hill (Football) Ltd (1964); University of London Press v University Tutorial Press Ltd (1916).

In the United States, the criterion of originality for copyright protection was invoked in the ruling of the United States Supreme Court in Feist Publications v. Rural Telephone Service (111 S.C.T. 1282 (1991)). This case law has rejected the old doctrine of the "sweat of the brow" and held that the author must demonstrate a minimum of creativity.

Despite these different conceptions of copyright, it is generally accepted that originality is not novelty (J. H., Albert E. Elsen and Stephen K. Urice, 2007, p. 509). Two people might paint the same landscape and realize quite similar works, and both would meet originality requirements provided that they have worked independently. The landscape being an idea, it belongs to the public domain and therefore cannot be appropriated. Hillary Ballon and Mariet Westermann summarize the subject matter of copyright as follows: "[C]opyright protects the expression of an idea (visual or otherwise) rather than the idea per se, and in that it is meant to safeguard the actual and potential commercial value of an artistic work for its creator, for a legally specified period" (Hillary Ballon and Mariet Westermann, 2006).

The Question of Whether the Author Retains the Right to Control the Use of the Work after Having Sold It

The Supreme Court, basing on article 53 of the law No 27/1983 of 15th November 1983 on copyright, held that the author doesn't lose the ownership of the work following the sale thereof.

Article 53(4) provides that: "The transfer of ownership of the single or multiple copies does not constitute a transfer of copyright in the work". This provision raises the question of the property right in a copy of a work and the copyright in that work, especially a work of visual art. The two types of rights being different, it should be stressed that, in copyright philosophy, the simple possession of an object containing or representing a work (for example a book) or a copy of such a work does not by itself give any right under the copyright law.

This principle can be applied to works of art like paintings as the sale of a painting does not automatically assign the copyright to the purchaser (David I. Bainbridge, 2010, p. 104).

Scholars are of the view that:

> The transfer of a material object (...) does not carry with it the underlying copyright. One who purchases a work of art, therefore, does not gain the exclusive rights to reproduce the work or prepare derivative works based on it" (John Henry Merryman, Albert E. Elsen and Stephen K. Urice, *2007*, p. 528).

The author keeps the copyright (reproduction right, right in performances, right to assign or license the work) while the holder of the copy retains the right to sell his copy (J. Gainsbourg, 1994, p. 811). In principle, the purchaser of the copy of a work is the owner while, unless otherwise specified, only the author or his heir is entitled to the exercise of economic rights (J. Gainsbourg, 1994, p. 811.). The author may assign the original copy of his work (the painting) without transferring the rights to exploit the work (for example the reproduction right). He/she can also sell the rights to exploit the work, partially or wholly, even if he no longer possesses the copy of the work. This means that the copyright is divisible; any of the exclusive rights that is comprised in the copyright can be transferred and owned separately (John Henry Merryman, Albert E. Elsen and Stephen K. Urice, *2007,* p. 528).

In *Bushayija v. COGEBANQUE SA* the purchaser (COGEBANQUE SA) has

acquired the property in the physical object (the painting). He is vested with the real right in the object: he may sell, exchange, give it away for free or against another property, or accomplish any other act "which do not conflict with a normal exploitation of the work and do not unreasonably prejudice the legitimate interests of the right holder" (Daniel J. Gervais, 2005). For example, he may display the painting publicly, but in the absence of any form of transfer of copyright in the work (through assignment or license), there is no copyright. In the absence of any other agreement about the use of this work, it means that means that the author has reserved all rights of reproduction and all copyrights in the work, including any incidental works made in the creation of the work (Tad Crawford, 2010, p. 123). Therefore, the act of reproduction which is the most important economic right in copyright can be assigned only in a written form (Law No 27/1983 of 15th November 1983 on copyright, art. 53). The assignment contract shall be valid only if it is signed by parties to the contract.

Article 53(3) of the law No 27/1983 of 15th November 1983 on copyright provides that the partial or total transfer of economic rights in the work to carry out any act of economic rights is limited to the modalities of exploitation provided for in the contract. The rights that the author does not mention in the contract are explicitly reserved to himself. A similar provision appears in the current Law No 31/2009 of 26/10/2009 on the protection of intellectual property under article 230 (*OG* n°50 bis of 14 December 2009):

> The assignment contract of economic rights on the work to carry out any act of economic rights use shall be limited to certain acts and specific kind of use or include certain restrictions to the plan of purposes, the aim of use, the duration of use, the scope and territorial extend and the

The Question of Whether COGEBANQUE SA Has Used the Work for Commercial Purposes

Certain acts accomplished on the work do not require the authorisation of the copyright owner and do not attract compensation in favour of the author. The law No 31/2009 on the protection of intellectual property provides a certain number of limitations to economic rights, such as:

- Private reproduction for personal purposes (art. 203);
- Temporary reproduction (art. 204) ;
- Free reproduction in the form of quotation (art. 205)
- Free reproduction for teaching (art. 206);

- Free reprographic reproduction by libraries and archives services (art. 207);
- Freedom of reproduction for judicial and administrative purposes (art. 208);
- Free use of works for informatory purposes (art. 209);
- Free use of pictures of works located on public places (art. 210);
- Free reproduction and adaptation of computer programs (art. 211);
- Free ephemeral recording by broadcasting organizations (art. 212);
- Free public performance (art. 213) ;
- Free importation of a work for personal purposes (art. 214);
- Free reproduction of the work for visually impaired persons (art. 215).

