

NEWS FROM AFRICA

LAURIER YVON NGOMBE

Doctor of Law

Legal counsel

Lecturer¹

Between 1 August 2016 and 31 December 2018, there were a number significant developments in African copyright law.² Major texts were adopted at both supranational level and in individual states (I). Case law, increasingly accessible and abundant, looked at various, sometimes recurring questions. The selection offered below relates to cases concerning a multitude of topics: originality of architectural works, remit and powers of collective management organisations, proof of ownership, confrontation between copyright law and other fundamental rights and freedoms, online sale of phonograms, conflicts of jurisdiction, scope of copyright registration, etc. (II).

1. Counsel at the Paris Court of Appeal, Lecturer, CNAM – Ile de France.

2. The author would like to thank Roger Mabouana for his invaluable aid.

I. LEGISLATION AND SUPRANATIONAL TEXTS

We will look firstly at texts adopted at supranational level by regional or subregional organisations and secondly at national texts.

A. SUPRANATIONAL TEXTS

For the period covered here, three texts merit a mention. The first two are from the African Intellectual Property Organization (OAPI) and relate to mediation and arbitration. These texts will be discussed taking into account the context of institutional and normative coexistence with the Organization for the Harmonisation in Africa of Business Law (OHADA).³ The fourth text relates to audiovisual works, and was adopted by WAEMU (West African Economic and Monetary Union).

1. Mediation regulations of the OAPI arbitration and mediation centre⁴

In resolution no. 56/23 dated 7 December 2016, OAPI adopted a set of mediation regulations. These regulations supplement the list of legislative texts and arbitration regulations available to litigants in OAPI member states. As sixteen OAPI member states are also members of OHADA, it is pertinent to present the OAPI text while taking into account the OHADA text.

3. On this issue, see L.Y. Ngombé, *OHADA versus OAPI. Lecture transversale et partielle: Revue Africaine de la Propriété intellectuelle [OAPI]*, no. 4, December 2013, p.31. – R. Kiminou, *L'OHADA et l'intégration des droits de propriété intellectuelle de l'OAPI. De l'art d'intégrer des droits intégrés: RRJ* 2016, no. 3, p.1363.

4. For more on the arbitration and mediation centre, see *RIDA* no. 250, October 2016, p.198.

The OHADA Uniform Act defines mediation as: “*any process, regardless of its name, whereby the parties request a third person to assist them in their attempt to reach an amicable settlement of their dispute, adversarial relationship or disagreement (“the dispute”) arising out of a legal or contractual relationship, or related to such relationship, involving natural persons or legal entities, including public bodies or States*”.⁵

Article 1 of the OAPI regulations tersely states that mediation “*refers to any extrajudicial dispute resolution procedure aimed at helping parties settle their dispute amicably, involving a mediator who ensures that the procedure runs smoothly*”.

The general nature of the OHADA text allows any parties wishing to settle a dispute amicably to avail of mediation pursuant to this text, including disputes relating to intellectual property. The OHADA text provides that parties opting for institutional mediation must sign up to the regulations of the institution chosen.⁶ This provision is in perfect harmony with the OAPI regulations, which provide that “*Where a mediation agreement provides for mediation under these rules, these rules shall be deemed to form part of that mediation agreement [...]*”.⁷

Like any form of mediation, OAPI institutional mediation presupposes agreement by the parties. Article 2.1 provides that *mediation is implemented at the request of either party and accepted by the other party*. Agreement by the

5. Article 1 of the Uniform Act on Mediation.

6. Article 3 of the Uniform Act on Mediation.

7. Article 2.3 of the OAPI Mediation Regulations.

parties can result from a contractual clause or an agreement after a dispute arises. Mediation at the OAPI centre therefore seems the only conventional route to mediation.

In fact, reading another provision in this text, it appears that this institutional mediation can be proposed at any time during arbitration proceedings.⁸ This provides a sort of gateway between arbitration and mediation. The OHADA text also provides the option of mediation at the invitation of a court.⁹ Even though the OAPI text does not mention this option, the condition required for referral to the mediation centre could be considered met insofar as the parties have accepted an invitation by a court.

Thus, the application of these two texts means that mediation can take place at any time, even where legal proceedings are under way. However, disputes are referred to the centre by one or both parties. This is stated in article 4 of the OAPI regulations.

As with most legislation, to encourage the amicable settlement of disputes, the mediation procedure suspends the limitation period.¹⁰ If the mediation procedure does not resolve the dispute, the limitation period starts to run again for a minimum of six months.

8. Article 16 of the OAPI Mediation Regulations.

9. Article 1 of the Uniform Act on Mediation.

10. Article 4 of the Uniform Act on Mediation.

The fact that evidence provided during the mediation procedure is inadmissible, excluding pre-existing evidence, is one factor contributing to its effectiveness.¹¹

Where the parties have agreed to mediation prior to commencing legal or arbitration proceedings, the OHADA Uniform Act states that “*the arbitral tribunal or the state court shall give effect to this undertaking as long as the underlying conditions are satisfied.*”¹² It would seem, therefore that the existence of such a clause constitutes an exception of inadmissibility. And this, in fact contributes to the effectiveness of the mediation agreement. It is also an application of the binding force of contracts.

If the mediation is successful, the parties’ agreement is documented and signed by both parties. This document is definitively binding on the parties. The agreement thus reached may not be challenged.¹³ The same rule applies to mediation proceedings not referred to the OAPI centre.¹⁴

The OHADA Uniform Act stipulates: “*Upon joint request of the parties, the mediation agreement may be submitted for registration under the notary’s registry, with formal recognition of the submissions and signatures. The notary provides, upon request of the relevant party, an engrossment or a copy of the agreement for enforcement.*”¹⁵

11. Article 12 of the Uniform Act on Mediation.

12. Article 15 of the Uniform Act on Mediation.

13. Article 13 of the Uniform Act on Mediation.

14. Article 16 of the Uniform Act on Mediation.

15. Article 16 of the Uniform Act on Mediation.

The OAPI text specifies that the agreement shall remain confidential unless its implementation or application requires its disclosure or if the parties agree in writing to disclose certain extracts or a summary thereof. Thus, if there is a difficulty in the execution of the agreement, either party may bring legal proceedings pursuant to article 16(3) of the OHADA Uniform Act, which provides that the mediation agreement may also be subject to approval or exequatur by the competent court.

2. Arbitration regulations of the OAPI arbitration and mediation centre

Within OAPI, there are at least three supranational texts: the OHADA Uniform Act on Arbitration¹⁶ applicable in most OAPI member states (sixteen out of seventeen), the OHADA arbitration rules and the OAPI regulation on arbitration adopted on 7 December 2016¹⁷ by resolution no. 56/24.

For the same reasons as outlined above concerning mediation, arbitration rules must be mentioned taking into account the OHADA legislation on arbitration.

The OAPI regulations only concern disputes relating to intellectual property where there is a link to the OAPI zone. This link can be the domicile

16. N. Aka, A. Fénéon and J.M Tchakoua, *Le nouveau droit de l'arbitrage et de la médiation en Afrique (OHADA)*, LGDJ 2018.

17. N. Binctin, *Le règlement d'arbitrage de l'OAPI. L'Essentiel Droits africains des affaires*, 2017 – no. 06, p. 1.

or residence of at least one party or can be the execution, even partial, of a contract.¹⁸

The OHADA Uniform Act provides as follows: “This Uniform Act shall apply to any arbitration when the seat of the arbitral tribunal is in one of the States Parties.” This means that the scope of application of the OHADA text does not exclude intellectual property. Therefore, all of these texts need to be articulated.

Beyond this aspect, the OAPI regulations will be briefly presented, with discussion of issues of arbitrability, arbitral jurisdiction, procedures and remedies.

The arbitrability of disputes relating to intellectual property rights is clearly indicated in the Bangui Agreement, at least in the text currently being ratified.¹⁹ Be that as it may, the various texts currently in force in OAPI member states allow for the arbitrability of disputes. Most of these States are also OHADA member states. The Uniform Act on Arbitration provides as follows: “*Any natural or legal person may resort to arbitration with respect to any rights that may be freely disposed of.*”²⁰

The very adoption of an arbitration regulation by OAPI testifies to this arbitrability. The OAPI arbitration regulations stipulate as follows: *disputes relating to intellectual property rights must be capable of being subject to*

18. Art. 2 of the OAPI arbitration regulations.

19. Annex VII (art. 4.1) of the Bangui Agreement (1999).

20. OHADA – Uniform Act on Arbitration (art. 2).

arbitration. This could be read as implying that certain intellectual property rights cannot be subject to arbitration. It would therefore exclude intellectual property rights whose holders are not free to dispose of them. In terms of literary and artistic property, these are moral rights.²¹

The OHADA Uniform Act and national laws relating to civil procedure provide the option for parties to opt for *ad hoc* arbitration or institutional arbitration. The OAPI text offers litigants within its purview the option to avail of specifically adapted institutional arbitration should they wish.

The OAPI arbitration regulations provide that the place of arbitration is determined by the arbitration agreement or is agreed by the parties at a later stage. The default seat is in Yaoundé but the tribunal can adjudicate in any location.

Article 10 of the arbitration regulations provide the option to join arbitration procedures where there are various applications regarding the same contract, or if the parties so agree or again if the disputes arise from the same legal relationship.

If urgency is demonstrated and if the parties agree, the centre can set up a fast-track procedure. The application for this must be made before the tribunal is set up.

21. See B. Oppetit, *L'arbitrabilité des litiges de droit d'auteur et de droits voisins*, in *Arbitrage et Propriété Intellectuelle (Colloque IRPI 1994)*, Librairies techniques 1994, p.121.

In addition to the fast-track procedure, the text also provides for emergency arbitration, in terms similar to the CCI regulations.²² Any party seeking conservatory or protective measures that cannot wait for the arbitral tribunal to be set up can apply for this.

Emergency arbitration does not prevent the parties from seeking conservatory or protective measures or emergency measures before the competent judicial authority. This thus forms a sort of ‘gateway’ between extrajudicial proceedings and judicial proceedings. In this scenario, the court ruling is notified to the centre (article 31). The regulations do not stipulate by whom. It can be assumed that the obligation is incumbent on the party that referred the matter to the court. The regulations further stipulate that referral to the judicial authority does not contravene the arbitration agreement and does not constitute a waiver thereof.

In the same spirit, the OHADA Uniform Act provides as follows: “the existence of an arbitration agreement shall not prevent a court, upon request of one party, in the event of recognised urgency or where the measures shall be executed in a State which is not a party to OHADA, from ordering interim or conservatory measures, as long as this does not involve the hearing on the merits of the substantive dispute, over which the arbitral tribunal has exclusive jurisdiction.” (article 13 *in fine*).

Under the terms of the OAPI regulations and in line with conventional rules in this field “[t]he parties shall be free to agree upon the rules of law to

22. CCI Arbitration Rules, art. 28.

be applied by the arbitral tribunal to the merits of the dispute. In the absence of any such agreement, the arbitral tribunal shall apply the rules of law which it determines to be appropriate”.²³ This leaves the arbitral tribunal some room for manoeuvre. However, the regulations also specify that “in any event, the arbitrator shall apply the provisions of the Bangui Agreement relating to the protection of intellectual property, where rights conferred by OAPI are at issue”.

