

**PROPOSED AMENDMENTS FOR CONSIDERATION IN THE REVIEW OF  
THE COPYRIGHT AND TRADEMARKS PROTECTION FOR THE  
DIGITAL ENVIRONMENT IN NIGERIA**

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## DEDICATION

This thesis is dedicated to God Almighty and to the loving memory of my late father Moses Adeoye Solanke.

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## CHAPTER 1: INTRODUCTION AND BACKGROUND.

### 1.0 Introduction

This thesis considers the manner in which Nigerian intellectual property law regulates the digital environment. The main question it asks is whether existing intellectual property law adequately balances and protects the rights of rightholders and users in the digital environment.

In answering this question, this thesis will raise the following sub-questions:

- a. How effective are the copyright laws in preventing or reducing illegal copying of copyright protected works?
- b. How are the rights of users balanced in the use copyrighted works which they have lawfully obtained?
- c. How effective is the copyright law in preventing circumvention of technological protection measures?
- d. Should registered trademarks be given priority in the registration of those marks as domain names? If yes, what legal justifications are there which support such ideology?
- e. How does the trademark legislation protect trademarks in online advertising being used as metatags, keywords, adwords, linking and framing?

Questions a, b and c will be answered in chapter two by first presenting an overview of the current legislation after which a comparison would be made with some other jurisdictions. Questions d and e will be answered in chapter three.

## 1.1 Background

Intellectual property connotes a series of legal principles which create exclusive rights in intangible property of the mind. Intellectual property law is that aspect of law which is applicable to and governs legal rights related to creative effort or commercial reputation and goodwill.<sup>1</sup> The legislative arms of various countries and states have enacted series of laws to govern and protect the rights contained in intellectual property. Intellectual property is a form of property, howbeit intangible property. Just as rights exist in tangible property and are protected by various statutes and enactments, so also rights in intangible property known as intellectual property exist and are also protected. Intellectual property rights confer on the owner the right to use exclusively his work/ property in prescribed ways he wishes so to do to the exclusion of all others thus it is important to enact laws to secure these rights.

Generally, it is the intellectual property rightholders who have the rights to authorise certain people to use their works/property in a manner as agreed by them. It is worth noting that while intellectual property rights are granted for the purpose of increasing knowledge, it is also very important to restrict its use.<sup>2</sup> In Nigeria, the Copyright Act Cap C28 Laws of the Federation 2004 governs and protects the rights in copyright works, the Trademarks Act Cap T13 Laws of the Federation 2004 governs and protects the rights in trademarks and the Patent and Design Act Cap P2 Laws of the Federation 2004 governs and protects the rights in patents. There are some other regulations which were enacted for protection of intellectual property rights but these three Acts are the major pieces of legislation that are used.

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<sup>1</sup> D Bainbridge *Intellectual Property* 7ed (2009) 3, D Hunter *The Oxford Introductions to U.S. Law: Intellectual Property* (2012) 1.

<sup>2</sup> Hunter op cit (n1) 2.

Indeed the world has gone digital and digitalisation has contributed immensely in the areas of economic development and growth, intellectual development and innovative developments through the easy and cheap acquisition and dissemination of information digitally. The internet has brought about a significant rise in information technology which has as a consequence, led to great developments in this information age. The internet which is the origin of digitalisation has impacted various aspects of intellectual property which include copyright, trademarks and patents and this has led to various digital intellectual property issues.<sup>3</sup>

Intellectual property rights subsist in all these digitalised works just as they subsist in their hard copy form and thus they are exposed to infringements from both innocent and non-innocent users. In the international arena, the Agreement on Trade Related Aspects of Intellectual Property Rights<sup>4</sup>, the Berne Convention for the Protection of Literary and Artistic Works<sup>5</sup>, the World Intellectual Property Organisation Copyright Treaty<sup>6</sup>, the Paris Convention for the Protection of Industrial Property<sup>7</sup> while encouraging intellectual and innovative developments through some of their provisions, all seek to protect intellectual property rights of the right holders and to balance these with the users interests in the analogue environment as well as the digital environment. Some countries have ratified and domesticated these treaties and conventions while some who did not ratify them have simply incorporated relevant aspects of them into their national laws. Although Nigeria is among the countries who

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<sup>3</sup>AAdewopo 'The Global Intellectual Property System and Sub-Saharan Africa. A Prognostic Reflection' (2001-2002) 33 *U. Tol. L. Rev.* 749 at 762.

<sup>4</sup> Agreement on Trade-Related Aspects of Intellectual Property Rights 1869 UNTS 299; 33 ILM 1197 (1994).

<sup>5</sup> Berne Convention for the Protection of Literary and Artistic Works S. Treaty Doc. No. 99-27 (1986); 1161 U.N.T.S 3.

<sup>6</sup> WIPO Copyright Treaty, adopted 20 December 1996, entered into force on March 6 2002 36 ILM 65 (WCT).

<sup>7</sup> Paris Convention for the Protection of Industrial Property, concluded July 14 1967, entered into force 26 April 1970, 828 UNTS 305 (as amended September 28 1979) (Paris Convention).

are signatories to these conventions and treaties, they are not enforceable because they haven't been codified into national laws.<sup>8</sup>

## 1.2 Research Problem

With an estimated population of 174.51 million people<sup>9</sup>, 45.04 million people use the internet which places Nigeria in the 11<sup>th</sup> position on the rating statistics of top nations on the internet according to Internet World Stat.<sup>10</sup> Nigeria holds the record of the largest internet market in Africa as almost 40 per cent of all internet traffic from Africa comes from Nigeria having the largest mobile and internet market with about 112.78 million mobile phones being in use as of 2012.<sup>11</sup> Africa holds the record of seven percent of internet users of the world with Nigeria using 29 per cent of the seven per cent.<sup>12</sup> This is unsurprisingly so as Nigeria is the most populous nation in Africa and the largest black nation in the world. Research also shows that the 15-54 years age bracket makes up 49.4 per cent of the entire population.<sup>13</sup> This is the class of persons who use the internet for various activities among, but not limited to, social networking, sourcing information, studying online, playing games,

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<sup>8</sup> Section 12 (1) of the Constitution of the Federal Republic of Nigeria 1999 (As amended) provides that 'no treaty between the Federation and any other country shall have the force of law to the extent to which any such treaty has been enacted into law by the National Assembly'.

<sup>9</sup> 'The World Factbook', available at [www.cia.gov/library/publication/the-world-factbook/geos/ni.html](http://www.cia.gov/library/publication/the-world-factbook/geos/ni.html), accessed on 4 February 2014.

<sup>10</sup> E Amaefule 'Nigeria Joins Top 20 Internet Nations', 6 May 2012, available at [www.punchng.com/business/nigeria-joins-top-20-internet-nations/](http://www.punchng.com/business/nigeria-joins-top-20-internet-nations/), accessed on 31 January 2014.

<sup>11</sup> M Malakata 'Nigeria Claims Top Internet Spot in Africa' 13 August 2010, available at <http://saharareporters.com/news-page/nigeria-claims-top-internet-spot-africa>, accessed on 31 January 2014, 'The World Factbook', available at [www.cia.gov/library/publication/the-world-factbook/geos/ni.html](http://www.cia.gov/library/publication/the-world-factbook/geos/ni.html), accessed on 4 February 2014.

<sup>12</sup> 'Internet Usage Statistics for Africa', available at [www.internetworldstats.com/stats1.htm](http://www.internetworldstats.com/stats1.htm), accessed on 31 January 2014.

<sup>13</sup> 'The World Factbook', available at [www.cia.gov/library/publication/the-world-factbook/geos/ni.html](http://www.cia.gov/library/publication/the-world-factbook/geos/ni.html), accessed on 4 February 2014.

downloads, uploads and sharing of movies and music and internet fraud popularly known as yahoo-yahoo.<sup>14</sup>

In Nigeria, the Copyright Act, the Trademarks Act and the Patents and Designs Act are the major legislation that protects intellectual property rights of right holders. Unfortunately, piracy is still a very big problem in the country. In August 2013, the Nigerian Copyright Commission (NCC)<sup>15</sup> arrested 12 suspects for allegedly illegally transmitting signals of Multi-Choice and in the course of the arrest seized illegal transmitting equipment worth ₦29.3 million.<sup>16</sup> Also in September 2013, operatives of the NCC accompanied by some officers of the Nigerian Police Force raided two replicating plants in Lagos which were involved in illegally duplicating original copyright works and recovered over 8000 copies of suspected pirated CDs. Earlier in the year, 145 suspected pirates were also arrested and assorted pirated works of over seven million units comprising of books, software, CDs, DVDs worth over ₦1.2 billion were recovered from them.<sup>17</sup> The legislation available at the moment has not been able to effectively tackle the problem of piracy in the analogue environment

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<sup>14</sup> Internet Usage in Nigeria', available at [www.woweffectng.com/new/internet-usage-nigeria](http://www.woweffectng.com/new/internet-usage-nigeria), accessed on 5 February 2014. Yahoo-yahoo is a practice that involves the use of the internet to perpetrate fraud through the creation of fictitious email accounts and websites by fraudsters. Fraudulent emails are sent to unassuming people outside the country whereby the senders make up fake identities and portray themselves to be who they are not in order to lure these unassuming people to embark on business ventures or investments which are none existent and also enter fake relationships with them so as to elicit huge sums of money from them thereby defrauding them.

<sup>15</sup>The Nigerian Copyright Commission (NCC), a federal agency, formerly known as the Nigeria Copyright Council was established by s 30 (1) of the Copyright Act. It was changed from a Council to a Commission by s 2 of the Copyright (Amendment) Decree No 42 1999 Laws of the Federation of Nigeria. Its responsibility as provided in s 30 (3) of the Act is the administration of copyright matters in Nigeria through monitoring, supervisory, advisory and regulatory activities.

<sup>16</sup> Premium Times 'NCC Arrests 12 over Alleged Illegal Transmission of DSTV signals', 29 August 2013, available at [premiumtimesng.com/newsx/143759-ncc-arrests-12-over-alleged-illegal-transmission-of-dstv-signals.html](http://premiumtimesng.com/newsx/143759-ncc-arrests-12-over-alleged-illegal-transmission-of-dstv-signals.html), accessed on 8 February 2014.

<sup>17</sup> V Oyefeso 'Copyright Commission Impounds 10,000 Cartons Of Pirated Books Worth ₦1.5billion', available at <http://copyright.gov.ng/index.php/news-and-events/99-copyright-commission-impounds-10-000-cartons-of-pirated-books-worth-n1-5billions>, accessed on 8 February 2014.

how much more the digital environment. Also in the analogue environment, the rights of right holders and users are not well secured or protected in a manner that is reflective of this technological age.

In the light of the advances in technology usage and current state of the laws, it can be rightly said that Nigerian Legislators have not been able to enact laws that are up to date and that would adequately protect intellectual property in the digital environment.

### **1.3 Approach**

This thesis will commence by first outlining the historical development of existing law and attempts made at reforms. Secondly, it will review the current provisions of the copyright law in Nigeria and where appropriate, consider the legal position in some other jurisdictions like the United Kingdom, the United States of America, France, Canada, New Zealand and South Africa. These countries have been selected because they are among the few countries which have amended different aspects of their copyright laws and also enacted statutes to meet up with the current demands of this technological age. It would also in the course of the work make recourse to some international legislation. Thirdly, it will review the current provisions of the trademarks law in Nigeria and will make a comparison of the current regime with what operates in other jurisdictions like the United States of America, South Africa and Australia. These countries have also taken steps to provide trademarks protection that covers the digital environment. Finally, it will broaden the scope of the copyright and trademarks legislation by proposing amendments to update this legislation so that they can adequately protect rights of rightholders and also the rights of the users.

#### 1.4 Development of Intellectual Property Law in Nigeria

The history of intellectual property in Nigeria can be split into two; the pre-colonial or aboriginal society and the classical intellectual property incorporated by colonial law which has since been maintained by post-independence intellectual property statutes.<sup>18</sup>

The pre-colonial/indigenous society was a period where customs and practice were the system of governance before the advent of colonialism. The customs were unwritten but they were well known by all the members of the community and administered by the traditional rulers. The different tribes were actively involved in and were well known for certain activities and the creation of some particular things like cloth weaving, each community had its folk songs, clay pot moulding, sculptures, designs, textiles, bead making, tribal marks among other things which would have been eligible for intellectual property protection in the classical period.<sup>19</sup>

The classical intellectual property period can be traced back to the long historical and political connection Nigeria has with Great Britain. Nigeria was a former colony of Great Britain, thus a discussion of the development of intellectual property in Nigeria without recourse to England would be incomplete. The introduction of intellectual property law into Nigeria was through the colonial legal development which Britain used in Africa, Asia and Latin America.<sup>20</sup>

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<sup>18</sup> AAdeowo 'According To Intellectual Property: A Pro-Development Vision of the Law and the Nigerian Intellectual Property Law and Policy Reform in the Knowledge Era' (2012) *NIALS* 12.

<sup>19</sup> B Shodipo 'Piracy & Counterfeiting, Gatt, Trips and Developing Countries' (1997) 37.

<sup>20</sup> F Shyllon 'Intellectual Property Law In Nigeria' (2003) 21 *IIC Studies in Industrial Property & Copyright Law* 27.

The United Kingdom Act<sup>21</sup> came into force in the then Southern Protectorate by the Trademark Proclamation of 1900. Upon the amalgamation of the Northern and Southern protectorates in 1914, the Trademark protection available in the then Southern protectorate was extended to the newly formed country. The Trademark Ordinance No.13 of 1926 replaced the 1900 Proclamation and it was primarily aimed at promoting trade by British Imperial power. In 1965, the first intellectual property law and the first post-independence intellectual property law was enacted which was the Trademarks Act 1965<sup>22</sup> which repealed the 1926 Trademark Ordinance. Since 1965 till now, there has been no amendment whatsoever made to the Trademarks Act.<sup>23</sup>

The Order in Council of 24<sup>th</sup> June 1912 extended the Copyright Act of 1911 of England to the Southern Protectorate and remained in force after the amalgamation. In 1970, the Copyright Act was enacted as the first post-independence copyright statute and it repealed the 1911 Copyright Act. Almost two decades after the enactment of the 1970 Act, there was a great clamour for review by the copyright industry especially the publishers and the musicians. There had been a record of huge losses attributable to the growing incidence of piracy. Thus in 1988, the pressure for an amendment of the copyright law brought about the enactment of the Copyright Act 1988 and the repealing of the 1970 Act. The 1988 Act, since its inception has been amended in 1992 and also in 1999.<sup>24</sup>

Nigeria is also a signatory to numerous international treaties and conventions but they have not been domesticated such as the Berne Convention, the TRIPS Agreement, the WIPO Copyright Treaty, the WIPO

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<sup>21</sup> Patents, Designs and Trade Marks Act 1888 51& 52 vict c 50.

<sup>22</sup> Which is now contained in Cap T13 Laws of the Federation 2004.

<sup>23</sup> Adewopo op cit (n18) 13.

<sup>24</sup> Which is now contained in Cap C28 Laws of the Federation 2004.

Performances and Phonograms Treaty,<sup>25</sup> and the Rome Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organisations.<sup>26</sup>

### **1.5 History of Intellectual Property Reform in Nigeria till Date**

The first attempt at IP reforms began in the early 80's. The pressures for the reform of the Copyright Act which were born out of the bane of piracy of books and musical works were led by the book publishing and music industries. In 1988, the Copyright Act was promulgated and amended twice, first in 1992 and later in 1999. There were also efforts howbeit unsuccessful to review the Trademarks Act of 1965 and the Patents Act of 1970. One of such attempts was in 1991 when the draft Industrial Property Bill which was made to consolidate the trademarks and patent and designs law in one industrial property law under the control of an industrial property office<sup>27</sup> in order to upgrade the two Acts in accordance with present commercial and technological development and intellectual property at the international level. The 1991 Report of the Nigeria Law Reform commission was produced on the intention of reforming the industrial property law which had become crucial for the trademark and patents regimes to evince the significant changes in commercial terrain and the protection of inventions and new technologies respectively.<sup>28</sup>

In September 1999, WIPO and the Nigerian Government organised a workshop on teaching Intellectual Property for the African region. At the opening, the Federal Government announced that the Intellectual Property

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<sup>25</sup> WIPO Performances and Phonograms Treaty adopted 20 December 1996, entered into force on March 6 2002 36 ILM 76 (WPPT).

<sup>26</sup> "Rome Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations." October 26, 1961. 496 U.N.T.S. 43.

