

# Africa Focus



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In the past, developments in Intellectual Property legislation and practice in Africa have been hamstrung by a lack of government commitment. The need to comply with the TRIPS Agreement has brought about changes in several countries across the continent and in this bulletin, we focus briefly on these and other changes and provide an overview on membership of the Madrid Protocol on the continent.

## ALGERIA

During the course of 2003, a new Algerian Trade Mark Act was promulgated which deals, in the main, with procedural issues during the trade mark registration process. One of the more important changes is the introduction of examination on relative grounds (ie prior rights).

## ARIPO

Numerous queries are continuously received in respect of ARIPO protection but we remain of the view that until such time as the member states have amended their domestic laws to recognise ARIPO rights, proprietors should continue to protect their marks on a national basis. The Protocol came into force on 6 March 1997 but, to date, only Botswana, Lesotho, Malawi, Namibia, Swaziland, Tanzania (Tanganyika), Uganda and Zimbabwe have acceded to it.

## EGYPT

Although the new Egyptian Intellectual Property Law was enacted in June 2002, enabling regulations have not yet been published.

## GHANA

The new Trade Marks Act no. 664 was promulgated earlier this year and has introduced substantial changes, including protection for service marks, the ability to claim priority and register licence agreements. Although it would appear that in terms of the new Act the existing regulations will continue in force until new regulations have been passed, we believe this will create problems in view of the substantial amendments incorporated in the new Act.

## KENYA

Although the new Kenyan Trade Marks Act was promulgated during the latter part of 2002, the enabling regulations were only published in September 2003. Again, there has been a substantial departure from the previous Act with provision made for multiple class filings, protection for well known marks in line with the TRIPS Agreement and the duration of a registration fixed at 10 years, renewable for like periods.

LIBYA

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A unilateral decision by the Libyan authorities to declare all applications filed between 1988 and 2002 null and void due to correct administrative procedures not being followed, has caused a public outcry. Through the International Trade Mark Association and the World Intellectual Property Organisation, we are making representations in an effort to overturn this decision but as things stand, re-filing in this former pariah state may be necessary.

## MAURITIUS

The Trade Marks Act was promulgated on 6 January 2003, while the enabling regulations were published on 10 April 2004. Substantial changes to the 1868 Act were introduced, including a classification system, provision for multi-class applications, claiming convention priority, provision for the protection of well known marks and a 10 year term.

## MOROCCO (FRENCH and TANGIER)

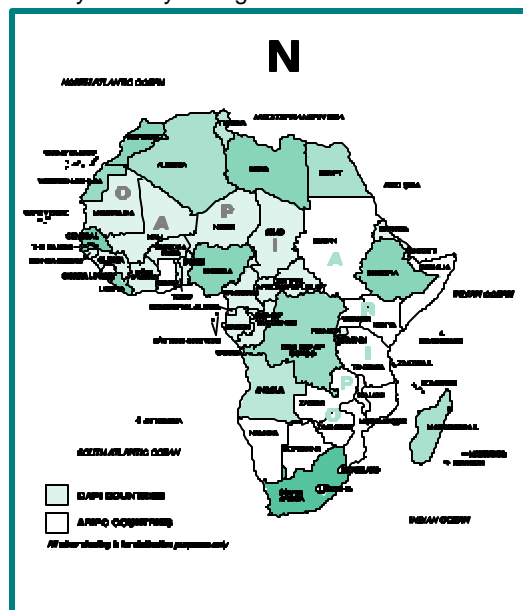
Unified trade mark legislation is in the pipeline, although we do anticipate further delays before an Act comes into force.

## MOZAMBIQUE

It became possible to file trade mark applications on 4 July 1999. The Industrial Property Code provides for the filing of a Declaration of Intent to Use on the fifth anniversary of a trade mark registration. Initially there was uncertainty as to whether or not the authorities would be calling for the filing of these Declarations from 4 July 2004. It is now confirmed that trade mark owners will be required to submit Declarations in order to maintain their registered rights.

## NAMIBIA

On 31 March 2004 Namibia acceded to both the Madrid Agreement and the Protocol, which will enter into force on 30 June 2004. However, Namibia has not yet enacted into law the draft Trade Marks Bill of 2002, and until it has, the validity to any designation



of Namibia in an International application is open to question, as the current Trade Marks Act does not recognise a right secured through an International Registration.