Under the terms of the OHADA Uniform Act, an arbitral award is not subject to opposition, or to appeal in a court of appeal or the highest appellate court. It may be subject of an application for annulment filed before the competent judge in the State party. However, the parties may agree to waive the remedy of application for annulment of the arbitral award provided it is not contrary to international public policy. The decision of the competent judge in the State Party shall only be appealable before the Common Court of Justice and Arbitration.

Choosing institutional OAPI arbitration implies waiving the remedy of annulment because the article 36.6 of the OAPI text stipulates that *every award shall be binding on the parties. By submitting the dispute to arbitration under the Rules, the parties undertake to carry out any award without delay and shall be deemed to have waived their right to any form of recourse.*

23. CCI Arbitration Rules, art. 21.1.

3. WAEMU directive on legal deposit of audiovisual works

Under the “Digital Capital” project set up by the International Organisation of La Francophonie with support from the European Union and the ACP Group of States (African, Caribbean and Pacific States), work on this project started in 2015. It led to the adoption of a directive on 21 September 2018 by the statutory Council of Ministers of the West African Economic and Monetary Union. member states of WAEMU²⁴ are also member states of OAPI.

This text, which must be transposed in the member states within two years establishes legal deposit and sets up the obligation preserve audiovisual works. The National Audiovisual Institute (France) is supporting WAEMU in implementing this project to preserve some of the cultural heritage of member states.

B. LEGISLATION AND NATIONAL TEXTS

The texts of OAPI member states will be differentiated from those of the ARIPO zone.

1. OAPI zone

Within the OAPI zone, two texts merit a mention here. These are the Benin Digital Code, enacted in 2018, and the new Côte d’Ivoire Copyright Act, published in October 2016.

24. Burkina Faso, Côte d’Ivoire, Mali, Senegal, Togo, Benin, Niger.

a) Law no. 2017-20 establishing a digital code in the Republic of Benin (Benin Digital Code)

The Benin parliament adopted a digital code on 20 April 2018. This particularly dense text governs all digital-related activities. It includes rules regarding personal data protection, online selling, cyber security, liability of internet players, etc. Concerning intellectual property in general and copyright in particular, three points merit attention:

- general provisions on the enforcement of intellectual property rights
- provisions on liability
- criminal provisions on intellectual property

a.1) General provisions on the enforcement of intellectual property rights

Like a number of African laws on electronic commerce,²⁵ the Benin Digital Code contains many provisions reiterating the requirement for various e-commerce players to respect intellectual property rights.

In a chapter on dominance and competition, the new Benin Digital Code sets out the requirements for “dominant operators” under the supervision of

25. See for example art. 44(2e) of Congolese law 9-2009 of 25 November 2009 regulating the electronic communications sector. See also art. 3 of Algerian law 18-05 of 10 May 2018 on electronic commerce.

the regulatory authority.²⁶ When deciding whether to impose obligations on a dominant operator, the regulatory authority takes account of any intellectual property rights.²⁷

The code also stipulates the obligation to respect intellectual property rights of domain names. Domain names are allocated and managed in full compliance with intellectual property rights.²⁸ Non-compliance with copyright law constitutes an obstacle to the allocation of a domain name.

a.2) Provisions on liability

While in many respects the liability provisions of the Benin code are similar to those in the 2000 European directive, the LCEN law and the laws of a number of African countries such as Senegal,²⁹ Cameroon³⁰ or Burkina Faso,³¹ several provisions stand out.

The text distinguishes between specific and general rules. The specific rules relate to online service providers and internet access providers.

26. Article 145 provides that “any operator of significant power on a services or grouped services market with at least 25% of the volume or value of that market, can be declared dominant”. The text goes on to say that dominance is assessed in terms of an operator’s capacity to influence the market, its capacity to act independently of its competitors or the control it exercises over the means of access available to end users.

27. Art. 148 of the Benin Digital Code.

28. Art. 211 of the Benin Digital Code.

29. Act no. 2008-008 of 25 January 2008 on electronic transactions.

30. Act no. 2010/013 of 21 December governing electronic commerce in Cameroon. - On Cameroon and Senegal, see J. Fometeu, *La responsabilité des intermédiaires techniques dans l’utilisation en ligne des objets protégés. Revue africaine de la propriété intellectuelle [OAPI]* no. 4, Dec. 2013, p.25, for a brief overview of the Cameroon law, see L.Y. Ngombé, *News from Africa: RIDA* no. 233, July 2012, p. 156.

31. Law on electronic services and transactions in Burkina Faso.

Regarding publishers of online services, one provision in the code relates to providers of “*goods and services*”³² while others seem to concern only service providers. Article 377 relates to the liability of providers of online goods and services. These e-commerce players have a general duty of vigilance.³³ This duty cannot be interpreted as a general duty of care. Online service publishers do not, therefore, have to constantly and systematically monitor user activity. This distinction is also found in the law of 21 June 2004 relating to confidence in the digital economy (LCEN law) and in other African e-commerce³⁴ or cyber security legislation. This general duty of care relates to “content and offers provided as part of their service offerings and to user activity”. Service providers therefore have a duty of care. Providers of goods or services are required to immediately notify the police services and/or the competent government and judicial authorities if they become aware of any illegal, unlawful or suspicious activity.

With regard specifically to online service providers, articles 497 et seq. provide clarifications similar to relevant texts applicable in other African states or European states. An online service provider cannot be held liable in tort for activities or information stored at the request of recipients of its services if it was unaware of their illegal character or of events or circumstances revealing their illegal nature or if it responded promptly to remove the data or render it impossible to access as soon as it became aware of it. The same rule applies as regards criminal liability. However, the provision on criminal liability does

32. Emphasis added.

33. The text stipulates that “this general duty does not constitute a general duty to monitor information transmitted or stored by users, nor does it constitute a duty to actively seek out events or circumstances indicating illegal, unlawful or suspicious activity.

34. Art. 3.5 of the Senegalese law on electronic transactions.

not mention the “activities” of service recipients.³⁵ Under the terms of the Benin Digital Code, online service providers are presumed to be aware of the facts alleged if they are specifically notified. The information required by the Benin law resembles those provided for by the Senegalese law or the LCEN law (date, identity of the notifier, information on the law infringed, content localisation, etc.).

However, there is a difference when it comes content localisation. On this point, the Benin Digital Code provides as follows: “if possible, their precise location”³⁶ whereas the LCEN law indicates that notification must include the “precise location”³⁷ (which entails supplying the URL of the illegal content). Contrary to the law currently in force in France,³⁸ under Benin law, a service provider is held liable even if the notification informing it of illegal content does not provide precise information as to its location.

The provisions of the Benin code on the liability of internet access providers echo those of the LCEN law, the European directive of 2000 or the American Digital Millennium Copyright Act (DMCA). Internet access providers can only be held liable if the transmission of illegal content originated with them, if they select the recipients of the transmission or if they select or modify the information being transmitted.³⁹ Thus, internet

35. Compare article 496(1) (civil liability) and article 496(3) (criminal liability).

36. Article 497(4).

37. Art. 6.I.5 of the law on confidence in the digital economy.

38. See Cass. 1st civil chamber, 17 February 2011, appeal no. 09-15.857.

39. Art. 496 of the Benin Digital Code.

access providers who remain neutral⁴⁰ cannot be held liable for content that infringes copyright law being put into circulation by one of their subscribers or users.

There are specific liability regimes for caching providers, providers of hypertext links, search engine providers and hosting activities.

The case of search engines⁴¹ requires no special comment because the conditions for holding them liable are identical to those for internet access providers.

The conditions for holding hosting providers liable differ slightly from those provided in most other African texts and in the LCEN law. As in other African legislation or the LCEN law, the Benin text provides that hosting providers can only be held liable if they were aware of the illegal content. However, contrary to the other texts cited for comparison purposes, the Benin text does not stipulate the obligation to “promptly remove” illegal content.⁴² Under the terms of the Benin Digital Code, hosting providers must inform the police or judicial services and are only required to remove the content

40. Article 12 further provides that operators guarantee the secrecy of user correspondence and the neutral processing of messages transmitted and related information. This provision is supplemented by other articles imposing obligations in relation to neutrality. For instance, article 15 stipulates that “operators providing internet access shall treat all traffic equally and without discrimination [...]”.

41. Article 505.

42. Art. 137 of law 045-2009/AN of 10 November 2009 regulating electronic services and transactions in Burkina Faso. Art. 33 of law 2010/021 of 21 December 2010 on electronic commerce in Cameroon. Art. 3.3 of law 2008-08 of 25 January 2008 on electronic transactions [Senegal].

if ordered to do so by those services.⁴³ Pending such an order, the hosting provider may make the content temporarily inaccessible, without removing it. This may suit copyright holders who report online content that infringes their rights. The key thing for rightholders is that internet users cannot access the illegal content. If a hosting provider is ordered to remove content, it must promptly remove the illegal content, render it impossible to access or deactivate it.⁴⁴ If the regime set up by the LCEN law or the 2000 directive can be described as ‘liability-lite’, the regime set up in Benin law could be described as ‘super-lite’. This liability regime is obviously disadvantageous to copyright owners.

The liability regime for providers of hypertext links, despite being worded differently, sets out the same rules as for hosting providers. Article 504 provides that providers of hypertext links are not held liable if they “promptly delete or prevent access to the information after being ordered by the judicial authority to remove the hypertext link”. As with hosting providers, this means requiring prompt removal of illegal content after being ordered to do so by the judicial authority. The text also ultimately provides that if a hypertext link provider is made aware of illegal content other than by the judicial authority, it must inform the authority, which will decide whether the content should be removed. Lastly, the difference with the liability regime for content providers resides partly in the fact that the bodies to be informed are the police and the judicial authorities for hosting providers and only the judicial authority for hypertext link providers. Furthermore, a hosting provider can render disputed

43. Article 506(1)(1).

44. Article 506(1)(2).

content inaccessible whereas hypertext link providers do not have a similar faculty. All things considered, however, the differences are minimal.

Seen from a European perspective, the regime adopted by the Benin legislators could be seen as striking (or beguiling) in its simplicity, at least when compared to the state of law resulting from CJEU case law in the Svensson and GS Media cases. The Benin courts do not have to verify whether links are aimed at the same audience as the source site or whether the site publisher providing the link is operating on a non-profit basis.

a.3) Criminal provisions on intellectual property

The Benin Digital Code contains a number of provisions on combating online infringements of intellectual property rights, particularly copyright.

For example, knowingly publishing, providing or communicating to the public software that is “manifestly aimed at the unauthorised provision of protected works or objects to the public” entails criminal penalties.⁴⁵ Incentivising the use of such software is also punishable.

Illegal downloading also entails criminal penalties. The fine stipulated is particularly hefty, at one million CFA francs (€1500). This is a significant amount given average wages in Benin.⁴⁶ Nevertheless, as in France, the code provides a graduated response similar in form to that adopted in France

45. Article 540.

46. About 50,000 CFA francs.

in the HADOPI law.⁴⁷ Internet users who illegally download content first receive a warning by email followed by a formal warning and, if they reoffend within six months, risk incurring criminal penalties. In contrast to the French Intellectual Property Code, which assigns the implementation of this response to an independent *ad hoc* authority, the Benin law entrusts this task to the national collective management organisation.

