

Suggested Actions to Address the Illegal Distribution of Copyright Content

May 2024/1

Addressing copyright infringement is an ongoing process, and complete elimination may not be possible. What steps can publishers take against unauthorised copying and distribution, for example, a copyshop making copies for students, or a social media group, or a pirate selling illegal copies?

Content

Suggested Actions

Trade Mark Registration

Complaint in terms of the Counterfeit Goods Act No 37 Of 1997

Digital Rights Management

'Friendly' Letters

Cease and Desist Letters

Digital Takedowns

Legal Action

South African Police Service

Educational Initiatives

Continuous Monitoring and Updates

Monetary investment

APPENDIX A Draft 'friendly' letter to a social media group to make members aware of the illegality of their activities

APPENDIX B Draft cease and desist letters to demand social media groups to disband the group

APPENDIX C Guidelines for lodging of a complaint in terms of the Counterfeit Goods Act

Trade Mark Registration

In South Africa, copyright is not registered. A publisher may decide to register its brand name, a slogan or a logo which provide a distinctive identity in the marketplace and a legal foundation to protect their intellectual property.

For types of intellectual property, including trademarks, see the DALRO information at <https://dalro.co.za/intellectual-property/>

‘When a trade mark (brand name, slogan or logo) has been registered, nobody else can use this trade mark, or one that is confusingly similar. If this happens, legal action may result...

‘A trade mark can only be protected as such and defended under the Trade Marks Act, 1993 (Act 194 of 1993) if it is registered...

‘CIPC administers the Register of Trade Marks which is the record of all the trade marks that have been formally applied for and registered in the Republic of South Africa.’

(https://www.cipc.co.za/?page_id=4118)

Complaint in terms of the Counterfeit Goods Act No 37 Of 1997

This 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, e.g. police officers and customs officials: The mere possession of counterfeit goods in the course of trade is a criminal offence.

APPENDIX C outlines the steps in taking action in terms of the Counterfeit Goods Act. Take note of the requirements in APPENDIX C when you consider to submit a complaint with the Companies and Intellectual Property Commission.

Requirements when lodging a complaint include alleging 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 give an indication of the intended course of action, i.e. civil and/or criminal litigation.

Importantly, note that 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.

Digital Rights Management

Get assurance from digital platform suppliers that they are using the best possible digital rights management (DRM) systems to protect your content from unauthorized duplication and distribution.

'Friendly' Letters

Depending on the severity of the eventual action you plan to take, you could first send 'friendly' letters to social media groups to make members aware of the illegality of their activities like sharing PDSs of popular titles. See APPENDIX A.

Cease and Desist Letters

Send cease and desist letters to known infringing parties. This is a standard procedure to request the removal of infringing content and to notify infringers of your rights. See APPENDIX B.

Digital Takedowns

Work with online platforms and hosting providers to have infringing content removed.

Legal Action

When cease and desist letters and takedown requests are unsuccessful, consult with intellectual property attorneys to understand the result of pursuing legal action against infringers.

South African Police Service

The infringement of copyright is a complex issue where the origination of the infringement is a burning point as well as the concept of ownership of the copyright itself. The easiest way forward would be if authors or copyright owners pursued legal action directly with SAPS.

Educational Initiatives

Creating awareness could be a crucial part of a long-term strategy. Consider educational campaigns on social media platforms to inform authors and readers about the importance of respecting copyright and the potential consequences of infringement and to report any wrongdoers.

The following examples of copyright and anti-piracy information and materials are available on the PASA website at <https://publishsa.co.za/antipiracy-protecting-creatives/>:

* Infographic – 'When may you download and share?'

* Anti-piracy logo – 'Respect creators. Say no to illegal copying.'

- * Anti-piracy social media slides and videos
- * 3 Anti-piracy Posters
- * Frequently asked questions
- * Plagiarism: An introduction for publishers, authors & editors
- * ANFASA-PASA Agreement on Contract Terms (APACT)

The PASA whistle-blowing email address is: reportpiracy@publishsa.co.za.

Also see:

- * DALRO information on copyright and licences: <https://dalro.co.za/copyright/>
- * The WIPO frequently asked questions on copyright:
https://www.wipo.int/copyright/en/faq_copyright.html

Continuous Monitoring and Updates

Continuously monitor changes on social media platforms and digital piracy trends. Staying informed is essential to adapting strategies effectively. Various well-organised and experienced organisations and agencies provide such services, e.g. Link Busters (<https://www.link-busters.com/>).

Some institutions provide assistance in taking action against piracy groups, e.g. UNISA, although the extent of piracy is far wider than that at UNISA.

The <https://unisa-groups.co.za/> website is used as portal by Telegram groups among UNISA students. 'UNISA-Groups' might take notice of takedown requests and disable the offending Telegram groups. These responses will appear at: <https://unisa-groups.co.za/2023/groups-not-available/>

Publishers that have adoptions at UNISA should contact team@unisa-groups.co.za and inform them of the UNISA Telegram groups (module code or URL) that can be accessed from their website that has illegal PDF files. Name the title being shared illegally in the group.

Monetary investment

Allocate budget to feasible and result-orientated copyright protection efforts.

APPENDIX A

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

APPENDIX B

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

XX XX 202X

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

APPENDIX C

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 of 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.

PASA Administrative Office: Wynberg Mews, House Cloete, Brodie Road, Wynberg, 7800
t: +27(0) 21 762 9083 f: +27(0) 864817680 e: pasa@publishsa.co.za url: www.publishsa.co.za

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 Lotheringen

Senior Manager Copyright and Intellectual Property Enforcement

CIPC