<sup>27</sup> Draft Industrial Property Decree, Part 1.

<sup>28</sup> Nigerian Law Reform Commission 'Working Paper on the Reform of Industrial Property Law' (1990) 1.

administration was going to be re-structured with the inauguration of an Intellectual Property Commission. This announcement was followed by the set up of a committee which comprised of delegates from the various agencies governing the intellectual property and also relevant stakeholders. They were saddled with the responsibility of working out requirements for creation of an intellectual property Agency which would oversee the activities of the Copyright and Industrial Property regimes and also the responsibility of making recommendations for the review of the current IP Laws. This pronouncement of this policy never went beyond that.<sup>29</sup>

In late 2006, the previous Industrial Property Bill which now included the copyright was built upon by a draft Nigerian Intellectual Property Commission (NIPCOM) Bill. The NIPCOM bill was made by the executive to compliment the Federal Government's Reform Agenda. In 2007, the NIPCOM Draft bill was prepared to cover all the subject matters of intellectual property rights in Nigeria including copyright, trademarks, service marks, patents and designs but this turned out to be unsuccessful. These unsuccessful attempts led to another attempt for the amendment of the Copyright Act by another Copyright Law Reform group which drafted a Copyright (Amendment) Bill 2010 which attempted to amend the Copyright Law to reflect the budding technological and digital environment. However there has been no passage of the Bill into Law.<sup>30</sup> The Director General of the Nigerian Copyright Commission (NCC) on the 6<sup>th</sup> of September 2012 announced that the NCC had set in motion machinery tagged "Copyright System Reform" aims to reform the nation's copyright system to reposition the copyright sector for increased economic performance. He stated further that this reform had become long overdue and that it was necessary in order to bring the copyright system up in line with

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<sup>29</sup> Adewopo op cit (n18) 49.

<sup>30</sup> Adewopo op cit (n18) 50.

international treaties and also to boost the sector and the economy.<sup>31</sup>There is also ongoing attempt to revise the trademark law.

In an attempt to combat computer crime related activities, two Draft Bills were drafted entitled Computer Security and Critical Infrastructure Protection Bill 2005 and the Cyber Security and Data Protection Agency (Establishment, etc) Bill 2008 but both were never passed into law. These two Bills, by criminalising activities that related to tampering with access codes or passwords used to protect data stored up in a computer would have been able to combat activities of circumventing technological protection measures. This would have somewhat impacted intellectual property in the digital environment.

Despite all these attempts at reforms, none has yielded any positive returns and it is evident that the intellectual property law regime which is in place at present, having failed to be upgraded is very much behind and there is a very urgent need for a new regime. The Copyright Act seems to be the luckiest of these three major legislations as it is the most recent which was amended in 1998, about 15years ago in spite of the major technological developments and advancements which have been recorded in the 21<sup>st</sup> century. It is therefore important that there be a thorough overhaul of these two Acts and bringing up to standard to meet up with the demands of the present age we are at the moment.

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<sup>31</sup> 'Nigerian Copyright Commission to Reform Copyright System....DG seeks stakeholders' collaboration' available at [www.copyright.gov.ng/index.php/news-and-events/117-nigerian-copyright-commission-to-reform-copyright-system-dg-seeks-stakeholders-collaboration](http://www.copyright.gov.ng/index.php/news-and-events/117-nigerian-copyright-commission-to-reform-copyright-system-dg-seeks-stakeholders-collaboration), accessed 8 January 2014.

## **CHAPTER 2: OVERVIEW OF THE PROVISIONS OF THE COPYRIGHT ACT FOR PROTECTION OF COPYRIGHT IN THE DIGITAL ENVIRONMENT AND A COMPARISON WITH OTHER JURISDICTIONS**

### **2.0 Introduction**

Chapter one of this thesis presented the problems which copyright and trademarks in the digital environment are faced with. It examined how copyright and trademarks have developed in Nigeria and the attempts at reform which proved abortive. This chapter would be examining some relevant provisions of the Copyright Act, considering its peculiarities and inadequacies and how the law is applicable in protecting the rights of rightholders as well as ensuring a balance with the rights of users particularly in relation to the digital environment. It would also be examining the laws applicable in the United Kingdom, the United States of America, Canada, New Zealand and South Africa as stated in chapter one. It would consider the aspects of the laws that make provisions for copyright protection in the digital environment which make them fair better than the Nigerian law.

### **2.1 Background**

The current structure in place for the protection of copyright can be said to be awfully below the required standards for this time and age. The Copyright Act is 26 years old and was last amended 14 years ago. This Act has become outdated and needs to be fine-tuned in order to meet up with developing technological standards. Some of the major problems of the copyright regime stems from the age of the statute, the nature and scope of rights governed by the law does not reflect the contemporary developments of this time and age, failure on the part of the law reforms administration to

formulate reform policies and also the inability to link intellectual property with the environment.<sup>32</sup>

## 2.2 Copyright Protection

The Copyright Act has retained the fundamental principles of copyright. Section 1 (1) of the Act provides that literary works, musical works, artistic works, cinematograph films, sound recordings are works eligible for copyright. It is also provided in s 1 (2) that a literary, musical or artistic work shall be ineligible for copyright except it is regarded as original through the dissipation of sufficient effort on the work and if it is 'fixed in any definite medium of expression from which it can be perceived, reproduced or otherwise communicated either directly or with the aid of any machine or device'. Section 1 (4) further provides that a work shall not be unqualified for copyright merely because copyright in some other work was infringed in making the work. The Act defines literary works in s 39 to include:

- a. Novels, stories and poetic works;
- b. Plays, stage directions, film scenarios and broadcasting scripts;
- c. Choreographic works;
- d. Computer programmes;
- e. Textbooks, treaties, histories, biographies, essays and articles;
- f. Encyclopaedias, dictionaries, directories and anthologies;
- g. Letters, reports and memoranda;
- h. Lectures, addresses and sermons;
- i. Law reports excluding decisions of courts;

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<sup>32</sup> Adewopo op cit (18) 16.

- j. Written tables or compilations.

### 2.3.1 File sharing and Graduated Response Scheme in Nigeria

File sharing is a technology that was developed to allow users to copy and share music, movies, books and other copyrighted works at an immeasurable and unlimited scale at little or no costs.<sup>33</sup> File sharing has greatly reduced the cost of reproduction of copyright protected works and there is no limit to the number of copies that could be made via file sharing. Also, because most laws/legislations are targeted at infringements in the analogue environment, file sharing has posed significant challenges to the copyright protections. The provisions of the Copyright Act are wide enough to cover infringements of copyrights even in the digital environments;<sup>34</sup> however, the limitations and exceptions provided in the act which are primarily targeted at the analogue environment are not adequate for the digital environment. For instance, technological protection measures which are installed to restrict access to works are a major source of problems to the exercise of copyright exceptions and limitations. Users are prevented from exercising their statutory rights unless they pay some amount of money to grant them access.

File sharing online is done majorly through peer-to-peer sharing via internet networks. Peer-to-peer (P2P) file sharing is a technology that is internet based which allows users with certain P2P software to exchange and transfer files and media.<sup>35</sup> Legal issues arise where a user makes unauthorised copies of a copyrighted work and distributes them in such a way that is detrimental to the copyright owner's economic interest.<sup>36</sup>

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<sup>33</sup> F Oberholzer-Gee and K Strumpf 'File Sharing and Copyright' (2010) 10 *Innovation Policy and Economy* 16.

<sup>34</sup> Section 15 of the Copyright Act.

<sup>35</sup> W Fung & A Lakhani 'Combating Peer-to-Peer File Sharing of Copyrighted Material Via Anti-Piracy Laws: Issues, Trends and Solutions' (2013) 29 *Computer Law & Society Review* 382 at 383.

<sup>36</sup> Fung & Lakhani op cit (n35) 384.

Internet service providers which provide the internet networks that are used to share files should be made to bear the liability for the activities of the infringers and the justification for this is discussed below.

### **2.3.1.1 Liability of Internet Service Providers**

There is no statutory provision for liability for any other person other than the direct infringers but the courts have introduced the concepts of contributory infringements and vicarious liability.<sup>37</sup> When one person knowingly induces, causes or contributes materially to infringing activities of another person, such a person would be found to be liable for contributory infringement. Where also a person has a technology that is capable of infringing and non-infringing uses and is entitled and able to monitor the infringing activities and is making or likely to make in the future financial gains therefrom, he will be vicariously liable for such activities.<sup>38</sup> File sharing online as stated earlier is done through P2P sharing on the internet networks. These networks and internet service providers make available the platforms on which these P2P transfers occur and so they bear secondary liability for the acts of infringement that are being committed.<sup>39</sup> They also have the wherewithal and technology to detect infringing activities going on online.<sup>40</sup> Thus, internet service providers bear indirect liability for infringing activities of users because they have available at their disposal, knowledge of infringing activities as well as the technology to identify and block the activities; they have control over

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<sup>37</sup> M Lemley & R Reese 'Reducing Digital Copyright Infringement Without Restricting Innovation' (2004) 56(6)*Stanford Law Review*1345 at 1354.

<sup>38</sup> Lemly & Reese op cit (n 37) 1368.

<sup>39</sup> Lemley & Reese op cit (n 37) 1369.

<sup>40</sup> J Peha & A Mateus 'Policy Implications of Technology for Detecting P2P and Copyright Violations' (2014) 38 *Telecommunications Policy* 66 at 68.

what goes on online; and they have received remuneration from users for internet access.<sup>41</sup>

With the P2P detection technology, an ISP may apply a Graduated Response Scheme where the user is suspected of engaging in copyright infringement online. The detection technology can be used to prevent infringement by blocking transfers where it is certain that the transfer would amount to an infringement. It could also be used to send warnings out to alleged infringers that they are engaging in infringing activities. It is also required so as to determine what compensation is to be paid out to copyright holders. It is also useful for statistical purposes.<sup>42</sup>

However, there are no safe harbour exceptions for Internet Service Providers or website owners for exclusion from liability for secondary infringements for acts of infringements committed by the users. At present in Nigeria, most of the efforts to combat infringement are aimed at the analogue environment. This is probably due to weak law enforcement<sup>43</sup> and also the fact that the copyright owners and the NCC due to inadequate consultation on the Act are not yet knowledgeable enough to understand the technology of file sharing and its impact.

A Graduated Response Scheme is an alternative enforcement mechanism<sup>44</sup> that has been introduced in different countries either through

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<sup>41</sup> D Lichtman & W Landes 'Indirect Liability for Copyright Infringement: An Economic Perspective' (2002-2003) 16 *Harv. J. L. & Tech* 394 at 402-403.

<sup>42</sup> Peha & Mateus op cit (n 40) 68.

<sup>43</sup> Section 18 of the Copyright Act provides that it is an offence to make or cause to be made, import or caused to be imported into Nigeria, sell, let or hire or distribute for the purpose of business or trade as well as have in possession other than for private use any infringing copy of a work in which copyright exists. Anyone found guilty of any of these offences is liable to a fine not exceeding ₦1000 for each copy of the infringing work or a term of imprisonment not exceeding two or five years depending on the offence or both fine and imprisonment.

<sup>44</sup> A Stowel 'Internet Piracy as a Wakeup Call for Copyright Law Makers - Is the "Graduated Response" a Good Reply?' (2009) *WIPO Journal* 75 at 78.

legislation or private ordering due to the failure and inefficiency of litigation by copyright holders against individuals involved in copyright infringement activities through file sharing and P2P platforms.<sup>45</sup> It is a departure from the old order of litigation or other statutory mandates which previously, rights owners had to pursue to challenge infringements.<sup>46</sup> It entails copyright holders collaborating with Internet Service Providers to enforce their copyright and also enforce sanctions on users suspected to be infringing copyright through various activities like issuing warning notices, forwarding details of infringing activities and contact details of the alleged infringer to the copyright holders, keeping records of activities of users, capping of internet services, blocking of certain concerned sites, portals or protocols among others.<sup>47</sup> It is seen as a less expensive mechanism for the enforcement of copyright and curbing infringement.

A Graduated Response Scheme is beneficial to copyright holders and ISPs because it is cheaper, quicker and more efficient. It discourages the disrespect of other people's intellectual property and by so doing, secures the legal rights of creative citizens.<sup>48</sup> A Graduated Response Scheme is campaigned for on the grounds that in terms of costs, it is a cheaper mechanism of enforcement for combating copyright infringements and that internet service providers who enjoy unfair benefits which accrue to them from the infringement activities have a duty to join in this enforcement process.<sup>49</sup>

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<sup>45</sup> C Ncube 'Copyright Enforcement: Graduated Response Takes Centre Stage' (2012) 24 *SA Merc LJ* 133.

<sup>46</sup> A Bridy, 'Graduated Response and the Turn to Private Ordering in Online Copyright Enforcement' (2010-2011) 89 *Or. L. Rev.* 81 at 83.

<sup>47</sup> N Suzor & B Fitzgerald 'The Legitimacy of Graduated Response Schemes in Copyright Law' (2011) 34 *UNSWLJ* 1, C Swartout 'Toward a Regulatory Model of Internet Intermediary Liability: File Sharing and Copyright Enforcement' (2011) 31 *Nw. J. Int'l L. Bus* 499 at 500.

<sup>48</sup> PK Yu 'The Graduated Response, The copyright USA- A Collection: The Surging Influence of Copyright Law in American Life' (2010) 62 *Fla. L. Rev.* 1373.

<sup>49</sup> Suzor & Fitzgerald op cit (n47) 3.

There is no law providing for A Graduated Response Scheme in Nigeria. Such a scheme has not yet been created by private ordering. The closest legislation that could have been available is the Cyber Security and Data Protection Agency (Establishment, etc) Bill 2008 which was not enacted.

Section 15 of the Bill obligates every service provider to retain all internet traffic, information of its subscribers' information and specified content on its network for a specified duration of time as directed by the Agency. Upon request by any law enforcement agency, the service provider has to make available the traffic of subscriber information which it has been directed to keep and also is required to release upon a warrant being issued, information preserved, held or retained or any related content. The data so retained or procured by the service provider for the law enforcement agency as provided in the Bill can only be utilised for legitimate purposes subject to obtaining the consent of owner of the data or upon the authority of a court of competent jurisdiction and having due consideration for the right to privacy as guaranteed by the Constitution, measures shall be taken by those involved to ensure that all data retrieved for law enforcement are treated with confidentiality. Wilful contravention by any person, natural or juridical, or service provider of these provisions amounts to an offence which upon conviction gives rise to liability for a fine, imprisonment both fine and imprisonment.<sup>50</sup> From the provisions of these sections of the bill, it is apparent that the Legislature did not have the intention of legalizing graduated response schemes between the rightholders and the internet service providers. The internet service providers are only obligated to the law enforcement agencies.

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<sup>50</sup> Sections 16 and 17 of the Cyber Security and Data Protection Agency (Establishment, etc) Bill 2008.

### 2.3.2 File Sharing and Graduated Response Scheme in the United Kingdom

Countries like the France, Taiwan, South Korea and New Zealand have introduced while the United Kingdom proposes to introduce the graduated scheme through legislation. In the United Kingdom, the Digital Economy Act (DEA) was enacted in 2010. In France, the France Haute Autorité pour la diffusion des œuvres et la protection des droits sur internet<sup>51</sup> (Hadopi) which had the three strikes model was introduced in 2009 but the three strikes penalty was revoked on 8 July 2013 and replaced with an automated fine system.<sup>52</sup> In New Zealand, the Copyright (Infringing File Sharing) Amendment Act 2011 (NZ) was enacted in 2011 and has since then been in force. Countries like the United States of America and Ireland have adopted the private ordering arrangement where Internet Service Providers enter into private agreements with the rightholders to terminate accounts of alleged infringers without any legislative regulation or involvement.

The United Kingdom's Digital Economy Act (DEA) was enacted to, among other functions; make provisions in relation to online infringement of copyright of rightholders and penalties for such infringement activities by amending some of the sections of the Communications Act 2003. However, the Act is yet to come fully into force as only ss 5, 6, 7, 15, 16(1), 30, 31, 32, 46 and 48 came into force the day the Act was passed.<sup>53</sup> The other provisions including the provisions that relate to online infringements of and penalties for copyright infringement would only come into force when the Secretary of State makes, through a statutory instrument, such order.<sup>54</sup>

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<sup>51</sup> Law promoting the distribution and protection of creative works on the internet.