Finally, article 531 provides for a custodial sentence ranging from three (3) months to two (2) years and a fine of five hundred thousand (500,000) CFA francs to ten million (10,000,000) CFA francs for infringements of intellectual property rights committed via or on an electronic communication network or IT system. These penalties are specified by Benin copyright law to combat counterfeit infringement. The minimum penalty stipulated by this text is to be increased insofar as the OAPI text adopted in 2015 and currently being reviewed provides for a fine of 1,000,000 to 10,000,000 CFA francs.⁴⁸

As stipulated by article 529 of the Digital Code, these penal provisions “supplement the provisions of law 2005-30 of 10 April 2006 on the protection of copyright and related rights in the Republic of Benin”. Thus, litigants and performers need to supplement article 108 et seq. of the Copyright Act with articles 529 et seq. of the digital code.

47. Art. L331-25 of the Intellectual Property Code.

48. On this text, see L.Y. Ngombé, *News from Africa: RIDA* no. 250, October 2016, pp. 164 et seq., esp. pp. 166 et seq. See also F. Siirriäinen, *Le droit de la propriété littéraire et artistique dans l'accord de Bangui après la révision de Bamako: RFPI* no. 6, June 2018, p.33.

b) Law of 26 July 2016 on Copyright and Related Rights [COTE D'IVOIRE]⁴⁹

A new Côte d'Ivoire law was adopted on 26 July 2016 and published on 20 October of that same year. The tenor of the new text is not radically different from the 1996 text. However, there are some amendments, most of them minor. Some provisions of the new Côte d'Ivoire law raise questions as to their compliance with the Bangui Agreement. This review will provide a brief overview of the new law, including an examination of the copyright provisions, the provisions on related rights and the common provisions on copyright and related rights.

b.1) Copyright provisions

The new Côte d'Ivoire law introduces amendments in terms of both the scope and the implementation of protection.

Scope of protection

The changes are relatively minor in terms of both the object of protection and ownership rights.

As with the 1996 law, the 2016 law provides that works are protected regardless of merit, genre or purpose. Eligibility for protection depends on

49. Law 2016-555 of 26 July 2016 on Copyright and Related Rights, *O.J.* of Côte d'Ivoire, no. 84 of 20 October 2016, p.1277.

the originality of the work. While the condition of originality is explicitly laid down for titles (as in the French law of 1957), it is deduced for all works from the article on rights conferred upon the author. This article provides that the “author of *an original work*⁵⁰ shall enjoy in that work an [...] incorporeal property right [...]”. A creative work is original if “it is the author’s own work”.⁵¹ In this definition, the Côte d’Ivoire legislators confirm the decision for a subjective approach to the concept of originality. This new definition is particularly terse. Nevertheless, it seems similar to that of the 1996 law, article 10 of which provided that a work is original “if its characteristic elements and form or its form alone enable the author to be identified”. The key thing is therefore that a work enables the identification of the author. This was retained by the Côte d’Ivoire legislators in the 2016 law. The reference to “form” and “characteristic elements” had caused difficulties for both litigants and courts.⁵²

The indicative list of copyrightable works still mentions expressions of folklore under the new appellation of traditional cultural expressions. This confirms the choice for a large majority of African states to provide copyright protection to works from their respective cultural heritages.

Concerning ownership rights, the principle remains unchanged: the copyright owner is the author of the work.⁵³ For works created as part of an

50. Emphasis added.

51. Article 1 of the Côte d’Ivoire Copyright Act.

52. On this point, see in particular D. Bohoussou’s observations on Supreme Court ruling (Côte d’Ivoire) no. 598 of 8 December 2005, *Touré Aboubacar v SICOA: Ohadata J-08-57* (<www.ohada.com>), *Actualités juridiques* no. 54/2007, p.93.

53. Art. 36 of the Côte d’Ivoire Copyright Act.

employment relationship, the Côte d'Ivoire legislators did not retain the rule laid down in Annex VII of the Bangui Agreement. The OAPI text provides that works created as part of an employment or commissioning contract are presumed to have been transferred to the employer or commissioning party. The Côte d'Ivoire law provides that unless otherwise stipulated, copyright over a work created as part of an employment contract or service contract belong to their author. The law assimilates students and interns with businesspeople (commissioning parties).⁵⁴

This is more protective of authors than the OAPI regulations. For this reason, one is inclined to consider that it complies with the minimum laid down in Annex VII of the Bangui Agreement. This presupposes that in a scenario where the OAPI text and the national text are invoked by two parties to a dispute, the application of the national text should be retained on this issue. But another reading is possible insofar as the national text and the OAPI text provide opposing solutions. It is also possible to argue that the OAPI text prevails in the event of a conflict.

While the OAPI provides an agreed minimum, it is not always easy to clarify this minimum. Some provisions such as the protection period do not pose any difficulties in interpretation. The provision on ownership of works under a commissioning contract or an employment contract is harder to characterise. The desire to harmonise might have led the Côte d'Ivoire legislators to retain the OAPI provision on this question.

54. Art. 42 of the Côte d'Ivoire Copyright Act.

However, in relation to software and databases, the existence of an employment contract or service contract, unless otherwise agreed, means that the ownership rights revert to the employer or client. Works created by civil servants and public officials belong to them unless otherwise provided by regulations.⁵⁵ Thus, civil service statutes or the internal rules of a government department or public research institution may stipulate that works created by officials in the course of their duties are the property of the government department or public institution. Employers enjoy the rights of first publication to creative works by journalists.

The new law remains unchanged in its provisions on collective works, audiovisual works (a particular type of collaboration), anonymous and pseudonymous works and traditional cultural expressions or expressions of folklore (which belong to the national heritage).

Content and implementation of protection

Apart from a numbering change, there are no notable amendments to the rights recognised. Unsurprisingly, the text provides for both moral rights and pecuniary rights. Nevertheless, article 12 of the 2016 law now provides for five moral rights. To the list inspired by the law of 11 March 1957,⁵⁶ the Côte d'Ivoire legislators have added an "access right". By virtue of this right, an author has the right to demand that any person who holds or possesses a copy of his work provide access "insofar as this is shown to be indispensable

55. Art. 44 of the Côte d'Ivoire Copyright Act.

56. Right to publish, right to claim authorship, right of integrity, right to reconsider or right of withdrawal.

to the author's enforcement of copyright, unless this conflicts with the owner's legitimate interests".⁵⁷ In this case, the author must establish that such access is indeed "indispensable". Even if this access proves indispensable to enforce copyright, it must not be contrary to the owner's legitimate interests. On this point, Côte d'Ivoire law resembles the legislation of some European states expressly providing a right to access a material medium.⁵⁸

The protection period for pecuniary rights has been reduced from ninety years⁵⁹ to seventy years *post mortem auctoris* or post publication. Works of applied art now have a specific protection period. These works are protected for twenty-five years from publication instead of the previous ninety years *post mortem* (the same period as audiovisual works or collective works for example); above all, this period is much lower than that provided for other works whose protection period starts from publication. This limits the advantage of cumulating protection periods.

The Côte d'Ivoire legislators did not avail of the opportunity of this revision to insert a provision on the exhaustion of distribution rights. Nonetheless, from article 35 concerning the exception of importing for personal use, one can deduce that national exhaustion has been retained. In any event, with the upcoming entry into force of Annex VII following the 2015 revision in Bamako, OAPI States (including Côte d'Ivoire) must apply

57. Art. 15 of the Côte d'Ivoire Copyright Act.

58. See for example, art. 25 of the German Copyright Act; art. 14 of the Spanish Copyright Act. Both these texts nevertheless expressly provide for author compensation.

59. Art. 45 of the Côte d'Ivoire Copyright Act (1996).

the rule of international exhaustion.⁶⁰ It is regrettable therefore that the Côte d'Ivoire legislators did not use the opportunity to transpose into domestic law a rule that will necessarily prevail.

One of the innovations in the new text also relates to limitations and exceptions to copyright. It is important to note the insertion in the text of a new limitation in favour of the visually impaired. In accordance with the Marrakesh Treaty, the new article 32 of the Côte d'Ivoire law provides that protected works may be reproduced or represented in appropriate form by organisations or legal entities that use works to assist the visually impaired "strictly for personal use of the work by visually impaired persons". The other exception that merits attention in the new text is the lawful non-profit importation of a work for personal reasons. The text sets the maximum number of copies imported under this heading at five. Nevertheless, the interest and validity of this exception could be queried after the entry into force of the OAPI text currently being ratified, which provides for international exhaustion.

Regarding the exploitation of rights, the text provides little clarity on a question that has arisen in case law. The text also contains provisions on audiovisual production contracts and copyright assignment contracts. In terms of procedure and enforcement, the criminal penalties have been stepped up and, inspired by French law, damages and interest to compensate for any losses suffered by the rightholder are clearly laid down.

60. Bangui Agreement, 2015, art. 24 of Annex VII. - On these developments in the OAPI text, see A. Johnson-Ansah, *L'Acte de Bamako et l'épuisement des droits de propriété intellectuelle dans l'OAPI: une rupture copernicienne: Propriétés intellectuelles*, Oct. 2018, p.100.

The question that has arisen in case law regarding the exploitation of rights is that of how to penalise failure to indicate the copyright period.⁶¹ One solution would have been to provide for an additional contract period as is the case under Mauritian⁶² and Mozambican law.⁶³ Another would have been to provide for nullity of contract, as is the case under Mauritanian law.⁶⁴ As it stands, the OAPI text is of little assistance because it specifies a penalty for all mandatory acknowledgements but says nothing about the penalty for failure to indicate the assignment period. It may be possible to refer to general contract law in view of the fact that an author can terminate a contract at any time subject to reasonable notice.

The new text adds to the list of special contracts. The 1996 law provided for two special contracts, namely the publishing contract and the agency contract, which are regulated in detail. The 2016 law lists copyright assignment contracts under special contracts and refers implicitly to OHADA law. The Côte d'Ivoire law merely states that authors can enter into a contract assigning their rights "in accordance with current legislation".⁶⁵ And yet, in sixteen OAPI member states (including Côte d'Ivoire), common assignment law is governed by the OHADA Uniform Act on Securities. However, the text contains few provisions on the assignment of intellectual property.⁶⁶

61. Abidjan commercial court, case no. 2777/2015, *Bouaffo v MTN Côte d'Ivoire*, unpublished.

62. Art.9.6 of the Mauritius Copyright Act.

63. Art. 36.5 of the Mozambique Copyright Act.

64. Art. 63 of the Mauritius Copyright Act. On this text, see *RIDA* no. 243, January 2015, pp. 236 et seq.

65. Art. 80 of the Côte d'Ivoire Copyright Act.

66. On the assignment of intellectual property in the OAPI zone and the OHADA zone, see L. Y. Ngombé, *Sûretés mobilières et propriétés intellectuelles dans les Etats de l'OHADA et de l'OAPI. Un aspect de la concurrence de législations supranationales en Afrique: RRJ 2006-4*, pp. 2551 et seq. W.D. Kabré, *Etude critique du nantissement des droits de propriété intellectuelle*

Lastly, as regards defending rights, the main elements to retain are the more stringent penalties incurred in the event of copyright infringement and setting requirements for determining compensation.

