

Best practice guide for publishers to act against illegal copying and distribution

Piracy and other unauthorised copying and distribution of copyright material

Many publishers want to act on the worrying extent of illegal photocopying and piracy, especially at universities and TVET colleges, currently aggravated by the increase in online sharing of unauthorised copies on social media groups like WhatsApp groups. Illegal copying and distribution of copyrighted works can be severely punished.

Changing digital practices

Publishers have always acknowledged that copyright must be fair and balanced to all concerned. This remains true for the digital environment.

Online and other digital reading formats are now in sharper focus than before. New needs and new ways of meeting users' needs are developing continuously. Publishers understand that they need to meet these challenges and adapt business models.

Following is a collection of background information, templates and generic documents which publishers may use in cases of copyright infringements.

These documents represent an incremental severity of actions, from appealing to the offender to desist from infringing copyright, to sending a cease and desist letter, and to lodging a formal complaint with SAPS.

Find below:

- A. General overview of possible steps available to publishers
- B. Draft "friendly" letter to a social media group to make members aware of the illegality of their activities
- C. A draft cease and desist letter to demand social media groups to disband the group and delete or otherwise destroy copies
- D. A draft affidavit for a formal complaint with SAPS
- E. Guidelines for lodging a complaint in terms of the Counterfeit Goods Act

A. General overview of possible steps available to publishers

What steps can publishers take against unauthorised copying and distribution, for example, a copyshop making copies for students, or a social media group?

1. A publisher who wishes to take action against unauthorised copying of a title should rely primarily on the copyright in the published edition.
2. The infringement of the copyright in a literary work or a published edition can give rise to a civil law claim, and in most instances to a criminal offence, under the Copyright Act. In both instances the legal action can be instigated by the copyright owner or by an exclusive licensee. In **civil proceedings** an interdict restraining the unlawful conduct, damages, delivery up of infringing copies and various other forms of ancillary relief can be obtained. In the case of **criminal copyright infringement** the State can prosecute the offender and the court can impose a penalties of up to R10 000 per item, or on conviction of up to 10 years jail time.
3. If a book which is reproduced features a registered trade mark, for instance the publisher's registered trade mark, the sale of an unauthorised copy can also constitute trade mark infringement under the **Trade Marks Act**.
4. The **Counterfeit Goods Act** could render the making and sale of unauthorised copies of a book an act of dealing in counterfeit goods. The Counterfeit Goods Act gives wide ranging powers of search and seizure to inspectors (police officers, customs officials, and the inspectors appointed by the Department of Trade, Industry and Innovation). The Counterfeit Goods Act has certain advantages over the Copyright Act: The mere possession of counterfeit goods in the course of trade is a criminal offence, whereas under the Copyright Act in equivalent circumstances proving that the goods have been made and/or sold by the accused is necessary before an offence can take place.
5. When a copyshop makes an unauthorised copy of a book, and assuming that the book features or bears the publisher's registered trade mark, that copyshop perpetrates one or more of the following unlawful acts:
 - a. The infringement of the copyright in the literary work and the published edition – both a civil wrong and a criminal offence.
 - b. The infringement of the publisher's registered trademark.
 - c. An offence under the Counterfeit Goods Act.
6. This will entitle the publisher to institute civil proceedings for copyright infringement and/or trademark infringement and to lay a criminal complaint of copyright infringement and/or dealing in counterfeit goods.
7. Before any action is taken, the enforcement options should be discussed with a knowledgeable attorney.
8. In order to apply for an **Anton Pillar order**, which provides the applicant the right to search premises and seize evidence without warning in order to prevent the destruction of evidence, one already has to have prima facie evidence that some wrongdoing is happening.

It is advisable to use such an order only when other means of stopping transgressions have been exhausted.

From: <https://www.publishsa.co.za/copyright/faq> (Updated)

Acknowledgement: Ms Monica Seeber & Dr Owen Dean

B. Draft “friendly” letter to a social media group to make members aware of the illegality of their activities

Dear {Name If You Have It / Administrator}

We have noticed that members on this group are sharing books. As publishers, we are the legal guardians of our authors' intellectual property rights. We appreciate that people like to read, so we bring the following with the utmost seriousness to your attention.

Please note that it is an offence to copy or distribute any copyrighted material, such as books, without the necessary permission of the copyright owner. Unless you have a formal written agreement with the copyright owner, or the necessary permission from the authorized entity that holds and administers the rights on behalf of the copyright owner, you may not reproduce or distribute any copyright protected work. In the case of books, such authorised entity would often be the publisher of each book.

