

Adams & Adams

Client newsletter of Adams & Adams Patent, Trade Mark and Copyright Attorneys



ACTIVE IN AFRICA

Africa, a continent rich in natural resources, has long been an obvious target for possible investment opportunities but, over the years, mis-management in certain territories and the lack of real commitment from many prosperous

This brief synopsis, dealing in the main with developments on the trade mark law front in Africa, should serve to illustrate that many of the hitherto underdeveloped countries are attempting to make improvements on a legislative front to bring themselves in line with more progressive developing nations and, in due course, the Paris Convention and TRIPS.

countries has seen development on the continent limping along and economic prosperity for its people a mere hope, rather than a reality. However, in more recent times the winds of change appear to be blowing our way with renewed hope of massive funding for various

projects in Africa coming from institutions such as The Bill Clinton Foundation and The Bill and Melinda Gates Foundation and from entrepreneurs such as Richard Branson, all of whom seem to realize the potential on the continent and the possibility of bringing a brighter future to its people. Already, there is interest from the emerging markets and it is predicted that China, through its trade links with Africa, will increase its investment from around US \$ 30 Billion to US \$ 50 Billion in the current year. With FIFA having awarded the Soccer World Cup to South Africa for 2010 there is renewed interest in fostering economic development on the continent and a need for us to ensure that we can accommodate such organizations and their vision for Africa.

The recent Africa-China summit held in Beijing attracted at least 45 leaders from 53 countries on the continent and, while the official reasons for the summit were to commemorate the fifty years since China first opened diplomatic relations with an African country, Egypt, it came at a time of rampant Chinese commercial expansion in the continent. Resource rich countries such as Zambia, Ghana and D.R.C. will benefit from improvements in infrastructure, for more efficient transportation of minerals with the Tanzan Railway line and the Benguela line into the D.R.C. Internal transport infrastructure in smaller countries like Malawi and Tanzania will be improved for strategic purposes in tandem with the increased economic activity, it is imperative that countries have in place strong I.P. regimes to ensure that proprietary rights of owners are protected and enforceable.



BOTSWANA

Botswana recently acceded to the Madrid Protocol, but regrettably its domestic legislation fails to make provision for recognition of these rights, making the designation of Botswana in an international registration a nullity.

CAPE VERDE



Until recently it was only possible to publish cautionary notices, as a way of alerting the public to the existence of rights in trade marks, and in the absence of a formalised registration procedure.

The Old Portuguese Industrial Property Code of 1940 was never repealed and has, it appears, the effect of good law in Cape Verde. In terms of this legislation the registration of trade and service marks is possible and the authorities have recently begun accepting applications filed in accordance with the provisions of that code, read together with Cape Verde Decree Law no. 7/2003.

It is regrettable that the authorities have imposed rather onerous filing requirements, insisting on consular legalization of supporting documentation. In addition, the Old Portuguese "five item rule" is applied and not only are applicants required to pay additional fees for each item beyond five, the Registry is in fact insisting that additional applications be filed for all such additional groupings of five items.

On the positive side, there is draft legislation in the pipeline which we understand is modelled on the current Portuguese Industrial Property Code. It is not clear when this will come into operation and it would seem that regulations have not been drafted as yet.

DJIBOUTI

In a move to streamline the registration process we understand that there is a new draft law, modelled on the existing French Trade Mark Law, in existence. Again, regulations have not been finalised but it is expected that this new legislation will come into operation during the course of 2007.

ETHIOPIA

A formalised system of the publication of Cautionary Notices, run by the Ethiopian Intellectual Property Office, has been in existence for many years, in the absence of codified legislation.

A Trade Mark Proclamation was approved some months back and published in the Official Gazette during July 2006.

The Proclamation makes provision for the recognition of the International Classification, the application of Reciprocal Rights and priority applications. It also provides for the registration of collective marks, the recognition of well-known marks and the concept of trade mark dilution. There is provision for examination as to form, as well as substance, the publication of accepted applications for opposition purposes, as well as publication, at the applicant's expense, of registration.

The Proclamation sets out provisions dealing with the enforcement of rights and stipulates both criminal sanctions as well as civil remedies for dealing with infringements.

The enactment into law of this proclamation is unlikely to occur until such time as regulations have been finalised and implemented. Hopefully this will be during the course of 2007.



CAUTIONARY NOTICES

Of the several countries in Africa and the islands surrounding the continent, where no formalised legislation was in place and the publication of cautionary notices was recommended, only two remain. States appear to have been making significant progress with regard to introducing formalised legislation but it is still, regrettably, only possible to secure a modicum of protection in Eritrea and the Comoros through the publication of notices in the local newspapers.



The Registry in this country is probably regarded as the worst performing of all, with current delays in the publication of applications running into many years. This is largely due to the fact that the authorities do not receive adequate funding and publication of applications is not taking place. In recent times, the World Intellectual Property Organisation intimated that they would be sending a delegation to Banjul to review the situation and, possibly to assist in eliminating the backlog. This has yet to materialize but it is certainly encouraging that WIPO has its eye on the continent and is prepared to assist where the situation warrants it.