Under the previous law, copyright infringers incurred a fine of 100,000 to 1,000,000 CFA francs (with the fines doubled for a repeat offence).⁶⁷ Now the fine is set at 500,000 to 5,000,000 CFA francs. Previously, a custodial sentence was only incurred for a repeat offence. Now, a custodial sentence of one to ten years can be imposed, including for a first offence.⁶⁸ These new penalties are in line with the minimum penalties set out in Annex VII of the Bangui Agreement as revised in 2015.⁶⁹

The criteria for setting damages and interest for victims of copyright infringement are now clearly laid down. As with the French legislators, the Côte d'Ivoire legislators have provided two alternative criteria. In the first option, the amount can be set taking into account the negative consequences of the infringement, non-pecuniary damages and the savings to the copyright infringer. In the second option, damages and interest can be set at a flat rate, which must be higher than what the infringer would have paid if he had entered into a contract with the rightholder.⁷⁰

en Droit OHADA: Publications du CAMES, no. 1, 2014, p.127 et seq. <<http://publication.lecames.org>>

67. Art. 322 of the Côte d'Ivoire Penal Code (to which art. 64 of the 1996 Act refers).

68. Art. 138 et seq. of the Côte d'Ivoire Copyright Act.

69. See L.Y. Ngombé, *News from Africa: RIDA* no. 250, Oct. 2016, pp.164 et seq., esp. pp. 190 et seq. The OAPI text provides for a fine of 1 million to 10 million CFA francs and a custodial sentence of three months to two years (art. 73 of Annex VII (2015) of the Bangui Agreement).

70. Art. 147 of the Côte d'Ivoire Copyright Act.

b.2) Provisions on related rights

There are two main changes regarding related rights. Firstly, the protection period for related rights has been reduced and secondly, a related right to databases has been added.

In the 1996 law, pecuniary rights were protected for ninety years post publication. This protection period has now been brought down to fifty years.

The real innovation is the fact that the rights of producers of databases are now protected. For a long time, this protection was lacking in African texts.⁷¹ The new Côte d'Ivoire law now provides that producers of databases can ban their transfer to another medium, or the provision to the public of all or part of the contents of the database or of a part thereof that is substantial in terms of quantity or quality, temporarily or permanently. Database producers can also ban repeated and systematic use of parts of non-substantial contents of a database contrary to normal use of the database or that could cause unreasonably prejudice the legitimate interests of the producer.⁷²

b.3) Common provisions on copyright and related rights

One of the notable common provisions here is the creation of a register of copyright and related rights. This register should make a positive contribution to proving entitlement and to the enforceability of rights. However, the text

71. See W.D. Kabre, *Droit des bases de données et pays en développement: RIDA* no. 216, April 2008, p. 3.

72. Art. 87 of the Côte d'Ivoire Copyright Act.

rightly stipulates that non-inclusion in the register of copyright and related rights “shall not have the effect of denying the capacity of author, performing artist or producer to unregistered persons”.⁷³ The register is held and managed by the authorised collective management society.

The new law contains an innovation on collective management. While maintaining the principle of monopoly in collective management,⁷⁴ the 2016 Copyright Act states that only two collective management organisations (CMOs) can be created: one to manage copyright, the other to manage related rights.⁷⁵ The text provides a number of efficiency and competence criteria for accrediting these organisations. For instance, company directors’ professional qualifications in terms of collective management must be in line with the company object.⁷⁶ The legal form of these organisations is not specified. The text merely states that the organisations must be established in Côte d’Ivoire under Côte d’Ivoire law.⁷⁷ However, for a transitional period, the single organisation currently managing copyright and related rights when this Act enters into force will continue to perform its duties.⁷⁸

Lastly, the new Côte d’Ivoire Copyright Act provides the option of detention under customs control in matters relating to literary and artistic property.⁷⁹ The Côte d’Ivoire text refers rather tersely to “current legislation”.

73. Art. 148 of the Côte d’Ivoire Copyright Act.

74. Art. 62 of the 1996 Côte d’Ivoire Copyright Act.

75. Art. 113 of the Côte d’Ivoire Copyright Act.

76. Art. 114 of the Côte d’Ivoire Copyright Act.

77. *Ibid.*

78. Art. 149 of the Côte d’Ivoire Copyright Act.

79. Art. 137 of the Côte d’Ivoire Copyright Act.

On this point, insofar as the joint text adopted by OAPI is a conventional minimum. On this point, insofar as the joint text adopted by OAPI is a conventional minimum, when it enters into force, Annex VII of the Bangui Agreement – which regulates “border measures”⁸⁰ in detail – will be the standard text in Côte d’Ivoire.⁸¹

2. ARIPO zone

In the ARIPO zone, over the period covered by this review, two laws merit attention, both from Malawi. The first relates to copyright, the second to electronic commerce and cyber security.

a) Copyright Act of 1 September 2016 [MALAWI]⁸²

On 1 September 2016, Malawi adopted a new Copyright Act. This act takes most of its provisions from the 1989 act, which it replaces. Malawi legislators needed to update copyright law, in particular to take account of new technologies and international treaties adopted since the entry into force of the earlier text. This review will in turn investigate copyright provisions, the provisions on related rights and the common provisions on copyright and related rights.

80. Bangui Agreement, 2015, art. 83 et seq. of Annex VII.

81. Potentially supplemented by national customs legislation.

82. Copyright Act, 2016 (Act No. 26 of 2016).

a.1) Copyright provisions

There is little innovation as regards protection, in contrast to changes as regards the content and implementation of protection.

Scope of protection

Amendments have been made concerning protected works and ownership rights.

The new act includes the condition of originality regardless of the merit, genre or purpose of the work.⁸³ As in the 1989 act, an original work is defined as the product or fruit of the author's endeavours. The change made relates to the material fixation of works, which is no longer a criterion for entitlement to protection. In the 1989 act, this list included "expressions of folklore developed and perpetuated in Malawi".⁸⁴ The new act maintains the principle of protecting expressions of folklore via copyright law. Nevertheless, in contrast to other recent texts, the legislators did not avail of the opportunity to change the terminology and insert the phrase "traditional cultural expression".

Expressions of folklore are defined as works in literary, dramatic, musical or artistic fields that belong to the traditional cultural heritage of Malawi, preserved and developed by ethnic or local communities or unidentified authors. The latter criterion is questionable because the fact that the author of

83. Section 5.2 of the 1989 act.- Section 26.2 of the 2016 act.

84. Section 4.1b of the 1989 act.

a work is unknown is not sufficient for the work to be classified as a traditional cultural expression. Conversely, it is not sufficient for the author of a work to be unidentified for the work to be classified as part of the cultural heritage of a country. The Malawi Copyright Act states that these works are protected regardless of whether they are fixed in material form.⁸⁵

Databases, which were not listed in the 1989 act, feature in the indicative list of protected works.

The new act does not make any changes to ownership rights. The creator of a work is in principle the initial rightholder. The copyright to works made under a service contract or employment contract belongs to the client or employer. The rule regarding expressions of folklore remains unchanged. These belong to the national heritage.

Content and implementation of protection

As with the 1989 act, the 2016 act provides for moral rights and pecuniary rights. Regarding moral rights, the right to claim authorship and the right to object to any breach of integrity remain intact. The Malawi legislators nevertheless decided to add a provision specific to directors of audiovisual works, which stipulates that they have the right to be identified as such and that they have in particular the right to require that their name or pseudonym is mentioned in the manner required for each form of exploitation of the

85. Section 67.2 of the Malawi Copyright Act (2016).

work.⁸⁶ Directors of audiovisual works can also “object to any distortion, mutilation or other alteration of their work [...]”. In sum, the new Malawi act provides that directors of audiovisual works – like any author – have moral prerogatives.

The law still provides that moral rights “shall be transferable by reason only of the death of the author and henceforth such rights shall be exercisable by his heirs [...]”.⁸⁷ Concerning moral rights *post mortem*, the innovation in the new text lies in the mention of the author’s “legal representatives”. These representatives, not just the heirs, can exercise the moral rights on the author’s death.

As regards pecuniary rights, the main innovation in the new act relates to the inclusion of distribution rights. In this regard, Malawi law seems to have opted for international exhaustion.⁸⁸

The main change regarding the protection period relates to the protection period for computer programs. The former text provided for two specific periods. The first was twenty-five years *post mortem* for works of applied art, the second was for computer programs, which entered the public domain after ten years.⁸⁹ In the new text, the protection period in principle remains fifty years *post mortem auctoris* and fifty years *post publicationem* in certain

86. Section 30.6a of the Malawi Copyright Act (2016).

87. Section 35 et seq. of the Malawi Copyright Act (2016) and Section 9.2 of the Malawi Copyright Act (1989).

88. Section 29.2 of the Malawi Copyright Act (2016).

89. Section 13.1f of the Malawi Copyright Act (1989).

cases (such as pseudonymous works). The only specific protection period retained in the new act is for works of applied art (twenty-five years from the date on which the work is published or, if the work is not published within fifty years of it having been created, for a period of fifty years from the date on which the work was created).⁹⁰ As in the 1989 act, moral and pecuniary rights are protected for the same period.

The text contains new limitations and exceptions relating to the digital environment. Thus, the making of a copy of a work which is transient and incidental to a technological process is authorised if the reproduction is an integral and essential part of the technological process and the sole purpose is to enable either the transmission of the work in a network between third parties by an intermediary or lawful use of the work.⁹¹ But the making of such copies is strictly circumscribed by law. For instance, if the copy made is an object of applied art, a sculpture or other artistic reproduction of an artistic work, the reproduction may not be made by a person outside the normal circle of the user's family and closest acquaintances.

The act also contains new exceptions to copyright law, including reproduction for archival purposes. Libraries, archives, museums, scientific institutions and educational establishments may be designated by ministerial order to make copies of works without the rightholder's permission in certain conditions. One of these conditions restricts the number of copies to the needs of the regular activities of the body reproducing the work.⁹²

90. Section 35.1f of the Malawi Copyright Act (2016).

91. Section 37 of the Malawi Copyright Act (2016).

92. Section 48 of the Malawi Copyright Act (2016).

In accordance with the Marrakesh Treaty, the new Malawi act also authorises the reproduction of published literary, artistic or musical work in a form specifically intended for visually impaired persons or disabled persons who, due to the nature of their disability, are not able to access or enjoy the work in any of the forms in which it is commercially available. This exception is subject to a number of conditions, including a prohibition on reproducing or making available copies on a commercial basis and that the copies shall be made available only to such disabled people for which they are intended. The act adopts most of the provisions of the Marrakesh Treaty.

In contrast to other recent African legislation, the new act retains the translation and reproduction licences for developing countries as provided for by the Paris Act relating to the Berne Convention. The specific feature of the 2016 act is that it adds the option of a third compulsory licence for the organisation of public examinations. Under the terms of the new section 59, an institution which is responsible for arranging public examinations may, for this purpose, reproduce works that have already lawfully been made available to the public. Reproduction must be remunerated in accordance with tariffs set by the collecting society. The number of copies is limited to the number necessary to conduct the examination.