<sup>52</sup> Published in the Official Journal No. 0157 of 9 July 2013 page 11428 available at <http://www.legifrance.gouv.fr/affichTexte.do?cidTexte=JORFTEXT000027678782&dateTexte=&oldAction=rechJO&categorieLien=id>, <http://torrentfreak.com/three-strikes-and-youre-still-in-france-kills-piracy-disconnections-130709/> accessed 20 May 2014.

<sup>53</sup> Section 47 (2) of the Digital Economy Act.

<sup>54</sup> Sections 28 (8) and 47 (3) of the Digital Economy Act.

This section outlines the proposals made by ss 3, 4, 9 and 10 of the DEA which are yet to come into force. The DEA proposes to amend the Communications Act by inserting ss 124(g) & (h) which would empower the Secretary of State to obligate an internet service provider to take certain technological measures against relevant subscribers of its services to prevent or reduce infringement activities online.<sup>55</sup> The process begins where a subscriber of an internet service has infringed or allowed another person use the internet service to infringe the owner's copyright.

Section 3 which proposes to insert s 124A in the Communications Act provides that the owner of the copyright may make a report and send same within one month of gathering evidence of the infringement to the internet service provider. It shall be stated in the report that the owner's copyright has been infringed, a description of the infringement activity, evidence of the infringement showing the subscriber's IP address and the time the infringement evidence was collected. Upon receipt of the copyright infringement report and within one month of receipt of the report, the ISP is to notify the subscriber of the report. The notification being sent from the internet service provider to the subscriber must contain: a statement that the notification is sent consequent to a copyright infringement report; the name of the owner of the copyright who sent the report to the internet service provider; a description of the alleged infringement activity; evidence of the alleged infringement activity which shows the subscriber's IP address and the time the infringement evidence was collected; information notifying the subscriber of appeals options and grounds upon which they may be made; information on copyright education; information about how the subscriber may obtain advice on how to lawfully access copyright works; advice or information on how the subscriber may

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<sup>55</sup> Sections 9 and 10 of the Digital Economy Act.

obtain advice on how to prevent unauthorised access to his internet access service; any other thing that may be required by the initial obligations code.

The proposed s 124B<sup>56</sup> also obligates the internet service provider to provide copyright infringement lists to copyright owners upon request for it. The Secretary of State would by order impose a technological obligation on the internet service provider which entails the internet service provider taking certain technical measures to stop online infringement after the Office of Communications (OFCOM) has assessed that one or more technical obligations should be imposed on the internet service provider and the Secretary of State has also taken into account the assessments and reports prepared by OFCOM. The order would state the date it is to take effect and the criteria used in taking such technical measure against the subscriber.<sup>57</sup> A technical obligation as it relates to ISPs is an obligation requiring the carrying out of technical measures against some specific subscribers to its service in order to prevent or reduce infringement of copyright online.<sup>58</sup> These proposals have been heavily contested and it is not clear if, and when they will come into force. The two pieces of secondary legislation which are meant to supplement the Act, the Initial Obligations Code which is to contain obligations for ISPs to monitor the activities of their subscribers and the Costs Order which is meant to deal with apportionment of costs between the right owners, ISPs and affected subscribers, have been subject to series of judicial reviews and this one of the reasons for the delay in its implementation.<sup>59</sup> Another reason for the delay in its implementation is that its provisions have been vigorously criticised by civil

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<sup>56</sup> Sections 4 of the Digital Economy Act.

<sup>57</sup> Section 10 of the Digital Economy Act.

<sup>58</sup> Section 9 of the Digital Economy Act.

<sup>59</sup> A Barron 'Graduated Response' à l'Anglaise: Online Copyright Infringement and the Digital Economy Act 2010' (2011) 3(2) *Journal of Media Law* 305, 309, 310, R Giblin 'Evaluating Graduated Response' (2014) *Columbia Journal of Law & the Arts* 147, 167, 168.

liberties groups, ISPs and consumer groups' advocates as infringing on the rights to privacy and freedom of expression and access to court of users.<sup>60</sup>

### 2.3.3 File Sharing and the Graduated Response Scheme in New Zealand

The Copyright (Infringing File Sharing) Amendment Act 2011 (NZ) (CAA) was enacted in 2011 and came into force on September 1, 2011 amending the Copyright Act 1994. Section 5 of the CAA inserts ss (2A) after s 92B(2) of the Copyright Act and it provides that an ISP would not be liable for copyright infringement merely because it is aware of infringing activities of its users going on online as long as it complies with all its obligations as provided in the section and also under s 234 (eb) to (eh).

Infringement by file sharing under the Copyright Act now occurs where the uploading or downloading of a material from the internet via a network or application that allows concurrent sharing of materials between several users infringes the copyright in a work.<sup>61</sup> By this provision, it means that not all file sharing amounts to infringement, an example would be where a work is an orphan work or has fallen into the public domain, file sharing of such a work would not amount to an infringement.

The Copyright Act now places the responsibility of enforcing the Graduated Response on the Internet Protocol Address Provider (IPAP) which are commercially engaged in the activities of transmitting, routing and providing internet connection for online communications and allocation of IP addresses upon payment of specified amounts.<sup>62</sup> This separation was done so as to exclude organisations which only provide internet access to their members or employees from liability.<sup>63</sup>

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<sup>60</sup> Barron op cit (n59)310,311.

<sup>61</sup> Section 6 Copyright Amendment Act, s 122A of the Copyright Act.

<sup>62</sup> Giblin op cit (n59)160.

<sup>63</sup> Ibid.

A Graduated Response by the provisions of the Copyright Act is implemented through a judicial determination by the District Court and also the Copyright Tribunal which is an administrative body.<sup>64</sup> Thus, a rightholder is entitled to sue a suspected infringer in the District Court asking for an order requiring the IPAP to suspend the user's internet access for up to six months. This measure however would only become effective when the Copyright Tribunal System brings the disconnection provisions into force by an Order in Council.<sup>65</sup> Hence, only financial penalties have been awarded thus far against users for infringement and the Tribunal's first decision imposing a penalty of NZ\$616.57 was delivered on the 29<sup>th</sup> of January 2013 and it has delivered 12 other decisions as of August 2013.<sup>66</sup>

The New Zealand Graduated Response Scheme consists of a three-notice structure: the detection notice, the warning notice and the enforcement notice.<sup>67</sup> Where a rightholder identifies a particular subscriber who has engaged in infringement activities on an IPAP, the rightholder would contact the IPAP and provide it with information identifying the IP address on which the alleged infringement activity took place.<sup>68</sup> Upon receipt of the complaint, the IPAP is to issue the three notices in the prescribed format and within prescribed time frames as provided in the Act to the account holder.<sup>69</sup> The account holder is at liberty to challenge the infringement notice by sending a challenge to the IPAP in the prescribed format and within prescribed time.<sup>70</sup> The rightholder may take enforcement action against the account holder by either applying to the Tribunal for an order requiring payment to the rightholder under s 122O or

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<sup>64</sup> Suzor op cit (n47) 4.

<sup>65</sup> R Giblin 'On the (New) New Zealand Graduated Response Law (And Why it is Unlikely to Achieve its Aims)' 2012 62(4) *Telecommunications Journal of Australia* 54.1.

<sup>66</sup> [www.graduatedresponse.org/new/?page\\_id=28](http://www.graduatedresponse.org/new/?page_id=28), R Giblin op cit (n59) 162.

<sup>67</sup> Section 122B(3).

<sup>68</sup> Section 122C(1).

<sup>69</sup> Section 122D, E & F.

<sup>70</sup> Section 122G-H.

applying to the District Court for an order suspending the account holder's account under s 122P against the account holder.<sup>71</sup> The IPAP does not provide the account holders personal details to the rightholder and only provides same to the Tribunal when it receives such an order to provide same by the Tribunal there by dealing with issues of privacy of the account holders.<sup>72</sup>

The International Federation of the Phonographic Industry (IFPI) reported in its 2013 IFPI Digital Music Report<sup>73</sup> that since the introduction of the notification programme in New Zealand, P2P use fell by 16 per cent although it did not provide any data or statistics to support this assertion. Also, a report carried out by the Wand Research Network Group reflected that from the statistics observed, there could be a correlation in the decrease in P2P traffic since the commencement of the CAA. However, the statistics showed that there was a rapid growth in HTTPS which could mean, though not categorical that there was a likelihood that the P2P traffic had transferred to HTTPS. It is also possible that this is not the case considering the secure login nature of the HTTPS and the fact that HTTPS is used for a lot of secure online transactions.<sup>74</sup> Rebecca Giblin is however of the view that the Graduated Response Scheme is unlikely to be as effective as reported due to the fact that there are no statistics or reports available to buttress the assertion.<sup>75</sup>

Thus due to the fact that there are no official reports revealing statistics of the decline in P2P file sharing since the commencement of the CAA, one ca

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<sup>71</sup> Section 122I.

<sup>72</sup> Section 122J (3)&(4).

<sup>73</sup> IFPI Digital Music Report 2013 Engine of the World available at [www.ifpi.org/content/library/DRM2013.pdf](http://www.ifpi.org/content/library/DRM2013.pdf) p 30 as accessed on 18 June 2014.

<sup>74</sup> The Impact of Copyright Amendment Act: Update for September 2012, October 25, 2012, Wand Research Network Group, available at [www.wand.net.nz/content/impact-copyright-amendment-act-update-september-2012](http://www.wand.net.nz/content/impact-copyright-amendment-act-update-september-2012), accessed 18 June 2014.

<sup>75</sup> Giblin op cit (n59).

not say categorically whether the Graduated Response Scheme has or has not been effective in its application.

### **2.3.4 File Sharing and Graduated Response Scheme in the United States of America**

File sharing technology as was discussed earlier in chapter two is a technology that was developed to allow users to copy and share music, movies, books and other copyrighted works at an immeasurable and unlimited scale at little or no costs which is detrimental to the right of the owner of the copyrighted work because he is deprived of the economic benefit which should lawfully and ordinarily accrue to him. Although it cannot be said categorically that file sharing is a reason for the decline in artistic production or inspiration, there is no doubt that the owners of the rights are being deprived of rights which should accrue to them.<sup>76</sup> Statistics show that file sharing can increase profits for the rights owners.<sup>77</sup> There are different reports on the effect of file sharing on sales. Some hold that it has positive effect while some reflect that it has declining effects in sale and some hold that it does not in any way hurt sales but the underlying fact is that it increases popularity.<sup>78</sup> Be that as it may, file sharing constitutes copyright infringement because it involves the unauthorised copying of another person's copyrighted work and this has led to rightholders clamouring for more stringent copyright protection laws against illegal copying or sharing of files protected by copyright.

In spite of the successes recorded by right owners in getting more stringent statutory protections and stricter penalties for infringement and series of lawsuits against infringers, this did not in any way reduce the volume of files

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<sup>76</sup> Oberholzer-Gee & Strumpf op cit (n33) 23.

<sup>77</sup> Oberholzer-Gee & Strumpf op cit (n33) 35.

<sup>78</sup> F Oberholzer-Gee & K Strumpf 'The Effect of File Sharing on Record Sales: An Empirical Analysis' (2007) 115 *Journal of Political Economy* 5.

that were being illegally traded. This has led right owners to begin to seek privately ordered graduated response schemes with internet service providers which are potentially more effective in fighting infringements. The Recording Industry Association of America (RIAA) has also been involved in making series of graduated response agreements with internet service providers in fighting infringements. In December 2008, the RIAA announced that it would no longer pursue instituting actions against individual infringers but it was now going to make arrangements with internet service providers to fight copyright infringements.<sup>79</sup> Previously, the most common of the graduated response in the United States was the “three strikes” which entails the suspension of internet services after three notices of copyright infringement has been sent to him<sup>80</sup> but now it has been replaced by the more recent “six strikes” scheme.<sup>81</sup>

In 2011, some of the top ISPs and media and entertainment companies agreed and signed a Memorandum of Understanding on a common structure Copyright Alerts which is aimed at education and notifying internet subscribers that their internet service accounts could be suspended for illegal online downloading.<sup>82</sup> The Copyright Alert System (CAS) has begun implementation in 2013.<sup>83</sup>

The CAS is administered by the Centre for Copyright Information (CCI), a committee of six executive members that consists of three representatives of the Content Owners and three representatives of the participating ISPs. The CCI is saddled with the responsibilities of the education of the public on online

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<sup>79</sup> Oberholzer-Gee & Strumpf op cit (n33) 27.

<sup>80</sup> Bridy op cit (n46) 83, 84.

<sup>81</sup> Memorandum of Understanding dated July 6, 2011.

<sup>82</sup> G Sandoval ‘Top ISPs Agree to become Copyright Cops’ July 7, 2011 available at [www.cnet.com/news/top-isps-agree-to-become-copyright-cops/](http://www.cnet.com/news/top-isps-agree-to-become-copyright-cops/), accessed 18 June 2014.

<sup>83</sup> J Lesser Copyright Alert System Set to Begin, February 25, 2013 available at [www.copyrightinformation.org/uncategorized/copyright-alert-system-set-to-begin/](http://www.copyrightinformation.org/uncategorized/copyright-alert-system-set-to-begin/) as accessed 18 June 2014.

infringements, interfacing between ISPs and Content Owners on online infringement issues, sending Copyright Alerts to subscribers and enforcing mitigation measures on subscribers that persistently engage in online infringements.<sup>84</sup> The MOU was amended on the 29<sup>th</sup> of October 2012 to amend the Independent Review Program (IRP) contained in Attachment C of the MOU. The IRP is an avenue for and ground upon which subscribers may challenge any mitigation measures applied to their account.<sup>85</sup>

Section 4(c) of the MOU provides that the Content Owners representatives may send notices of alleged P2P online infringement to the participating ISPs. The details of the infringement activities shall be contained in an ISP Notice<sup>86</sup> which the Content Owners representatives will send to the participating ISPs which upon receipt shall accept and process. Each participating ISP is required to develop and enforce independently a Copyright Alert Program which shall comprise of six Copyright Alerts. The Copyright Alert Program consists of four steps<sup>87</sup> which are:

i. The Initial Education Step

Upon receipt of an ISP Notice from a Content Owner representative, the ISP shall send an Educational Step Copyright Alert to the subscriber informing him of the ISP Notice regarding the alleged infringement, educating him on copyright and copyright infringements and also informing him that receipt of further Copyright Alerts may result in the ISP applying Mitigation Measures against the subscriber.<sup>88</sup>

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<sup>84</sup> Memorandum of Understanding July 6, 2011, available at [www.copyrightinformation.org/wp-content/uploads/2013/02/Memorandum-of-Understanding.pdf](http://www.copyrightinformation.org/wp-content/uploads/2013/02/Memorandum-of-Understanding.pdf), accessed on 18 June 2014.

<sup>85</sup> Second Amendment to Memorandum of Understanding October 29, 2011, available at [www.copyrightinformation.org/wp-content/uploads/2013/02/CC1-MOU-Second-Amendment.pdf](http://www.copyrightinformation.org/wp-content/uploads/2013/02/CC1-MOU-Second-Amendment.pdf), accessed 18 June 2014.

<sup>86</sup> The ISP Notice shall contain relevant details contained in s 4d of the Memorandum of Understanding dated July 6, 2011.

<sup>87</sup> Section 4G of the Memorandum of Understanding dated July 6, 2011.

<sup>88</sup> Section 4G(i) of the Memorandum of Understanding dated July 6, 2011.

ii. The Acknowledgment Step

If the ISP receives further ISP Notices in respect of the same subscriber, it shall send two Copyright Alerts to the account holder asking him to acknowledge receipt of the Alert through a prescribed mechanism as shall be provided.<sup>89</sup>

iii. The Mitigation Measures Step

If the ISP receives further ISP Notices, it will send a Mitigation Measure Copyright Alert to the account holder requiring acknowledgement of receipt in the Acknowledgement Step, stating that the account holder had received prior warnings concerning the infringements, and also setting out the specific mitigation measure to be applied. Mitigation measures range from temporary reduction in the transmission speed of uploading and or downloading to temporarily stepping down the subscriber's service tier to either the lowest tier or an alternative bandwidth, or temporarily redirecting the subscriber to a landing page until he contacts the ISP to discuss the alerts, or temporary disconnection of the subscriber's internet account for a reasonable period of time determinable at the discretion of the ISP or any other mitigation measure which the ISP in its discretion in line with the aforementioned measures decides to apply.