GAMBIA

Although a new Act came into force in 2004, corresponding regulations have not yet been enacted. The authorities are relying on the transitional provisions contained in the new Act, which makes it possible for the regulations under the previous legislation to apply in the current situation. This is not entirely satisfactory, but at least it has allowed proprietors to file applications to protect their marks used or intended to be used in respect of services in Ghana.

GHANA

The publication of trade mark applications in the Commercial & Industrial Bulletin has now been taken "in-house" by the Registry in the hope that this will speed up the process and allow applications to mature to grant sooner. The Registry also recently amended its practice with regard to the allocation of filing particulars. Previously numbers were allocated to applications once they had been examined and accepted, but prior to publication. At the moment, the first notification that one receives of the official number is when the application is advertised for opposition purposes.



As reported in our previous Africa Focus, the Libyan authorities declared all applications filed between 1998 and 2002 null and void and insisted on the re-filing of any such applications. Notwithstanding submissions having been made arguing that the implementation of the new legislation was prejudicial to trade mark proprietors, the situation persists and no trade marks filed between 1998 and 2002 will be regarded as affording the proprietors any protection.

LIBYA

In addition to the need to file afresh in this jurisdiction, the onerous filing formalities, which include Libyan consular legalization of all supporting documents as well as certified Arabic translations, remain in place.

Although it is still not possible to register marks in respect of services yet, there was a recent dramatic increase in official fees in Malawi. This could suggest that the Minister of Trade and Industry is looking at IP and, thus, a possibility that new legislation will be discussed soon.

MALAWI

MOROCCO

We had reported previously that unified trade mark legislation was anticipated, as there were still two independent Registries requiring separate registrations to cover the entire territory. The new law has now been in force since December 2004. Registrations secured previously in either of the French or Tangier regions of Morocco now apply throughout the entire territory.

MOZAMBIQUE

Although still in its infancy, the Mozambican Industrial Property Office and the profession in that country have been lobbying for amendments to the IP code, which were eventually finalised and implemented in July 2006. The most important changes in the amendments related to oppositions and extensions of time in that regard.

The new code distinguishes between "well known marks" (for the purposes of the code a mark is considered well known amongst the interested public as a result of promotion of the mark in Mozambique), and "high renowned marks" (a mark is considered as high renowned according to the code when it is known amongst the interested public as a result of promotion of the mark in Mozambique or anywhere else in the world).

The authorities are insisting on the filing of a Declaration of Intention to Use either six months before or six months after the fifth anniversary of each Mozambican trade mark registration. This requirement applies to marks still pending five years after filing and, in the absence of the filing of the Declaration of Use it is likely that trade mark protection will be regarded as null and void. It has however been possible to file Declarations, beyond the deadline, supported by evidence of actual use in the trade. It would seem that, in the absence of extensive use, proprietors would be well advised to re-file fresh applications.

NAMIBIA

Namibia acceded to the Madrid system for the International Registration of trade marks in 2004 but as it had not yet enacted into law the Draft Trade Marks Bill of 2002, the implementation of the Protocol was suspended. The situation remains unchanged, although further draft legislation is currently being considered, dealing, not only with the Madrid system, but also with ARIPO. The legislation will seek to ensure that there is sufficient recognition, at domestic level, for registrations secured via other means, yet designating Namibia as a contracting state.

NIGERIA

Although Nigeria has been slow to bring its legislation in line with international standards, and it is still not possible to register service marks there, there have been a number of encouraging recent developments, which would suggest that the situation is in the process of being rectified.

The Federal Executive Council (FEC) recently approved the amalgamation of 4 previously independent bodies – the Trade Marks Registry, the Patents & Design Registry, the Copyright Commission and the National Office for Technology Acquisition & Promotion – to form the National Intellectual Property Organisation (NIPO). This body will be responsible for the administration of all matters relating to intellectual property and will have, as its supervising ministry, the Federal Ministry of Science & Technology.

In addition, there is a draft bill dealing with the establishment of the Intellectual Property Commission of Nigeria waiting for approval. The Bill is a comprehensive document dealing with all aspects of intellectual property law, including making provision for the registration of service marks, something that has been long-anticipated.

It is not yet known when the new legislation will enter into force, but the situation is being closely monitored, and it is hoped that implementation will be during 2007.



O.A.P.I

In our previous report we advised that the revised regulations to the Bangui Accord allowed for applications for extension to new territories to be requested at any time during the life of an existing registration, subject to the payment of a late fine. It is thus still possible for trade mark owners to request the extension of their rights to territories not covered by the initial registrations.