As regards the implementation of protection, there are no major changes to the exploitation of rights. Like its predecessor, the new act provides a range of provisions *in favorem auctoris* such as the requirement for authorisation in writing,⁹³ the obligation to specify the rights transferred⁹⁴ or the author's right

93. Section 15 of the 1989 act, Section 55 of the 2016 act.

94. Section 15.2 of the 1989 act, Section 55.2 of the 2016 act.

to seek an amendment to the contract if the price initially agreed is found to be grossly disproportionate compared to the income derived by the user from the work.⁹⁵

Regarding the defence of rights, new penalties are introduced for infringements relating to the digital domain along with changes to combat copyright infringement. The circumvention of technical protection measures are now classified as infringements.⁹⁶ The penalties incurred have been stepped up. For example, the fine incurred in case of infringement has been raised from 15,000 kwachas to 5,000,000 kwachas. The custodial sentence incurred has been increased from one to two years.

a.2) Provisions on related rights

Those benefiting from protection as regards related rights now include producers of phonograms, broadcasters and publishers as well as performing artists. The related right of publishers concerns the typographical arrangement of the published edition of a literary, dramatic or musical work. Publishers can in particular ban reproduction and distribution to the public other than by way of rental or lending. Nevertheless, the act allows the distribution of copies sold or otherwise assigned with the publisher's consent in Malawi or elsewhere. As with copyright law, the act provides for the international exhaustion of the publisher's distribution rights.

95. Section 15.4 of the 1989 act, Section 55.4 of the 2016 act.

96. Section 87 et seq. of the Malawi Copyright Act (2016).

Another major change in the area of related rights merits a mention. This change concerns duration. Under the 1989 act, various related rights expired twenty years after publication. The protection periods now differ according to the relevant right category. The protection period for performances and phonograms is now fifty years. It remains twenty years for broadcasting programmes and twenty-five years for typographical arrangements of published editions.

Finally, of the new provisions, the moral rights of performing artists also merit attention. These rights are the right to claim authorship and the right to respect for a performance. Their periods are the same as those for pecuniary rights.

c.3) Common provisions on copyright and related rights

The first provision this review will discuss is the maintenance of the monopoly of collective management entrusted to a single organisation.

Two other provisions merit attention. These relate to the copyright fund⁹⁷ and the public domain.

The copyright fund is used for the enforcement of copyright law; the promotion of creativity; the nurturing of artistic talent; the promotion and preservation of works which depict the cultural identity of Malawi; and civic education. The fund, the management of which is entrusted to the collective

97. Section 98 et seq. of the Malawi Copyright Act (2016).

management organisation, is financed through levies on the importing, manufacturing or placing of devices for digital storage materials on the market or levies on the public sale or auction of original works of art. Thus, some of the monies collected by the collective management organisation are remitted to the copyright fund. This is similar to the “social and cultural fund” provided for in the laws of several African OAPI member states (particularly texts adopted prior to 1999)⁹⁸.

Regarding the public domain, article 84 of the new act provides that “when a work is in the public domain the provisions of this Act shall not prevent or limit its use”. The act goes on to state that the rule applies to performances, phonograms and typographical arrangements in the public domain. It does not specify what compensation might be due for the use of such works or objects of related rights. It could be said that the Malawi legislators have abandoned the idea of a paying public domain. The 1989 act provided that “*subject to the payment of such fee as may be determined by the Minister in relation thereto, a work that has fallen into the public domain may be used without any restriction*”.⁹⁹

b) Electronic Transaction and Cyber Security Act [MALAWI]¹⁰⁰

On 20 October 2016, Malawi passed the Electronic Transaction and Cyber Security bill into law. This act relates in particular to the protection of

98. See for example art. 3 of the Congolese Copyright Act (Brazzaville).

99. Emphasis added.

100. Act no. 33 of 2016 to make provision for electronic transactions, *The Malawi Gazette Supplement*, dated 4 November 2016, containing Acts (No. 6C).

domain names, disputes concerning domain names and electronic contracts; we will look specifically at liability rules.

The act differentiates between intermediary service providers, caching providers, providers of hosting services, online content editors.¹⁰¹

Intermediary service providers cannot be held liable under civil or criminal law for any information contained in an electronic message for which it provides services. However, they can be held liable if they were effectively aware of the unlawful content when the content was distributed. Service provider liability is also excluded regarding content that they merely transmit, provided they do not monitor communications, are not the origin of the transmission and do not modify or select the content transmitted. In sum, as long as they remain neutral, intermediary service providers cannot be held liable for the unlawful transmission of content by their users.

Caching providers, if they stay neutral, also have reduced liability.

The rules for hosting providers retained by the Malawi legislators refer to Directive 2000/31/EC of 8 June 2000 on electronic commerce. Hosting providers are not liable if they were not aware of the unlawful nature of the content stored or if, immediately upon becoming aware of the unlawful nature of content they take the necessary measures to remove it or if, on foot of an injunction pursuant to the law, they delete or deactivate such content quickly.

101. Sections 25 et seq.

Hosting providers are therefore not liable unless it can be proven that they were aware of the unlawful content or that they delayed removing the content on foot of an injunction or notice. The text specifies the form and terms of the injunction. A person wishing to have content removed must provide their name and address, information on the law infringed and make a bona fide statement.¹⁰²

Online content editors are required to provide information identifying them. Furthermore, any persons identified in content or who wish to delete content are entitled to contact the content editor. From this it can be deduced that editors are directly responsible for the content they publish online.¹⁰³ The rule is therefore the same as that applicable in Europe.

II. CASE LAW

Of the decisions available over the period covered by this review, two in the OAPI zone and eight in the ARIPO zone merit attention.

A. OAPI ZONE

This review will look at three court rulings handed down in the OAPI zone: one ruling by the commercial court of Cotonou, Benin, and two decisions by the Abidjan court of appeal in Côte d'Ivoire.

102. Section 30.

103. Section 32.1.

1. Cotonou commercial court, 3 May 2018 TOHODE v AMOUNZOUN [BENIN]¹⁰⁴ – Musical work – Ownership – Collective management – Prior conciliation obligation

The facts, which are not always totally clear from the rulings, can be summarised as follows: Isaac TOHODE, a songwriter, singer and arranger, produced an album of traditional music entitled “DECOLLAGE”, comprising ten (10) tracks in December 2016. In January 2017, Mr TOHODE became aware that one of the tracks on this album, entitled “Evolution”, had been recorded for commercial purposes, in particular to advertise KGC brand metal sheets marketed by Phibaut AMOUZOUN. The plaintiff discovered that his song had been used constantly between January and August 2017 to promote metal sheets under the KGC brand on various Benin radio stations without the permission of Mr TOHODE. Convinced that his intellectual property rights to the song “Evolution” were being infringed, Mr TOHODE took legal action, seeking 75,000,000 CFA francs in compensation.

Some of the facts as set out by the plaintiff were contested by the defendant. The defendant maintained that the title “Evolution” was actually a collaborative work co-authored by Yves AKOUEGNONHOU aka “Somo crew DJOGBE”. The defendant said the track had been released in 2015. The defendant further maintained that the advertising campaign lasted from January 2016 to the certain knowledge of Isaac TOHODE, with his personal participation at certain times, for which he was paid a fee. The song

104. Cotonou commercial court, section II, ruling 017/18/CJ/SII/TCC of 3 May 2018, unpublished.

“Evolution” was then included in the album entitled “Décollage”, released in December 2016 and registered with the Benin Copyright Office on 25 August 2017. Mr Yves AKOUEGNONHOU objected to Mr TOHODE’s registration of the song.

Rejecting this argument, the defendant maintained that Mr TOHODE’s application was inadmissible as the latter had not demonstrated exclusive authorship and had taken legal proceedings without prior conciliation. The defendant also added that the commercial broadcast had involved payment of a fair compensation levy, the collection of which was the sole responsibility of the Benin Copyright Office. Mr AMOUNZOUN counterclaimed 30 million CFA francs for abuse of legal process.

Simultaneously applying Annex VII of the Bangui Agreement and Benin law,¹⁰⁵ the commercial court of Cotonou rejected Mr TOHODE’s suit on the grounds that only the Benin Copyright Office had standing to recover fees relating to copyright and holders of related rights.

This reasoning seems to prejudge the lawfulness of the marketing by the defendant of the work in dispute. Assuming that the song at dispute is effectively a collaborative work, is it certain that Monsieur TOHODE, the plaintiff, agreed to this marketing? Is it sufficient to contend that an author was aware of the broadcasting of the work to claim consent? On this point, Benin law provides that “contracts under which the author or his

105. This is what the courts in all OAPI member states should do, especially with the revised provisions of Annex VII (2015) on the supranational character of the regional text. See L.Y. Ngombé, *News from Africa: RIDA* no. 250, October 2016, pp. 164 et seq., esp. p. 192.

successors in title authorise the performance or publication of their works shall be concluded in writing, on pain of invalidity. The same shall apply to performance authorizations granted free of charge”.¹⁰⁶

The court’s reasoning is also puzzling as regards its interpretation of the concept of “fair compensation”. Compensation implies that a phonogram is made in advance for retail purposes.¹⁰⁷

Furthermore, as stated in article 68 of the Benin Copyright Act, “where a phonogram published for commercial purposes, or a reproduction of such phonogram, is used directly for broadcasting or communication to the public, a single equitable remuneration, intended both for the performers and for the producer of the phonogram, shall be paid by the user to the organisation responsible for collective management”. This compensation is payable to the holders of related rights. It does not involve the author or authors of the song. However, the plaintiff clearly brought the action in his capacity as the author – not the performer – of the work.

Regarding conciliation, article 86 of the Benin Copyright Act provides that “[a]ny dispute arising from the enforcement of contracts for reproduction, publication or public performance of literary and artistic works and creations protected by neighbouring rights shall be referred to the collective management organisation for attempted conciliation.” In the present case, it could be considered that the dispute related to the public performance, by

106. Article 37 of the Benin Copyright Act.

107. Article 68 of the Benin Copyright Act.

radio broadcast, of the musical work and the phonogram on which it was fixed. In contrast, the drafting of the text could indicate that the obligation for prior conciliation only relates to litigants bound by contract. This does not seem to be the case here.

This decision illustrates the occasional confusion on the continent between copyright and related rights;¹⁰⁸ it also raises the issue of the exploitation of collaborative works and the difficult question of how to prove authorship and ownership rights. Lastly, the TOHODE case is interesting from a procedural standpoint in that it reiterates the requirement in some African states to attempt prior conciliation before bringing legal proceedings.

2. Global Business Consulting Company v Société africaine de Cacao et al [COTE D'IVOIRE]¹⁰⁹ – Registration of works – Evidential scope – Originality

This case is interesting more for the questions it raises than for the issue decided by the court. Presented simply, the facts can be resumed as follows: a company, whose main object was research and training in the agricultural sector, stated that it had devised an “internal management system” and “methodology” for the farmers’ association to ensure traceability in the supply of cocoa. The system is configured in a manual, a certification method and certification form. Claiming that some exporters were using what it considered

108. For a case involving confusion where users thought they did not have to pay royalties to related rights societies on the ground that royalties had been paid to copyright societies, see High Court of Kenya at Nakuru, 27 March 2015 (Judicial Review Case no. 32 of 2014), *RIDA* no. 250, October 2016, p.232, obs. Ngombé.

