# intellectual property

## Inventa IP Review 2021

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But the past year was also a moment to reach milestones: it was the year that marked our 50th anniversary. We reinvented our image and we assumed ourselves as *Inventa*. Over these years we trailed a solid path in the Intellectual Property sector, looking to provide the best service to our clients and to advise them about the best solutions and strategies to adopted. In this compilation, you will find two articles that speak about the evolution of Intellectual Property in the last 50 years. A timeline that our firm followed and which, with satisfaction, witnessed significant developments in IP panorama.

For the second consecutive year, we present an anthology of articles and relevant announcements published by our team in 2021. We propose to create specific content throughout the year in order to share knowledge considered essential to better understand this sector and the importance it has in innovation, for our clients and their businesses. The topics range from several pocket guidelines, useful for registering trademarks or patents in different jurisdictions, how trademark legislation of predominantly Muslim countries - which prohibits the practice of gambling according to the Qu'ran - offers some opening in the registration of trademarks for gambling and casinos or how abbreviations and acronyms are registered as trademarks in the European Union.

Join us as we look back to 2021 and share a glimpse of some important issues in the world of Intellectual Property.

Inventa



"Inventa IP Review" is an annual compilation of articles written by Inventa team, with the main Intellectual Property (IP) topics that occur in the previous year. Inventa is an Intellectual Property firm, specializing in the protection and internationalization of trademarks, patents, industrial designs, copyright and domains, with a vast network of offices and local representatives. (in)
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## How to proceed when a trademark is about to be granted in Cape Verde

Diana Pereira



The receipt of an official notification requesting the payment of registration and certificate fees is one of the most eagerly awaited moments in the trademark registration process in Cape Verde. It means that an application has passed the Cape Verde Patent and Trademark Office's (PTO) substantial examination phase and has fulfilled all the requirements for grant. As such, the applicant is just a step away from receiving a registration certificate. However, this is also a critical time for rights holders to rethink their strategy.

Once an application has passed examination, the PTO will issue a payment notification, which identifies the trademark application by its number and states the classes of goods and/or services for which protection has been sought in commerce. After receiving this notification, the applicant has seven working days in which to proceed with the fee payment. Article 242 of the Cape Verde IP Law stipulates that an application will automatically be refused if these fees are not paid within the given deadline.

In Cape Verde, the payment of fees is segmented; there are fees for filing an application and then there are fees for the granting of a registration and issuing of a registration certificate. The latter are generally requested 12 months after filing the application (the average time frame from application to grant) and – since they are charged per class – can be expensive.

Trademark applicants should therefore be aware of the following processes:

There is a narrow window of time to proceed with the fee payment.

If the applicant, after analysing its budget and business strategy, decides that it does not need protection in all the previously requested classes, this is the time to take action.

There is an option to drop classes for which the applicant does not need protection by filing an official request at the PTO.

Any classes withdrawn will be recorded by the PTO and the applicant will receive an updated notification covering the classes that it wishes to maintain.

This is a critical time for an applicant to rethink its strategy, as a trademark must not suffer any major changes after the applicant has paid the registration fees. Article 170 of the IP Law states that a trademark must remain unchanged after registration; any alteration to its elements is subject to a new registration. If an applicant pays the registration fees and considers dropping a number of classes at a later stage, it must file a new application and pay all fees anew, since dropping classes is a major change for a trademark and is not permitted by the IP Law.

However, although the PTO charges registration fees per class, maintenance fees (ie, for a declaration of intent to use and renewals) are charged per trademark, regardless of the number of classes in question. This benefits rights holders as it reduces the amount of fees to be paid throughout the trademark lifecycle.

Taking this into account, some rights holders choose to bear higher registration fees and then take advantage of the more rights holder-friendly maintenance fees, while others opt to drop classes before paying the registration fees in order to save costs immediately. Whichever option an applicant chooses, it should be aware of these particularities of the Cape Verde trademark system.



## Protecting "The Chokwe Thinker"

Vera Albino



Whenever reference is made to a work of art named "The Thinker" in Angola, most people will think of the statuette "The Chokwe Thinker" ("O Pensador").

The history of "O Pensador", also known as "Samanhonga" or "Kuku", goes back to 1932, when the Swiss painter and ethnologist Théodore Delachaux found the statuette in a "divination basket" (a basket containing many small objects used for the diviner to made prophecies at request of his clients) during an expedition to Angola. It is a wooden figurine, representing an elder, woman or man, in a position of deep meditation.

The gracious and inspiring position of the elder encouraged Delachaux, influenced by August Rodin's sculpture "Le Penseur", to name it "The Thinker".

"O Pensador" is a work of art made by the Chokwe, a Bantu-speaking people living in northeastern Angola, as well as in southwestern parts of the Democratic Republic of the Congo and in the northwest of Zambia. Famous in Africa for their flourishing cultural traditions, the Chokwe's semantically complex art forms include sculpted figures, masks, thrones, divination implements, basketry, and ceramics, many of which express historical, moral, religious and political conceptions.

Praised for its symbology and finesse, "O Pensador" has been exhibited in museums since 1936, and it was granted the status of a national symbol of the Angolan culture in 1984. Currently it can be admired at the Art Gallery of the African Union in Addis-Ababa, Ethiopia, and it is expected to be present at the Expo 2020 Dubai (postponed to 2021 and 2022) in the Angolan Pavilion.

### Which IP rights?

Since 1984, "O Pensador" has gained greater visibility and relevance in Angola, in political, sociological and economic terms. For instance, besides being reproduced by sculptors and acquired in galleries, shops and craft fairs, it has influenced many economic sectors of Angola, which has resulted in a variety of trademarks applications in the country.

At present, there are 16 trademarks in Angola, in the names of five different applicants, consisting in the reproduction of the statuette, one of which is registered in class 30 for Coffee, tea, cocoa, sugar and coffee substitutes; rice, tapioca and sagú; flour and preparations made from cereals; bread, pastry and confectionery; sugar, honey and molasses syrup.

Bearing in mind the fact that the most relevant IP protection of an artwork is copyright, four questions arise:

(i) Is "O Pensador" a work of art protected by copyright, which could prevent the registration of a trademark?

(ii) Has a reproduction of "O Pensador" the needed distinctive character to be protected as a trademark?

(iii) What would be the consequences for a figurine originated by an indigenous people if it were registered as a trademark?

(iv) Can a reproduction of a work of art, which enjoys the status of national symbol of a state, be registered as a trademark?

In Angola, subparagraph h) of article 4 of the Angolan Law No. 15/14 of July 31, 2014, on Copyright and Related Rights, states that copyright protection shall cover works of sculpture. It is thus appropriate to determine in the present case that "O Pensador" is a copyrighted work.



However, as we work to answer that question, we are immediately struck by the difficulty of identifying the creator of the statuette. If, officially, this figurine is of Chokwe origin, its creator is, in fact, not known.

We find ourselves obliged to consider that "O Pensador" is an orphan work of Chokwe origin. In this sense, article 73 of the referred law provides that the term of the economic rights of the copyright owner for orphan works expires 70 years after the work has been lawfully made available to the public.

We know that the statuette was made available in 1936, almost 90 years ago, so we can safely consider that "O Pensador" is an artwork in the public domain and, as a matter of fact, freely available for reproduction. As a result, the copyright law shall not be a legitimate ground for opposing a trademark application.

With regard to trademark protection, article 31 of Angolan Law No. 3/92 of February 28, 1992, on Industrial Property, provides that trademarks are "any material signs that are used to distinguish the products or services of any enterprise". In other words, to be protected, a trademark must be able to distinguish the products or services of one company from the others. Does a reproduction of a well-known work of art comply with the distinctive function exigence stated in article 31?

The Angolan Institute of Industrial Property (IAPI) was of the opinion that it does when it granted one trademark on May 31, 2018, reproducing "The Chokwe Thinker". This position is in accordance with the European Union Intellectual Property Office which, for instance, has granted trademarks that reproduce the painting "Love and Pain" by Edvard Munch and the painting "The Night Watch" by Rembrandt. Even if the argument about the effective distinctive function remains, the reproduction of "O Pensador", in its artistic dimension only, can be registered as a trademark.

#### Other options

Can this specific piece of art be considered for any other type of IP?

First, "O Pensador" has the particularity of being of indigenous origin. It is true that Angola has no specific legislation regarding the IP protection of indigenous artworks, but it is also true that the safeguarding of traditional cultures including traditional works of art is the subject of increased concern and protection.

As happens in New Zealand when trademarks comprising Maori images are at stake, is it inconceivable that the IAPI would refuse a trademark if its use or registration may offend the Chokwe people? Such position would be legally possible pursuant to subparagraph f) of article 35 of the Law No. 3/92 of February 28, 1992. In accordance with this subparagraph, the IAPI is entitled to refuse a trademark if it is in conflict with public order or morality-—thus, is it in conflict with the morality of the Chokwe? Second, we must consider the fact that the statuette was officially declared a national symbol of the Angolan culture by the government, when the first cultural symposium took place in 1984. Hence, the figurine is part of the nation's cultural heritage and is a symbol of sovereignty. For instance, it is reproduced on the national banknotes and it is a traditional gift from Angolan representatives on the occasion of official visits. It also represents the country in international museums and exhibitions. Accordingly, should not any trademark that reproduces "The Chokwe Thinker" be refused in accordance with subparagraph c) of article 35 of the Law No. 3/92 of February 28, 1992, which precludes protection to any trademarks that reproduce symbols adopted by the state?

In conclusion, the reproduction of a work of art can, in essence, be protected as a trademark registration in Angola. Nonetheless, this principle should contain exceptions that must take into consideration the origin and any official status of the piece of art.



## Challenges of using the Madrid Protocol in Africa

João Francisco Sá



The Madrid Union is based on the Madrid Protocol 1989, which allows applicants to directly file trademarks in several countries with a single application and set of fees, through a centralised bureau that forwards them office actions. This cost-effective system can circumvent the need to directly file trademarks in national and regional offices, resulting in greater cost savings for applicants.

### **Regional reach**

The Madrid Union has 107 members and covers 123 countries. According to WIPO, these members represent more than 80% of world trade. While 22 out of 54 countries in Africa are members of the Madrid Protocol, this geographical reach actually extends to 38 countries due to the participation of the African Intellectual Property Organisation (OAPI). In total, the Madrid Union covers about two-thirds of the continent.

Notably, Angola, Ethiopia, Nigeria, South Africa and Tanzania do not belong to the Madrid Union. Since these five countries are among the top 10 largest economies in Africa,this has a significant impact on international filing strategies, as applicants are forced to file directly at the national IP offices of these regions. This reduces the cost-effectiveness of the Madrid Union for companies that are most interested in protecting their trademarks in the top African countries by market value.

### Legal protection challenges

African trademark offices tend to have bureaucratic administrative proceedings and lack the resources for an efficient trademark registration system. This means that some countries face larger backlogs in granting new marks. Most African countries do not issue grant of protection statements. Therefore, applicants must assume that their marks have been granted at the local level, which is not particularly reassuring for them. According to Article 5 of the Madrid Protocol, countries should issue notifications of refusal within 12 to 18 months after the extension notification. However, jurisdictions with larger backlogs may not be able to meet these deadlines if the national trademark office has not yet granted the mark. An extemporaneous notification of refusal would infringe the Madrid Protocol and create issues with the proceedings established by national law.

This conflict between national and international law does not have a straightforward solution and can lead to various outcomes depending on the national courts' interpretation. Further, the legal uncertainty created by the situation would be detrimental to trademark owners with legally valid trademark rights.

### Civil and common law divide

African countries are usually split between civil law jurisdictions (mainly lusophone and francophone countries), which tend to directly apply international treaties at the national level, and common law jurisdictions (mainly anglophone countries), which require that international treaties are enacted as national law.

In practical terms, this means that the Madrid Protocol is not enforceable in anglophone countries (eg, Eswatini, Lesotho, Sierra Leone and Zambia), even though they have joined the protocol.



On the other hand, while civil law countries are usually more capable of solving the constitutional uncertainties of applying international law, this does not preclude the abovementioned bureaucratic issues.

Although OAPI fully applies the Madrid Protocol, the fact that its establishing treaty, the Bangui Agreement, does not award the organisation with legal personality means that a legal argument can be made that OAPI does not have the powers to enter into an international agreement on behalf of its member states. However, this is yet to be tested in court.