This is a kind notice to say that we have collected information and kept track of the books and publications being distributed in this group. We will follow up this letter with a more formal, legal document. We offer you the opportunity to talk to a task team made up of representatives from different publishers, so that we can explain the wrongfulness of this situation. We can try to find a convenient time and method to chat.

Please remove all copyrighted material immediately from your group; this includes books and magazines from any business from around the world, unless you can provide us with a valid agreement that you have entered into with the copyright holder. Please also inform your members that the administrators or owners of this group, as well as individual members, may be prosecuted if anyone continues to distribute the copyrighted documents. This includes material currently shared in this group as well as any new copyrighted material.

Regards.

XXX

On behalf of XXX and with the mandate of the Publishers' Association of South

Beste {Naam as ons dit het / Administrateur}

Ons het gemerk dat lede op hierdie groep boeke deel. Ons as uitgewers is die wettige bewakers van ons skrywers se intellektuele eiendomsregte. Ons waardeer dit dat mense graag lees; daarom bring ons die volgende met die grootste erns onder u aandag.

Let asseblief daarop dat dit 'n oortreding is om enige materiaal, soos boeke, waarop daar kopiereg is, sonder die nodige toestemming van die kopiereghouer te versprei tensy jy 'n formele skriftelike ooreenkoms met die kopiereghouer het, of die nodige toestemming by

die gemagtigde entiteit wat die regte namens die kopiereghouer bestuur, verkry. In die geval van boeke sou dit dikwels die uitgewer van elke boek wees.

Hierdie is 'n vriendelike kennisgewing om te sê dat ons inligting versamel het en rekord hou van wat op hierdie groep versprei word. Ons sal hierdie skrywe opvolg met 'n meer formele, wetlike dokument. Ons bied jou die geleentheid om met 'n taakspan wat uit verteenwoordigers van verskillende uitgewers bestaan te gesels, sodat ons die onregmatigheid van hierdie situasie kan verduidelik. Ons kan 'n gerieflike tyd en metode probeer vind om te gesels.

Verwyder asseblief onmiddellik alle materiaal waarop daar kopiereg is van jou groep; dit sluit boeke en tydskrifte van enige onderneming vanoor die hele wêreld in, tensy jy vir ons 'n geldige ooreenkoms kan verskaf wat jy aangegaan met die kopiereghouer. Stel ook asseblief jou lede in kennis dat die administrateurs of eienaars van hierdie groep asook individuele lede vervolg kan word indien enige een aanhou om die dokumente waarop daar kopiereg is, te versprei. Dit sluit materiaal in wat tans in hierdie groep gedeel word, asook enige nuwe materiaal onderhewig aan kopiereg.

Met groete

XXX

Namens XXX en met mandaat van die Publishers' Association of South Africa

C. Draft cease and desist letters to demand social media groups to disband the group

XX XX 2020

XXX

By WhatsApp:

+27 XX XXX XXXX

RE: COPYRIGHT INFRINGEMENT

Dear XXX, Administrator of XXX

We confirm that XXX Publishers is the publisher (“the Publisher”) of XXX (“the Work”) by XXX (“the Author”) and XXX (“the Work”) by XXX (“the Author”) and other titles.

It has come to our attention that you are reproducing and distributing these two Works and many others, which are unequivocally subject to copyright, on your WhatsApp group “XXX”. This reproduction and distribution (i.e. copying and sharing) is being done without the authorisation of, or permission from, the copyright owners of the Works, namely the Author or the Publisher.

An excerpt from each of the two copyrighted Works as well as screenshots of them being shared are attached as Annexure “A” and “B”. Kindly be advised that more evidence has been collected and is in our possession for future legal processes should this be necessary.

Be advised that your unauthorized use (reproduction and distribution) of these Works is in contravention of the provisions of the South African Copyright Act, 98 of 1978, and is therefore unlawful and a clear infringement of the Author and Publisher’s rights. Due to your unlawful encroachment on said rights, the Author and Publisher are suffering a loss of income.

We are entitled to demand, and hereby do demand, that you and all members of XXX, your affiliates, officers, employees, agents and other persons or entities acting for you or under your direction, immediately:

- a) Cease and desist from reproducing, distributing and engaging in any other infringing acts in relation to these and any other copyright-protected Works;
- b) Provide written confirmation that you have deleted and removed all unlawful copies of these Works; and
- c) Further confirm in writing that you will not pursue any future infringement of these or any other copyright-protected Works.