109. Abidjan court of appeal, 1st chamber, 6 December 2018, case no. 44/2018, *unpublished*.

its works, the company brought legal proceedings before Abidjan commercial court. After losing its case at first instance, it filed an appeal.

To determine whether the appellant's copyright had been infringed, the court had to decide if the appellant actually held copyright to the systems and methods over which it was claiming ownership.

The proceedings revolved around eligibility for protection under the 2016 Côte d'Ivoire Copyright Act.¹¹⁰ Repeating an argument advanced at first instance, the appellant merely indicated that the "works" over which it was asserting ownership were registered with the Côte d'Ivoire Copyright Office (BURIDA). One defendant maintained that BURIDA did not have the power to judge whether a work registered with it was protected. This argument amounts to saying that the collective management organisation is not authorised to decide on the originality of a work. The argument is relevant. Another defendant contested the originality of the "methods" over which the plaintiff claimed copyright, referring to article 10 of the new Côte d'Ivoire Copyright Act which excludes the protection of "methods, procedures, concepts or information as such". This debate, which the court did not settle clearly, is about the scope of the registration of works over eligibility for copyright protection. There is no doubt about the answer. Registering a work with a collective management organisation does not imply that it is original.

Regarding copyright, the court's decision was based on the reference in the BURIDA registers to the ownership of methods, plans and systems over

110. See section I of this review for a discussion of this act.

which the appellant was claiming ownership. To assert the rights over which it claimed ownership, the appellant produced certificates of registration with BURIDA. One defendant argued that when registering a work, BURIDA could not say who owned it. This does not seem wholly accurate because such a registration could presuppose that the rightholder was the person who registered the work with BURIDA. But this is a rebuttable presumption.

However, the court found that the certificates produced in evidence by the appellant referred to a third party as the rightholder and that the third party in question had not given any powers to the appellant. The court therefore rejected the appellant's application as inadmissible due to lack of standing. The decision did not enjoy wholehearted support because it seemed to suggest that only the natural person or legal entity whose name was on the certificate had standing in a copyright infringement case.

B. ARIPO ZONE

1. *My Skool TV Show, High Court of Kenya at Nairobi, 13 February 2018 [KENYA]*¹¹¹ – *Registration of a work – Audiovisual work – Disputed ownership – Cancellation procedure – Scope of registration*

The My Skool TV Show case related to a dispute over the ownership of rights to an audiovisual work following its registration with the Kenya

111. *Republic v Executive Director, Kenya Copyright Board & another Ex-Parte Sugarcane Communications Ltd*, High Court of Kenya at Nairobi, 13 February 2018 (Miscellaneous Civil Application J.R. no. 298 of 2017): *e-KLR 2019*, <<http://kenyalaw.org/caselaw/cases/view/148365/>>

Copyright Board (KECOBO). This dispute is particularly interesting because it illustrates the practical difficulties that can be encountered in the registration of works. Moreover, these difficulties are not very different from those encountered in the industrial property arena. The case is also interesting in that one of the parties invoked constitutional provisions and principles of natural justice. Lastly, it reiterates the stringent rules of evidential law.

The facts in the matter are summarised below. The company Sugarcane Communications undertook the formalities concerning declaration to and registration with the Kenya Copyright Board of an audiovisual work over which it claimed ownership, entitled *My Skool TV Show*. A copyright registration certificate, number AV-02032, was issued to it on 19 April 2016. However, on 16 November 2016, the company Yellow Box Limited brought an action before the Kenya Copyright Board, asking for the removal of all entries concerning the ownership of the television programme *My Skool TV Show* from the copyright register and the cancellation of the certificate issued to Sugarcane. Yellow Box Limited also sought to have itself substituted for Sugarcane as the owner of the work. The Kenya Copyright Board granted the application by Yellow Box Limited in a ruling handed down on 14 March 2017.

Sugarcane challenged the validity and legitimacy of the cancellation of its certificate on the basis of copyright law, article 47 of the Kenyan constitution and the principles of natural justice. It therefore brought legal proceedings to have the decision by the Kenya Copyright Board overturned.

The High Court of Nairobi was asked to rule on the validity and legitimacy of the cancellation of the certificate issued to the applicant.

According to the applicant, the director of the Kenya Copyright Board had improperly cancelled the registration of its work on the sole strength of statements made by Yellow Box Limited and had not given it the opportunity to comment. The respondent replied that on 13 January 2017 it had sent a letter by email to the applicant informing it that another company, which held a certificate over the same work, was claiming ownership rights. According to the respondent, this letter stated that after a period of seven days, the earlier registration and certificate issued would be cancelled. The cancellation decision was deferred for a time to allow the applicant to respond to the allegations of Yellow Box.

The applicant argued that it had never received the letter dated 13 January 2017.

On this point, the High Court noted that the respondent had merely stated that it was quite suspect that the applicant received the letter dated 14 March but not the earlier one dated 13 January. The High Court noted that in fact there was no proof of the existence of the notification mentioned by the respondent because no copy had been produced in evidence and there was no proof that it had actually been sent. The High Court held that insofar as the Copyright Board had stated that it had complied with the law, it was incumbent on it to prove that this was effectively the case, in accordance with section 109 of the Kenya Evidence

Act.¹¹² Consequently, the High Court found that the respondent had breached the applicant's rights.

The High Court handed down a ruling it saw as inevitable,¹¹³ stating that the respondent's actions were fraught with procedural irregularities and could not be upheld. The decision to cancel the applicant's certificate was therefore overturned on the ground of irregularity. As the ruling ultimately indicates, this is without prejudice to the legitimacy of the approach taken by the company that initially asked for the cancellation of the certificate. And it would not prevent the Copyright Board from subsequently cancelling the disputed certificate.

The case is to be heard before another court because Yellow Box has already sued Sugarcane and Standard Group for infringement of the same audiovisual work. The case is registered under HCC no. 308 of 2017 at the High Court of Nairobi. The next decision is therefore eagerly anticipated.

Watch this space...

112. This is a rule that can be found in several codes or laws relating to the procedure and that are well summarised by the maxim *actori incumbit probatio*.

113. Paragraph 46 of the ruling.

2. Newton Oirere Nyambariga v KCB Bank Kenya Ltd and Quite Bright Films Ltd, High Court of Nairobi, 13 October 2017 [KENYA]¹¹⁴ – *Audiovisual works – Interim ruling – Non-protection of ideas*

The ruling reported here is an interim ruling in a dispute relating to an audiovisual work. The plaintiff claimed copyright infringement, passing off and breach of trust. This decision is interesting in that it reiterates the principle that ideas are not protected under copyright law, but also and especially because it clarifies – tangentially at least – the evidential scope of the copyright registration certificate. This certificate, provided for by the laws of several English-speaking African countries, records the registration of a work by the competent authority. In Kenya, this is the Kenya Copyright Board (KECOBO).

The plaintiff claims to hold copyright over a work recorded under the title *Lions Den*. He also claims to hold the LIONSDEN mark. He alleges that he proposed that KCB sponsor a reality TV show at which a number of entrepreneurs would present project ideas to a panel of investors who would invest in selected projects. The defendant, citing budgetary constraints, turned down the plaintiff's proposal.

The plaintiff then decided to approach other partners. Meanwhile, he organised a pilot of the show at Kingdom Business Network on 17 January 2015. He became aware that KCB and Quite Bright broadcast a show called

114. High Court of Kenya at Nairobi, Commercial & Admiralty Division, HCCC no. 407 of 2016, 13 October 2017, *eKLR 2019*: <<http://kenyalaw.org/caselaw/cases/view/143483/>>

“Lions Den” on national television. He therefore decided to sue the two companies in an amended application dated 4 November 2016:

– An order prohibiting the defendants from making use of, publishing in printed or electronic media or any other form of media and from making a programme on any electronic or printed medium entitled or bearing the name LIONS DEN;

– Damages and interest for breach of trust, infringement of the plaintiff’s copyright and passing off;

– Damages and interest for loss of business and income;

– Any other remedy that the court may deem appropriate.

When the matter was referred to the court, pending an order on the merits of the case, KCB filed an interlocutory application with the High Court seeking to have the amended application struck out and, on an ancillary basis, to have KCB struck out from the list of defendants. The ruling relates to these interlocutory proceedings.

Regarding copyright,¹¹⁵ the defendants first asserted that the plaintiff was seeking protection for the exploitation of an idea rather than a creative work. KCB, the first defendant, in particular pointed out that copyright law does not protect ideas but the expression of ideas. In any case, the show

115. Paragraphs 22–30 of the ruling.

broadcast was only a local adaptation of concepts registered under the names “Shark Tank” and “Dragons Den”, owned by Sony Pictures Television UK and Colgems.

The High Court nevertheless found that while there was little doubt that Sony held copyright for the shows “Shark Tank” and “Dragons Den”, the plaintiff’s case was that he had copyright in respect of an audiovisual work entitled “LIONS DEN”, which he justified by producing a certificate of registration dated 16 October 2015 (predating the alleged events).

The success of the interlocutory motion by the first defendant, concerning copyright, depended on two questions. Firstly, was the plaintiff seeking protection of a mere idea? Secondly, was the defendants’ show an adaptation of the Sony concepts or a copy of the plaintiff’s conception?

Regarding the first question, the High Court determined at that stage of the proceedings that the plaintiff’s request could not be dismissed because he held a copyright registration certificate. It found that the matter would have to be determined by way of evidence. This response by the High Court could be interpreted as conferring the status of preliminary proof of the existence of a protected work on the registration certificate. It would then be up to the defendants to prove during the proceedings that the plaintiff had not put his idea in a form eligible for copyright protection. The holder of a certificate consequently benefits from the presumption that a protected work exists and from the presumption of ownership of that work. The High Court’s reasoning is persuasive because the fact that there had already been a show with a similar

format to the one for which the plaintiff was seeking protection does not preclude the existence of another original work, different to the first.

The High Court found that the second question was also a matter of evidence. At that stage in proceedings, it was impossible to know whether the defendants had merely adapted concepts owned by Sony in particular (in which case there was no copyright infringement because Sony had given the licensing rights to the show to the second defendant) or whether they copied the plaintiff's work. It would therefore be premature to dismiss the plaintiff's case against KCB. Only by carefully comparing the two shows would the question as to whether the defendants copied the plaintiff's work be answered.

This is another case where the next decision is keenly awaited.

3. Mercy Munee Kingoo and Lydia Nyva Kingai v Safaricom Ltd and Attorney General, High Court of Malindi, 3 November 2016 [KENYA]¹¹⁶
– *Collective management – Pecuniary rights – Freedom of association*

This case pitted two artists, composers and performers of musical and audiovisual works, against the company Safaricom. The artists contracted Safaricom to digitise their musical work and upload it to Safaricom's Skiza Tunes portal. Under this contract, royalties had been paid to the petitioners and other artists via this platform since 2008. In December 2012, parliament adopted a new law partially amending the Kenya Copyright Act.¹¹⁷ One

116. High Court of Kenya at Malindi, Constitutional Petition no. 5 of 2016, eKLR report 2019: <<http://kenyalaw.org/caselaw/cases/view/127554/>>

117. See *RIDA* no. 243, January 2015, *News from Africa*, pp. 236 et seq.

consequence of the application of the amended act was that the artists could not be paid directly by the operator of the download platform. This was due to the new section 30A of the Copyright Act. These were the reasons why the petitioners brought proceedings at the High Court of Malindi.