### International trademarks for African applicants

Until now, the discussion has focused on the challenges of designating African countries in international trademark applications. However, African entities applying for international trademarks can still benefit from the system.

The United Nations maintains a list of least developed countries, which currently includes 33 African countries. Applicants from these countries can benefit from a 90% reduction in the basic fee to apply for international trademarks, which amounts to Sfr65 where the reproduction of the trademark is in black and white, or Sfr90 where the reproduction is in colour. However, this reduction does not apply to contracting parties' fees, which can still result in hefty total costs.

Another challenge for African applicants is the lack of information on trademark office proceedings. This can cause delays in forwarding international applications to WIPO's International Bureau, which can lead to the loss of the registration date.

According to Article 3(4) of the Madrid Protocol, rather than having a registration date that is the same as the date on which the international application was received at the office of origin, delays of more than two months will lead to the registration date being set only when the international application is received by the International Bureau.

### Comment

While there are clear advantages to using the Madrid Protocol, applicants should be aware of the challenges of applying and enforcing international trademarks in Africa. If applicants need to enforce their marks locally, they should seriously consider registering national trademarks directly at the relevant trademark office.





## An essential guide to filing trademarks in Uganda

Inês Tavares



Uganda is located at the heart of sub-Saharan Africa and is bordered by South Sudan, Kenya, Tanzania, Rwanda and the Democratic Republic of Congo. Its location makes it a strategic base for trade and therefore very attractive for potential investors as an emerging market. However, companies interested in entering the Ugandan market should seek IP protection beforehand, as it is common for third-party distributors to take advantage of new businesses and register their trademarks in bad faith, resulting in the unlawful use of marks and the creation of counterfeit products.

### International treaties and protocols

Since 2000 Uganda has been a member of the Banjul Protocol of the African Regional Intellectual Property Organisation (ARIPO), which means that trademarks can be filed regionally. However, Uganda has not ratified the Banjul Protocol. Therefore, it is not recommended to take this route over the national one, since it is uncertain whether marks that are filed in ARIPO designating Uganda will be enforced – and if they are, their effectiveness is highly questionable.

Further, Uganda has been a member of the Paris Convention since 1965 and the World Trade Organisation's Agreement on Trade-Related Aspects of Intellectual Property Rights since 1995.

### Trademarks in a nutshell

Chapter 3(4) of the Trademarks Act 17 (2010) defines 'protectable subject matter' as "a sign or combination of signs, capable of distinguishing goods or services of one undertaking from those of other undertakings". Companies can register goods and service marks, as well as certification marks. Further, Uganda is a single-class application jurisdiction and entities must apply for a mark through an agent. However, applications may be refused if the applicant or the address for service is not based in Uganda. Hence, applicants should proceed with an authorised agent that the registrar can recognise.

### Trademark registration requirements

There are not many strict formal requirements in Uganda. To file a trademark, an applicant must submit:

- a simply signed power of attorney;
- the applicant's data, including name and address;
- a sample of the mark (not required for word marks);
- a list of goods and/or services in accordance with the Nice Classification; and
- a certified copy of the priority document (if applicable), with a verified English translation.

### **Registration process**

The Ugandan Registration Services Bureau (URSB) must conduct an official search to ascertain the availability of the trademark in the jurisdiction before filing. The application process consists of:

- filing the request before the trademark registrar;
- an official search conducted by the URSB (mandatory);
- an examination conducted by the URSB and issuance of the acceptance letter;



• publication of the application in the Intellectual Property Bulletin;

a 60-day period for third parties to file an opposition; and

• issuance of the registration certificate.

The period from filing to registration may take between 10 and 18 months. However, this depends on whether there is a backlog at the registry.

### Validity

A trademark in Uganda is valid for an initial period of seven years from the filing date and consecutive periods of 10 years thereafter. Applicants need only submit a simply signed power of attorney to file a renewal. There is a continuous non-use period of three years from the granting date, after which the mark may be subject to cancellation.

#### Recordals

During the lifespan of a trademark, it may be necessary to amend the initially filed registration, given that the applicant or its details may change, and it is crucial that the information provided is accurate. In addition, any unrecorded information before the registry is not enforceable against third parties. The following services are available in the country provided that the formal requirements are met:

• For a recordal of assignment, the applicant must submit:

a) a simply signed power of attorney; and b) a deed of assignment, with a verified English translation.

• For a recordal of change of name, the applicant must submit:

a) a simply signed power of attorney; and
a certificate of a change of name, with a verified English translation.

• For a recordal of change of address, the applicant must submit a simply signed power of attorney.

- For a recordal of a licence, the applicant must submit:
- a simply signed power of attorney from the owner and licensee;
- a declaration and statement of case, with a verified English translation; and
- the licence agreement, with a verified English translation.

Due to the covid-19 pandemic there has been a slight delay in the timeframes to conclude proceedings in general. However, the situation is expected to improve as the pandemic dies down.







### Trademark registration in the Seychelles: A global data analysis

Diogo Antunes



The Seychelles is an archipelago in the Indian Ocean with less than 100,000 inhabitants. Data gathered over the past 13 years provides an interesting overview of the country's trademark filing landscape.

Between 2008 and 2021, more than 10,000 trademark applications have been filed in the Seychelles. Over the past eight years, trademark filing numbers have remained steady, with roughly 500 filings per year, excluding a small peak of 650 registrations in 2019. Although the numbers suggest that the Seychelles is not a particularly attractive country for trademark applicants, it is still an interesting area for brand owners to consider.

In the past five years, Class 35 covering "advertising and marketing services" has been the most popular class for Seychelles trademark applications – representing 8% of all applications. In second place is Class 9 for software products, representing 7.5% of applications in this period, followed by Class 36 with 6% and Class 12 with 5%.

The following companies own the largest number of trademarks in the Seychelles:

- Cable & Wireless Ltd;
- Toyota Motor Corp;
- Nissan Motor Co;
- Daimler AG;
- Hyundai Motor Company;
- Novartis International AG;
- ABSA Bank Limited;
- Compagnie Générale des Établissements Michelin Sca;
- Naspers;
- Merck KGaA; and
- Research In Motion Ltd.

US applicants file the highest number of trademark applications, with more than twice the number of domestic applicants. With regard to national applications, two of the largest domestic companies with the highest number of registrations are Cable & Wireless Ltd and Air Seychelles Ltd, which operate in strategic sectors – telecommunications and aviation, respectively. Japanese filers are in third place.

#### Beverage industry

The beverage industry is highly successful in the Seychelles. It is covered by Classes 32 and 33 – Class 32 for juices being the more popular of the two – and features in the top three most requested classes.

The company with the most applications in recent years is local company Trois Freres Distillery (Pty), followed by Swiss company Patron Spirits International AG and Mauritian company Phoenix Beverages Limited. Red Bull, Coca-Cola, PepsiCo and Monster also feature in the top 10. Overall, the United States leads with the most applications.

While the data shows that the Seychelles is not a particularly attractive country for trademark applicants, as its size and location mean that industries struggle to grow, it is still worth registering IP rights there. Considering that the government has announced that it intends to be the first country to vaccinate the entire population against covid-19 and resume its highly successful tourism activity, there is an opportunity for brand owners to invest in what the Seychelles has to offer.



## How the concept of morality is implemented at the African Intellectual Property Organisation

Vera Albino



Inspired by Article 6 quinquies of the Paris Convention, Annex 3, Article 3(c) of the Bangui Agreement provides that a trademark cannot be registered if "it is contrary to public policy, morality or the law". The legal concept of good morals is present in almost all WIPO members' trademark legislation. In particular, morality comes into play when trademark applicants – whether deliberately or not – apply to register controversial marks (ie, marks that contain insulting, sexually connotative, racist or religious or culturally offensive words or images). In this regard, the African Intellectual Property Organisation (OAPI) has been explicitly assigned the right and duty to control the morality of every trademark filed before it, which is straightforward in some cases, but not all.

There are three main causes related to the difficulties of upholding the concept of good morals in trademark registrations at OAPI. The first two are common to all countries and institutions, namely:

 the absence of a precise legal definition of 'morality'; and

• the conflict between morality and freedom of expression.

The third cause relates to the fact that the 17 OAPI member states have trademark laws in common, but have different understanding of morality. The cultural diversity in the regions is reflected in many different religions, traditions and languages, which means the concept of morality is not uniform across all states.

Trademark legislation in general, as well as the implementing regulations in the Bangui Agreement in particular, use the term 'morality'

as if it is taken for granted. Rule 2 of the Regulations Under the Agreement Revising the Bangui Agreement (1977) specifies that "morality is understood to mean the moral customs and practices generally recognized by a group or society". Rather than making it possible to grasp the specific meaning of the word, this definition refers to the words "moral customs and practices", which are vague. Further, Rule 2 attaches legal effect to the moral values of a group and therefore to the different customs and practices of the numerous groups present in the region.

In this context, morality is indefinable as it changes over time and varies according to localities and groups. Accordingly, the Bangui Agreement confers on OAPI the power to clarify the notion of morality in each region and to decide what conforms with this concept. OAPI must therefore consider a significant variation of the rules and ideals that each group living in the region puts forward as morality. Moreover, OAPI must refer to objective elements in its decisions; otherwise, it would be accused of arbitrariness. It must also take into consideration the negative effect that the over-zealous protection of trademark rights can have on the principle of free speech in each country.

To regulate filings, OAPI must identify the behaviours that the average citizen would consider to be moral. This is difficult, as unless the behaviour in question is transliterated into a trademark and has created a public scandal, OAPI does not have any scientific support to assess what is moral for an average citizen of the region.



## Cancellation for non-use can be used to avoid market monopoly in Sao Tome and Principe

Diana Pereira



Trademark owners have exclusive rights to exploit their protected goods and/or services, which prevent others from using equal or similar distinctive signs in the jurisdiction in which their rights are valid. In some cases, trademark owners adopt defensive strategies and file trademark applications in classes that are not directly related to their business in order to obtain the widest scope of protection and prevent third parties from filing similar marks that could dilute theirs.

This leads to the monopolisation of a mark that might not be used in all registered classes and the occupation of a market share that could be used by other companies that are struggling to gain their place in commerce and grow financially.

The Industrial Property Law allows applicants to file a cancellation for non-use in order to prevent undue market monopolisation. In Sao Tome, although use of a mark is not a prerequisite to file a new application, Article 205 states that a trademark's expiration must be declared if it has not been seriously used for five consecutive years from the application filing date. While the Sao Tome and Principe Intellectual Property Office does not ex officio monitor serious use, it does allow any interested party to file a request for cancellation due to non-use. The steps for this are as follows:

• A cancellation for non-use is submitted to the IP office.

The other party must reply within three months or file a one-month extension to reply.
The trademark owner or licensee must provide evidence of the trademark's use. Otherwise, non-use will be assumed. • The IP office will issue a decision within three months after the deadline to file the reply has passed.

• The non-use cancellation will be recorded and advertised in the IP Bulletin.

The onus in cancellation proceedings is on the trademark owner; the party interested in filing the cancellation for non-use is not responsible for providing proof of non-use. However, it must present a declaration expressing its interest in the trademark's cancellation, which claims that the mark has not been used.

The commencement or resumption of serious use within the three months immediately preceding the filing of a non-use cancellation will not be considered if such use occurred only after the trademark owner received the cancellation notification. In addition, where there are grounds for the registration of a trademark to lapse with regard to only some of the registered goods or services, the cancellation will apply to these goods or services only.

Trademark owners can also file for:

• the cancellation of bad-faith registrations;

• the cancellation of unfair competition registrations;

• a declaration of consent between the involved parties; and

• the grant of a licence of use.

However, due to the limited case law on cancellations on the grounds of bad faith or unfair competition, filing for these is not recommended.



### A new era for Sudan?

Inês Sequeira



Sudan is the third largest country on the African continent and the Nile river traverses the country from South to North, while the Red Sea makes Sudan a bridge between Africa and the Middle East.

Endowed with rich natural resources, Sudan was considered the 17th fastest-growing economy in the world in 2010 given the rapid development of the country largely from oil profits, despite international sanctions.

However, the secession of South Sudan after an independence referendum in 2011 gravely affected the economy, as more than 80% of Sudan's oil fields are located there. The situation was further exacerbated by the continuing tensions between Sudan and South Sudan.