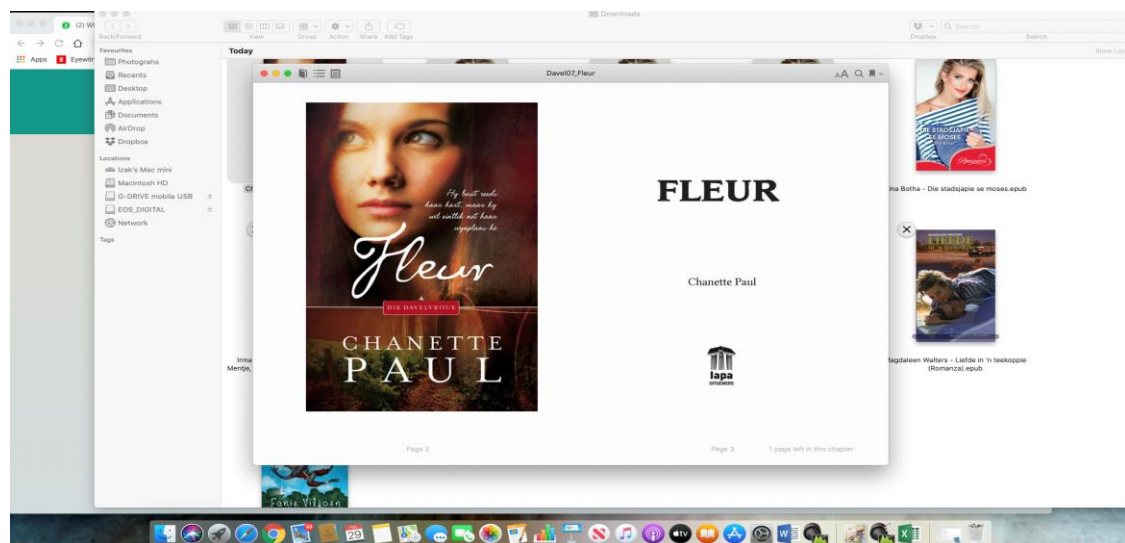
Should you fail to comply with the above demands by no later than XX XXX 2020 at XXhXX we will proceed with urgent legal action against you and will seek to hold you liable for the instituting of said legal action on a punitive scale.

I trust that you will be guided accordingly.

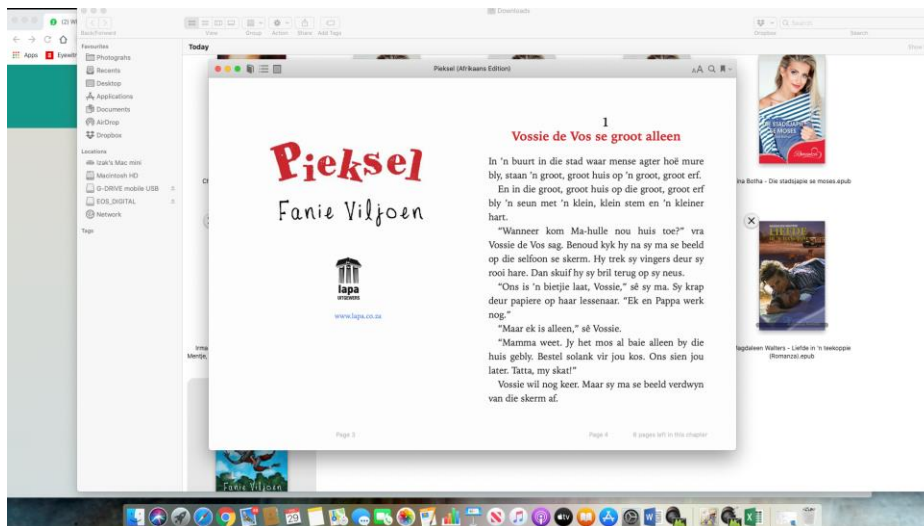
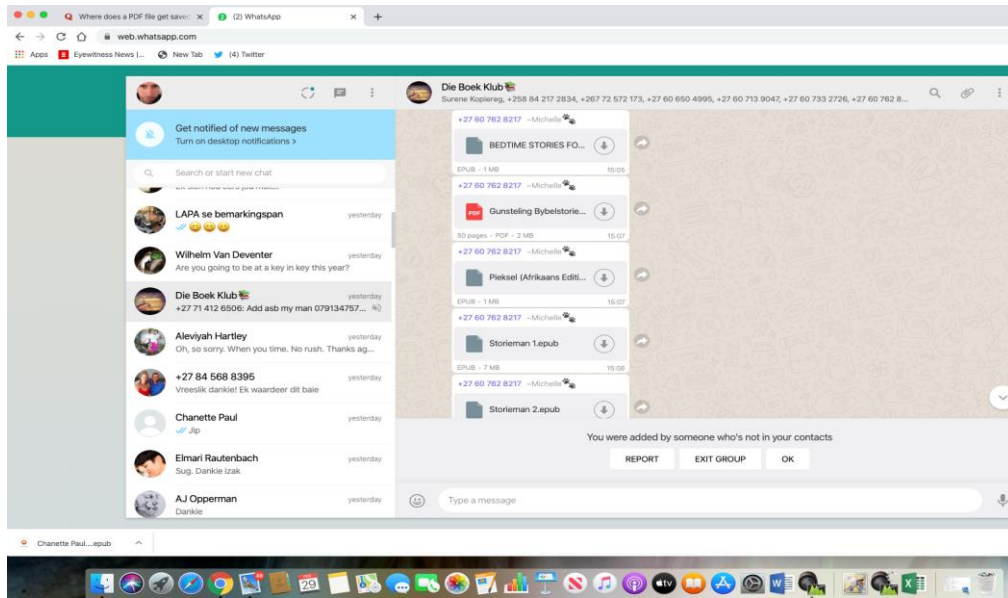
Regards.