The ISP is at discretion to decide whether or not to waive the mitigation measure. Where it decides to waive it, it will send to the account holder a final warning (the Fifth Warning Copyright Alert) which would contain everything contained in the Mitigation Measure Alert and also that if it receives any more ISP Notices, it would carry out the mitigation measure.<sup>90</sup>

iv. Post Mitigation Measure Stage

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<sup>89</sup> Section 4G(ii) of the Memorandum of Understanding dated July 6, 2011.

<sup>90</sup> Section 4G(iii) of the Memorandum of Understanding dated July 6, 2011.

Upon receipt of further ISP Notice, the ISP would send a further Mitigation Measure Copyright Alert to the account holder and after ten working days shall apply the previous mitigation measure or a different mitigation measure. The Alert would also contain that the subscriber may be subject to a lawsuit for copyright infringement by the copyright owner which may culminate in the temporary suspension or termination of the subscriber's account.<sup>91</sup>

In limiting the liability of internet service providers, s 512 of the Copyright Act provides four limitations on the liability of internet service providers for copyright infringement of their subscribers. In order to partake of and qualify for the benefits of these limitations on liability, the internet service provider must satisfy certain laid down requirements. In the case of online infringement activities, an online service provider would be protected from liability for the materials posted online or stored at the instance of its subscribers if the service provider can lead evidence to show:<sup>92</sup> it is not aware that the material or the activity using the material on the network was infringing; having no such knowledge, it is unaware of any fact or circumstances that makes the infringing activity discernible; when it became aware of the situation, it took expeditious steps to disconnect or disable access to the material; it is not receiving any financial gain that accrues directly from the infringement activity in which case it cannot control the activity; it has also filed a designated agent with the Copyright Office to receive notifications of claimed infringements.

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<sup>91</sup> Section 4G(iv) of the Memorandum of Understanding dated July 6, 2011.

<sup>92</sup> Section 512 (c) of the United States Copyright Act.

### 2.3.5 Criticism of the Graduated Response

The graduated response either by legislation or private ordering in spite of its successes and effectiveness in reducing infringement activities online has been criticized greatly by many authors and commentators.<sup>93</sup> It has been criticised on the ground that the exclusion of judicial oversight, breach of right to privacy, freedom of expression and access to courts either in the privately ordered schemes or by legislation raises constitutional issues. All these constitutionally protected rights are not given due considerations in any of the arrangements.<sup>94</sup> The right to privacy of a user is interfered with when the Internet Service Provider monitors the online activities of the user and also provides personal details about the user to the right owner.

The user is deprived of his right to freedom of expression where the user's internet access is disrupted where expressing himself through online activities is regarded as a form of expression of oneself.<sup>95</sup> The exclusion of a court oversight from the whole process threatens the right of access to court of the user to defend himself on an allegation of infringement.

The Graduated Response also raises issues of proportionality to the offence in the sense that it entails extraordinary counter measures which may not represent the common good. In other words, the prohibition or denial of a user of access to internet is seen as disproportionate to the infringement activity allegedly carried out by the user because it goes far beyond the compensatory system of the copyright regime.<sup>96</sup> The punishment in this instance cannot be

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<sup>93</sup> Ncube op cit (n45) 133, Suzor & Fitzgerald op cit (n47) 1, Briddy op cit (n46) 81, Kleinschmidt 'An International Comparison of ISP's Liabilities for Unlawful Third Party Content' (2010) 18(4)*Int J L Info Tech* 332.

<sup>94</sup> Ncube op cit (n 45) 144.

<sup>95</sup> N Lucchi 'Regulation and Control of Communication: The French Online Copyright Infringement Law (HADOPI)' *Max Planck Institute for Intellectual Property and Competition Law Research Paper* No 11-07 22.

<sup>96</sup> Suzor & Fitzgerald op cit (n47) 6.

said to be proportionate to the crime, disconnection of internet is too severe a punishment more so because of the modern information society we are in at present where everyday activities go on online and the importance of access to online information for research purpose and educational purpose.<sup>97</sup>

The severity of the punishment could also lead to devastating effect on the unlicensed user's exercise of his fair use rights. This is because people would abstain from exercising their fair use rights for fear of having their internet access capped or disconnected and this could lead to a dearth of social discourse.<sup>98</sup> Since the service provider is not aware or cannot determine whether the use falls under the fair use exception or not, it is likely to disconnect the access to internet without such knowledge.

In some privately ordered arrangements, the user is not given the right or opportunity to put a defence and thus, some users have become victims of immature filtering technologies and impetuous enforcement due to the harsh unregulated principles which they use as guides.<sup>99</sup> This occurs in cases where the user was not the one who engaged in the infringing activity but someone else who probably had or did not have authorisation to make use of the user's internet access or also the cases where a number of people in a household or in a company use the same internet access and everyone has to suffer for the infringing activity committed by another person.

A problem also associated with the Graduated Response is inability of global application due to the different laws in different countries. There is no uniform system which is binding on all the countries and the legal system in one country cannot be imported into or applied in another country. While some countries have strong copyright protection laws, some have weak laws and this

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<sup>97</sup> Suzor & Fitzgerald op cit (n47) 8.

<sup>98</sup> Suzor & Fitzgerald op cit (n47) 11.

<sup>99</sup> Bridy op cit (n46) 86.

has encouraged content providers to move to the countries with weak laws and operate from there.<sup>100</sup> Global application of the Graduated Response would bring about uniformity across countries and suppress forum shopping by perpetual infringers who go about looking for forums with less stringent laws to carry out their infringement activities.

#### **2.4.1 Format shifting and Fair Dealing in Nigeria**

Format shifting is the transfer of a copyrighted work from one medium to another. An example is where a person purchases a music CD and downloads the contents to his computer, laptop, iPod, MP3 players or any other device. A music CD consists of different parts, the musical work, the lyrics (literary work) and the sound recording and each of these parts are copyright protected individually. Copyright protection exists for the musical work and lyrics of a song as a literary work while the sound recording enjoys its own copyright protection on its own. Format shifting is not legalised in many countries yet. It is as a form of infringement on the rights of owners of copyright in sound recordings.

The Second Schedule to the Copyright Act provides that the exclusive right enjoyed by the right owners of literary, musical, artistic and cinematograph film works does not include the right to control any use made by a user by way of fair dealing for research, private use, criticism or review, journalism subject to the condition that if the use is made public there should follow an acknowledgement of the title of the work and the author. However, the Third Schedule to the Act which provides for special exceptions in respect of sound recording in a musical work does not have any exception for private copying or copying for private use. Thus, any copying of the sound recording in a musical work amounts to an outright infringement of copyright. Thus, a

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<sup>100</sup> Kleinschmidt op cit (n93) 355.

person who purchases a CD, though having the right to transfer the musical work and lyrics to another medium, does not have the right to transfer the sound recording in the musical work. This inevitably means that he cannot transfer the content of the CD to another medium except he can do so without affecting the sound recording which is impossible. This thus limits the right to fair dealing which the user enjoys as provided in the Act.

Fair dealing is an exception to the absolute right which the owner of a copyrighted work enjoys. Copyright laws were made fore-mostly to protect the rights of the authors and subsequently to ensure and protect the rights of the public to access the copyrighted works. Thus the right to fair dealing and fair use are exceptions and limitations to the absolute rights of the rights owners.<sup>101</sup> Fair dealing can be defined as a right exercised by others than the owner of the copyright in the use of copyrighted material in such a manner that is reasonable without his consent.<sup>102</sup> Fair dealing in Nigeria is provided for in Schedule two to the Copyright Act; however, it is only in respect of literary and musical works. Thus, the fair dealing provision needs to be broadened in other to accommodate rights in respect of sound recordings as well.

#### **2.4.2 Format shifting and the Fair Use Exception in the United States of America**

Fair use in the United States of America is a defence to copyright infringement. It is an extraordinarily open ended limitation which restricts the otherwise unlimited copyright protection rights given to rightholders and it is the provision that protects otherwise infringing activities.<sup>103</sup> Fair use is not

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<sup>101</sup> K Pham & S Mkhitarian 'Fair Use of Copyrighted Works in the Digital Age' *WIPO Publication No 789(E)* 2.

<sup>102</sup> F Abbott, T Collier & F Gurry *The International Intellectual Property In An Integrated World Economy* (2007) 423.

<sup>103</sup> B Beebe 'An Empirical Study of U. S. Copyright Fair Use Opinions, 1978-2005' (2008) *University Of Pennsylvania Law Review* 156 No. 3 549 at 551.

defined by the Act but in determining the fairness of a use, the court would consider the facts of each case presented before it. Fair use differs from and is broader than fair dealing in the sense that it is not confined to use for research, study, criticism, review and news reporting and it is also not restricted to any particular kind of protected works, rather it applies to all kind of works.<sup>104</sup>

The fair use exception in the United States of America is by far the most liberal among other countries. The law allows judges to determine whether an activity in relation to copyright should fall under copyright protection or not. Under fair use, format shifting is legitimate and has no need for regulation. The laxity of the fair use exception has given room for a flourishing creative industry.<sup>105</sup> Fair use in the United States is provided for in s 107 of the Copyright Act which permits the reproduction of a copyrighted work for the purpose of criticism, comment, news reporting, teaching, scholarship or research provided that in deciding whether such use would be regarded as fair use or not, there would be considered the purpose and character of the use, whether it is commercial or nonprofit educational, the nature of the copyrighted work itself, the amount and substantiality of the work copied in relation to the whole work itself, and the effect of such copying upon the market value of the copyrighted work. In essence, in as much as the law protects the rights of the rightholders from intruders and trespassers, it also recognises at the same time that not all reproductions amount to piracy.

Thus, the fair use concept identifies the need to permit copying for various purposes such as educational, news reporting, history, criticism and humour and so exempts them from copyright infringement. The court has

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<sup>104</sup> T Schonwetter & C Ncube 'New Hope for Africa? Copyright and Access to Knowledge in the Digital Age' (2011) 13 *Info* No. 3 64 at 67.

<sup>105</sup> I Hargreaves 'Digital Opportunity: A Review of Intellectual Property and Growth' *An Independent Report* (May 2011) 45.

latitude to decide whether a use amounts to copyright infringement or not and not slavishly follow statutory provisions which could stifle creativity, the promotion of which the law is aimed at.<sup>106</sup> Although the fair use doctrine has been criticised by authors, commentators, lawyers and judges as being arbitrary, adhoc and indefinable because of its flexibility and erratic in nature, the courts have been quite consistent in their decisions post 2005.<sup>107</sup> The courts in deciding whether the use amounted to fair use, would consider whether the use of the work was transformative and not expressive of the same expressive purpose in which case it would not be regarded as fair use. Where the court finds the use to be transformative, it would also look at the amount of work copied whether it was reasonable or not for the purpose. Where it finds that the copying was not excessive, then it would be held to be fair use.<sup>108</sup>

Thus, the fair use exception because of its liberality is wide enough to accommodate copying of sound recordings for private use.

### **2.4.3 Format shifting and the Fair Dealing Exception in the United Kingdom**

Sections 29 & 30 of the United Kingdom Copyright, Designs and Patents Act 1988 provides for fair dealing of copyright protected works for the purpose of research, private study, criticism, review and news reporting. The fair dealing exception only covers literary, dramatic, musical and artistic works where such dealing is non-commercial and adequate acknowledgment is made where applicable.<sup>109</sup> It does not cover broadcasts, sound recordings and films.<sup>110</sup> In order to benefit from this exception, the use of the work must fall in any of the aforementioned categories of use. Also, the dealing must be fair considering

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<sup>106</sup> S Halpern, C Nard & K Port, *Fundamentals of United States Intellectual Property Law: Copyright, Patent, Trademark* 3ed (2011) 118.

<sup>107</sup> N Netanel 'Making Sense of Fair Use', (2011) 15 *Lewis & Clark L Rev* 715 at 771.

<sup>108</sup> Netanel op cit (107) 716, 717.

<sup>109</sup> Section 29 (1), (1c) of the United Kingdom Copyright, Designs and Patents Act.

<sup>110</sup> G D'Agostino 'Healing Fair Dealing? A Comparative Copyright Analysis of Canada's Fair Dealing to U.K. Fair Dealing and U.S. Fair Use' (2008) 53 *McGill L. Review* 309, 339.

the nature of the work, how the work was obtained, the amount of the work taken, to what use it is put, if there are commercial benefits, motives behind such dealing, consequences of such dealing on the market of the original work and if there were other means by which the purpose would have been achieved and where required, there must be adequate acknowledgement.<sup>111</sup>

In reviewing the fair dealing provision of the Act which has no exception for private copying of recorded music from one device to the other, Gowers recommended that there should be introduced a private copying exception which does not include any levy to be paid by users that would allow format shifting of works as lack of such exception makes this legitimate act illegal.<sup>112</sup> This exception would be restricted to private use and the owner cannot sell, give away or share the copy made as well as keep the copy made where he has been dispossessed of the original. Also, third parties would not be permitted to make copies on behalf of consumers and it would also not apply to file sharing with family and friends.<sup>113</sup>

Hargreaves also made a review and agreed with Gower that there was no need to add any extra charge or levy on devices to be used by consumers. He recommended that a limited private copying exception should be introduced by the government that would allow people make copies of work on a different media for use by them and their immediate family.<sup>114</sup> This limited exception should be one that is already reasonably catered for in the sale by the buyers and sellers of the work in such a way that would not entail economic loss for the rightholders.<sup>115</sup> Hargreaves resists putting up a case for the

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<sup>111</sup> D'Agostino op cit (110) 338, 342-343.

<sup>112</sup> A Gowers 'Gowers Review of Intellectual Property' December 2006 p 62 available at [https://www.gov.uk/government/uploads/system/uploads/attachment\\_data/file/228849/0118404830.pdf](https://www.gov.uk/government/uploads/system/uploads/attachment_data/file/228849/0118404830.pdf), as accessed on 18 June 2014.

<sup>113</sup> Gower op cit(n112) 63.

<sup>114</sup> Hargreaves op cit (n105) 48.

<sup>115</sup> Hargreaves op cit (n105) 49.

introduction of the fair use concept in Europe and the United Kingdom because the current EU laws which contain suitable laws for the European context would produce more economic benefits and also, the United States case law validity would not fit in the legal mechanism of Europe.<sup>116</sup>

Following these recommendations, the United Kingdom made a Regulation titled The Copyright and Rights in Performances (Personal Copies for Private Use) Regulations 2014 to amend the Copyright, Designs and Patents Act 1988<sup>117</sup> to make exceptions for private copying for non-commercial use. The Regulations will come into force on the 1<sup>st</sup> of October 2014. Regulation 3 inserts s 28B after s 28A of the CDPA and provides for the making of personal copies of a work other than a computer program for private use. Making a copy of a work is not an infringement of copyright provided the copy is made from the person's copy or personal copy of the work and is made for private use and not commercial either directly or indirectly.<sup>118</sup> Also, private use is limited only to use for the purpose of making a backup copy, format shifting or for storage purposes including in an electronic storage accessed by the internet.<sup>119</sup> However, where the individual transfers permanently his own copy of the work or a personal copy which he made from the work without the consent of the rightholder, he has infringed the copyright.<sup>120</sup>

Thus, when this private copying Regulation comes into effect, it will broaden the fair dealing exception in the United Kingdom in such a way that covers television programs, sound recordings and films.

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<sup>116</sup> Hargreaves op cit (n105) 52.

<sup>117</sup> Based on the provisions of Art 5 (2)(b) of Directive 2001/29 of the European Parliament and the Council of 22 May 2001 on the harmonisation of certain aspects of copyright and related rights in the information society (OJ No. L167, 22.6.2001.p10) which permit member states to make exceptions for copyright and related rights provided under the Directive in respect of reproduction on any medium by a natural person for private non-commercial use.

<sup>118</sup> Section 28B(1) of the Copyright, Patent and Design Act.

<sup>119</sup> Section 28B(5) of the Copyright, Patent and Design Act.

<sup>120</sup> Section 28B(6),(8) of the Copyright, Patent and Design Act.

#### 2.4.4 Format shifting and the Fair Dealing Exception in Canada

In Canada, the Copyright Act maintains the fair dealing exception however, it is not too different from the United States Fair Use exception.<sup>121</sup> The history of the Copyright Act prior to 1911 showed that the copyright exception was actually fair use but was named fair dealing in the words of the statute.<sup>122</sup> The confusion stemmed from the notion that the express mention of the listed exceptions excluded all others whereas this is an erroneous interpretation when you consider the mischief rule principle of interpretation of the statute and also how the courts have applied the law.<sup>123</sup> However, at the moment, the Act specifically provides for fair dealing exception.