The 27-year period of isolation left Sudan a diplomatic pariah and blocked access to financial aid that it now urgently needs.

On December 14, 2020, the US Department of State officially rescinded Sudan's designation as a state sponsor of terrorism after considering Sudan's actions to normalise relations with Israel and the resolution of terrorism claims regarding the bombing in 1998 of US embassies in Kenya and Tanzania, and the bombing in 2000 of the USS Cole.

However, the lifting of established restrictions will not be effective immediately as the US restrictions are incorporated into several regulatory regimes that may take some time to be amended.

Despite this fact, the end of the biggest barrier to the African country's access to international and economic development will open new possibilities. Sudan presents underexploited opportunities that can reinvigorate economic growth. With this announcement, Sudan has the chance to re-engage with the global economy, from students seeking scholarships in Western countries to companies seeking trade deals and foreign investment.

The African Development Bank Group says that about 63% of Sudan's land is agricultural, but only 15% to 20% of it is under cultivation. This represents an excellent opportunity for private investment since large-scale irrigated agriculture has the potential to create employment and increase national income and foreign exchange earnings.

Key emerging country partners, especially China, Malaysia, and India, will now see an open door for their international banks and multinationals looking to do business in Sudan.

#### IP matters

Business opportunities are possible only with the assurance that it is a safe and profitable business, and this point is fundamental for IP as well. Thus, all investors should be mindful of the need to ensure that their rights, trademarks, patents, and designs are protected before exploring business opportunities in Sudan.

As far as IP is concerned, there has been an increase in the number of applications for registration in Sudan over the past two years, as well as an increase in the assets' valuation. Given the coronavirus pandemic situation and the crushing economic crisis, this growth is expected to be even more visible from the first quarter of 2021, in the areas of agricultural commodities, medicine and medical devices.

According to the African Journal of Science, Technology, Innovation and Development, economic development is closely related to the inadequacy



of the IP rights protection in Sudan. With this change, we might see Sudan improving its national system of innovation and transfer of technology.

These factors will certainly contribute toward enhancing IP rights, as will the promotion of adequate IP legislations and enforcement; a commitment to international IP agreements; finance, investment, and resources; social partnerships to encourage IP protection; increasing government and private sector concern; improvement of public awareness; encouragement of cooperation between universities and industry, and improvement of institutions; and coordination and culture for IP protections.

Sudan is a member of the Madrid Agreement, the Madrid Protocol and the African Regional Intellectual Property Organization (ARIPO). A trademark registration is available through a national filing or international filing. However, patents applications can be filed via national filings in Sudan, regional filing at ARIPO and national phase Patent Cooperation Treaty application. Designs applications are possible throughout ARIPO and national filings.

### Trademark registration

Here is a brief description of the trademark registration process in Sudan:

• Filing of the request before the Registrar

General of Intellectual Property and issuance of an application filing receipt with application filing number;

• Formal and substantial exam conducted by the IP office;

• Issuance of report of acceptance by the IP office;

Publication of the application in the IP Bulletin;
Six-month period for the filing of oppositions if residents, and eight months for non-residents by third parties who considered themselves to be adversely affected with the trademark registra-

Issuance of registration certificate.

tion; and

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Trademarks in Sudan are valid for ten years from the filing date and may be consecutively renewed for the same period. Moreover, the time frame of a trademark registration until completion may take two to three years. Regarding South Sudan, there is still no actual trademark law, but for some time the Ministry of Justice accepted the reservation of trademark applications as guided by the provisions of Sudan Trademarks Act of 1969.

Indeed, an official communication from the office of the chief registrar has confirmed that the registration of trademarks has been suspended until the IP laws are enacted.

However, pending the enactment of these laws, applicants intending to register their trademarks were able to proceed to reserve their trademarks. The registration process would then be completed once the laws have been passed by parliament. Nevertheless, even the reservation of trademarks is suspended until further notice.

The removal of Sudan's status as a state sponsor of terrorism is a significant step to restore and resume its economic and other relations with the world after more than 27 years of isolation from international community, attracting prominent international companies to avail themselves of the great investment and business opportunities.

Consequently, this announcement may also lead to the reversion of the inadequacy of IP rights protection in Sudan.

According to the African Journal of Science, Technology, Innovation and Development, economic development is closely related to the inadequacy of the IP rights protection in Sudan.





## A brand owner's guide to Africa's regional IP agreements

João Francisco Sá



Africa is a vast continent with 54 countries and a plethora of legal traditions that can bewilder trademark applicants wishing to protect their intellectual property in this fast--growing region. The continent boasts two regional agreements, which allow multi-jurisdictional trademark applications: the African Intellectual Property Organisation (OAPI) and the African Regional Intellectual Property Organisation (ARIPO). These two organisations cover 27 countries and greatly facilitate the process of applying for and protecting trademarks in Africa.

### ΟΑΡΙ

OAPI was created in 1977 by the Bangui Agreement and has 17 member states. It offers protection in mostly French-speaking countries of West Africa, namely Benin, Burkina Faso, Cameroon, Central African Republic, Chad, Congo, Cote D'Ivoire, Comoros, Equatorial Guinea, Gabon, Guinea, Guinea-Bissau, Mali, Mauritania, Niger, Senegal and Togo. OAPI's trademark registration system is automatic and unitary. Therefore, an application will cover all member states without the need for subsequent formalities and trademarks cannot be refused in connection with one or a few member states. Further, member states do not have trademark laws or subregional registration systems. Therefore, it is not possible to seek national protection with the Bangui Agreement functioning as a region-wide IP code. The usual time frame from application to registration is 10 to 14 months. The opposition period is six months after the date of grant.

### ARIPO

ARIPO was established in 1976 by the Lusaka Agreement as an umbrella treaty to foster cooperation on IP matters between member states. It has been further developed by several implementing treaties, which deal with individual IP rights, such as the Banjul Protocol on Marks (1993). ARIPO's Banjul Protocol members are mostly English-speaking countries, namely Botswana, Eswatini, Lesotho, Liberia, Malawi, Mozambique, Namibia, Sao Tome and Principe, Tanzania, Uganda and Zimbabwe. The most interesting component of the ARIPO registration system is that, unlike OAPI, it requires applicants to designate the individual member states in which protection is sought, and an application can be refused in connection with some member states without cancelling the whole trademark or affecting other designations.

Upon receiving an application, ARIPO will conduct a formal review and forward the trademark to the designated national IP offices for examination according to their national trademark laws, which may include a prior mark search. The usual time frame from application to registration is 12 to 18 months. The opposition period is three months after publication in the regional Marks Journals. The ARIPO registration system is less straightforward than OAPI's and relies heavily on each member state's ability to adapt its national trademark laws and practice to the Banjul Protocol. While this can be construed as a shortcoming, it is actually its strength, as it is more adaptable and future proof, and makes it easier for new countries to participate.

The growth of cross-national African trade spearheaded by the ratification of regional free trade agreements will foster the expansion and improvement of regional trademark registration systems. Companies with economic interests in Africa that wish to expand their trademark portfolio should be aware of the advantages of ARIPO and OAPI as they enable cost-efficient and effortless protection strategies.



## Kenya proceeds with the publication of expired trademarks

Vítor Palmela Fidalgo



In a special edition of the Industrial Property Journal, the Industrial Property Institute of Kenya (KIPI) has stated that as of 15 February 2021 it will now publicly notify trademark owners that have not filed a renewal application for their marks but have been notified of the expiry date.

What is more, KIPI has listed more than 2,400 expired marks, which it intends to remove from the trademark register.

The publication follows a previous update on 15 June 2020, in which KIPI published information on a number of updated trademark rules. These provisions state that trademark owners will now receive notice if no application for the renewal of a registered trademark has been received after the 10-year validity period.

This information will be published in the Industrial Property Journal if no application to renew the registered trademark has been received within 60 days from the notification date.

This aims to give legal force to the rules under Section 23 of the Trademarks Act, which states that trademark registrations expire after 10 years, notwithstanding renewals.

The special edition of the journal clarifies that following Provisions 67 and 68 of the Trademark Rules, a notice will be published in the bulletin under the following circumstances:

• If the owner of a registered trademark makes an application to renew its listed mark and pays the renewal fee (and the additional late renewal fee) within 30 days from the date of publication, the trademark will be renewed and will not be removed from the trademark register.

• If no application to renew a mark listed in the bulletin is received within 30 days from the date of the publication, the trademark will be immediately removed from the trademark register.

• If the mark has been removed from the register, the owner can file an application to renew it upon payment of the renewal fee plus additional fees for restoration. Should the register show that is fair to do so, the trademark will then be restored.





## South Africa: Primark v Truworths – who will win?

Inês Sequeira



For the past seven years, fashion retailer Truworths has had its eye on the PRIMARK trademark. In 2018 it successfully cancelled Primark Holdings' UK mark for non-use and in 2019 the company applied for its own version of the mark.

Truworths CEO Michael Mark has now announced that it will launch 15 stores in the next few months in an attempt to adapt to changing shopping habits following the covid-19 outbreak.

#### Background

Primark is an international retailer that offers the latest fashion, beauty and homeware products at great value to customers. The company opened its first store in Dublin, Ireland in 1969 under the name Penneys and now operates more than 380 stores in 13 countries across Europe and the United States, owning more than 400 valid trademarks around the globe.

The Primark website states that: "Adored by fashion fans and value seekers alike Primark is widely established as the destination store for keeping up with the latest looks without breaking the bank." Primark's parent company, Associated British Foods (ABF), is 20 times the size of Truworths and has plenty of reason to prevent this entity from setting a precedent.

With more than 900 valid trademarks – mostly in South Africa and other African countries – Truworths owns a number of top brands such as Earthchild, Identity, YDE and Uzzi. Now, it is looking to introduce its new brand, Primark, to the clothing market as well. Truworths claims that the new label will offer "good quality at great value and highly competitive prices yet reasonable margins" and will be tactically aligned with local suppliers.

### Primark Holdings trademark cancelled for non-use

In South Africa, a third party can cancel a trademark if it has not been used for five years.

In 2018 Truworths filed a cancellation action against Primark's registration for PRIMARK on the basis that the mark was not subject to use.

In 1976 Primark applied to register PRIMARK in Class 25. At the time, it did not have a presence in South Africa.

During the cancellation proceedings, Primark argued that its registration was entitled to protection as a well-known mark and that the non-use requirements did not apply.

The Supreme Court of Appeal found that Primark's evidence was insufficient to establish the required degree of knowledge of the mark and that, although PRIMARK could be regarded as well known elsewhere, particularly in the United Kingdom, the company had to show that the mark was well known in South Africa among the relevant sector of the public.

The court stated that the relevant sectors "will be constituted by those who are potentially likely to be attracted by the mark's reputation to do business with the proprietor of the mark, whether as consumers, agents, importers, channels of supply, retailers or otherwise... any other knowledge of the mark is irrelevant for the purpose of determining whether the mark is a well-known mark deserving of protection under s 35(1)".



### Pending applications and a political effort

However, the Supreme Court of Appeal also commented on Truworths' dishonest motivations and approach. Truworths then claimed that "*it did not actually want to open stores named Primark, but only wanted to use the name on a line of clothing*".

It now says that it will launch standalone and free-standing stores under the Primark name.

In addition, the Supreme Court of Appeal warned that cancelling Primark's trademark did not necessarily mean that Truworths could register its own mark.

Both applications filed by Truworths (2013) and Primark Holdings (2019) remain pending in South Africa.

" Primark v Truworths is a warning for IP owners to make use of their trademarks to ensure that they are not cancelled based on non-use."

Primark states that it will take whatever steps necessary to protect its trademark and hard-earned reputation. "*Truworths is attempting to misappropriate our brand and, in so doing, deceive the South African consumer*" the company told Business Insider South Africa in March 2021.

As a result of Brexit, now is a good time for owner brands such as ABF, which has a local and important presence in Africa (particularly in South Africa), to consider help from the UK government.

The court's final notes are remarkable, stating that:

Territorial isolation is a vanishing phenomenon... national boundaries and borders may restrict the movement of people, money, goods and services but the osmotic power of ideas and indeed images has intensified immensely in recent decades... in the twinkling of an eye, a brand or label not well known in South Africa can become embedded in the consciousness of ordinary people living here... if the principle of territoriality in relation to trade marks is to be revisited in the light of the changing social milieu, this will require an internationally concerted political effort and considerable political will... these are matters beyond the province of this court.