XXX

Annexure A



Annexure B



D. Draft affidavit for a formal complaint with SAPS

AFFIDAVIT

I the undersigned,

XXX

state under oath that:

- 1 I am an adult male residing at XXX in the Western Cape. I attach a copy of my identity document as well as proof of address hereto marked **Annexure A** and **Annexure B** respectively.
- 2 The facts herein contained fall within my personal knowledge unless otherwise stated or indicated by the context and are to the best of my knowledge and belief both true and correct.
- 3 I am an employee of XXX; a literary publishing company.
- 4 On XXX I was told by XXX about a WhatsApp group that distributes XXX's books free of charge. (**Annexure C**: Screenshot 20XX-XX-XX at XX.XX.XX)
- 5 I investigated a WhatsApp group called "XXX" which was created on XXX. It was created by a person with a WhatsApp number +27 XX XXX XXXX. This number still appears as an Admin on the group. The name XXX appears on my screen in proximity to that number.
- 6 I found a very large number of books from many different companies being distributed on the WhatsApp group called "XXX". The books appear to be distributed free of charge with no indication that any compensation is paid to the copyright holders of these items.
- 7 On 20XX-XX-XX I identified and downloaded five publications of which the copyright holders of the original texts are known to me and in each case the publication rights had legally been assigned to XXX.
- 8 XXX owns the copyright of **XXX**. On 20XX-XX-XX she ceded rights to XXX., the complete agreement is hereto attached as **Annexure D**.
- 9 On 20XX-XX-XX I identified a file named **XXX**.
- 10 I downloaded the file and opened the document. It was a copy of XXX. On page X XXX is identified by its logo (see **Annexure F**: Screenshot 20XX-XX-XX at XX.XX.XX) and on the colophon page XXX is identified as the copyright holder of the text, XXX is identified as the copyright holder of the publication and the copyright notice declaring that the text should not be reproduced in any manner without the written consent of the copyright holders is clearly displayed (see **Annexure G**: Screenshot 20XX-XX-XX at XX.XX.XX). I am not aware of any written agreement allowing "XXX" or anyone associated to the group to

distribute or reproduce this document.

- 14 XXX owns the copyright of **XXX**. On 20XX-XX-XX she ceded rights XXX, the complete agreement is hereby attached as **Annexure L**.
- 15 On 20XX-XX-XX I saw a notice, posted by one XXX asking whether anyone has “XXX”. Directly below it was a file displaying as **XXX** and below that a notice that indicated that the file might be XXX. Upon further investigation the full name of the file was shown to be “XXX.epub”- see **Annexure M: IMG_0172.JPG**.
- 16 I downloaded the file and opened the document. It was a copy of **XXX**. On page X XXX is identified by its logo (see **Annexure N: Screenshot 20XX-XX-XX at XX.XX.XX**) and on the colophon page XXX is identified as the copyright holder of the text, XXX is identified as copyright holder of the publication and the copyright notice declaring that the text should not be reproduced in any manner without the written consent of the copyright holders is clearly displayed (see **Annexure O: Screenshot 20XX-XX-XX at XX.XX.XX**). I am not aware of any written agreement allowing “XXX” or anyone associated to the group to reproduce or distribute this document.