Section 29(22) of the Canada Copyright Act permits the reproduction by an individual of substantial part of the copyrighted work for private purposes. An individual is allowed to shift a work from one medium to the other subject to certain conditions being met, which are:

- i. The work from which the reproduction is being made must not be an infringing copy.
- ii. The individual must have legally obtained the copy of the work from which the reproduction is being made and must also own or be authorised to use the medium or device on which it is reproduced.
- iii. The individual did not circumvent a technological protection measure to make the production.

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<sup>121</sup> A Katz 'Fair Use 2.0: The Rebirth of Fair Dealing in Canada' Michael Geist (ed) *The Copyright Pentology: How the Supreme Court of Canada Shook the Foundations of Canadian Copyright Law* (2013) 93, 130.

<sup>122</sup> Katz op cit (n121) 120, 135.

<sup>123</sup> Katz op cit (n121) 104, 114,140.

- iv. The individual must not give the reproduction away.
- v. The reproduction can only be used for the individual's private purposes.
- vi. The individual cannot give out the original copy from which the reproduction was made without first destroying the reproductions of the copy that are made.

#### **2.4.5 Private Copying Exception Internationally**

The European Commission introduced the concept of fair compensation to compensate rightholders for the private copying right given to users in the Information Society Directive (ISD) 2001/29/EC. The Directive entails collection of levies on copying media and equipment such as blank media, USBs, hard disks, MP3 players, printers and personal computers in the European Union and this levy system has been adopted by 22 out of 27 member states.<sup>124</sup> The United Kingdom did not adopt this levy system though it has made a Regulation to permit private copying. Fair compensation is calculated on the basis of the harm that owners of protected works would suffer due to the introduction of the private copying exception.<sup>125</sup> Reproduction for private use that go on digitally include format shifting for the purpose of making backup copies, making and giving copies to friends and family, making downloads for private use and uploading materials to digital storage facilities.<sup>126</sup> The levies are a form of indirect remuneration to the rightholders due to the fact that most countries have laws that permit reproduction of copyrighted works in the form of private copying exception and art 5 of the ISD also guarantees the

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<sup>124</sup> M Kretschmer 'Private Copying and Fair compensation: An Empirical Study of Copyright Levies in Europe' (2011) *Independent Report Commission by Intellectual Property Office 10* available at [www.ipo.gov.uk](http://www.ipo.gov.uk) as accessed on 24 February 2014.

<sup>125</sup> Kretschmer op cit (n124) 9, 10, see also Recitals 35 & 38 of the Information Society Directive (2001/29/EC).

<sup>126</sup> Kretschmer op cit (n124) 9.

reproduction right by providing for the private copying exception. Article 5 provides that member states may make provisions for exceptions or limitations to the reproduction right as it pertains to reproductions from one medium to another by a natural person to make use of privately and for non-commercial purposes either directly or indirectly, subject to the right holders receiving fair remuneration which considers whether technological measures are applied or not to the work.

### **2.5.1 Technological Protection Measures in Nigeria**

In a bid to protect copyrighted works and prevent unlawful access or reproduction, rightholders employ technological protection measure to protect their works digitally. Technological Protection Measures are technological constraints put in place by authors and rightholders to secure their works from being infringed and control access to them in the digital environment.<sup>127</sup> Digital Rights Management (DRM), which is the generic name for TPM<sup>128</sup>, imposes restrictions. Some CDs and DVDs are DRM encrypted and so they could restrict use of same on some types of devices or even make provision for some form of registration before software can be installed. They could also prevent an individual from being able to make copies for private use, restrict the number of uses or even prescribe devices for use.<sup>129</sup>

There is currently no legislation in Nigeria that provides for the anti-circumvention of technological protection measures. The implication of this is that anyone who circumvents a technological protection measure would not be liable for any offence and so right owners would have to expend a lot of

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<sup>127</sup> C Visser, 'Technological Protection Measures: South Africa Goes Overboard. Overboard.' (2006) 7 *SAJIC* 54.

<sup>128</sup> H Deveci 'Can Hyperlinks and Digital Rights Management Secure Affordable Access to Information?' (2012) 28 *Computer Law And Security Review* 651 at 652.

<sup>129</sup> Deveci op cit (n128) 656.

resources to strengthen their technological protection measures to ensure that they are not easily circumvented by individuals.

The best attempt at remedying this situation was a failed one due to the non-passage into law of the Cyber Security and Data Protection Agency Bill. The Bill criminalises the act of accessing without authority any computer in order to gain access to the programme or data kept in the computer.<sup>130</sup> It also provides that anyone who without authority discloses a password or access code or uses a device or computer programme or software to retrieve password or access code in order to gain access to the program data or database for unlawful purpose is guilty of an offence punishable with a fine or imprisonment or both.<sup>131</sup> It further provides that anyone who engages in the act of production or procuring for use or sells any device or computer programme or component that is devised basically to break through security measures, intending that the device would be used to perform any of the acts in relation to a password or access code in violation of the provisions of the Bill commits an offence.<sup>132</sup>

This Bill would have impacted on intellectual property in the digital environment in that its provisions that criminalise the acts of accessing, disclosing or production of devices that are designed primarily to overcome passwords or access codes would have been extended to cover activities that involved circumventing technologically protected works in order to gain access to copyright protected works. This attempt would have been manageable for the time being and better than nothing even though the provisions of the Bill is laden with shortcomings on the grounds that it is quite uncertain and not very definitive for application to digital intellectual property.

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<sup>130</sup> Section 7 of the Cyber Security and Data Protection Agency (Establishment, etc) Bill 2008.

<sup>131</sup> Section 8 of the Cyber Security and Data Protection Agency (Establishment, etc) Bill 2008.

<sup>132</sup> Section 12 of the Cyber Security and Data Protection Agency (Establishment, etc) Bill 2008.

Another major uncertainty is the determination of what of unlawful purpose is as referred to in s 8. From the provision of the said section, it seems to be inferred that if one without authority gains access into a protected database but not for an unlawful purpose, the person is not guilty of an offence. This invariably means, after it has been determined that there has been a circumvention, the court would then consider the purpose for which the circumvention was done, whether for a lawful purpose or an unlawful purpose. It is well known that not all activities of circumvention technological protection measures are for unlawful purpose. Some of the circumventions are done without any criminal intent. Perhaps, if the Bill had been drafted to relate to unlawful access as against unlawful purpose, the situation would have been salvaged.

Also, it does not make provision for civil liability for the offenders, the owners of the copyright protected work should be compensated for the loss suffered which was caused by the circumventing activity of the offenders. Every act of illegally gaining access to a technologically protected work deprives the rightowners of economic benefit which should have accrued to him if the protected work was legally obtained.

### **2.5.2 Technological Protection Measures in the United States of America**

The United States Digital Millennium Copyright Act (DMCA) was enacted in 1998 in compliance with the WCT and the WPPT of 1996.<sup>133</sup> These two WIPO treaties obligate member states to provide adequate legal protection to prevent circumvention of effective technological measures put in place to protect copyrighted works and also provide efficient legal remedies where there is circumvention.<sup>134</sup> In consonance with the provisions of these two

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<sup>133</sup> The Digital Millennium Copyright Act of 1998, U.S Copyright Office Summary, December 1998 available at [www.copyright.gov/legislation/dmca.pdf](http://www.copyright.gov/legislation/dmca.pdf) accessed on 24 February 2014, Arts 18 & 19 WPPT.

<sup>134</sup> Article 11 of WIPO Copyright Treaty.

treaties, a joint reading of s1201 paras (a) and (b)<sup>135</sup> provides that no one shall circumvent effective technological measures controlling access to a work or unauthorised copying of a copyright protected work or be involved in manufacturing, importing or offering for sale any technology, product or device that is primarily designed for circumventing a technological measure or is limited in commercial use aside from circumventing technological measures that protect the right of a copyright owner. Technological measures in this provision are classified into measures which control access to work and measures that control unauthorised copying of works. Thus the Act does not prohibit circumvention of a technological measure that is put in place to prevent copying. With this classification, the right of the public to make fair use of copyrighted works is protected.

Also provided in the DMCA are certain exceptions to the prohibition of the circumvention of a technological measure which would only become applicable upon fulfilment of certain conditions. The exceptions are:

- For the purpose of law enforcement, intelligence and other governmental activities.<sup>136</sup>
- Non-profit library, archive and educational institutions.<sup>137</sup>
- For the purpose of reverse engineering.<sup>138</sup>
- For use for encryption research.<sup>139</sup>
- For the purpose of protecting minors.<sup>140</sup>

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<sup>135</sup> Section 1201 paras (a) and (b) of the Digital Millennium Copyright Act of 1998.

<sup>136</sup> Section 1201 para (e) of the Digital Millennium Copyright Act of 1998.

<sup>137</sup> Section 1201 para (d) of the Digital Millennium Copyright Act of 1998.

<sup>138</sup> Section 1201 para (f) of the Digital Millennium Copyright Act of 1998.

<sup>139</sup> Section 1201 para (g) of the Digital Millennium Copyright Act of 1998.

<sup>140</sup> Section 1201 para (h) of the Digital Millennium Copyright Act of 1998.

- For personal privacy.<sup>141</sup>
- For the purpose of security testing.<sup>142</sup>

Any person who circumvents a technological measure would be liable both civilly and criminally. The owner of the copyright protected work can institute a civil action in a Federal court against the infringer claiming equitable and monetary remedies as well as statutory damages.<sup>143</sup> Also, because it is a criminal offence to circumvent a technological measure, the infringer may incur, for a first time offence, criminal liability of a fine to the tune of \$ 500,000 or an imprisonment term of up to five years and for subsequent offences, up to \$ 1,000,000 fine or imprisonment term of up to ten years.

### **2.5.3 Technological Protection Measures in South Africa**

South Africa did not ratify the WCT but in 2002it enacted the Electronic Communications and Transactions (ECT) Act 25 of 2002 which was amended in 2014. It provides for the offence of cybercrime in Chapter XIII of the Act. A joint reading of the provisions of s 86 paras (1), (2), (3), (4) and (5) provides that it is an offence for anyone to engage any of the following act:

- Intentionally access any data without the requisite permission to do so;
- Intentionally interfere with data in such a way that data is modified without permission;
- Unlawfully produce or sell any device as well as a computer programs that is manufactured purposely to tamper with security measures installed to protect data;

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<sup>141</sup> Section 1201 para (i) of the Digital Millennium Copyright Act of 1998.

<sup>142</sup> Section 1201 para (j) of the Digital Millennium Copyright Act of 1998.

<sup>143</sup> Section 1203 of the Digital Millennium Copyright Act of 1998.

- Utilise any device or computer program with the aim of unlawfully overcoming measures made for protecting such data;
- Do any act with the intention of tampering with access to information in order to deny legitimate users access for the information.

Section 86 (6) provides that any person found guilty of the offences in S 86 would be liable to a fine of R10 million or imprisonment for a period up to 10 years. However, unlike the United States DMCA, the ECTA does not make any provisions for any exception to the anti-circumvention provision and this has been criticised greatly by many authors as being too extreme and destructive of research and education in a developing country like South Africa.<sup>144</sup>

## 2.6 Criticisms

The protection of TPMs has been criticised on the ground that it creates a new right known as access right which is unknown in copyright, that is, access to materials which do not have copyright protection is prevented due to the DRM protection.<sup>145</sup>

The traditional copyright defences are no longer available since end users cannot circumvent a TPM to exercise those traditional defences. The restriction of exercise of fair use exception through the use of TPMs in the digital environment creates a dichotomy between works in hard copy or print form and works in the digital environment.<sup>146</sup>Consequent upon the digital lock up of copyright protected works, end users have no access to these works even

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<sup>144</sup> Visser op cit (n127) 62.

<sup>145</sup> Deveci op cit (n128) 657.

<sup>146</sup> Visser op cit (n127) 59, J Larrington 'Impact of the Digital Millennium Copyright Act on Libraries and Library Users' (2007) 19 *Against The Grain* no. 4 25 at 28.

for non-infringing uses unless they pay a certain sum of money to gain access to and make use of the work.<sup>147</sup>

Works that fall into the public domain are inaccessible to end users because they are digitally locked up and there is no law that permits circumvention of technological protection measures for works that have fallen into the public domain.<sup>148</sup>

Also, because of the requirement for payment of a prescribed sum in order to gain access to certain works, this would lead to a situation where there would be no free use of a work, not even for the purpose of browsing through the work and end users must pay for every form of access.<sup>149</sup>

The control of access to works by authors could result in privacy implications for end users and this occurs where authorized access to a work can be detected by policing private activities which make it possible through the use of metering technologies to reveal the information being accessed and the identity of the person accessing it.<sup>150</sup>

Also, lawful possessor of a copyrighted protected work may not be able to use the copyright work which he purchased as he pleases because of the limitation of circumventing the technological measure.<sup>151</sup>

This chapter has examined the current position of copyright protection as afforded by the Copyright Act in Nigeria highlighting its defaults and inadequacies. It has also considered critically the position in the other jurisdictions discussed which reflects that no system is fool proof but there are

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<sup>147</sup> Visser op cit (n127) 59.

<sup>148</sup> Ibid.

<sup>149</sup> Ibid.

<sup>150</sup> Ibid.

<sup>151</sup> Ibid.

aspects which can be imported into our laws which would make the laws adequate for the digital environment.

## **CHAPTER 3: OVERVIEW OF THE PROVISIONS OF THE TRADEMARKS ACT FOR PROTECTION OF COPYRIGHT IN THE DIGITAL ENVIRONMENT AND A COMPARISON WITH OTHER JURISDICTIONS**

### **3.0 Introduction**

Chapter two of this thesis discussed the current state of protection of copyright in the digital environment in Nigeria as well as some other countries. This chapter would be examining the current state of trademarks protection as it can be applied in the digital environment in Nigeria and it will also be considering the state of development of trademarks law for the digital environment in some other countries, in particular the United States of America, South Africa and Australia. It will also consider briefly how the courts have applied the law in some decided cases. This chapter is divided into two major parts. The first part will discuss trademarks protection for domain names while the second part will discuss trademarks protection for online advertising.

### **3.1 Background**

The current structure in place for the protection of trademarks is also awfully below the required standards for this time and age. The Trademarks Act is 48 years old and has not been amended since its enactment. It has become outdated and needs to be fine-tuned in order to meet up with developing technological standards. Some of the major problems of trademarks regime stems from the age of the statute, the nature and scope of rights governed by the law does not reflect the contemporary developments of this time and age, failure on the part of the law reforms administration to formulate reform

policies and also the inability to link intellectual property with the environment.<sup>152</sup>

Online advertising and marketing have become powerful tools used by businesses to advertise their products and engage in other commercial activities through the use of websites, linking and framing.<sup>153</sup> The use of metatags, keywords, domain names, linking and framing in online advertising have proved to be capable of trademark infringements. This occurs where a person decides to use another person's registered mark without his prior consent being obtained either to pass off his goods as that of the owner of the trademark or cause a deception on the mind of the innocent party. Trademarks though not protected as property per se, gives rights upon registration for the owner to prevent others from using it where it would lead to a likelihood of confusion.<sup>154</sup>

The Trademarks Act provides that trademarks are only granted in respect of goods, the Act does not include services in the marks that can be protected. Registration of a mark gives the owner rights of exclusive nature to utilise the trademarks in commerce in respect of those goods.<sup>155</sup> Section 3 provides that no one can institute an action to claim or recover damages in respect of an unregistered mark but the person would not be precluded from recovering damages from a person who passes off goods as though they were the goods of that person with the unregistered mark. This means to say that a person who owns an unregistered mark is can only recover damages where someone tries to pass off goods as his own and not for merely using the marks or similar marks. Infringement of a trademark occurs where a person uses an

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<sup>152</sup> Adewopo op cit (n18) 16.

<sup>153</sup> T Sangal 'IP Issues in Linking, Framing and Keyword Linked Advertising' (2010) 16(3) *C.T.L.R* 64-67.

<sup>154</sup> A Obayuwana 'Unintentional Trademark Expansion and Unfair Competition in Cyberspace: the Domain name Phenomenon' (2012) 34(3) *E.I.P.R* 177-178.