Primark v Truworths is a warning for IP owners to make use of their trademarks to ensure that they are not cancelled based on non-use.

Proof of use should be documented and preserved in case an application for cancellation occurs. Further, owners of well-known marks should identify the relevant sector and then ensure that the appropriate evidence is provided to establish knowledge of their mark in this area.

Primark has not said what kind of action it foresees and Truworths' actions so far may not guarantee its ultimate success.



## ARIPO trademarks maintenance in Mozambique

Miguel Bibe



The registration of trademarks in Mozambique is possible through three different procedures. The first is a national filing directly alongside the Industrial Property Institute (IPI), the second is via the African Regional Intellectual Property Organization (ARIPO) (in force since August 15, 2020, after Mozambique joined the Banjul Protocol), and finally, with a registration at the World Intellectual Property Organization (WIPO), as Mozambique is member of the Madrid System.

The registration of trademarks in Mozambique through ARIPO has been possible only since last year, so some issues can arise regarding the maintenance of these registrations in the country. On one hand, a trademark registration in Mozambique and its corresponding renewal does not raise major issues since the registration will be valid for a period of ten years, with the possibility of indefinite renewal for an equal period; non-renewal will result in the automatic expiration of the trademark.

Even in the situations where Mozambique has been designated as the territory at a later stage, as is possible in accordance with the Banjul Protocol, the renewal of those trademarks will not be a problem because section 9:3 of the protocol provides that: "The period of protection under the subsequent designation expires on the same date as the earlier registration."

This means that, when requesting a subsequent designation of an ARIPO trademark shortly before the renewal of the original trademark, the renewal fees must be paid for all the designated jurisdictions including the newest.

### Questions

On the other hand, the filing of declarations of intention of use (DIU) in Mozambique, a legal requirement for the maintenance of trademark registrations, raises some queries, as demonstrated below.

The Industrial Property Code of Mozambique (Mozambican IP law), of December 31, 2015, establishes the requirement of a DIU for trademarks. It should be noted that this requirement is applicable only for trademarks and not for other distinctive trade signs.

Generally, the DIU should be presented every five years, except in the corresponding renewal years (which occur every ten years), within a time frame of one year, namely, between six months before and six months after the respective deadline. However, the date from which the deadline starts counting has raised some doubts regarding international and ARIPO registrations when the designation of the Mozambican territory was made after the original application.

First, it should be noted that section 9:2 of the Banjul Protocol states: "Where, under section 9:1, the owner of a registered mark or applicant for registration of a mark subsequently designates any other state, such designation shall be deemed to be an application for the registration of a mark with respect to the state so designated and shall accordingly be subject to examination under the national law of such designated state as provided for under section 6 of the protocol.

"In such a case, the filing date of the application in the state so designated shall be the same as the filing date of the earlier application. The date of subsequent designations, if it complies with the applicable requirements, shall be the date on which it was received by the office. The date of subsequent designations



shall be recorded in the register and published in the ARIPO Journal."

The IPI was invited to pronounce on this issue and the answer provided was as follows. The date that should be considered to start counting the five years period to file the DIU is the filing or renewal date of the original registration, regardless of whether there was, or not, a subsequent designation.

The IPI advanced two arguments in support of this position:

(i) the date of designation shall be taken into consideration only for the purpose of determining the period until which the designated country must notify the ARIPO of its decision to grant or refuse the trademark registration; and

(ii) article 138 of the Industrial Property Code clearly states that the "DIU must be presented every five years, counting from the date of registration or renewal".

Therefore, it seems accurate to point out that the understanding of the IPI is in accordance with section 9:2 of the Banjul Protocol, namely, "the filing date of the application in the state so designated shall be the same as the filing date of the earlier application". Therefore, the relevant date to consider for counting the five-year period for filing the DIU in Mozambique should be the filing date of the original trademark.

Moreover, these arguments may lead to an unfounded application of this article since, contrary to the position of the IPI, it seems evident that an ARIPO registration that subsequently designated Mozambique could not be subject to the five-year period before the designation date to file the corresponding DIU.

The main reason to justify this opinion is that, despite the fact that the Mozambican IP Law states that it is not required to present any proof of the trademark's use when the DIU is presented within the legal time frame, a DIU filed after the corresponding legal period must be accompanied by a proof of the trademark's use in Mozambique.

It shall be stressed that if the proof of use is not filed with the DIU, there is the possibility for an interested third party to request the trademark's cancellation before the IPI pursuant to article 138(4) of the Mozambican IP Law. In the view of the position of the IPI and considering the Mozambican IP Law, it is not fair to require to a holder of an ARIPO registration to provide evidence of the trademark's use in Mozambique prior to the date of the subsequent designation in the country.

It seems clear that in a case when the trademark owner decides not to designate the Mozambican territory upon the original application and then proceeds with the subsequent designation, it will be precisely because initially he did not intend to use the trademark in Mozambique, and then pretends to start using it.

The owner of an ARIPO registration that chooses for a subsequent designation should not be prejudiced by it. However, it is precisely what will occur through the current position of IPI and with a strict application of section 9:2 of the Banjul Protocol.

In this regard, the acceptable position — the only one that will not jeopardise the trademark rights of owners when Mozambique has been subsequently designated — is that the five-year period should be counted from the date of the subsequent designation at ARIPO, otherwise the possibility of subsequent designation will be pointless in Mozambique. Additionally, to avoid possible cancellation requests, there is also the possibility for IP owners to consider the subsequent designation as an implicit DIU since, in practice, it is an expression of the owner's will to initiate the trademark use in Mozambique.



## Data reveals significant drop in national registrations in São Tomé and Príncipe

Diogo Antunes



São Tomé and Príncipe is an island country located on the western equatorial coast of Central Africa. The country consists of two islands: São Tomé and Príncipe, respectively. The official language is Portuguese due to the Portuguese occupation that lasted until the country's independence from Portugal in 1975.

The country has more than 200,000 inhabitants and is considered a paradise by many, yet it remains relatively unexplored by the tourism industry.

### Global data analysis

Data from the past 15 years reveals that São Tomé and Príncipe has a disproportionately mixed trademark registration system. The Madrid Protocol came into force in 1995 and the country joined the WIPO Convention in 1998. In this sense, and because the country is known in practice for having applicant-friendly trademark procedures, most of the trade-



marks registered in São Tomé and Príncipe are international registrations. More than 14,000 trademark applications have been filed in the past 15 years. However, only about 3,000 are national filings. The rest are international registrations. The number of national applications has been in decline since 2004, reaching only 74 national trademark applications in 2020. Moreover, the number of overall registrations has decreased by around 16%. If we include trademark applications that designate Sao Tomé and Principe, 750 applications were filed in 2020 – 300 fewer than in 2019.

### Classification

Class 9 (software) is the most popular Nice Class for trademark applications in São Tomé and Príncipe. However, Class 35 is the most popular for national applications specifically. The most widely used product for national trademark applications is tobacco.

#### Applicants

The companies with the highest number of trademarks in São Tomé and Príncipe are as follows:

- Apple Inc
- Avon Products, Inc
- Huawei Technologies Co, Ltd
- TOYOTA JIDOSHA KABUSHIKI KAISHA (also
- trading as TOYOTA MOTOR CORPORATION)
- Novartis AG
- ROLEX, SA
- Celgene Corporation (NJ)
- Omega SA (Omega AG) (Omega Ltd)
- PHILIP MORRIS PRODUCTS SA
- AUDI AG
- Intel Corporation (CA)
- GUCCIO GUCCI SpA



• Nissan Jidosha Kabushiki Kaisha (also trading as Nissan Motor Co, Ltd)

- Hyundai Motor Company
- L'OREAL
- British American Tobacco (Brands) Inc (DE)
- BASF SE
- TISSOT SA
- Rigo Trading SA
- Montres Tudor SA

The fact that this list includes no national companies indicates the little local use of the IP system by companies in São Tomé and Príncipe.

Such use should be encouraged in the coming years.

### Applicant nationalities

The countries with the highest number of applicants in São Tomé and Príncipe are as follows:

- United States
- China
- Switzerland
- Portugal
- Germany
- Japan
- United Kingdom
- France

Topping the list is the United States, with almost 2,000 applications in São Tomé and Príncipe. In comparison, São Tomé companies own only around 200 applications.

This demonstrates not only the United States' international presence in the local marketplace but also its growing commitment to local commerce in São Tomé.

Global data analysis what you need to know Global data analysis reveals Angola's varying trademark landscape 1. What do I want to drink today? Data search reveals African filing trends 2. African database searches uncover small rise in corona or covid-related marks

3. WIPO data reveals rise in international trademark applications originating from Africa

For other jurisdictions, please contact info@ inventa.com



## Trademark data reveals South African investment has opened previously closed markets in Mozambique

Vera Albino



Due to their geographical proximity and the fact that they share a common border of 493km, the economic and human relations between Mozambique and South Africa date back a long way. Trade relations between the two countries, in the economic configurations in which they exist today, were established at the end of the 19th century and followed inconstant periods of rapprochement and distance. However, in 1994 two unprecedented events occurred that had a profound impact on societies in both countries: the multi-racial elections in South Africa and the first multi-party elections in Mozambique. Since then, the two countries have continued to maintain close commercial relationships. South Africa has invested significantly in the Mozambican economy, thanks largely to the fact that Mozambique is an attractive destination for foreign direct investments (FDI). Indeed, in 2011 FDI became the country's main source of income.

Mozambique is attractive to investors because it is rich in natural resources and has good road, rail and port infrastructures. However, unlike traditional investors, their close proximity means that South African investors can invest in almost all sectors of the Mozambican economy, ranging from banking, brewing, soft drinks, sugar and tourist facilities to large infrastructure projects. In terms of trademarks, South African applicants own approximately 5,500 national trademarks in Mozambique. They rank second after applicants from the United States, which own approximately 5,850 national trademarks.

Most South African trademarks (11.4%) are applied for or registered in Class 35 and are

mostly related to retail and wholesale services. This class is followed by Classes 30 and 29 relating to food products (7.1% and 6%, respectively), Class 36 for insurance and financial services (5.8%) and Class 9 for electrical and scientific devices (5.5%).

These trademarks are mostly associated with consumer goods and their distribution, illustrating the fact that there are many South African goods in the Mozambican market. This notable presence has been highly beneficial to Mozambique in the sense that it has increased the supply of goods into the country and helped to stabilise prices.

Additionally, these numbers underline the fact that, even though US applicants also largely protect their trademarks in Classes 9, 30 and 35, only South African applicants register significant numbers of trademarks in Class 36 (insurance and financial services). Indeed, unlike traditional investors, South African investors are willing to invest in sectors such as finance, which are avoided by other countries.

While the top South African trademark owners are Edcon Limited, which operates in the clothing industry, the Standard Bank of South Africa Limited, a financial services group, and AfriSam South Africa Proprietary Ltd, a construction materials group, the top US trademark owners are Walmart Stores, Inc, a multinational retail corporation present in Mozambique through its South African company Massmart Holdings Ltd, and two oil companies: Anadarko Petroleum Corporation and Exxon Mobil Corporation.

Clearly, investment from South Africa has opened previously closed markets in Mozambique by securing foreign investment in the country through South African affiliates; Walmart is just one of many examples of this. It is



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also the main investor in Mozambique outside the oil industry.

Presently, South Africa is by far the biggest trading partner with Mozambique, which benefits both countries. However, this commercial relationship is considered by some economists to be "too close", in the sense that the Mozambican economy depends largely on South Africa, which could have a negative impact in Mozambique if the country does not improve its economic structure. " (...) the two countries have continued to maintain close commercial relationships. South Africa has invested significantly in the Mozambican economy, thanks largely to the fact that Mozambique is an attractive destination for foreign direct investments"



## The Registration of Chinese, Korean and Japanese Characters as European Union Trademarks

João Pereira Cabral



According to the available information on the European Union Intellectual Property Office's (EUIPO) database, since the 1st of April of 1996, 13.430 European Union trademark (EUTM) applications seeking protection for Chinese, Japanese and / or Korean characters were filed. Currently, resulting from those applications, there are 7.805 registered EUTM that consist of or include Chinese, Japanese and / or Korean characters.