### **OAPI**

In the latter part of December 2003, the OAPI administrative council passed a resolution to amend the regulation concerning the extension of rights in respect of new OAPI member states.

An OAPI registration covers the territories that were members of OAPI at the time of filing the application. The extension regulation passed during the course of December 1998 introduced procedures for the extension of an existing OAPI registration to countries which were not originally covered, or to extend existing rights in a new OAPI member state to the other OAPI states. There was a non-extendable deadline of 18 months within which to apply for the extension of rights.

In terms of the revised regulation, extensions may now be requested at any time during the life of the existing registration (subject to the payment of a late fine) if the extension application is filed more than 20 months after the date of the new member state joining OAPI. The current member states of OAPI are:

*Benin, Burkina Faso, Cameroon, Central African Republic, Chad, Congo, Equatorial Guinea, Gabon, Guinea, Guinea-Bissau, Ivory Coast, Mali, Mauritania, Niger, Senegal, Togo*

### **SOMALIA**

After many years of struggling to communicate with Mogadishu, we have eventually managed to make contact and it appears that the Trade Marks Office is once again operational. Unfortunately, most documentation was destroyed in the civil war and if trade mark owners intend renewing registrations, it will be necessary to submit official documentation, failing which re-filing will probably be necessary. There are still a number of issues that must be clarified with the Registry but we expect to be in a position to pursue trade mark protection in Somalia in the coming months.

### **TANZANIA (ZANZIBAR)**

Although the full scale amendment to the 1930 Act has not yet been finalised, a recent amendment to the regulations has now made it possible to seek protection for goods in terms of the International Classification rather than the Old British system. Although we have received word that it is also possible to obtain service mark protection, it is our view that this would be irregular until such time as the Act is amended.

### **TUNISIA**

Whilst the new Act has been in force for some time, we wish merely to highlight the fact that there is now provision for the protection of well known marks, the examination procedure was overhauled and an opposition procedure introduced.

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## **MADRID PROTOCOL**

At present there are still only a limited number of African states that have joined the Madrid System. These are, in no particular order:

*Egypt, Morocco, Sudan, Algeria, Kenya, Lesotho, Liberia, Mozambique, Sierra Leone, Swaziland, Zambia, Namibia*

The oldest members are Algeria, Egypt and Morocco, who have all recognised their obligations in international law and have ensured that these (and the ramifications of membership of the Madrid System) have been included in their national laws. Thus, with effective enforcement measures in place, at national level, a trade mark owner who has designated Algeria, Egypt and/or Morocco in his international application, is assured that his rights will be recognised and enforceable in terms of the national laws of those states. His 'international' right, if challenged or infringed in these countries, will be recognised as if it were a national registration.

The newest accession is that of Namibia, having deposited its instrument of accession at WIPO on 31 March 2004. Although, in theory, it will be possible to designate Namibia after 30 June 2004, until Namibia has promulgated its new Trade Marks Law, it is submitted that a registration will not be enforceable there.

Mozambique became a member of the Madrid system when its Industrial Property Code was passed in 1999. The legislation, at the outset, made specific provision for the recognition of international trade mark registrations, and for the filing of international applications by Mozambican nationals.

Very recently Kenya passed enabling regulations, giving effect to a number of amendments contained in the 2002 Trade Marks Amendment Act, including a provision dealing with Madrid applications.

The same, however, can not be said for the remaining African member states, who have failed to fulfil their obligations under the Agreement and/or the Protocol by amending their national laws to give effect to an international registration at state level.

With Sierra Leone and Zambia not yet having made provision for the registration of service marks, it is likely that the incorporation of international obligations into the national laws (to provide for effective recognition of international registrations) is still a long way off.

Lesotho, Liberia, Sudan and Swaziland likewise still need to pass the necessary legislative amendments before an international registration designating any, or all of those countries is capable of being legally recognised and enforceable there.

Our advice to clients, for the time being, is to continue to register their marks at national level in those African countries where legislation is still to be amended. The same would apply to any new members of this system, until national legislation has been suitably amended.

We recently published two handbooks covering the IP legislation in African countries, one on Patents and one on Trade Marks. These are available upon request. Enquiries should be addressed to the Professional Affairs Manager, Margo Walters, Adams & Adams, PO Box 1014, Pretoria, 0001, South Africa. Email: margo-w@adamsadams.co.za.