<sup>155</sup> Section 5 (1) of the Trademarks Act.

identical mark or resembling mark likely to cause deception or confusion in relation to any goods in which they were registered.<sup>156</sup>

The Registrar would refuse to register a trademark where the mark is deceptive, scandalous, identical or bears resemblance with an existing registered mark.<sup>157</sup> An alleged infringer of trademarks would succeed in an action against a trademark owner if there is evidence to show that he or his predecessor had continuously used the identical or nearly resembling mark bonafide prior to the registration by the registered owner<sup>158</sup> and where use of the identical or nearly resembling mark is bonafide use of his name or the name of his predecessor, his place or his predecessor's place of business or a bonafide description of the character or quality of his goods.<sup>159</sup> It is uncertain the position of the law in relation to online trademarks infringements because the courts have not decided any cases on any of such issues. While it may be easier to apply the Trademarks Act to keywords, adwords, linking and framing, it is uncertain whether the Act would be applicable to issues arising out of the registration and use of registered trademarks as domain names. These issues are considered elaborately below. The only infringing activities envisaged by the Act seem to the likelihood of causing deception and confusion for registered marks and passing off for unregistered mark. Online infringing activities extend beyond this and the Act is not equipped enough to cater for such issues.

### **3.2.1 Regulation of the use of Trademarks as Domain Names in Nigeria**

Trademarks law does not give exclusive right to anyone to use a word either commercially or otherwise. It only gives exclusive rights to make use of a word as trademark for product a person trades in and in markets where the

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<sup>156</sup> Section 5 (2) of the Trademarks Act.

<sup>157</sup> Sections 11 & 13 of the Trademarks Act.

<sup>158</sup> Section 7 of the Trademarks Act.

<sup>159</sup> Section 8 of the Trademarks Act.

person has actually transacted.<sup>160</sup> The aim is to prevent others from using a name in such a way that confusion or deception is probable in the mind of the customers or in the case of popular names, prevent dilution.<sup>161</sup>

A domain name is an internet address which is easy to remember used to contact a website. Trademarks for domain names is dependent on whether the domain name can be classified either as a name or an address.<sup>162</sup> Generally, names are a means of identity while addresses show location. Trademarks are names and they are used to identify particular goods. However, domain names are both names and addresses as they are used for both locating and identifying resources online.<sup>163</sup> The dynamic nature of addresses is one reason why it is difficult for it to be protected by trademark law. Geographic names are excluded from trademarks protection under various trademarks laws; however, some geographic names have their sources from the trademarks an example is Mc Donald's corporation on one Mc. Donald Plaza.<sup>164</sup> Hence, it is on this basis that since in the real space, some trademarks serve as both names and addresses (where an area gets its name from a trademark) and are thus protected by trademarks law, trademarks law could be extended to domain names too.<sup>165</sup>

A URL may consist of a secondary Top-Level Domain (sTLD), a generic Top-Level Domain (gTLD) and a country code Top-Level Domain (ccTLD). Applications for generic domain names are usually made to authorised domain name registrars of the Internet Corporation for Assigned Names and Numbers

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<sup>160</sup> J Litman 'The DNS Wars: Trademarks and The Internet Domain System' (2000) 4 *J. Small & Emerging Bus. L.* 149 at 153.

<sup>161</sup> Litman op cit (n160) 154.

<sup>162</sup> D Burk, 'Trademarks Along the Infobahn: A First Look at the Emerging Law of Cybermarks' (1995) 1 *Rich J.L & Tech* 129 - 33.

<sup>163</sup> Burk op cit (n 162) 31.

<sup>164</sup> Burk op cit (n 162) 34, 35.

<sup>165</sup> Burk op cit (n 162) 33.

(ICANN) while applications for country code domain names are made to the relevant local authorities who usually administer the administration.<sup>166</sup>The Nigerian trademarks legislation as well as that of many other African countries is constantly faced with domain name related issues.<sup>167</sup>The traditional trademarks law is not equipped to deal with such issues. In Nigeria, the Nigeria Internet Registration Association (NIRA) is the authority responsible for maintaining and registering ccTLD.<sup>168</sup> It is a non-profit and non-governmental self-regulating body and its objectives include administration of the .ng TLD and its associated sub level domain names; maintenance of the operational stability of the .ng TLD; ensuring cost effective administration of the .ng TLD and its sub level domains; development of rules for governing the operations of sublevel domain registries; creation of sublevel domains and making rules for governance of the accreditation of registrars and registry operators; making rules to govern the registration of names within the sublevel domains and access to sublevel domain registries and ensuring that registrars have equal access to sub level domain registry for the development and administration of the .ng TLD; management of the operation of critical technical functions; interfacing with other national and international bodies on issues concerning the development and administration of domain name systems; establishment of competent complaints and dispute resolution processes in order to settle amicably or redress of grievances in matters arising from the administration of .ng ccTLD.<sup>169</sup>

Although the NIRA can establish dispute resolution processes for the resolution of disputes that arise from the administration of the .ng ccTLD, there is no legislative policy for resolving disputes arising out of domain name

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<sup>166</sup> A Roy 'A New Australian Development in Trade Marks and Online Infringement: The Mantra Case' (2011) 33(10) *EIPR* 647-654.

<sup>167</sup> *Adewopo op cit* (n 3) 749.

<sup>168</sup> *www.nira.org.ng* accessed on 19 February 2014.

<sup>169</sup> Section 2 of the Constitution of Nigeria Internet Registration Association.

registration in Nigeria. The decisions reached by the NIRA executives are not binding on either of the parties. A third party who claims to have an interest in a gTLD can file a domain name complaint using the Uniform Domain-Name Dispute Resolution Policy (UDRP) Administrative Procedure, a party who has a dispute involving a ccTLD does not have access to the UDRP Administrative Procedure because the NIRA has not adopted the UDRP Policy.<sup>170</sup> Also, Nigeria is not among the countries in which the WIPO Domain Name Dispute Resolution Service provides domain name dispute resolution for ccTLDs.<sup>171</sup> Thus individuals have to make their own private alternative dispute resolution arrangements which the infringer is not bound to attend and even where he attends, might not consent to the decision and may resort to the Court with claims for infringement. The Nigerian legal system is adversarial and the court procedure is very slow. So they could find themselves in court for many years and spending a lot of money.

### **3.2.2 Regulation of the use of Trademarks as Domain Names in the United States of America**

In the United States, domain names did not fall strictly under the trademark provision and so it followed that the Trademark Act (Lanham Act) would be inapplicable and this led to the amendment of the Lanham Act to include provisions that regulate domain names. In addition to the traditional trademarks rights, defences, remedies and provisions in relation to domain name disputes, the Act extends liability to domain name Registrars and Registries in certain circumstances.<sup>172</sup>

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<sup>170</sup> WIPO Guide to the Uniform Domain Name Dispute Resolution Policy (UDRP), available at <http://www.wipo.int/amc/en/domains/guide/>, accessed on 19 February 2014.

<sup>171</sup> Domain Name Dispute Resolution Service for country code top level domains (ccTLDs), available at [www.wipo.int/amc/en/domains/cctlds/](http://www.wipo.int/amc/en/domains/cctlds/), accessed 19 February 2014.

<sup>172</sup> § 1114 (D) of the Lanham Act.

Back in 1993 and 1994, registration of domain names was done with Network Solutions Inc which was a small company subcontracted by the National Science Foundation.<sup>173</sup> People registered different kind of names as domain names for different reasons which was not a problem at the time as registration was on a first come first served system. Some registered names with the intentions of doing business with them while some speculators anticipated that the internet would become a viable business in the near future and so registered some well-known names.<sup>174</sup> Subsequently, when trademark owners tried to register those names, they found that their names had been registered, thus they sued the speculators and Network Solutions for trademark infringement and dilution. While the suits against Network Solutions did not work out, a number of the suits against the speculators were successful.<sup>175</sup>

This gave rise to a situation where there were a lot of suits being instituted and millions of dollars being spent in pursuit of litigation, this situation led to the handing over Internet Domain Names administration to a non-profit private organisation, the Internet Corporation for Assigned Names and Numbers (ICANN) by the United States of America's government whose structure was designed by the government.<sup>176</sup> The ICANN adopted a policy in which the Registrar, when confronted with a complaint by a trademark owner that a domain name identical to its trademark had been registered in bad faith, would send such complaint to mandatory arbitration which is the uniform dispute resolution process.<sup>177</sup> The arbitrator after considering the facts of the matter makes a decision either to transfer the domain name to the trademark owner or that the registration was not done in bad faith.<sup>178</sup>

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<sup>173</sup> Litman op cit (n160) 151.

<sup>174</sup> Litman op cit (n160) 151.

<sup>175</sup> Litman op cit (n160)155.

<sup>176</sup> Litman op cit (n160) 160.

<sup>177</sup> Para 4 (A) Uniform Domain Name Dispute Resolution Policy.

<sup>178</sup> Litman op cit (n160)161.

The § 1125(d) of the Lanham Act<sup>179</sup> provides that registering, trafficking or using a domain name that is so identical to another's trademark or a personal name so as to cause confusion or dilute it are acts liable in civil action.<sup>180</sup> These acts entail registering, trafficking or using a domain name that is so identical as to cause confusion with another person's mark that is distinctive at the time the domain name was registered,<sup>181</sup> the domain name so registered is dilutive of a famous mark that is famous at the time it was registered,<sup>182</sup> the domain name is a trademark, word or name protected by s 706 of title 18 USC or s 220506 of title 36.<sup>183</sup> Upon a finding that a domain name is registered or used in bad faith with the intention of profiting from its similarity to the trademark, trademark owners can, in addition to order of transfer of the domain name, recover damages.<sup>184</sup>

In considering whether the person had bad faith intentions when registering the domain name, the court would consider among other things;<sup>185</sup> if the person had any existing trademark or other property rights;<sup>186</sup> how much of the person's name or a name he is generally known by makes up the domain name consists;<sup>187</sup> previous use of the domain name in good faith in commerce;<sup>188</sup> good faith fair or non-commercial or use of the mark in an accessible website with the domain name;<sup>189</sup> the intention of the person to redirect customers from the website of the mark owner so as to damage the good will which the mark represents either to gain commercially from it or to

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<sup>179</sup> Also known as the Anticybersquatting Consumer Protection Act 1999 15 U.S.C. Trademark Act.

<sup>180</sup> 15 U.S.C. Trademark Act §1125(d)(1) & (11).

<sup>181</sup> § 1125 (d)(i)(A)(ii)(I) of the Lanham Act.

<sup>182</sup> § 1125 (d)(i)(A)(ii)(II) of the Lanham Act.

<sup>183</sup> § 1125 (d)(i)(A)(ii)(III) of the Lanham Act.

<sup>184</sup> §1125(d)(1) 15 U.S.C. Trademark Act.

<sup>185</sup> § 1125 (d)(i)(B)(i) of the Lanham Act.

<sup>186</sup> § 1125 (d)(i)(B)(i)(I) of the Lanham Act.

<sup>187</sup> § 1125 (d)(i)(B)(i)(II) of the Lanham Act.

<sup>188</sup> § 1125 (d)(i)(B)(i)(III) of the Lanham Act.

<sup>189</sup> §1125 (d)(i)(B)(i)(IV) of the Lanham Act.

disrepute the mark through the confusion created in the minds of the customers as to the origin or connection with the site;<sup>190</sup> the person offering the domain name for sale, having not used it commercially pertaining to any goods or services or having such a manner of conduct;<sup>191</sup> a person using misleading or fake contact details in his application for registration and has a pattern of doing such;<sup>192</sup> a person registering or acquiring domain names that he is aware are similar or identical to marks of other persons that are distinctive and famous at the time of registering it with no regard to those others' goods and services;<sup>193</sup> the degree of integration of the mark in the domain name of the person.<sup>194</sup>

Where a registered owner of a mark finds that registration or use of a domain name has infringed his mark, he may bring a civil action against the infringer and the court may make an order forfeiting, cancelling or transferring the domain name to the user of the mark.<sup>195</sup> These principles of law were illustrated by the court in the *Daimler-Chrysler v The Net Inc.*<sup>196</sup> case. The issue to be determined by the court was whether by registering the domain name "foradodge.com." the defendants had violated the Anti-Cybersquatting Consumer Protection Act (ACPA) provisions in line with the fact that DaimlerChrysler had registered the DODGE mark as a trademark in 1939 and also in September 1995, it registered the domain name "4ADODGE.com" and established a website using the domain name. The court held that for a claim under ACPA to succeed, the trademark owner had to prove that it had a valid trademark to be protected, its mark being sought to be protected was distinctive or famous, the domain name registered by the defendant was identical or so

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<sup>190</sup> §1125 (d)(i)(B)(i)(V) of the Lanham Act.

<sup>191</sup> §1125 (d)(i)(B)(i)(VI) of the Lanham Act.

<sup>192</sup> §1125 (d)(i)(B)(i)(VII) of the Lanham Act.

<sup>193</sup> §1125 (d)(i)(B)(i)(VIII) of the Lanham Act.

<sup>194</sup> §1125 (d)(i)(B)(i)(IX) of the Lanham Act.

<sup>195</sup> §1125 (d)(i)(C) of the Lanham Act.

<sup>196</sup> 388 F. 3d 201 (6<sup>th</sup> Cir. 2004).

similar as to cause confusion in the minds of people or in the case of a famous mark, dilutive of the owner's mark, the defendant registered and was using or trafficking in the domain name and the defendant did so in bad faith with the intention of profit.

The court in this case found that the plaintiff had a valid trademark in "4ADODGE", the defendant's domain name "foradodge.com" was confusingly similar to it and that from the provisions of the Lanham Act, the registration was found to be in bad faith on every ground except one and thus decision of the district court to grant the plaintiff summary judgement was affirmed by the sixth circuit.

### **3.2.3 Regulation of the use of Trademarks as Domain Names in South Africa**

In South Africa, the Trademarks Act does not provide for protection for domain names. In essence, domain names are not protected as trademarks. However, the registration of another person's trademark as a domain name can give rise to an action against the registrant.<sup>197</sup> Domain name registration is administered by a company established by s 59 of the Electronic Communications and Transactions Amendment Act 2002, which is called .za Domain Name Authority (.zadna). .Zadna is saddled with the responsibilities of administering and managing the .za domain name space<sup>198</sup> as well as updating and maintaining the central registry.<sup>199</sup> It also has a duty to develop and publish guidelines on its management and administration as well as requirements and procedures for registration of domain names.<sup>200</sup> It may, with

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<sup>197</sup> Regulation 2 of the Alternative Dispute Resolution (ADR) Regulations 2006.

<sup>198</sup> Section 65 (1) (a) Electronic Communications and Transactions Amendment Act 2014.

<sup>199</sup> Section 65 (1) (d) Electronic Communications and Transactions Amendment Act 2014.

<sup>200</sup> Section 65 (1) (e) Electronic Communications and Transactions Amendment Act 2014

the approval of the Minister of Communications make regulations in relation to the assignment, registration, renewal, refusal or revocation of registrations.<sup>201</sup>

The Act also provides in s 69 that the Minister of Communications in consultation with the Minister of Trade and Industry must make regulations for alternative means of resolution of conflicts that arise out of registrations on the .za domain name space. In exercise of this duty, the Minister in consultation with the Minister of Trade and Industry made the Alternative Dispute Resolution (ADR) Regulations which was enacted in 2006. The Regulations apply to domain name disputes that arise between a complainant and a registrant in respect of registration and use of domain names registered in the .co.za second level domain, which also means that ADR under this Regulation is restricted to only these kinds of disputes.<sup>202</sup> A registrant is required to prove on a balance of probabilities that it rights in a domain name or mark that is similar to the domain name which amounts to an abusive registration in the hands of the registrant or amounts to an offensive registration.<sup>203</sup>

Factors indicative of an abusive registration are where the circumstances in which the registrant registered the domain name shows that it was done for the purpose of sale or rental to a complainant or a competitor at an amount in excess of the registrant's reasonable expense in acquiring the domain name; to intentionally block the complainant from being able to register a name or mark in which he has rights; to prevent the complainant from exercising his or her rights; where circumstances show that the registrant is using the domain name in a way that leads people to believe that the domain name is affiliated with the complainant; where the registrant has a pattern of making abusive registrations from previous experiences which shows that the registration of this domain

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<sup>201</sup> Section 68 (1) (b) Electronic Communications and Transactions Amendment Act 2014

<sup>202</sup> Regulation 2 of the Alternative Dispute Resolution (ADR) Regulations 2006.