Figure 1 - Comparison between the total number of EUTM applications for Chinese, Japanese and/or Korean characters and the total number of respective registrations

The purpose of this article is to analyze how these characters are protected by EUTMs and the statistic evolution of EUTM applications covering them. The researcher for the information here presented was carried out using the EUIPO's database and by application of the EUIPO's modified Vienna Classification, namely, class 28.03 "Inscriptions in Chinese, Japanese or Korean Characters.

### Types of EUTM

The EUIPO's Trade mark guidelines presents

the following mark types as available for protection: word, figurative, shape, position, pattern, colour, sound, motion, multimedia and hologram. Being registered as EUTM, Chinese, Japanese and / or Korean characters can only be of one of these types of mark.

In a first analysis, for they cannot consist of a character, it may be concluded that Chinese, Japanese and / or Korean characters cannot be registered as colour marks and sound marks. A colour mark is a mark consisting only of colour and a sound mark, despite being able to consist of a sound corresponding to a Chinese, Japanese and / or Korean character, cannot consist of the character itself.

Chinese, Japanese and / or Korean characters could be, in principal, protected as any other mark type, as they consist of words, they may be deemed as figures, they can be part of a shape of a product or its packaging, they may be positioned in a product in a certain way, if repeated they can form a pattern, they can be part of a motion, can be included in a mark with several types of mediums or can be or be part of a hologram.

## How are Chinese, Japanese and / or Korean characters being registered as EUTMs?

But in reality, the distribution of the 13.430 EUTM applications for Chinese, Japanese and / or Korean characters, by the several mark types is as follows: 13.411 figurative marks, 13 shape marks, 2 colour marks and 4 "other" type marks.

As for the applications granted, Chinese,



Japanese and / or Korean characters were registered as 7.794 figurative marks, 8 shape marks, 2 "other" type marks and 1 colour mark. It should be stressed that, the classification of this "colour" mark in EUIPO's database is erroneous as it is actually a figurative mark.

Mark type	Count
Figurative marks	13411
Shape marks	13
Colour marks	2
"Other" type marks	4

Table 1 - EUTM applications for Chinese, Japanese and / or Korean characters by mark type

Mark type	Count
Figurative marks	7795
Shape marks	8
"Other" type marks	2

Table 2 - EUTM applications for Chinese, Japanese and / or Korean characters by mark type

The first obvious conclusion is that almost all EUTM applications or registrations for these characters are figurative marks. Another clear fact is that no word mark could be found. Nor it could have been, as the Vienna Classification only applies to marks that include figures. However, the reason for not being possible to find any registered EUTMs for Chinese, Japanese and / or Korean characters as word marks is more meaningful.

Despite the EUIPO defining word marks as any "typewritten mark with elements including letters (either lower or upper case), words (either in lower or upper case letters), numerals or standard typographic characters.", it can only be accepted if it is written in the alphabet of any official EU language. Since Chinese, Japanese and / or Korean characters do not correspond to an alphabet of any official EU language they cannot be registered as word marks.

Chinese, Japanese and / or Korean characters are not considered word elements by the EUIPO, but figurative elements. Therefore, its adequate mark type is the figurative mark or any other mark type which may include figurative elements.

The scope of protection and distinctiveness of Chinese, Japanese and / or Korean characters

The reason for all characters that do not correspond to an alphabet of any official EU language to be considered figurative elements instead of word elements is the premise that the relevant EU consumer does not understand those characters. If those characters are not understood they cannot function as word elements.

Therefore, its protection can only be visual. This means that phonetic and conceptual similarities with other trademarks are irrelevant.

For example, the registration of a Chinese character corresponding to an English word already registered as a EUTM can be also registered as a EUTM, without infringing the prior rights.

Similarly, the distinctiveness of a Chinese character cannot be affected by its meaning. If the meaning of a Chinese character is not understood it cannot be taken into consideration when assessing its distinctive character.

For example, if it is held that the relevant EU consumer does not understand the Chinese character for "water", it will not be understood by the relevant consumer as an indication of the type of a good and, therefore, it can be registered in class 32, to cover water.



### The evolution of Chinese, Japanese and / or Korean characters as EUTMs

However, this may change in the future, for example, if the number of Chinese speaking consumers in EU countries rises. The growing interest in having Chinese, Japanese and / or Korean characters registered as EUTMs is clear in the below graphic:



Figure 2 - Evolution of EUTM applications for Chinese, Japanese and/or Korean characters by filing date intervals.

#### Conclusion

If the number of, for example, Chinese speaking consumers rises in the EU countries there may be a point where the premise that the relevant consumer does not understand Chinese characters will no longer be true. If this happens, Chinese characters will be held by the EUIPO as word elements and its meaning will become relevant when assessing its distinctive character and conceptual and phonetic similarity with previous EUTM registrations.

If this happens, an issue will rise. What will happen to the Chinese, Japanese and / or Korean characters already registered as EUTMs? Shall those Chinese, Japanese and / or Korean characters already registered as EUTMs, which meaning will then be understood as non-distinctive and those which will become phonetically and /or conceptually similar to previous EUTMs be subject to invalidation? Generally, the answer will have to be affirmative.

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# How African companies can use the international trademark system to their advantage

João Francisco Sá



According to the UN Conference on Trade and Development (UNCTD), total trade from Africa to the rest of the world averaged roughly \$760.5 billion between 2015 and 2017. The UNCTD also indicates that the share of exports from Africa to the rest of the world ranged from 80% to 90% during the same period, making the continent the second most export-dependent region in the world.

While African jurisdictions are particularly dependent on the export of primary commodities such as ores, oil, gas and cotton, as well as food and drink products such as coffee, tea and various grains, there is a growing need to diversify the economy and add value to the chain of production.

Trademarks are an essential tool for African enterprises looking to add value to their goods and services, as they provide exclusive rights to the registered owner and foster trust between the company and its customers.

### Using the Madrid Protocol

The Madrid Protocol for the international registration of trademarks was established in 1989 and enables applicants to protect their trademarks in several countries through a single application.

The Madrid Protocol is applicable in 38 African countries, including the 17 member states of the African Intellectual Property Organisation (OAPI). However, notable exceptions include Angola, Ethiopia, Nigeria and South Africa, among others. Applicants that have a connection with a member state to the Madrid Protocol because they are domiciled there, are nationals of the country or have a local business are entitled to file an international trademark.

Having a business in a contracting state should be interpreted as having a real and effective industrial or commercial establishment there. This formulation was borrowed from the Paris Convention and while it does not limit entitlement to a company's principal place of business, it does require that some business activity takes place in the contracting state, excluding fictitious establishments.

This means that companies that have a principal place of business in non-Madrid Union countries such as Angola, Ethiopia, Nigeria or South Africa can still take advantage of the system by having a real and effective industrial or commercial establishment in a member state.

### Cost effectiveness

Trademarks are the most affordable IP rights and help to develop a company's reputation with its customers.

When it comes to international trademarks, one of the main advantages to using the Madrid Protocol is the reduced cost compared to filing trademarks in each individual trademark office.

A further 90% discount applies to applicants from the world's least developed countries, as



defined by the United Nations. This includes 33 African countries, such as Madagascar and Mozambique. Therefore, as the usual cost for a colour trademark is Sfr900, the discount reduces this to Sfr90.

While this discount is helpful, applicants should be aware that it only applies to the basic fee and not the complementary or designations fees that can still represent a larger amount of the grand total.

### Filing in other African countries

The UNCTD further highlights that regional trade can help to reduce the vulnerability of African businesses to external forces, as intra--African exports comprised 16.6% of total exports in 2017, compared with 68.1% in Europe.

Through several key regional agreements that foster trade and eliminate trade barriers, African countries have moved to ratify free trade arrangements that promote economic integration.

With the gradual increase in intra-regional trade, African companies will likely want to file cross-border trademark applications and take advantage of the existing regional agreements that facilitate registrations.

OAPI provides a registration system that protects trademarks in 17 mostly French-speaking countries in West Africa. OAPI's trademark registration system is unitary and automatically covers all of its member states. As of April 2021, these include Benin, Burkina Faso, Cameroon, the Central African Republic, Chad, Comoro Islands, Congo, Equatorial Guinea, Gabon, Guinea, Guinea-Bissau, Ivory Coast, Mali, Mauritania, Niger, Senegal and Togo.

The African Regional Intellectual Property Office (ARIPO) is another regional agreement that provides a designation-based registration system, enabling companies to file a single application and choose from 11 mostly English-speaking countries in East Africa that have ratified the Banjul Protocol.

Designations under ARIPO can include Botswana, Eswatini, Lesotho, Liberia, Malawi, Mozambique, Namibia, Sao Tome and Principe, Tanzania (excluding Zanzibar), Uganda and Zimbabwe.

Both regional agreements facilitate the management of trademark registrations, allowing centralised recordals and renewals.

### Collective and certification trademarks

Collective trademarks can be registered by associations and only used by their members. On the other hand, certification marks can be used by anyone provided that a set of rules and standards are met by the user.

African rights holders can take advantage of these two types of mark to strengthen awareness and the reputation of the qualities of their products, thereby adding value and increasing profit margins. Good examples of this include the Ethiopian coffees Harrar, Sidamo and Yirgacheffee.





## Trademarks in Africa – a bird's eye view on filing strategies

João Francisco Sá

Africa

Trademark

Africa is the continent with the largest number of countries – 54. As trademarks are usually protected at a national level, an African-wide trademark protection strategy can be taxing. However, there are some shortcuts that will help applicants to secure African-wide trademark protection.

### Madrid Protocol

The Madrid Protocol for the international registration of trademarks was established in 1989 and provides applicants with the possibility of designating several countries with a single application.

The Madrid Protocol was ratified by 22 African countries, and the geographical reach is extended to 38, due to the participation of the African Intellectual Property Organization (OAPI). Putting this into perspective, about 2/3 of the continent are covered by the Madrid Union, allowing applicants to take full advantage of the system and obtain cost-effective protection throughout the continent. There are some notable exceptions of countries that did not join the Madrid Union, such as Angola, Ethiopia, Nigeria, South Africa or Tanzania. For the most part, it is possible to circumvent the need to contact national trademark offices. However, there are some circumstances where the Madrid Protocol might not be the best option for applicants.

First, there are local challenges that make it difficult to ascertain if a trademark was indeed granted and if it is enforceable under national law. Several member-states do not issue statements of grant of protection, as a result of larger backlogs, undigitized records or delays in the administrative proceedings due to office actions or oppositions. While Article 5 of the Madrid Protocol provides that countries can only issue notifications of refusal within 12/18 months after the notification of extension, potential conflicts between national and international law arising from the above-mentioned reasons do not provide applicants with the sufficient legal certainty to ensure that their trademarks – beyond a reasonable doubt – are locally enforceable.

Second, there are several countries that did not enact domestic provisions to apply the Madrid Protocol. In countries with a Civil Law tradition (mostly Arabic, French or Portuguese speaking countries), implementing regulations is a necessity depending on the constitutional norms that directly apply international treaties or as a practical need to ensure that the administrative proceedings correctly handle international trademarks. In countries with a system of Common Law, the incorporation of international law is usually required to ensure that their provisions are legally binding in domestic law.

Third, while the regional organization OAPI fully implements the Madrid Protocol and examines international applications, there are substantiated questions about the enforceability of international trademarks that designate OAPI. OAPI's Bangui Agreement does not explicitly mention the Madrid Protocol in its procedural provisions, and it is unclear whether the regional organization has the legal powers to ratify international treaties on behalf of its member-states and not merely implementing them.

As such, applicants should be aware of these difficulties when filing international applications in Botswana, eSwatini, Gambia, Ghana,



Kenya, Lesotho, Liberia, Malawi, Namibia, OAPI and its 17 member states, São Tomé e Príncipe, Sierra Leone, Tunisia, Zambia and Zimbabwe. On the other hand, international trademark applications are advisable in Algeria, Egypt, Madagascar, Morocco, Mozambique, Rwanda, Sudan.

Finally, while the above considerations and legal uncertainties can be more theoretical than practical, they are yet to be tested before national courts of law. As IP litigation in Africa is still sporadic it can be difficult to provide much needed clarity regarding the enforceability of trademarks, especially for applicants with greater concerns in anticounterfeiting.

### ΟΑΡΙ

The African Intellectual Property Organization was establ\ished in 1977 by the Bangui Agreement and created a regional trademark system in West and Central Africa, mostly comprised by French speaking countries.