Any other act accomplished outside these limitations requires authorisation from the copyright holder, especially when the act intended is for commercial purpose.
In *Bushayija v. COGEBANQUE SA*, the court considered that the author of the work is invested with exclusive rights to:

1) Prevent others from using his work without his authorisation; and
2) Allow third persons to accomplish one of the acts specified under article 9 concerning economic rights of the author.

Therefore, if one wishes to use an image of a copyright-protected work of art for commercial purpose, he/she may obtain the authorisation of the copyright holder.

To know if a work is used for commercial purpose, one should examine if the user targeted a commercial interest or has taken any commercial advantage from the work. In this occurrence, COGEBANQUE SA has acquired the right to display the copy of the work in the office of the CEO as it was mentioned in the contract. Therefore, copying the work realized by Mr. Bushayija on its chequebooks and diaries and selling them to its customers constitutes undoubtedly a commercial behaviour since the diaries are distributed to customers (and potential customers) to market the company. Likewise, the chequebooks sold to the customers of the bank provide the latter with a commercial interest. The Supreme Court did not attempt to determine the amount of sales, but it has established that COGEBANQUE SA has been selling chequebooks bearing the reproduction of the respondent's work for five years.

The Question of Whether the Compensation Was Justified

In his appeal COGEBANQUE SA contested the amount of damages awarded to Mr. Bushayija alleging that it was not justified. In intellectual property, like in civil law, the question of compensation is a matter of fact. The holder of any right protected whose right has been infringed shall be entitled to compensation by the infringer. The compensation is determined taking into account the importance of the prejudice suffered by the owner of the right and the importance of the infringer's profit. This is the application of the general principle of tort (art. 258 the Civil Code, Book III: Decree of 30 July 1888 governing Contracts or Contractual Obligations (*B.O*. 1888, p. 109)). In order for a copyright lawsuit to succeed, the plaintiff must prove that he/she is the owner of the copyright in the work and that the work has been illegally copied by the defendant.

In copyright infringement, damages might be assessed as the amount of royalties the copyright owner would have secured had the infringer obtained and paid for a licence to perform whatever the infringing act was. Another way of calculating the quantum of damages might be based on the profit the copyright owner would have derived from sales lost as a result of the infringement (David I. Bainbridge, *2010*, p. 184).

As it has been ruled by Lord Wilberforce in *General Tire & Rubber Co v Firestone Tyre & Rubber Co Ltd* [1975], p. 819:

> As in the case of any other tort...the object of damages is to compensate for loss or injury. The general rule at any rate in relation to 'economic' torts is that the measure of damages is to be, so far as possible, the sum of money which will put the injured party in the same position as he would have been in if he had not sustained the wrong.

In *Bushayija v. COGEBANQUE*, the plaintiff was claiming the payment of Rfw 100,000,000 (about USD 115,665) as the equivalent of the chequebooks allegedly sold by COGEBANQUE SA to its clients for a period of five years. The Commercial High Court held that the claimant should prove the quantity of illegal copies realized by the infringer and sold to its customers.

Even though this ruling seems to be in conformity with the general principle of civil and commercial procedure according to which the burden of proof of the amount of the prejudice falls to the claimant, it should be unfair to require the claimant to prove the quantity of chequebooks produced and distributed by his opponent. This is quite

impossible since the claimant was not the bank's agent (*probatio diabolica*). In such a situation, the burden of proving the quantity of chequebooks effectively produced should rather fall on the defendant, i.e. COGEBANQUE SA. The Supreme Court should have held that where a party to civil proceedings is facing an impossible evidence, the remedy shall be to reverse the burden of proof or give additional rights to the individual facing the *probatio diabolica*, for example in this case, to authorise investigation in the bank.

The Supreme Court held that the unauthorised reproduction of the claimant's work caused a loss to the latter who is entitled to compensation as per article 258 CC Book III. Consequently, the Court allocated a compensation of Rwf 30,000,000 (about USD 34,682) determined *ex aequo et bono, i.e.* according to principles of what is fair and just (without taking into consideration the quantity of infringing copies of chequebooks sold). In my view, this way of computing damages, which is current in Rwandan courts, should be revisited to reflect the true prejudice suffered. In most cases, the courts simply say that the damages sought by a party to the proceedings are very high, and must be determined *ex aequo et bono*. I therefore agree with the opinion that the way of calculating the quantum of damages might be based on the profit the plaintiff would have derived from sales lost as a result of the infringement (David I. Bainbridge, 2010).

Conclusion

As it has been ascertained by the court in *Bushayija v. COGEBANQUE SA,* copyright provides a very useful and effective way to exploit a work economically and to prevent others from taking undue advantage of the copyright owner's investment. The copyright owner has a legitimate right over the potential commercial value of his/her creative endeavours. The Supreme Court, as the apex court of law of the country, has created a precedent in the protection of exclusive rights of the copyright holder.

Despite the little experience of Rwandan judges in intellectual property, this case law has created awareness of copyright users about the importance of the protection of intellectual property and the economic gains that accrue from it. It is interesting to note that after the *Bushayija v. COGEBANQUE SA* case, the number of decided cases of intellectual property has significantly increased (see for example: *Kayirebwa Cecile v ORINFOR, City Radio and others*, HCC, 15/2/2013, R.Com 0178/12/HCC; *Bakhresa Grain Milling (Rwanda), Ltd v Mikoani Traders, Ltd*, HCC, 20/10/2016, RCO MA 0027 6 / 20 16 / CHC/ HCC; *Madios, Ltd v BIC*, HCC, 09/09/2016, RCOMA 00319/2016/CHC/HCC). There is no doubt that, as Rwanda has embarked on a major reform of its business laws to

create a more favourable environment for business, the role of the court in the protection of intellectual property rights will keep growing.

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