Apart from questions of procedure, particularly the defendants' assertion of *res judicata*,¹¹⁸ the dispute relates to the constitutionality of the new section 30A of the Kenya Copyright Act.

The petitioners made two assertions regarding the unconstitutionality of section 30A of the Copyright Act. Firstly, they argued that the text in question was adopted without public participation and was therefore unconstitutional (particularly articles 10.2 and 118). The Kenyan constitution of 2010¹¹⁹ effectively provides that national values and principles of governance include "democracy and participation of the people". Article 118 provides that parliament shall "facilitate" public participation in legislative business.¹²⁰ The petitioners stated that they had not been informed of the amendment to the Copyright Act so that they could participate in the legislative process leading to the insertion of section 30A into the Copyright Act.

Secondly, section 30A requires authors who have contracted with download platforms to become members of a collective management society approved by the Kenya Copyright Board (KECOBO). The petitioners argued

118. The High Court rejected the "exception" of *res judicata* because the parties in both cases were not the same (the case in question and the case invoked by the defendants to argue that the matter had already been ruled on).

119. Text available on WIPO Lex.

120. Constitution of Kenya, art. 118.1b.

that under this text, royalties had to be paid by the platforms to collective management organisations (CMOs).¹²¹ These organisations then pay their members the share due to them as fair compensation. However, the petitioners argued that non-members could not receive this remuneration. Thus, they argued, section 30A of the Copyright Act was contrary to freedom of association, guaranteed as a fundamental right by article 36 of the Kenyan constitution. This article stipulates that everyone has the right to join an association of their choosing.

Regarding the first assertion, the defendants contended that the 2012 bill had been submitted to parliament on 19 December 2012 for the first reading. It was referred to the relevant committee and then brought back to parliament for the second reading. It was presented to parliament on 21 December 2012 for a third reading at which point it was adopted. The defendants also pointed out that the 2012 act had minimal amendments.

On this point, the High Court first held that section 30A was not a minor amendment to Kenyan law and noted that the committee had only 3 days – between 19 and 21 December 2012 – to present the bill to parliament. As this period was not sufficient to engage the stakeholders, section 30A was

121. Section 30A: “(1) If a sound recording is published for commercial purposes or a reproduction of such recording is used directly for broadcasting or other communication to the public, or is publicly performed, a single equitable remuneration for the performer and the producer of the sound recording shall be paid by the user through the respective collective management organization, and the remuneration shall be shared equally between the producer of the sound recording and the performer.

“(2)) If a fixation of a performance is published for commercial purposes or a reproduction of a fixation of a performance is used for broadcasting or other communication to the public, or is publicly performed, a single equitable remuneration for the performer shall be paid by the user to the collective management organization.”

unconstitutional because it was not adopted as provided under articles 10 and 118 of the constitution.

Regarding the second assertion, Safaricom, the operator of the download platform, contended that it was no longer obliged to pay royalties directly to artists. It had ceased all payments since 2015 and had contracted with a CMO for the payment of royalties. The High Court held that it would be unfair to insist that artists could only receive their royalties via CMOs if the expenses retained by CMOs were higher than those of other partners freely chosen by the artists. The High Court found that if all royalties were to be paid through CMOs, the effect would be that artists could only receive their royalties if they joined one of the three Kenyan CMOs. The right to choose where their royalties are paid is therefore not respected. Applying section 30A in this way infringes the freedom not to join an association or to join an association of one's choosing.

The High Court thus held that section 30A unconstitutional and that authors and holders of related rights could therefore not be compelled to join a CMO.

4. Justin Mbita Silumbwe v Barclays Bank Zambia Ltd, Supreme Court of Zambia, 7 July 2017 [ZAMBIA]¹²² Architectural work – Originality – Registration

Does the owner of a house own the rights to its image? Copyright specialists may see this as a curious question because the answer seems so obvious. Nonetheless, the question was put to the Supreme Court of Zambia in a dispute between the owner of a house and a bank.

Barclays Bank approached Mr Silumbwe for permission to photograph his house with a view to using it to advertise its house loans. To Mr Silumbwe's surprise, before any agreement had been entered into, he saw the image of his house on billboards advertising its home loans. Mr Silumbwe contended that he had suffered loss of business because banks refused to grant him loans as they believed that his house was already mortgaged to the defendant.

Mr Silumbwe therefore decided to sue the bank for damages and interest for infringement of his intellectual property rights due to the unauthorised use of the image and plans of his house.

Mr Silumbwe's case was dismissed at first instance on the ground that he had not drawn the plans to his house or built it. He was not the author of an intellectual work and consequently could not claim copyright over the picture of his house.

122. *Silumbwe v Barclays Bank Zambia Limited* (Appeal No. 90/2011), Supreme Court of Zambia, judgement no. 40 of 2017. Available online: <<https://zambialii.org/node/12915>>

It was in these conditions that the owner of the house decided to lodge an appeal, which was also unsuccessful.

In his appeal, Mr Silumbwe referred to the case of Scholz Design Inc v Sard Custom Homes, tried by a US court, to argue that architectural drawings were eligible for copyright protection. He submitted that the house had been specifically designed and built to his taste and specifications.

Referring to information available on the WIPO site, the court first indicated that architectural works were eligible for copyright protection. The court pointed out that the 1958 Zambian Registered Designs Act, applicable at the time of the events, provided for the registration of works and included architectural works as protected works. The necessity of the reference to the WIPO site could be questioned.

More specifically, the act provided that the registration of a drawing or model (including architectural works) gave the person registering the work copyright over the drawing or model. The court noted that the works over which the plaintiff was claiming ownership had not been registered. If they had, he could have benefited from a presumption of ownership.

In any event, the court found that the plans had been drawn up by an architect and that the plaintiff had not built the house himself. The court also found that the plaintiff had no skills or training in architecture. The decision of the first court was therefore upheld. The owner of a house cannot hold copyright over an architectural work just because he owns the house. Only the

creator of the architectural work is the initial rightholder over the work. This is what the Supreme Court of Zambia rightly restates.

Apart from the solution to the dispute, which can only be welcomed, this decision also merits attention because of the importance of foreign case law as a source of domestic law in a number of African disputes relating to intellectual property.¹²³

5. Prof. Nzele David Nzomo v Moses Namayi Anyangu and Competitive Edge Kenya, High Court of Nairobi, 16 March 2018 [KENYA]¹²⁴ – *Originality – Employment – Injury without damage*

This case substantially pitted two university lecturers against each other: the plaintiff, Professor Nzele David Nzomo, and Mr Moses Namayi Anyangu, first defendant. Mr Namayi Anyangu's publisher was also named as a defendant. The plaintiff is the author of two financial accounting books, published in 1985 and 2002 respectively. The first defendant published a book on the same subject in 2004.

Contending that Mr Namayi Anyangu's book copied and reproduced his own book, Mr Nzele David Nzomo sought an order from the High Court restraining the defendants from publishing, selling or otherwise distributing the allegedly infringing financial accounting manual, and ordering them to

123. See also *Financial Intelligence Unit v Cyber Space Ltd*, Court of Appeal, Seychelles, 3 May 2013: *SLR*, 2013, p.97; *RIDA* no. 243, January 2015 (News from Africa), p. 296, obs. L.Y. Ngombé

124. High Court of Kenya at Nairobi, Civil Suit no. 364 Of, *eKLR* 2018: <<http://kenyalaw.org/caselaw/cases/view/146209/>>

provide accounts of all of the sales of the allegedly infringing book and any other relief that the court deemed fair and just.

According to the plaintiff, the first defendant had copied verbatim part of one book and copied the other with minor modifications. The defendant, who had been a post-graduate student of the plaintiff, had consequently infringed his copyright, thus causing him to suffer loss and damage.

The defendants contested both the existence of proprietary rights to the exercises alleged by Mr Nzele David Nzomo to have infringed his copyright and the authorship of said exercises. The author of the allegedly infringing book stated that his book was based on past examinations papers at the University of Nairobi. But Mr Namayi Anyangu contended that these examinations are set by lecturers teaching the course being examined and after setting they are submitted to the University for processing. After processing, the University administers them to the students. After this, the papers are generally available to the public, who can use them in any way as they now fall within the public domain. The defendants concluded that the plaintiff had failed to prove an exclusive right as defined in section 26(1) of the Kenya Copyright Act.¹²⁵

The High Court first noted that for a work to be eligible for copyright protection, sufficient knowledge, labour and skill must have been expended on the making of such work to give it some original character. The drafting of the decision indicates that materials compiled by lecturers demonstrated the

125. Paragraph 63 of the ruling.

necessary efforts to be considered as original works. This seems to stem from the fact that the exercises do not appear to be copies of another work.

The next issue was to establish who owned the copyright to this common source. The High Court held that because the documents were drawn up by several lecturers on behalf of the university, it was the university that had copyright over the examination papers. This follows from the application of section 11 of the Kenya Copyright Act on the ownership of works created as part of an employment contract or commissioning contract. Consequently, the plaintiff could not claim any right over these works.¹²⁶ The charge of copyright infringement was therefore set aside regarding the plaintiff's first work. However, contrary to the defendants' claim, these works are not in the public domain.

Regarding the second book (*Basic Accounting and Principles and Procedure*), a work that essentially restates universally applied principles, the author claimed he had adapted them to local circumstances. The High Court undertook to verify whether these modifications involved sufficient knowledge, labour and skill to give the book an original character. According to the High Court, this was not the case. Thus, even though the first defendant had copied the work, there was no copyright infringement because the plaintiff's work was not protected by copyright due to insufficient originality.

The High Court therefore held that whereas the plaintiff may have suffered loss as a result of the first defendant's action in that the plaintiff's

126. Paragraphs 66–70 of the ruling.

sales may have been reduced as a result, “this is the kind of situation known in legal parlance as *injuria sine damnum* (injury without damage)”.¹²⁷ Thus, even though there was no copyright infringement, the court held that a loss had been suffered. But the victim of such a loss could not obtain compensation. The first lesson from this case is that it reminds us of the central character of the concept of originality in copyright law. The decision is also interesting because it illustrates the concept of an original work, including an original derivative work. Here the concept of originality does not refer to the “imprint of personality” (the objective conception of originality). Admittedly, the concept is easier to handle in practice, at least when compared to the subjective approach used by OAPI member states.

6. Southern Sun Africa v Sun Square Hotel (Pty) Ltd, High Court of Namibia, Main division Windhoek, 23 April 2018 [Namibia]¹²⁸ – Copyright infringement – Conflict of jurisdiction

The applicants in this case were two companies belonging to the TSOGO SUN group, operational in the hotel sector since 1969. The first applicant was the Mauritian company SOUTHERN SUN AFRICA, which offers hotels and related services. It owns the SUN SQUARE trademark, registered in 2005 in the Republic of South Africa. The second applicant was the South-African company SOUTHERN SUN HOTEL INTERESTS, which owns the copyright in original artistic works in the ‘SUN SQUARE’

127. Paragraph 79.

128. *Southern Sun Africa v Sun Square Hotel (Pty) Ltd*, 23 April 2018, unpublished, decision available online: <<https://namiblii.org/na/judgment/high-court-main-division/2018/105-0>>

logo, (consisting of the ‘first logo’ created in 2005 and the ‘derivative logo’ created in 2014 depicting 3 half-suns).