OAPI currently has 17 member-states, namely Benin, Burkina Faso, Cameroon, the Central African Republic, Chad, Comoro Islands, Congo, Equatorial Guinea, Gabon, Guinea, Guinea-Bissau, Ivory Coast, Mali, Mauritania, Niger, Senegal and Togo.

The main advantage of this regional organization is that it allows applicants to submit a single trademark application that automatically covers all its member-states. In fact, the system is unitary in the sense that trademarks are valid in all countries without the possibility of individually designating specific countries, in a similar fashion to Benelux or European Union Trademark systems.

Furthermore, the Bangui Agreement functions as a national Intellectual Property Code, especially because its member-states do not have national IP legislation. However, enforcement actions still need to be handled at a national level. It should be noted that separate applications for goods and services have to be filed. The usual timeframe for filing up to registration is 10 to 14 months, including a 6-month postgrant opposition period. Trademarks are valid for 10 years from the application date and renewable for further periods of 10 years.

#### ARIPO

The African Regional Intellectual Property Office (ARIPO) was established in 1976 by the Lusaka Agreement and further capacitated by successive Protocols, such as 1993's Banjul Protocol on Marks, mostly comprised by English speaking countries.

Of ARIPO's 19 member-states, 11 became parties to the Banjul Protocol on Marks, namely Botswana, Eswatini, Lesotho, Liberia, Malawi, Mozambique, Namibia, Sao Tome and Principe, Tanzania, Uganda and Zimbabwe. Zanzibar has a separate registration system from mainland Tanzania and is not included with ARIPO designations.

Under ARIPO's registration system, applicants are able to file a single trademark application, designating the above-mentioned countries. After a formal examination, the process is forwarded to each country's IP Office to conduct separate examinations, according to the applicable national provisions. Unlike OAPI, ARIPO applications do not automatically cover all member-states and do not have a unitary effect, so it is possible to secure registration in regard to some of the designated countries. In this sense, ARIPO's system is more similar to the international system implemented under the Madrid Protocol, but still has the advantage of allowing applicants to centralize most proceedings before ARIPO-'s bureau and not individually with each country's IP Office.

The process from application up to granting can take between 12 to 18 months, including a 3-month opposition period. Trademarks are valid for 10 years and are renewable for successive periods of 10 years.





While ARIPO is not party to the Madrid Protocol, its member-states individually joined the international system, with the exception of Tanzania and Uganda.

#### Concluding remarks

While filing international trademarks in Africa can initially sound like a daunting process considering the sheer number of jurisdictions, using the Madrid Protocol and the two regional IP organizations – OAPI and ARIPO – provides applicants with much desirable shortcuts to secure broad territorial protection.

Applicants should be aware of the advantages and shortcomings when deciding to use the Madrid Protocol, OAPI or ARIPO, so that their registered trademarks are not hollow rights and are able to be locally enforced before courts of law.

- OAPI & MADRID PROTOCOL (Both agreements are applicable)
   MADRID PROTOCOL
  - (countries that are not part of any regional organizations)
- ARIPO\* & MADRID PROTOCOL (Both agreements are applicable)
- ARIPO\* (countries that are members of ARIPO but not the Madrid Protocol)
- National trademarks only (countries that are not part of regional organizations and Madrid Protocol)

\* Only the countries included in the ARIPO Banjul Protocol on Trademarks were considered. © Ingo Menhard. Modified by Inventa | 2021



## Djibouti – a sea of opportunities

Inês Sequeira



Djibouti is one of the smallest countries in Africa. Its strength lies in its location at the southern entrance to the Red Sea and the fact that it is adjacent to some of the world's busiest shipping lanes, acting as a bridge between Africa and the Middle East.

According to the World Bank's global economic prospects report, Djibouti is expected to experience the strongest growth in the gross domestic product (GDP) in Africa this year. The country's growth remained positive at 0.5% in 2020, following the recovery of key domestic markets. What is more, the output growth in Djibouti is set to reach 5.5% in 2021 and an average of 6.1% a year in 2022 and 2023. This will put the country's shipping, logistics and telecommunication services to the test.

Djibouti's ports lead the country's economy. The system is among the most sophisticated in the world, and trade through these ports is expected to grow rapidly in parallel with the expanding economy of the country's largest neighbour and main trading partner, Ethiopia.

In October 2020, the Djibouti Sovereign Fund provided support to pool the country's wealth, invest in partnerships on international projects, boost the domestic private sector and steadily increase savings.

Meanwhile, the Vision 2035 development plan established in 2013 has led to:

 the development of a first-rate ecosystem and new railway line to Addis Ababa (October 2016);

• the commission of the Doraleh Multipurpose Port (2017-2018); the building of mineral ports in Ghoubet (June 2017) and Tadjourah (June 2017);
the creation of the Djibouti International Free Trade Zone (July 2018);

• an agreement between Air Djibouti and Ethiopian Airlines and the port of Djibouti (January 2021); and

• a \$350 million agreement with the China Merchants Group to redevelop the old Port of Djibouti (2021).

Other areas being developed include:

- the tourism sector;
- fishing, including untapped marine resources and artisanal fishing;
- an undersea telecommunications infrastructure;
- new digital and service industries; and
- geothermal, solar and eolian energy.

Investment over the past few years has made Djibouti an attractive area for commerce, which is one reason why brand owners should register their trademarks before exploring business opportunities in the country.

IP protection in Djibouti

Djibouti has been a member of the WIPO Berne and Paris Conventions since 2002 and the Agreement on Trade-Related Aspects of Intellectual Property Rights since 1995. However, as it is not a member of the Madrid System, an international application through WIPO is not possible.

With regard to trademarks, Law No 50/AN/09/6th L was enacted in 2009 and was due to come into force six months after publi-


cation in the Official Journal. The publication took place on 25 May 2011 and the law came into effect on 9 June 2012.

Before filing a trademark registration in the country, brand owners should be familiar with the following aspects of the system:

• Djibouti follows a multi-class filing system and uses the Nice Classification. Service, collective, 3D, colour and certification trademarks are registrable.

• A registered trademark may be subject to cancellation by any interested party if it has not been used for five consecutive years.

• Trademarks are valid for 10 years from the filing date and may be consecutively renewed for the same period.

• Renewal is due six months before expiry. The grace period to renew after expiration is six months.

• Registration may take two to three months.

Filings must include:

• power of attorney, simply signed;

applicant data;

 a sample of the mark (not required for word marks);

a list of goods and/or services; and

• a certified copy of the priority document (if priority is claimed).

The registration process comprises:

• filing the request before the Office of Industrial Property and Commerce (ODPIC);

• the issuance of an application filing receipt with the application filing number;

- a formal exam conducted by the ODPIC;
- the issuance of a registration certificate; and
- publication in the Official Gazette of Djibouti.

• There is no opposition system in Djibouti.

To sum up, Djibouti has entered 2021 with determination, despite the challenging international economic situation arising from the covid-19 crisis.

The country's ongoing infrastructure projects, port repair and maintenance facilities should give it a competitive advantage over neighbouring ports and reinforce its position as a regional trade and logistics hub.

As a result, the number of trademark applications relating to shipping, logistics, energy, tourism and telecommunication services is expected to rise in the coming years.

However, Djibouti's growth prospects, while favourable, depend heavily on Ethiopia's political and economic conditions, as well as foreign investment.



# Nivea wins men's shower gel packaging dispute in South Africa

Miguel Bibe



In the latest IP judgment to be handed down in South Africa, the Supreme Court of Appeal has dismissed an appeal by Koni Multinational Brands against a court decision ruling that its Connie men's shower gel products are confusingly similar to those of Nivea.

Body care product supplier Koni was established in 2012 by South African celebrities Connie Ferguson and Joseph Nchabeleng. The company supplies 12 types of Connie-branded personal care products to 900 stores around the country. Beiersdorf AG, owner of the well--known Nivea brand since 1911, brought legal proceedings against Koni in relation to its Connie men's shower gel products. In 2019 the High Court ruled in favour of Beierdorf, interdicting Koni from competing unlawfully with Nivea by passing off its Connie's men shower gel products as those of Nivea. In particular, the court found that the Connie Men Active Shower Gel was too similar to that of its competitor.

The legal matter began in 2017 when Beiersdorf wrote to Koni protesting that "it was manufacturing and offering for sale the Connie Men shower gel with a get-up confusingly similar to the respondent's products". Koni denied this statement and argued that the different names of the products were sufficient to distinguish them. Beiersdorf obtained an interdict from the High Court in Johannesburg, which held that there was a potential for confusion between the two products on the following grounds:

The shower gel is often an impulse buy, wherein the consumer is less likely to be discerning. Parts of the appearance of a product that is distinctive in relation to a particular mark or brand are sufficient to create confusio. The court ordered Koni to remove this get-up from all packaging, signage, printed material, websites and social media platforms under its control.

Koni appealed the judgment on the grounds that it was barred from lawfully competing with Beiersdorf. However, the majority of the appeal court found that the Connie Men Active Shower Gel was confusingly similar to Nivea's products and therefore maintained the decision.

The majority of the Supreme Court of Appeal held that Beiersdorf had established that its goods had acquired a particular reputation and that since 2010 its Nivea Men shower gel and body lotion range has led the market. On the other hand, the majority also found that the logo on the Connie shower gel was an appropriation of the Nivea Men wave label used on the same kinds of product and that the overall appearance and format of the Connie shower gel was confusingly similar to Nivea products. "Given the similarities between the appellant's and respondent's products, the inference is inescapable that the appellant's logo is an appropriation of the Nivea Men wave--label indicia on the same kind of product, so as to connect it to a known and established brand" the court held. It went on to state that consumers could not help but be deceived when attempting to purchase a Nivea product. This was confirmed by the majority of the judges.

However, the decision was not unanimous. One of the appeal judges did not agree with this view and believed that only a careless consumer would end up purchasing Koni shower gel rather than Nivea. Further, the judge believed that the Connie men's range was merely an extension of the already popular women's range. Nevertheless, Koni must now remove the disputed products from all stores, including signage, printed material, websites and social media platforms.



## Gambia ratifies the Banjul Protocol

Inês Tavares



Gambia in West Africa is home to the capital city in which the African Regional Intellectual Property Organisation's (ARIPO) Administrative Council first adopted the Banjul Protocol in 1993. Under ARIPO's regional system, applicants are required to designate the member states for which their trademark protection is intended. The associated costs of the procedure depend on the number of designated states in each application.

On 3 May Gambia joined the Banjul Protocol, bringing the number of member states to 12 (joining ARIPO, Botswana (joined 2003), Eswatini (1997), Lesotho (1999), Liberia (2010), Malawi (1997), Namibia (2004), Sao Tome and Principe (2016), Tanzania (1999), Uganda (2000) and Zimbabwe (1997)). The government deposited its instrument of ratification with the ARIPO director general on the same day.

In accordance with Section 11:3 of the protocol, it will enter into force three months after the deposit of the instrument of ratification, which means that from 3 August 2021 Gambia will be eligible for designation by applicants under the protocol.

The documents required for trademark registration in ARIPO include:

- power of attorney, simply signed;
- applicant data;

 sample of the mark (not required for word marks); and

• a list of goods and/or services.

Further, the registration procedure in ARIPO is as follows:

• A request is filed through the Banjul Protocol at ARIPO or at a member state's trademark office.

• A formal examination is conducted by the office where the application is lodged, and a filling date is attributed.

• The office informs the other offices of the filing.

• If applicable, national offices have 12 months to inform ARIPO that the registration will have no effect in its territory.

• ARIPO then accepts the application and publishes a notice of acceptance in the Official Journal.

• There is a three-month opposition period.

• The registration certificate is issued and published.

Trademarks in ARIPO are valid for 10 years from the filing date and may be consecutively renewed for the same period.

It can be extremely beneficial to file applications through ARIPO due the efficiency of the process and because it may result in reduced charges (when compared to filing in each national office). However, this of course depends on the specific case and all these jurisdictions have national offices where applications can be filed through the national route.



# ARIPO sets plans to further digitise processes at working group hearing

Diogo Antunes



The African Regional Intellectual Property Organisation (ARIPO) encompasses two major regional protocols: the Banjul Protocol for the protection of trademarks and the Harare Protocol for the protection of designs and patents.