<sup>203</sup> Regulation 3 of the Alternative Dispute Resolution (ADR) Regulations 2006.

name is abusive; where the registrant has provided false or incomplete details in the whois database; where the complainant has been using the domain name exclusively and has paid for registration or renewal of the domain name registration.<sup>204</sup>

The registration of a domain name would not be regarded as abusive where, unaware of the complainant's cause of complaint, the registrant has used the domain name in offering goods and services in good faith, he has become known by a name or mark that is similar to that domain name or made legitimate non-commercial or fair use of the domain name; the domain name is generic or descriptive and the registrant is making fair use of it; the domain name is used in good faith in tribute to or in criticism of a person or business; the registrant has to rebut the presumption of abusive registration by proving that the registration of the domain name is not abusive.<sup>205</sup>

The above principles are the principles an Adjudicator would consider in determining whether the party complaining of infringement of its trademark should be granted the use of the mark as his domain name or whether the person who registered the mark has bona fide rights to use the domain name. This principles were duly considered and applied in the decided case of *Holistic Remedies (Pty) Ltd & Amka Pharmaceuticals (Pty) Ltd v Oxygen For Life (Pty) Ltd*<sup>206</sup>, where the complainants filed their complaint on the grounds that they had rights in the name or mark similar or identical to the domain name registered by the registrant and the registration by the registrant amounted to an abusive registration. The Adjudicator found that the first complainant had led enough evidence to prove that it indeed had rights in a name or mark similar to the domain name and that considering the fact that the complainants and the

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<sup>204</sup> Regulation 4 of the Alternative Dispute Resolution (ADR) Regulations 2006.

<sup>205</sup> Regulation 5 of the Alternative Dispute Resolution (ADR) Regulations 2006.

<sup>206</sup> ZA 2007-009 available at <http://www.domaindisputes.co.za/downloads/decisions/ZA2007-009.pdf>.

registrant dealt in identical products, the registrant's domain name misled customers and consumers as to its origin and thereby took unfair advantage and was detrimental to the rights of the complainants, thus the registration in the hands of the registrant amounted to an abusive registration.

### **3.2.4 Criticism against the Grant of Trademarks Protection for Domain Names**

Trademarks protection for domain names has been criticised on the ground that it tends to extend the domain name space to the trademarks space, that is, once you have a registered trademark it means almost inevitably you are entitled to those domain names.<sup>207</sup> Thus carrying over real space to cyberspace which would make the real and virtual markets converge.

Also, in some circumstances, it tends to be giving the right that ownership of a trademark is automatically ownership of a domain name by precluding an individual from being able to register a domain name in which he has no trademark in.

It seems to be giving more weapons to the trademark owners to force legitimate users to forgo lawful uses.<sup>208</sup>

One of the attributes traditional trademarks is that two people can use the same trademark concurrently if they are not dealing in similar products, the mark is being used in good faith and there is no likelihood of confusion.<sup>209</sup> However, in the virtual space, there is no room for concurrent use of the trademarks as domain names because of the peculiar nature of the domain name system which does not have any boundaries that allow for such

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<sup>207</sup> Litman op cit (n160) 163.

<sup>208</sup> Litman op cit (n160) 164.

<sup>209</sup> G Weiswasser 'Domain Names, The internet and Trademarks: Infringement in cyberspace' (2003) 20 *Santa Clara Computer & High Tech. L. J* 215, 247 & 248.

because there cannot be two registrations for one domain name. This brings about an overlap.<sup>210</sup>

There is also the problem of multi-territorialism. The cyberspace being a non-national vehicle of any state, domain names evade regulations in that an individual can register a name in one country in the top level domain irrespective of its status or location.<sup>211</sup> Thus territorialism becomes a problem as trademark laws in countries are independent of each other. There is no international system that regulates registration of domain names and all the countries have their own laws. Even though international treaties try, they do little. Its only when domain names are nationally delimited that reflects boundaries consideration.

Thus, the conclusion is not that trademarks protection should not be given to domain names but that in an application for registration of a trademark as a domain name, the registered owner of the trademarks should be given priority to use the trademarks as a domain name over any other person who may wish to register the trademarks also as a domain name.

### **3.3.1 Trademarks Protection for Metatags, Keywords, Adwords, Linking and Framing in Nigeria**

Meta tags are invisible codes that are embedded in websites which direct search engines to generate results page that include the website.<sup>212</sup> Key words or adwords are words which are usually sold by search engines to advertisers whether they own the trademarks in those adwords or not so as to link their advertisement with those trademarked term which would result in a high rank

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<sup>210</sup> Weiswasser op cit (n209) 248.

<sup>211</sup> G Dinwoodie '(National) Trademark Laws and The (Non-national) Domain Name System' *Selected Works of Graeme. B. Dinwoodie*, Jan 2000, available at [http://works.bepress.com/graeme\\_dinwoodie/](http://works.bepress.com/graeme_dinwoodie/) 16498 pg 503-504 accessed on 17 May 2014.

<sup>212</sup> Roy op cit (n167) 4.

on the search engine's page.<sup>213</sup> Linking is an online practice that involves moving from one web page to another by clicking a logo or text or graphic while framing occurs where content of a web page is viewed on another webpage without leaving that web page.<sup>214</sup> In all these activities, intellectual property issues arise where another person's trademark is being used either in the metatag, as adword or keyword, linking or framing in such a way that is likely to cause confusion to an innocent user. Linking becomes a problem where it gives the false impression that the website is somehow linked or affiliated to the other website. Framing also gives rise to intellectual property infringement where in the course of framing another person's site in his own website, the author eliminates the advertising or other content that identifies the site on the other page. All these give rise to various issues of trademark infringement, unfair competition, trademark dilution, consumer confusion, misappropriation among others.<sup>215</sup>

Section 19 of the Cyber Security and Data Protection Agency Bill which is yet to be enacted provides that any person who intentionally and without permission uses a name, trademark, business name, domain name or any registered word or phrase which belongs to or is being utilised by another person, natural or juridical, or any arm of government on the internet in order to interfere with the owner's use on the internet commits an offence under the Bill and on conviction shall be liable to a fine or imprisonment or to both such fine and imprisonment. In arriving at its decision in the case against an offender, the court shall consider the refusal of the offender to surrender the use of a name after being formally requested to do so by the person who owns the name, trademark, business name, domain name or any registered word or phrase; or any effort made by the offender to collect any form of compensation

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<sup>213</sup> Sangal op cit (n153) 5.

<sup>214</sup> Roy op cit (n166) 4.

<sup>215</sup> Sangal op cit (n153) 2.

as a condition precedent to relinquishing the name, trademark, business name, domain name or any registered word or phrase to the rightful owner to enable him use same on the internet. The court shall, as an ancillary to the penalty already provided in this section, also order the offender to surrender the name to the owner. The Bill does not specifically mention the use of names as metatags, adwords, linking and framing, but it can be gathered from the words and the intention of the Legislature that the Bill if enacted is intended to relate to the use of names or marks online generally, thus it could applied to metatags, adwords, linking and framing.

There is currently no case law in relation to trademarks online infringement because of the absence of legislation in this respect. From the foregoing, we see that the Trademarks Act in its current form and with no other subsidiary legislation is greatly incapable of securing digital activities related to trademark rights.

### **3.3.2 Trademarks Protection in Online Advertising, Metatags, Adwords, Linking and Framing in the United States of America**

In the United States of America, the traditional trademark law applies to online trademarks infringement issues. The Lanham Act defines a trademark as any word, symbol, device or any such combination used by a person in commerce and applies to register same on the principal register established by the Act to identify or distinguish his product from those of other manufacturers and to show the source of the goods though unknown.<sup>216</sup>To succeed in an action against an alleged infringer, the person must have been using the mark in commerce in relation to the said goods and services and to the best of his knowledge, no one has the right to use the same or similar mark in commerce

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<sup>216</sup> 15 United States Trademark Act § 1127.

that has the likelihood of causing confusion or deception.<sup>217</sup> A person would also only succeed in such action for infringement where the court finds that the competitor used the trademark as a metatag to intentionally deceive or misdirect consumers by causing “initial interest confusion”.<sup>218</sup> The likelihood of confusion is the major determinant of whether the court would regard the use of the trademark either as metatag in linking or framing as an infringement of trademarks.

Section 32<sup>219</sup> provides that anyone who without the consent of the registered owner of the mark knowingly uses the copy or imitation of the mark in commerce in such a way that confusion or deception of others is probable is liable in civil action by the registered owner for the remedies provided in the Act. Where it is established by the court that the court that the defendant has violated the registrant’s trademark, the registrant is entitled, subject to the principles of equity to<sup>220</sup> an injunction;<sup>221</sup> the defendant’s profits; any damages sustained by the plaintiff; cost of the action; and the court may order destruction of all the articles like labels and signs bearing the mark.<sup>222</sup>

The Trademarks and Patents Office can refuse to register a mark where<sup>223</sup> the mark consists of immoral, deceptive or scandalous matter; it consists of any emblem of the United States, any state or any other country; it consists of the name, portrait or signature of a living person without his consent or that of a dead President of the United States without the written consent of his widow; it resembles a mark registered in the Patent and Trademarks Office

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<sup>217</sup> *Obayuwana* op cit (n154) 6; s 1051 15 United States Trademarks Act.

<sup>218</sup> T Gerdes ‘The Trademark Behind the Curtain; The Use of Trademark as Metatags’ para 6 available at [www.gerdeslaw.com/wp-content/themes/gerdes/inc/Trademarks-as-Metatags.pdf](http://www.gerdeslaw.com/wp-content/themes/gerdes/inc/Trademarks-as-Metatags.pdf) accessed on 3 February 2014.

<sup>219</sup> § 1114 15 United States Trademark Act.

<sup>220</sup> § 1114, 1116, 1117 15 United States Trademark Act.

<sup>221</sup> § 1116 15 United States Trademark Act.

<sup>222</sup> § 1118 15 United States Trademark Act in relation to the violation under s 1125 (a) & (c).

<sup>223</sup> § 1052 15 United States Trademark Act.

or name or mark already used by someone else in the United States in connection with goods which is likely to cause confusion, mistake or deception; consists of a mark that is descriptive or deceptively mis-descriptive of the goods in which they are connected with, the mark is descriptive of the geographical location of the goods, except in cases where it indicates regional origin of the goods, the mark is basically geographically deceptive or mis-descriptive of the goods to which they are connected, is primarily merely a surname or comprises of any matter that is functional as a whole.

The defences available include; the registration of the name was obtained by fraud; the registrant has abandoned the mark; the registered mark is being used with the consent of the registrant; the name is the individual's name in his own business or the term is descriptive of the goods and services or its geographical origin and such is used in good faith; the mark has been used continuously by the person unaware of the registrant's prior use; the mark has been registered and used prior to the registration under the Act and was not abandoned; the mark is being used to violate the antitrust laws of the United States; the mark is functional; the equitable principles of laches, estoppels and acquiescence apply.<sup>224</sup>

A practical application of the traditional trademark for the use of another person's trademark in online advertising was in the case of *Playboy Enterprises Inc. v Terri Wells et al*,<sup>225</sup> where the plaintiff brought an action against the defendant for infringements of its registered trademarks where the defendant embedded in her website the metatags "playboy" and "Playmate of the Year". The court held that the defendant was entitled to the fair use<sup>226</sup> defence of the trademarks after being "Playboy Playmate of the Year 1981" and also that her

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<sup>224</sup> § 1115 15 United States Trademark Act.

<sup>225</sup> 162 F 3d 1169 9<sup>th</sup> Cir February 2002.

<sup>226</sup> § 1125, 1115 (4) 15 United States Trademark Act.

website did not demonstrate any likelihood of confusion with the plaintiff's business and the metatags were used in good faith.

### **3.3.3 Trademarks Protection in Online Advertising, Metatags, Adwords, Linking and Framing in Australia**

In Australia, the traditional principles of Australian trademarks law also apply to online trademarks infringement issues.<sup>227</sup> A sign is defined to include any or a combination of the following, letter, word, name, signature, numeral, device, brand, heading, label, ticket, aspect of packaging, shape, colour, sound or scent.<sup>228</sup> Although the scope of coverage in Australia is wider than that of the United States as can be seen from this definition, they share some similarities also in relation to the rights attached to a trademark. The Act also gives the registered owner exclusive rights to use the mark or authorize others to use same in respect of the goods or services that they are registered for.<sup>229</sup> Unlike in some other jurisdictions like the United States, a registered mark is regarded as personal property in Australia<sup>230</sup> and the registered owner is at liberty to deal with the trademark as its absolute owner.<sup>231</sup> The trademark would be refused for application where it consists of a sign or a sign resembling a sign that is not to be used as a trademark as contained in s 18;<sup>232</sup> it cannot be represented graphically.<sup>233</sup> It would also be refused where the trademark does not have features that distinguish the applicant's goods or services from those of other persons, where the trademark does not inherently distinguish the goods or the applicant has not used the mark before filing for registration to the extent that it

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<sup>227</sup> Roy op cit (n166) 1, 2.

<sup>228</sup> Section 6 of the Australian Trademark Act.

<sup>229</sup> Section 20 of the Australian Trademark Act.

<sup>230</sup> Section 21 of the Australian Trademark Act.

<sup>231</sup> Section 22 of the Australian Trademark Act.

<sup>232</sup> Section 39 of the Australian Trademark Act.

<sup>233</sup> Section 40 of the Australian Trademark Act; this brings about the question of validity of granting trademarks to scents which cannot be represented graphically.

actually does distinguish the goods.<sup>234</sup> Also where the mark is scandalous and contrary to law;<sup>235</sup> likely to cause confusion or deception in relation to the goods with those of another person's;<sup>236</sup> is deceptively or substantially identical to the registered trademark of another person in respect of similar goods or closely related services subject to the exception that the Registrar finds and is satisfied that there has been honest concurrent use of the two trademarks or that it is proper to do so in the circumstances.

In defence to a claim of infringement of trademark, a person can rely on the defence<sup>237</sup> that the person used his name or the name of his predecessor or place of business in good faith; the person used the sign indicating the kind, quality, intended purpose, geographical origin etcetera of the goods or services in good faith; the person used the trademark to indicate the purpose of the goods in good faith; the trademark was used for the purpose of comparative advertising; in using the trademark, the person was exercising a right given under the Act; the court is of the opinion that if the person were to apply for the trademark in his name, he would get it; the person in the use of the sign referred to in s 120 (1), (2), (3) does not infringe the right of the registered owner to exclusive use of the mark; the person used the mark regarding similar goods or services in respect of which the trademark is registered with the consent of the owner to use the mark; the person or his predecessor has been using the unregistered mark continuously prior to the date of registration of the mark or the first time the person who registered the mark used it.<sup>238</sup>

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<sup>234</sup> Section 41 of the Australian Trademark Act; Inherently here refers to kinds, quality, purpose, value, geographical origin, characteristics of the goods, time of production, these are not inherently distinguishing.

<sup>235</sup> Section 42 of the Australian Trademark Act.

<sup>236</sup> Section 43 of the Australian Trademark Act.

<sup>237</sup> Section 122 of the Australian Trademark Act.

<sup>238</sup> Section 124 of the Australian Trademark Act.

Where the court finds that there has been an infringement, the owner of the mark would be entitled to<sup>239</sup> an injunction; damages or account of profit; additional damages as the court deems fit upon consideration of the facts of the case.

Thus, the court in the case of *Mantra Group Pty Ltd v. Tailly Pty Ltd*<sup>240</sup>, was faced with determining whether the use of the words “Circle on Cavill” by the defendant as a metatag constituted a trademark, whether the sign was used in good faith and whether it was used basically to indicate the biographical origin of the accommodation services. Reeves J. found that the prominent, widespread and highly repetitive nature in which the words were used was not genuinely for descriptive purpose and this did not show a sign of good faith on Tailly’s part. Also that the sign did not fall into the category neither did it constitutes geographical origin which relates to countries, regions, towns where the goods or services originated from and not the name of a privately owned building in the town.

One significant feature common to the United States Statute and the Australian Statute is the requirement for good faith. Thus to avail oneself of the exceptions available in these two jurisdictions, the good faith requirement must be complied with and met.

This chapter has examined the provisions of the trademarks law in Nigeria as well as some other jurisdictions in relation to application of trademarks law to the digital environment. It also made reference to some cases on how the courts in these other jurisdictions have applied the law when faced with these issues. Having considered the current position of the copyright and trademarks law in various jurisdictions, as well as some criticisms of different

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<sup>239</sup> Section 126 of the Australian Trademark Act.