[It is suggested that five titles be added in similar fashion as evidence.]

DEPONENT

THE DEPONENT ACKNOWLEDGES THAT HE KNOWS AND UNDERSTANDS THE CONTENT OF THIS AFFIDAVIT, SIGNED AND SWORN TO BEFORE ME AT _____ ON THIS THE _____ DAY OF XXXX 20XX, WITH THE PRESCRIPTIONS RELATING TO OATHS HAVING BEEN COMPLIED WITH.

COMMISSIONER OF OATHS

E. Guidelines for lodging of a complaint in terms of the Counterfeit Goods Act

To whom it may concern

COMPLAINT IN TERMS OF THE COUNTERFEIT GOODS ACT NO 37 OF 1997

Your enquiry relating to the lodging of a complaint in terms of the Counterfeit Goods Act No 37 of 1997 (the Act) has reference.

It would be important for you to take note of the following requirements when you consider to submit a complaint in terms so the Act with **CIPC**:

- Any person with an interest in the protected goods may complain. A **person with an interest** in the protected goods, is the owner or licensee of an Intellectual Property Rights or the importer, exporter or distributor thereof, or a duly authorized agent, representative or attorney of the above who reasonably suspects that an offence has been or is likely to be committed.
- A complaint must be lodged in the form of an **affidavit under oath**.
- All annexures attached to the affidavit must also be sworn to.
- It is expected from the complainant to provide **the CIPC** in writing with **indemnity** for the requested actions to be taken by the inspector based on the complaint affidavit.
- The complainant must provide as part of the affidavit the necessary **evidence** that the goods are protected goods, such as certified copies of the **registered trademark** or design.

Information is required in relation to the alleged offence and that the suspect has **failed to take reasonable steps** to avoid an offence. Evidence could include:

- The **suspect knew or had reason to suspect** (intent to commit an offence);
- The goods in his/her possession or under his/her control are counterfeit goods;
- Are in his/her possession for the purpose of dealing in those goods. (The suspect might have received a warning (from the IP owner of his/her authorized representative or agent) prior to the complaint being lodged that the goods in his/her possession are counterfeit goods or counterfeit goods might have been found in the suspect's possession during a previous inspection.);
- It is expected from the complainant **to provide all the background information** available on the suspect in support of the complainant's suspicion that an offence is being committed or is likely to be committed.

Information and the particulars that the alleged counterfeit goods are *prima facie* counterfeit goods have to be submitted to enable the inspector to identify the **essential physical and any other distinctive features, elements, and characteristics** of the products. This could be done by furnishing the inspector with a specimen of the genuine protected goods and the counterfeit goods, or giving a detailed explanation and making use of photographs.

The complainant must allege that an act of dealing in counterfeit goods has been, or is being committed, or is likely to be committed, which allegations must be based on a reasonable suspicion.

The complainant must **confirm** in the complaint affidavit that he/she has made a full disclosure **of all material facts** known that a judge or magistrate before whom a request for a search warrant will be placed would rely on. That should include all correspondence and discussions that took place between complainant and alleged suspect and/or any undertakings given by any of the relevant parties on the alleged infringement and/or offence in terms of the Act any “voluntary surrenders” that might have occurred between the complainant and the suspect.

The complainant must include in the complaint affidavit if the suspects was previously raided by any law enforcement agency and if a raid did occur previously, what were the circumstances and the outcome of that raid.

The complainant must give an indication of its intended course of action, i.e. civil and/or criminal litigation.

Although it need not be included in the complaint affidavit, it is expected that the complainant will inform the inspector, in the covering letter whether or not the complaint lodged with the inspector was also lodged with any other law enforcement agency and if so, the reason why the other enforcement agency did not accept and/or act on the complaint. The covering letter should also contain information on the counterfeit goods depot that will be used to store the seized goods and the name of the person will be listed on the warrant to assist as knowledgeable person.

It is trusted that the information provided will be of assistance to you in lodging a complaint with **CIPC**.

Yours sincerely,

(signed)

AJ Lothringen

**Senior Manager Copyright and Intellectual Property Enforcement
CIPC**