Signatories to the Banjul Protocol are Botswana, Eswatini, Gambia, Ghana, Kenya, Lesotho, Liberia, Malawi, Mozambique, Namibia, Rwanda, Sao Tome and Principe, Sierra Leone, Somalia, Sudan, Tanzania, Uganda, Zambia and Zimbabwe.

Signatories to the Harare Protocol are Botswana, Eswatini, Gambia, Ghana, Kenya, Lesotho, Liberia, Malawi, Mozambique, Namibia, Tanzania, Uganda, Rwanda, Sierra Leone, Zambia and Zimbabwe.

Applications for registration before ARIPO can be made on paper, by email or via the online platform.

The online platform enables applicants to:

• pay fees;

 file applications and additional documents; and

 receive notifications from ARIPO or member states.

The platform therefore serves as an example for all countries that have not yet effectively digitised the registration process. However, several improvements still need be made, including addressing the issues of increased filings and payment receipts. Fortunately, ARIPO regularly consults its users at annual meetings to discuss various topics, including the development of its processes.

On 13 and 14 May, the organisation held the 10th session of the Working Group on the Improvement of Protocols Relating to Industrial Property. Several proposals from member states and users of the regional route were discussed, including:

 establishing deadlines for responding to notifications from ARIPO that are omitted or not directly explained by the protocols and respective regulations; and

• amending various requirements to streamline administrative procedures.

The ARIPO secretariat has also undertaken to issue payment receipts for publication and concession fees.

These changes and improvements to the online platform are now awaiting verification.

The working group session has demonstrated the willingness and enthusiasm of the working members of ARIPO to innovate and provide a better experience for their users, as well to ensure the good procedural management of applicants' intellectual assets.

Given ARIPO's success, it is unsurprising that in recent years other member states have adhered to the protocols and are predicted to follow suit.



# Cape Verde: is there a brighter picture for patent rights?

Diana Pereira



Trademarks have dominated Cape Verde's IP field at the expense of other rights such as patents and industrial designs for many years. But this scenario could be about to change, says Diana Pereira of Inventa.

As is the case in many countries, trademarks have taken the biggest IP share in Cape Verde ever since the creation of the region's IP ri ghts legislation. This has been to the detriment of other rights such as patents, utility models and industrial designs, which are all poorly represented in the jurisdiction.

According to data provided by the Cape Verdean IP office, the Institute for Quality Management and Intellectual Property (IGQPI), 4,327 trademark applications were filed between 2005 and 2020. Only 21 applications were for patents and 17 for industrial design applications, with a dearth of applications for utility models. In percentage terms, this breaks down to 99.12% for trademarks, against 0.88% for patents and industrial designs.

### Positive steps

This trend may be partially due to the registration process for trademarks, which is faster and simpler when compared to the processes required for other forms of IP, including patents. The official fees for trademark filing and registration are also substantially lower than those demanded for patent rights. The financial burden on trademark applicants tends to be lower because patented inventions require more innovation and development given their technical nature.

Motivated by the low numbers of patent filings in the country, the technical team of IGQPI

became more focused on, and specialised in, trademarks rather than inventions. Due to its lack of patenting experience, the team did not engage a methodology for the substantial examination of applications that require an analysis of patentability requirements such as novelty, inventive step and industrial application. This led to a deadlock in the registration process of these IP rights.

This lack of progress discouraged applicants, and they started to informally abandon their applications, by means of non-payment of the necessary maintenance fees.

To address the situation, the IGQPI's directive board sought guidance, training and closer collaboration with Portugal's IP office, the Portuguese Institute of Industrial Property (INPI), because Cape Verde shares many cultural and legal bonds with that country.

### Collaboration with Portugal

Cape Verde and Portugal signed a protocol, the "Memorandum of Understanding between IGPQI and INPI", on December 9, 2019, establishing a framework for technical cooperation aimed at strengthening the existing bilateral cooperation between the two IP institutions.

Under this memorandum, which is valid for four years, an action plan is established annually by the institutions.

Under these provisions, the IGQPI aims to improve the technical skills of its staff and enhance the awareness of key stakeholders on IP.

Other goals include increasing the competiti-



veness of the country's business sector; more innovation and sustainable development; the creation of an anti-counterfeiting group; and the integration of IP within the Community of Portuguese Language Countries.

As a result, Cape Verde recorded increased patenting activity, more specifically concerning the granting and refusal of rights. During the memorandum's start-up year, two patent applications were refused (due to lack of fulfilment of the patentability requirements defined in numbers 1 and 2 of article 12 of the Cape Verdean IP Code: novelty and inventive step) and one patent design was granted.

This progress highlights the knowledge gained by the Cape Verdean technical team concerning patent examinations.

#### Impact of COVID-19

Despite this initial progress, the coronavirus pandemic seems to be stalling further developments.

According to the two IP Bulletins issued by IGQPI during 2020, 179 new trademark applications were published, but there was no sign of any patent applications.

In 2019, four IP Bulletins were issued and a total of 428 trademark applications were published, against three new patent applications.

Comparing the 2020 numbers with those of previous years, it seems the COVID-19 pandemic is having an adverse effect on IP rights published in the country, with a significant drop of published applications.

The office's technical team encountered unprecedented difficulties due to the limitations of working remotely, resulting in a lowered response rate. Consequently, such limitations contributed to the delay of the administrative procedures, as illustrated by the decrease of published IP Bulletins. None has been published so far this year of 2021. Looking to the future, the collaboration between INPI and IGQPI is crucial to help fill technical gaps and to add value to the latter. If IGQPI's technical staff have access to better quality training, they will have a greater ability to respond to and deal with more forms of IP, including patents.

Cape Verde is on the way to a brighter scenario, especially when it comes to patent rights.



# Can gambling and casino trademarks be protected in Egypt?

Vera Albino



As a predominantly Muslim country, Egypt prohibits gambling in line with the Qu'ran. However, the practice is not entirely illegal and the country's trademark legislation reflects this.

The Law on the Protection of Intellectual Property Rights (82/2002) includes no interdiction on the registration of gambling and casino trademarks. However, Article 67(2) of the law prohibits the registration of trademarks that are considered contrary to public order or morality.

While land-based casinos are legal in Egypt (there are more than 20 in the country and one on a Nile River cruise), the liberality of the Egyptian government regarding casinos is limited, as the Penal Code expressly prohibits Egyptian citizens from using them, stating that they are exclusively for tourists.

Yet in contrast to the United Arab Emirate Trademarks Office, which considers casinos and related services contrary to public order and refuses to register corresponding trademarks, the Egyptian Patent Office does not appear to refer to public order or morality when examining gambling-related marks.

There are close to 100 valid national trademarks that identify gambling and casino-related goods and services in Classes 28, 41 and 43 in Egypt. In addition, more than 250 international registrations are valid in Egypt that identify the same goods and services. Of these national marks, 20% are owned by Egyptian applicants.

Although these numbers are merely indicative, they demonstrate two things. First, they

show that the Egyptian Patent Office accepts gambling and casino trademarks without any excessive restrictions. Second, they illustrate that a difference must be established between the legal ownership of a right and the illegal use of the services related to the same right as far as Egyptian citizens are concerned.

As in most countries, casinos are strictly regulated and their number is closely supervised by the government – namely, the Ministry of Tourism. This poses an additional question in terms of trademark rights. Because the number of casinos is limited, many of these marks cannot be used in Egypt and are in jeopardy of being revoked for non-use.

However, this must be mitigated by the fact that there are many online casinos in use in the country, albeit none of which are licensed by the government as online gambling is not regulated under Egyptian law.

The question then is whether such use would be accepted by the Egyptian registry.





## Latest amendments to Uganda's Trademark Regulations come into effect

Miguel Bibe



Uganda's trademark regulations have been amended, with 26 changes to provisions in the Trademark Regulations 9/2021. The most significant of these are the implementation of the registration of trademark agents and the introduction of an IP journal and fees for time extensions. The amendments were published in the Uganda Gazette on 5 February 2021 and are now in effect for trademark applications and requests filed on or after this date. The amendments aim to tackle several existing loopholes in the practical enforcement of the Trademarks Act 17/2010 and to aid the country in moving closer towards international trademark standards.

#### **Register of agents**

The rules relating to registering a 'trademark agent' – defined as "an advocate of the High Court registered by the Registrar as required by regulation 11" – have been altered. Those who qualify as an agent may apply for registration and once all requirements have been met, the registrar will enter the individual's name in the agent's register. Although only individuals can register as agents, a firm's address may be entered. The registrar will then publish the list of trademark agents on its website, which will be regulated and renewed each year. This is a significant move towards discouraging fraudulent trademark agents.

#### Classification of marks, goods and services

Under the previous regulations, for the purposes of trademark registration, goods and services were classified in accordance with the ninth edition of the International Classification of Goods and Services (Nice Agreement), which was published in 2007. The new amendments now refer to the current edition of the International Classification of Goods and Services and clarify that the most recent, 11th edition should be used. The amendments also state that marks should be classified in terms of the current edition of the International Classification of Figurative Elements of Marks under the Vienna Agreement – the regulations previously omitted this type of classification. In this regard, the amendments follow international standards and provide for the application of any future amendments to the International Classification of Goods and Services or changes to the International Classification of Figurative Elements of Marks.

#### Publication of applications and notices

While the regulations expressly mention publication in the Uganda Gazette, the publication of a trademark application will no longer be confined to this publication. Publication may now take place in the Uganda Gazette "or other media as the Registrar may direct". The authorities have already announced that the Uganda Registration Service Bureau (URSB) IP Journal is considered to fall under 'other media'. As such, the URSB can now publish trademark applications and other related matters. These will be published in electronic format on a weekly basis. The first edition of the URSB IP Journal was published on 14 May 2021.

[...]



# Examining the official and unofficial translation rules for trademarks in Cape Verde

Diana Pereira



Trademarks are the main form of IP right in Cape Verde. To date, 4,355 trademark applications have been advertised in the IP Bulletin.

Applicants with the highest number of trademark applications in the country originate from:

- Cape Verde (676 applications);
- Portugal (402);
- The United States (384);
- Switzerland (233);
- Japan (170);
- Spain (165);
- Germany (128);
- France (121);
- The United Kingdom (115); and
- China (108).

Although Cape Verde nationals have the highest filing numbers, the top trademark owners are Phillip Morris (Switzerland), Toyota Jidosha Kabushiki Kaisha (Japan) and Hyundai Motor Company (South Korea).

In contrast to rights holders from Cape Verde and Portugal, applicants from the other countries listed are most likely to file applications in languages other than Portuguese. This raises the issue of translation and semantics when filing trademark applications. While Portuguese is the official language of Cape Verde, Cape Verdean Creole is spoken by much of the population. As such, both are considered by the Cape Verde Patent and Trademark Office (PTO) when analysing translations of words used in trademarks.

Under Article 152(4) of the IP Law, if a trademark contains sayings in lesser-known characters, these shall be transliterated and translated and inserted in the filing form, close to its representation when filing an application. Failure to do so will mean that applicants risk non-compliance with the formal requirements and a request by the PTO to provide technicians with the necessary information to examine the applications formally and substantially.

By using the terms 'characters' and 'transliterate', the scope of languages to be considered corresponds to written systems other than the Latin, for instance, Japanese (mixed scripts of Kanji and Kana) and Chinese (Chinese characters), if relying on the list of countries above.

With regard to the type of trademark, applications with sayings in lesser-known characters, notwithstanding those consisting of words, are filed as device marks, which means that the characters are deemed as images or logos.

Providing a translation of a trademark into Portuguese is crucial, as it allows the PTO to verify whether the mark lacks distinctiveness and whether it contains expressions that are contrary to morals or customs, offensive to national or community law or public order, in which case it will be refused.

Considering the linguistic elements of the jurisdiction, before filing a trademark application it is advisable to get to know some cultural and linguistic features and attest whether the translation of the trademark's sayings into Portuguese or to Creole would have any negative impact.

Being aware of these variants in an early stage allow applicants to adjust their filing strategy and to make the necessary alterations to have a smooth process until registration.



## The end of 'Moroccan Habanos'

Miguel Bibe



In June 2021, the Casablanca Commercial Court invalidated the Moroccan businessman Mohamed Zehraoui's claim to use the word "Habanos", which belongs to the Cuban Habanos Corporation, on cigars manufactured in Morocco.

It all started in 2011 when the entrepreneur registered the company name Habanos SA in the Casablanca Commercial Register, taking advantage of the fact that the Cuban corporation of the same name had not registered the brand in Morocco.