<sup>240</sup> (No. 2) (2010) 183 F.C.R 450 (Fed Ct Aus) (Sgl Judge).

aspects of these laws, chapter four attempts to make recommendations which would improve the laws in Nigeria and try to avoid some of the pitfalls of the jurisdictions considered.

## **CHAPTER 4: RECOMMENDATIONS AND CONCLUSION.**

### **4.0 Introduction**

Chapters two and three of this work considered the relevant provisions of the Copyright Act and Trademarks Act in relation to how they will be applicable to the digital environment in their current state. They also discussed the current position in some other jurisdictions and the criticism of the systems. This chapter seeks to proffer possible amendments to these two laws to make them conformable to the current technological developments. This chapter is divided into two parts. The first part will discuss recommendations in respect of copyright protection while the second part will deal with trademarks.

### **4.1 Recommendations for Copyright**

#### **4.1.1 File sharing and Graduated Response Scheme**

As discussed earlier in chapter two, file sharing online via P2P networks is a major source of copyright infringement activities. It was also discussed that internet service providers bear indirect liability as the providers of the platform upon which these infringing activities take place. It was also highlighted that the high cost of monitoring activities online and litigation has made rightholders veer towards the graduated response scheme. Graduated response in different forms has been introduced in many countries. While some countries have incorporated the Graduated Response Scheme into their law, some countries have the privately ordered arrangements. This recommendation would consider whether or not the Graduated Response Scheme should be introduced and how best it can fit in the Nigerian environment.

In ensuring that the law effectively balances the rights of the copyright holders and the consumers, it is recommended that graduated response in the form of notice and notice with a fine system be incorporated into the national law. That is, graduated response should be statutorily regulated. Statutory regulation is necessary to provide regulatory and monitoring control against arbitrary private agreements between rightholders and internet service providers which would be detrimental to the rights of consumers.

In doing this, first, it is proposed that the legal frame work of the law should obligate internet service providers to co-operate with rightholders in the attempt to curb infringements. This will ensure that the internet service providers cooperate without hesitation.

The law should also lay down a procedure for enforcement where infringing activities are alleged. This should require that the internet service providers be obligated to have P2P detection technology which can be used to identify, monitor, prevent and block transfers.<sup>241</sup> By so doing, they would be able to keep track of infringing activities. The law should also require a rightholder whose copyright has been infringed to notify, by way of complaint, the internet service provider with proof of ownership of the copyright being alleged to be infringed. Upon receipt of the complaint, the internet service provider should notify the alleged infringer within seven days of receipt of the complaint via a detection notice and request that the infringer either takes down the infringing material or present its defence if it has one for the use of the material. If within 30 days, the internet service provider gets no response and the infringing material is not taken down, the internet service provider should send a warning notice to the alleged infringer that the material would be taken down if he fails to do so within 15 days. If the material is not taken down and no defence is received from the alleged infringer, the internet service

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<sup>241</sup> Peha & Mateus op cit (n40).

provider would be authorised to take down the material and send alongside a notice of enforcement to the alleged infringer.

The law should also provide for mechanisms for challenging infringement notices within a prescribed period and in a specific format.

The law should also establish a tribunal for the purpose of hearing infringement claims. Where the ISP receives a complaint, it should forward same alongside a detection notice and the details of the alleged infringer to the Tribunal. The Tribunal upon receipts of the document would open a file for the case. If the infringer responds to any of the notices sent, the ISP would forward the response to the Tribunal which would, after considering the complaint and the response, issue summons to the parties involved to appear before it to show cause. Where there is no response, the Tribunal should review the complaint and summarily levy a fine on the alleged infringer. The Tribunal would be saddled with the responsibilities of hearing the parties, taking evidence and deciding the case.

The ISP would not be under any obligation to disclose the personal details of the alleged infringer to the rightholder in order not to breach the user's right of privacy. However, the law should provide that the ISP would be obligated to provide same to the Tribunal where the Tribunal orders it to do so. This would protect the constitutional right of privacy of the owner subject to the judicial process.

Also, the Graduated Response would not involve the arbitrary disconnection of the alleged infringer's internet connection by the ISP in order not to tamper with his freedom of expression considering the level of technology at present where so many activities go on daily online. Only the Tribunal should be empowered to make an order for disconnection and this should be done only in the severest cases.

If the ISP does not take steps expeditiously in line with the provisions of the law upon the complaint of the rightholder and the infringing activities continue, it would be secondarily liable and the rightholder can take an action against the ISP.

An ISP would only be held liable where it has direct knowledge of the infringement activity being carried out on its network. Knowledge of the infringement can be imputed to him where there are facts or circumstances that reveal that the infringement was going on. This could also serve as limitations on the liability of the ISP. Also, it would not be responsible where it was only acting as a conduit for information communicated by other.

#### **4.1.2 Format Shifting and Fair Dealing**

As was discussed in chapter two, the major issue in respect of format shifting is the copyright exception of copying for private use for sound recordings. The fair dealing exception in the copyright law should be amended to allow copying of sound recording which would permit users to copy music from a CD to any other digital or storage media. This exception would allow users who have lawfully obtained the copyrighted work to enjoy the private use of the work in any way they want as long as it is not commercially detrimental to the rightholder.

The law should provide that a user who has lawfully obtained a copyright protected work can make copies of them for his private use from one device to the other and also for electronic storage online. The user would however not be allowed to transfer the copy of the copyrighted work made to anybody or share it either digitally or electronically. The user would also not be allowed to keep the copy of the work made where he gives out the original copy of the work, he can only keep the copy where the original copy is lost or destroyed. The user would also not be allowed to make any copying which is

for commercial purpose. Engaging in any of these prohibited acts would amount to a copyright infringement of the work.

The fair dealing exception should also be expanded to accommodate other private use exceptions like allowing the user make up backup copies of a digital data for example movies. The exception should accommodate format shifting of materials of works in the analogue form. The law should also accommodate the recording of radio or television programmes for viewing at a later time.

#### **4.1.3 Technological Protection Measures**

The only attempt ever made towards the provision for TPMs was in the Cyber Security and Data Protection Agency Bill which was not passed into law as discussed in chapter two. The Bill proposed to criminalise activities related to tampering with passwords or access codes through the use of devices or computer programmes in order to gain access to a programme data or database for unlawful purpose. In line with the provisions of the WCT and the WPPT 1996 which obligate member states to make sufficient legal protection to prevent circumvention of effective technological measures put in place to protect copyrighted works, I make recommendations below.

The proposed Bill should in its sections make provisions that refer explicitly to the prohibition of circumvention technological protection measures.

It should make anyone indulging in circumvention activities either through use or making available the device for circumvention both civilly and criminally liable.

The law should define what is regarded as unlawful purpose or delete the phrase entirely by making provisions for the traditional copyright and some other exceptions like; for the purpose of making a backup copy from a lawfully

obtained original copy of a work for private use; for the purpose of protecting minors and public policy; for the purpose of reverse engineering; for the purpose of encryption research; for the purpose of security testing; for educational and non-profit library use; for the purpose of law enforcement among other government activities; for the purpose of exercising fair dealing rights.

Policing activities should be regulated in such a way that internet service providers would only divulge details of users engaging in circumvention at the order of a court to prevent intrusion of privacy issues.

A register of technologically protected copyright works should be maintained by the NCC so as to monitor and be able to know when a work has fallen into public domain. After the expiration of the copyright in the work, the owner of the protected work is obligated to open the work to make access available to the public and where he cannot be found the commission would employ personnel to remove/deactivate the protection measure.

It is important to maintain a balance between the rights of the copyright owners and the rights of the users. The rights of the copyright owners cannot be absolute because that would defeat the purpose of legislation which is to protect the rights of all the parties.

#### **4.2.1 Trademarks as Domain Names**

In the current trademarks regime as discussed in chapter three, domain names are not protected as trademarks. The issues about disagreement over use of a distinguishing name in respect of use, ownership and infringement of trademarks exists in the virtual space just as it does in the real space<sup>242</sup>. The current legal system should be expanded to accommodate the domain name

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<sup>242</sup> Burk op cit (n162) 23.

phenomenon. Trademark law is adaptable to accommodate the virtual space as well.<sup>243</sup>

This, the law could do by the proper establishment of a non - governmental authority or incorporate the Nigeria Internet Registration Association (NIRA) which would be under the supervision of the Minister of Commerce and would regulate domain names registration in Nigeria. The Minister would oversee and supervise the activities of the non- governmental authority. Government oversight and proper legislation enacted will deal with the issues of legitimacy in the domain name system regulation.<sup>244</sup>

The law should set out a procedure for registration of domain names in place of the first come first serve basis of allocation subject to a priority consideration for the registered owner of trademark proposed to be registered as a domain name in such a way that would further the development of the internet.<sup>245</sup> It should include a procedure where applications for domain names are published for a specified number of days to give room contests and challenging of the domain name before such domain name is registered.<sup>246</sup>

The law should also set out a procedure for dispute resolution similar to the mandatory uniform dispute resolution policy devised by the ICANN. This policy should contain substantive and procedural principles of law which would govern the resolution of disputes between registrants and mark owners which would include compulsory arbitration process which parties must submit to.

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<sup>243</sup> J Liu 'Legitimacy and Authority in Internet Coordination: A Domain Name Case Study' (1998-1999) 74 *Ind. L. J* 587 at 606.

<sup>244</sup> Liu op cit (n243) at 622.

<sup>245</sup> Dinwoodie op cit (n211) 522.

<sup>246</sup> International Ad Hoc Committee (IAHC) Recommendations 1997.

Protection of domain names should extend from trademarks protection to trademark dilution protection.<sup>247</sup>

There should also be periodic reviews of domain names to identify those that are not active or have become abandoned. This would encourage continuous use and reduce obsolete entries and extortion from cyber squatters.<sup>248</sup>

The law should provide for cause of action against anyone who with bad faith registers, traffics in or uses a domain name that is identical to, confusingly similar to or in the case of famous marks dilutive of such trademark.<sup>249</sup> Civil action can also be pursued against anyone who registers someone's name whether living or dead without his consent so as to profit by selling the name to such person or another person. However, if the person has a right in the name, even if he registers it for profiting, civil action cannot arise against him.<sup>250</sup>

#### **4.2.2 Trademarks Protection for Metatags, Keywords, Adwords, Linking and Framing**

The legislature should be more serious about the enactment of the Cyber Security and Data Protection Agency Bill which was proposed before the National Assembly in 2008 but was never passed into law.

The definition of mark eligible under the Act is very restrictive at the moment as it only provides for devices, headings, labels, tickets, names, signatures, words, letters, numerals or any combinations of them.<sup>251</sup> The definition should be extended to include generally, anything capable of

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<sup>247</sup> Dinwoodie op cit (n211)522.

<sup>248</sup> IAHC Recommendations; Weiswasser op cit (n209)257.

<sup>249</sup> Section 43 (d) of the Lanham Act.

<sup>250</sup> Section 3002 (b)(1)(a); G Dinwoodie 'Rational Limits Of Trademark Law (Plus 2005 Postscript)' *From The Selected Works Of Graeme B. Dinwoodie* January 2002 58 at 77 available at [http://works.bepress.com/graeme\\_dinwoodie/27](http://works.bepress.com/graeme_dinwoodie/27) accessed on 15th May 2014.

<sup>251</sup> Section 67(1) of the Trademarks Act of Nigeria of 2004.

graphical representation, phrases, symbols, designs, patterns, colours and containers for goods.

The Trademarks Act currently assigns trademarks only to marks in respect of goods, that is, there is no trademarks protection for services under the Act.<sup>252</sup> The Minister of Commerce in exercise of powers conferred by ss 42 & 45 (1)(b) of the Trademarks Act which<sup>253</sup>, purportedly issued a regulation entitled “the Regulations” on April 19, 2007 for the purpose of extending the classification of goods as contained in the Fourth Schedule of the Trademarks Regulations to insert service marks in line with the framework of the 9<sup>th</sup> Edition of the Nice Agreement Concerning the International Classification of Goods and Services for the Purpose of Registration of Marks.<sup>254</sup> Currently there are debates on whether the Minister is empowered by the law to extend the classification of goods to include marks which are not registrable by the Act and by so doing amending the Act which is a legislative function, thereby questioning the validity of the Regulations.<sup>255</sup> Also, the Nice Agreement which the Regulations is modelled after clearly distinguishes trademarks from service marks.<sup>256</sup>

However, in reliance on the Minister’s Regulations, practitioners have been encouraging their clients to file service marks applications alongside warnings that the applications are being received for registration with a caveat

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<sup>252</sup> Fourth Schedule of the Trademarks Regulations of 1967.

<sup>253</sup> Sections 42 & 45 (1)(b) of the Trademarks Act empower the Minister to make regulations “for classifying goods for the purpose of registration of trademarks” and also make regulations “necessary to empower the Registrar of trademarks to adapt the register of trademarks to any revised classification of goods”.

<sup>254</sup> “Nice Agreement Concerning the International Classification of Goods and Services for the Purpose of Registration of Marks” June 15, 1957. As revised at Stockholm on July 14, 1967, and at Geneva on May 13, 1977, and amended on September 28, 1979. 23 U.S.T. 1336, 550 U.N.T.S. 45.

<sup>255</sup> U Nwokocha ‘Nigerian Intellectual Property: Overview of Development and Practice’ (2012) *NIALS Journal of Intellectual Property [NJIP]* 101, 105.

<sup>256</sup> *Jumping the Gun on Service Marks*, available at [www.chrisogunbanjo.Com/Files/Jumping\\_the\\_Gun\\_on\\_Service\\_Marks.Pdf](http://www.chrisogunbanjo.Com/Files/Jumping_the_Gun_on_Service_Marks.Pdf) as accessed on 18 June 2014.

that they would not be advertised<sup>257</sup> until relevant legislations is enacted.<sup>258</sup> Thus service marks is yet to receive the requisite legislative backing. The Act should be amended to extend trademarks to services which would legitimately protect marks used in respect of services as well as goods.

In respect of infringements, in addition to s 5(2), the Act should provide that anyone who uses a mark which is identical or similar to another person's registered trademark in such a way that it takes unfair advantage of or is detrimental to the reputation and goodwill of the registered mark is guilty of infringement of that mark.

### 4.3 CONCLUSION

This thesis has been able to answer the research question of whether existing intellectual property law adequately balances and protects the rights of right-holders and users in the economy in the negative.

Chapter two examined the current copyright position in Nigeria in comparison with the position in the United Kingdom, the United States of America, Canada, New Zealand and South Africa. It discussed file sharing and the Graduated Response Scheme, format shifting and fair dealing, and technological protection measures. Chapter three examined the legislative position of trademarks protection for domain names and online advertising and marketing schemes in comparison with the United States of America, South Africa and Australia. Chapter four made some proposals for the amendment of the copyright and trademarks laws so as to adequately protect the rights of owners and as well balance the rights of the owners and users.

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<sup>257</sup> Advertisement is a precursor for registration under the Act.

<sup>258</sup> Service Marks Protection in Nigeria available at [www.tejulaw.com/service-mark-protection-nigeria/](http://www.tejulaw.com/service-mark-protection-nigeria/) as accessed on 18 June 2014.

In addition to the suggestions made in chapter four towards amending the laws, it is advised that the government sets up effective enforcement mechanism to ensure compliance/adherence with the provisions of the law. Poor enforcement has been a problem in the past and it is important that good and workable mechanisms be set up so that the laws will not be an exercise in futility. Thus, the law enforcement agencies should be instructed and equipped on how they would join effectively in ensuring that rights of owners and users are not being violated.

Also, there should be enlightenment campaigns all over the country sensitising members of the public on what it means to infringe intellectual property rights, the rights available to users both in the analogue and digital environments. This enlightenment campaigns should be done in the schools, majorly the high schools and universities because these are the people who are more prone to get involved in intellectual property issues. The campaigns should also be done via the television and radio media (through jingles, adverts, public announcements) so as to get across to the general populace. Also, town hall meetings where professionals could address the public on these intellectual property issues should be organized in all the local governments periodically. By so doing, claims of ignorance of the law would be no excuse.

In addition, the penalties for infringement of copyright are very low. The law should be amended to increase the fines as well as the imprisonment terms for large scale infringers so as to serve as a deterrent to copyright infringers.

Finally, there should be regular stakeholders meetings between the government, government agencies in charge of copyright and trademarks, right-holders, users (members of the populace), intellectual property gurus and enforcement agencies to discuss pertinent issues on intellectual property as they arise. As well as proffer solutions on how to properly develop intellectual

property laws in such a way that everybody's rights are taken into consideration and adequately protected.

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