The respondents were SUN SQUARE HOTEL, a Namibian company, and the registrar of companies.

In this case, the first applicant claimed unfair use of its trademark and wrongful passing-off, while the second applicant claimed copyright infringement. Only the copyright issue will be discussed here.

SOUTHERN SUN HOTEL INTERESTS claimed that the first respondent had infringed its copyright by using its logo. The applicant sought an order banning any use of its logo by SUN SQUARE HOTEL.

To support its application, SOUTHERN SUN HOTEL INTERESTS submitted that the first respondent had used its work for commercial purposes without permission or a licence granted by the copyright owner.

SUN SQUARE HOTEL contended that the Namibian courts did not have jurisdiction, arguing that the action taken by the applicant, a company under South African law, was tantamount to seeking the protection of a foreign law. The Namibian courts had no jurisdiction in respect of foreign copyright matters. To support this plea, the respondent referred to *Gallo Africa Ltd and Others v Sting Music*¹²⁹ (*the Gallo Africa case*), where the South-African court

129. On this case, see *RIDA*, no. 233, p.164, obs. L.Y. Ngombé.

held that it did not have jurisdiction to hear matters relating to copyright infringement committed outside its territory.

In the present case, this argument was set aside because the High Court of Windhoek held that the *Gallo Africa* case was irrelevant. The High Court, presided over by Judge Usiku,¹³⁰ held that the *Gallo Africa* case differed from the facts in this case. In the *Gallo Africa* case, the applicant alleged that the respondent had infringed its rights in several foreign countries and sought to rely on the copyright laws of each of those foreign countries in a South African court. This is why that court decided it did not have jurisdiction to hear the matter. However, in the SUN SQUARE case, the applicant based its claim on the Namibian Copyright Act and consequently the *Gallo Africa* case was not applicable to the matter at hand.¹³¹

Thus, in this case, the Namibian court hearing the case seems to have made a direct link between jurisdictional competence and applicable law. In this case, the Namibian court had jurisdiction due to the applicability of Namibian law.

The respondent also claimed that the High Court had no jurisdiction to hear the matter because it came under the jurisdiction of the copyright tribunal established under section 35 of the Copyright Act. This argument was also set aside as not having any bearing on the case in hand, with no further explanation given. The copyright tribunal, which is composed of High Court

130. Paragraph 37 of the ruling.

131. Paragraph 38 of the ruling.

judges,¹³² mainly has jurisdiction to hear disputes relating to licensing (for example between those applying for a licence and the person or organisation authorised to award licences).¹³³

On the substance of the case, the High Court first pointed out that the Copyright Act protects all original works and that the copyright owner had intellectual property rights over the protected work, in accordance with section 2 of the Namibian act. The unauthorised use of a protected work constitutes copyright infringement. Having said this, the High Court found firstly that there was no real dispute as to the authorship of the works in question.

It then noted that the logo used by the respondent was a replica of the applicant's logo. Given this almost slavish imitation, the High Court ruled that the respondent had infringed the applicant's copyright. The decision did not specify in what way the logo was original. Nonetheless, referring to *Haupt t/a Soft Copy v Brewers Marketing Intelligence (Pty) Ltd and Others* (2006), it stated that a work is considered to be original if it has not been copied from an existing source and if its production required a certain degree of skill, judgement or labour. The originality of the applicant's logo seemed obvious to the judge.

The High Court consequently upheld the application by SOUTHERN SUN HOTEL INTERESTS.

132. Section 35.1 of the Namibia Copyright Act.

133. Section 35.2 of the Namibia Copyright Act.

7. Clet Wandui Masiga v Association for Strengthening Agriculture in Eastern and Central Africa, High Court of Kampala, 20 December 2016 [UGANDA]¹³⁴ – Copyright infringement – Immunity from legal process – Alternative dispute resolution procedures

To what court can an employee or former employee of a regional intergovernmental organisation turn if that organisation enjoys immunity from legal process? This is the question answered by a Ugandan court in this matter.

The facts can be resumed as follows: a former employee of an organisation set up by several states in eastern and central Africa, with its head office in Uganda, wrote a number of books while he was still under contract with the organisation. Having noticed that his former employer was exploiting one of his books, the author decided to bring legal proceedings for copyright infringement.

The defendant claimed immunity from legal process and submitted that the issue of potential copyright infringement could therefore not be heard.

The High Court first had to determine whether the defendant enjoyed immunity or exemption from legal process in its capacity as a regional organisation.

134. High Court of Uganda at Kampala, Civil Suit no. 266, 267 and 268 of 2016, 20 December 2016.

Having analysed the texts and evidence submitted, the court concluded that the defendant could incontestably claim exemption from legal process as recognised by the government of Uganda in accordance with article 29 of the constitution creating the defendant, pursuant to article 31 of the Vienna Convention on Diplomatic Relations. However, the High Court found that this immunity could not be claimed in every type of dispute. It only related to disputes arising from the activities or mission of the international organisation in question.

Disputes not related to the mission of the organisation do not have this immunity. In the case in hand, the court had to determine whether Ugandan courts had jurisdiction over the dispute, which related to copyright infringement under this immunity from legal process. The High Court found that the plaintiff's claim related to his copyright on books about agriculture and breeding, which meant that the books that allegedly infringed his copyright had a direct link to the defendant's mission.

The High Court therefore held that it had no jurisdiction to hear this dispute about copyright. The court clarified that the plaintiff had access to out-of-court dispute resolution remedies. The constitution of the association and the headquarters agreement concluded with the Ugandan government provide for the establishment of an alternative dispute resolution mechanism to handle potential disputes with private individuals where the association does not waive immunity. According to the court, the author is therefore entitled to seek redress for alleged loss via arbitration or mediation or another mechanism which the defendant and the government of Uganda are obliged

to set up for the resolution of this dispute. Once the resolution route has been chosen, the next issue is to determine which law applies to the dispute (at least in arbitration cases). Choice of law could be decisive to resolving the dispute. If, as seems likely,¹³⁵ Ugandan law is applied to the dispute, copyright infringement might not actually be established and some works could in fact belong to the defendant. This is because the rules on ownership would favour the defendant. According to section 8.2 of the Uganda Copyright Act, where a person creates work under the direction or control of an international organisation, unless agreed otherwise, the copyright in respect of that work shall vest in the international organisation.

8. Jeffrey Ndungi Sila v Kenya Copyright Board and 2 others, High Court of Nairobi, 6 April 2018 [KENYA]¹³⁶ – Copyright infringement – Seizure by sworn officers – Constitutional rights

This case relates to an alleged violation of the constitutional rights of a person suspected of digital piracy.

It all started with a visit in May 2014 by officers of the Kenya Copyright Board, a television company and an officer of that company to the home of a person suspected of infringing the company's copyright. Following a search,

135. This is a hypothesis suggested by section 28 of the Ugandan Arbitration and Conciliation Act, which provides (in line with most texts on arbitration) that where there is no choice of law by the parties, the arbitral tribunal will apply the rules of law it considers to be appropriate given all the circumstances of the dispute. The place of performance of the contract and the nature of the dispute could lead to the choice of Ugandan copyright law.

136. High Court of Kenya at Nairobi, Constitution and Human Right Division, *Jeffrey Ndungi Sila v Kenya Copyright Board and Muticho Kenya limited and Frederick Saramba*, petition no. 541 of 2015, 6 April 2018: *e-KLR 2018*: <<http://kenyalaw.org/caselaw/cases/view/150842/>>

various items were confiscated, including electronic appliances and personal documents.

The alleged infringer was subsequently charged in criminal proceedings which are still pending before the Chief Magistrate's Court at Milimani. Further visits to his home led to more confiscations.

The petitioner argued that the visits and the confiscation of his effects were illegal because they were conducted *ultra vires* in view of the provisions of the Copyright Act. These actions consequently violated his constitutional rights since he had neither infringed the Copyright Act nor committed any crime.

He therefore decided to sue the Kenya Copyright Board, the television company and the officer involved in the search, seeking a declaration by the High Court to the effect that the visit to his home and the confiscation of his effects by the defendants without a search warrant or court order constituted:

- a violation of the petitioner's fundamental right to equal protection and benefit of the law,
- an infringement of his human dignity,
- a violation of his privacy,
- and a violation of his right of ownership,

– all of which are rights guaranteed by articles 27(1), (2), 28, 31 and 40 of the constitution.

Defending, the Kenya Copyright Board stated that it had mandate to administer all matters of copyright and related rights in Kenya and that under article 40(5) of the constitution, the state had mandate to support and protect intellectual property. Enforcement of copyright can consequently be a legitimate limit to another right. The Kenya Copyright Board added that under section 40 of the Copyright Act, a copyright inspector is authorised to enter any premises to ascertain whether copyright has been infringed. Moreover, section 40(2) of the Copyright Act also allows a copyright inspector to seize and retain anything recovered in the premises which is suspected to be an infringing copy of any work.

The Kenya Copyright Board argued that search warrants had been properly obtained and that the items seized on the premises were to be produced as exhibits in the criminal cases which have unfortunately stalled because the petitioner had jumped bail. It was deposed that the petitioner had made an application before the court of first instance for release of the items seized in his premises but these are yet to be concluded because the petitioner absconded.

The television company and the third defendant stated that the plaintiff was suspected of infringing the television company's broadcasting signal. They declared that the plaintiff had originally been a subscriber to the second defendant's television service and that he subsequently set up eleven

pirate accounts. He was identified using technical measures and the Kenya Copyright Board became involved.

The High Court held that the statements and evidence submitted showed that the defendants had reason to believe that the plaintiff was infringing the copyright of others. However, section 39 of the Copyright Act allows the Kenya Copyright Board to appoint copyright inspectors who may, under section 40 of the Act, on production of a certificate of authority, enter any premises, ship, aircraft or vehicle for the purpose of ascertaining whether there is or has been, on or in connexion with such premises, ship, aircraft or vehicle any contravention of the act. Section 42 also authorises a police officer to arrest, without a warrant, any person suspected, upon reasonable grounds, of having committed an offence under the act. The High Court held that from the evidence on record, it was clear that the defendants' officers were on a mission to ascertain whether the petitioner was infringing the Copyright Act. The defendants were therefore found not to have violated the petitioner's privacy, human dignity or right of ownership.

In fact, this case involved the court arbitrating a conflict of constitutional rights. While the plaintiff was relying on his fundamental rights under the constitution, the right to visit his home and confiscate his effects was also guaranteed by the Kenyan constitution. As the Kenya Copyright Board pointed out, the constitution mandates parliament to protect intellectual property. Furthermore, article 260 of the constitution clarifies that the right of ownership includes intellectual property (meaning that intellectual property is a fundamental right guaranteed by the constitution). Lastly, article 11 on culture cites intellectual property rights as one of its components.

Copyright is a topical issue in African courtrooms and parliamentary agendas. The last couple of years testify to this and confirm, if proof were needed, the growing interest in this question. The difficulties in gaining access to the case law of OAPI member states remains regrettable. But this cannot dent the optimism regarding the future of arts law on the continent.