Legislation dealing with trade marks recently came into force and the Act is modelled on the existing Portuguese legislation. Multiple class applications are permitted and, where it was only possible previously to ensure protection by publishing cautionary notices in the local newspaper, trade mark proprietors now can seek statutory protection in terms of the new law.

SAO TOME

In our previous report we had indicated that the Trade Marks Office had started operating but, regrettably, and due to ongoing civil strife, matters have reverted to the previous unsatisfactory state. The Trade Marks Office is presently not operating although we are monitoring the situation for developments.

SOMALIA

With its intended accession to the Madrid Protocol in the pipeline, the Trade Marks Office has been diligent in its attempt to reduce the backlog in dealing with trade mark applications and ensuring that official actions are issued within a reasonable time so as to comply with regulations pertaining to the Protocol.

SOUTH AFRICA

In line with the obligations that come into existence with accession to the Madrid Protocol, certain legislative amendments need to be finalised and thus, while this is receiving attention, the implementation of the international registration system under the Protocol is unlikely to come into force for the next twelve months or so.

A Draft Trade Marks Amendment Bill was drawn up in 2004 and, while this bill makes provision for the registration of service marks, as well as enabling legislation dealing with the implementation of the Nice agreement, inter alia, cabinet has not yet discussed the legislation. It is hoped that this will occur in the New Year.

UGANDA

The Minister of Trade and Industry has realised the importance of a strong IP regime and has recognized the need to update the hopelessly outdated current Trade Marks Act. Although still at an early stage, it is hoped that a new Trade Marks Bill will be made available for comment within the next twelve months or so.

ZAMBIA

As part and parcel of the renewed focus on intellectual property in Zambia, the Minister has also suddenly increased official fees quite substantially.

In our previous report we advised that Zanzibar had done away with the Old British classification of goods, and was accepting trade mark applications in goods classes, filed in terms of the international classification. Regrettably, the amendments to the Act that will allow for the registration of service marks in classes 35 – 45 have not yet been finalised and it is still only possible to file in classes 1 to 34.

ZANZIBAR

ARIPO

As a system for the regional protection of trade marks, we had indicated that ARIPO was not currently to be recommended as most member states had failed to amend their domestic legislation in order to give effect to registrations secured through the ARIPO offices in Zimbabwe. The situation remains unchanged and there have, in fact, been no new accessions to the Banjul Protocol on Marks in terms of the ARIPO system and thus trade mark owners are well advised to continue to seek protection at national level in the various member states.

MADRID PROTOCOL

Just to recap on the situation since our last update, there are some 12 members of the Madrid System on the African continent. Sadly, the territories of Liberia, Sudan, Namibia, Zambia, Lesotho and Swaziland have not passed enabling legislation to give effect to Madrid registrations, nor are there any procedures in place at the Registries to deal with these applications, rendering such designations meaningless.

The only new African accession to the Madrid system this year is Botswana, and it will be possible as of 05 December 2006, to designate that country in an international application under the Protocol. However, due to a lack of enabling domestic legislation, designating Botswana is not advisable, as such a registration will likely be of no real force or effect. The majority of the existing African member states have failed, as yet, to recognise their obligations under the system and to incorporate into their domestic laws provisions dealing with trade mark registrations secured via the International Registration system.

Namibia deposited its instrument of accession more than two years ago, but has failed to implement the system as a result of a delay in the promulgation of enabling legislation. There is a draft bill presently under consideration and it is hoped that this will be finalised soon, allowing trade mark owners to designate Namibia in an international trade mark application.

SERVICE MARKS

There remain several countries in Africa that have failed to amend their legislation to make it possible for proprietors to register their marks used in respect of services. We will continue to exert what pressure we can on the authorities in countries such as Gambia, Malawi, Nigeria, Sierra Leone, Zanzibar, Uganda and Zambia to realize the need to make these amendments and to ensure that there is continued protection for investment by the proprietor's service marks. The flip side for these proprietors is the assurance that there are adequate mechanisms in place for protection and maintenance of these rights.

2010

Over 500 000 visitors and \$425 million are expected to flow through South Africa during the 2010 FIFA World Cup South Africa and trade mark proprietors would do well to consider the impact which this event will have on their brands in this country and surrounding regions.

Firstly, there is an opportunity for businesses to develop new brands on the momentum of the potential 2010 economic boom. Obtaining trade mark protection is a vital part of this but the trade mark registration process in South Africa can currently take up to three years. Brand owners should therefore file applications for new brands and review existing portfolios now if they wish to be sufficiently covered by 2010.

Secondly, trade mark proprietors should familiarise themselves with the prohibitions which are in place on the use of trade marks in connection with the event itself and other restrictions on advertising. South Africa has strict and wide-reaching anti-ambush marketing laws in place and sponsor's rights will be vigorously protected.

Please contact us should you require more information.



In closing, the message is clear, Africa has a strong desire to engage seriously in trade with the rest of the world, having particular emphasis on fostering co-operation with emerging markets.