For years that was nothing more than a name in a register, until 2019 when Zehraoui started to manufacture his own cigars locally and offer them to luxury shops. The cigars were called Premium, Roberto, Corona, or Romeo (an obvious reference to the Cuban Romeo y Julieta cigars), among other names.

Cuban Habanos Corporation has extensive experience in protecting its most emblematic trademarks, such as 'Cohíba', 'Montecristo' or 'Guantanamera'.

Here it was faced with a Moroccan company starting to produce tobacco under its own name, with the aim of taking away a part of the international market.

During this period, Zehraoui insisted on his rights to use the name Habanos SA, which appears on the logo of all the boxes and labels of cigars sold by his company. Moreover, he went on the offensive, filing an action against La Casa del Habano, a franchise of the Cuban corporation, for having opened a shop in Casablanca and "usurping" the name he had registered.



#### A long battle

Initially, the Moroccan courts ruled in his favour and took action against La Casa del Habano. But the Moroccan Tobacco Society (SMT), with the discreet support of the Corporation Habanos de Cuba, fearful that other entities would follow Zehraoui's example, started a patient legal battle which was successful in the end.

Zehraoui also invoked the dispute over sovereignty of the Western Sahara province, claiming that the Cuban government has provided financial backing to the Polisario Front, a rebel national liberation movement by the Sahrawi people claiming Western Sahara. He once told EFE Agency: "If one day they break with the Polisario, then I will take the name off my company and call it simply HaHa."

For decades Cuba has been the main supporter throughout the Americas of the Saharawi movement which seeks recognition of Western Sahara. Moreover, during the period of this legal conflict, Cuba opened an embassy in Rabat, and it seems that the political relationship between the two countries has become less strained. Apparently, the Moroccan government has not been involved in this trademark dispute and has chosen to let the competent courts decide.

[...]



# Yoruba trademark case sparks Nigerian cultural appropriation debate

Inês Sequeira



When CultureTree's tweet and hashtag #Yorubaisnotforsale went viral, it ignited an online debate about whether registering a trademark name for an ethnic group is cultural appropriation.

The Yoruba people – who live mainly in Benin, Nigeria and Togo – represent around 35 million people in Africa, making them one of the largest ethnic groups on the continent. Most are from Nigeria, where they represent up to 15.5% of the country's population.

The author of CultureTree's polemic tweet was Gbemisola Isimi. Isimi was born in Nigeria, but moved to the United Kingdom at the age of 11. She was raised by her grandmother and speaks Yoruba fluently. However, when Isimi's first child was born, she could not find anywhere to teach them Yoruba. Moved by a sense of identity and cultural pride, Isimi founded CultureTree, a Yoruba language academy for the children of diaspora Nigerian citizens. The project began to grow through partnerships with the Mayor of London, Westminster City Council and the British Library. CultureTree went on to produce children's content for the BBC, Vox Africa and YANGA TV.

One programme, Yoruba Stars, has been particularly successful. As such, Isimi decided to apply for the trademark YORUBA STARS at the UK Intellectual Property Office (UKIPO). After a few months, she was informed by the UKIPO that the word 'Yoruba' had been owned since 2015 by UK retail clothing firm Timbuktu Global, which had opposed her application. "I thought it was really strange that a company would be allowed to trademark the word 'Yoruba', a tribe and language of millions of people" Isimi wrote, after Timbuktu opposed her attempt to register the phrase YORUBA STARS. "I feel this is the height of cultural appropriation" she stated, adding to CNN: "I don't think anybody should own 'YORUBA'." Isimi took to social media to raise her concerns, tweeting: "Let's all call out @timbuktuglobal on this daylight robbery! Today it's Yoruba, tomorrow it could be Igbo, Swahili or even the word AFRICA! I intend to fight this with everything in me!"

The flood of negative publicity forced Timbuktu Global to close its Twitter and Instagram accounts and to shut down its website. The UK clothing retailer then offered to sell the trademark to CultureTree, but Isimi refused. Timbuktu later withdrew the opposition to YORUBA STARS and informed Isimi that it had filed an application to surrender YORUBA. A representative of Timbuktu Global told the BBC that the matter was concluded. Isimi may have won this battle, but this is not the first time that IP laws have allowed western individuals or companies to claim words or symbols with an African country's cultural, linguistic and even culinary heritage.

This can lead to difficult questions about the effectiveness and the fairness of western IP regimes. For Isimi, the case highlights a much bigger problem. "Why should we have to spend our time and resources rectifying something that should never have happened?" she asks. Instead, trademark laws should be reviewed to prevent similar situations in the future." It means cultural, spiritual and socio-cultural infringement. It is also demeaning and insulting to the entire 60 million people that make up the Yoruba race today. The name should not have been considered for a trademark by the company in the first place, the word Yoruba should not be the property of anybody" says Nigerian culture activist Oludamola Adebowale.

[...]



## Why Rwanda is the next big opportunity for IP investors

Inês Tavares



Rwanda is a landlocked country, located south of the Equator in east-central Africa, bordering Tanzania, the Democratic Republic of Congo, Burundi and Uganda. Its capital, located in the centre of the country, is Kigali and the local currency is the Rwandan Franc, issued by the National Bank of Rwanda.

The last two decades have been ones of reconstruction and reconciliation, following the troubled 90s that left the country scarred by civil war and the 1994 genocide, in which more than 800,000 civilians were tragically killed. Almost 30 years later, Rwanda still struggles to heal and rebuild, however, it is showing signs of steady recovery.

Even after the turn of the millennium, the country had insufficient access to energy, particularly in rural areas, and to this day still requires significant investment in its infrastructure if it is to achieve socioeconomic development.

Nevertheless, the nation has made major progress in the last 20 years and was, in 2019, on the verge of an economic boom, when it was hit by the coronavirus pandemic, which shifted Rwanda's debt sustainability from low to moderate.

Earlier this year it was reported that a \$1.2 billion investment would be made in energy production projects, setting the target date of 2024 to reach 100% access to energy. Power projects are mainly hydroelectric, taking advantage of the country's favourable conditions for sustainable energy production.

This will be crucial to Rwanda's socioeconomic development, especially given the expected

population growth of 25% over the next decade, totalling a population of over 16 million. Of course, with such predictions, Rwanda becomes more and more interesting to foreign investors and importers, and, with that, proper protection of the intellectual property is climbing up the agenda.

#### Current trademark system in Rwanda

Trademark applications are reasonably simple in this jurisdiction. Rwanda has been a member of the Paris Convention since 1984 and of the World Trade Organisation's Agreement on Trade-Related Aspects of Intellectual Property since 1996. It has also been a member of the Madrid Protocol on Trademarks since March 2013.

Protection is possible either through national registration in the local trademark office or international registration via WIPO or through the Madrid Protocol.

Types of trademarks in Rwanda include goods and services as well as collective and certification trademarks. It is also possible to claim priority in this jurisdiction. The Nice Classification applies and Rwanda is a multi-class jurisdiction.

The protection of well known trademarks is also possible. Trademark search before filing is not mandatory although it is highly recommended. The official search will take 10 to 12 days to be concluded.

[...]





## IP considerations when investing in Egypt

Inês Sequeira



With a population growth rate of 2.25%, Egypt has the second biggest population in Africa, as well as the third-largest economy. The Egyptian government is promoting investment in all economic sectors and is already a continental leader in some.

For instance, Egypt is the largest construction market in Africa, with more than \$350 billion of active projects. Just under half (48%) of active projects are represented by the real estate sector. The energy and transport sectors take up second and third places with 18% and 17%, respectively, of active projects.

The five top projects in Egypt are described below:

1. Egypt is racing to build an impressive new capital city in the desert east of Cairo. This \$58 billion project will promote residential, commercial, government, universities, entertainment, leisure and transport sectors and is set for completion by 2023.

2. Located in front of the New Administrative Capital, the Nour City project aims to meet the requirements of population and urban growth in the East Cairo axis, currently home to about 4.5 million people. Its population is expected to reach 10 million people by 2030. Talaat Mostafa Holding has revealed plans for a new city east of Cairo with an investment cost of \$31.8 billion.

3. The Egyptian Ministry of Electricity and Renewable Energy will develop the new El Dabaa Nuclear Power Plant. The Egypt Ministry of Transportation, meanwhile, is set to build the country's first high-speed train line (the Ain Sokhna El Alamein Railway) that will connect the Red Sea to the Mediterranean. The entire route will run for 1,000km, and the first 460km-long section will link up El Alamein on Egypt's Mediterranean coast and Ain Sokhna.

4. Egyptian Petrochemicals Holding Company is also developing a 2.2 million tonnes per annum petrochemical facility and a 650,000--tonne petroleum refinery in Ain Sokhna.

5. Major international companies will be the main contractors for the above-mentioned projects, such as Systra (France); China Civil Engineering Construction Corporation (China); Rosatom (Russia); Siemens (Germany); Bechtel (United Arab Emirates); DFC and the US EXIM Bank (United Arab Emirates).

#### Trademarks on the rise

In 2019, international applications in Africa increased 24%, with Egypt ranking in the third position, showing dominance in North Africa. Egypt's Central Agency for Public Mobilisation and Statistics (CAPMAS) has revealed that the number of applications submitted to the Egyptian Trademark Office reached 18,735 in 2020, compared to 17,760 applications in 2019, an increase of 5.5%.

Along with the above-mentioned projects and new business opportunities, it is expected that the increase of trademark applications in Egypt will be even more notable.

This increase in the number of international trademark applications originating from Africa appears to suggest that more companies are protecting their businesses abroad.

The legal basis is the Intellectual Property Rights Law No. 82 of July 2 2002, in force since



June 2003, which replaces the Trademark Law of 1939.

Egypt is a member of the Madrid Agreement concerning the International Registration of Marks (Act of Stockholm of 1967) and a member of the Madrid Protocol.

The process from application to registration might take between 18 to 32 months to be completed at the Egyptian trademarks office, the Internal Trade Development Authority (ITDA). This process requires a legalised power of attorney up to an Egyptian consul and, for companies, a certificate of incorporation legalised up to an Egyptian consul, with verified Arabic translation.

#### Steps for registration include:

• Filing of the request before the ITDA; Formal and substantial examination conducted by the ITDA and issuance of acceptance letter;

• Payment of publication of the application in the IP Bulletin;

• Two-month period for the filing of oppositions by third parties who considered themselves to be adversely affected with the registration of the trademark; and

• Payment of the registration fees and issuance of the registration certificate.





# Read all about it: the advantages of cautionary notices

Vera Albino



Located in the Horn of Africa with a total area of 1,100,000 square kilometres and approximately 118 million inhabitants, Ethiopia shares borders with Eritrea, Djibouti, Somalia, Somaliland, Kenya, South Sudan and Sudan.

The history of the country dates back 2,000 years. From 1973 to around 2000, Ethiopia was plagued by drought, famine, infectious diseases, internal conflict, war and an unstable economy.

But in 2015, it was welcomed as a miracle of African economy. Moving gradually from a state-run economy to a market economy since 1991, Ethiopia is now stepping up its efforts to attract foreign investors. For instance, the country became an observer of the World Trade Organization (WTO) in 1997 and applied for membership in 2003. Its GDP grew 8.4% in 2019 and 6.1% in 2020.

Despite these positive outcomes, the country is currently facing important challenges. In accordance with the International Monetary Fund, gross domestic product (GDP) growth is expected to be 2% in 2021, largely due to the COVID-19 pandemic. It is expected to reach 8.7% in 2022, subject to the post-pandemic global economic recovery and the resolution of the nine-month war in the northern Tigray region. Additionally, the accession process to WTO has not yet been completed, being the IP regime a major area of scrutiny by WTO members.

### A new phase

Ethiopia had no IP legislation until 2006, yet IP holders could obtain some protection of their IP rights, even if it was somewhat limited, by way of publishing cautionary notices in local newspapers. These notices were then taken to the Ethiopian Intellectual Property Office (EIPO), which issued a deposit certificate with a six-year term of validity and periodic republication requirements.

In this sense, Ethiopia was not a cautionary notice jurisdiction stricto sensu. Indeed, even though the deposit certificate did not confer a legal right to its holder, in the event of a dispute involving a trademark infringement before the courts, the trademark holder could use unfair competition provisions presented in commercial, civil, and penal codes and the certificate as evidence proving the holder was the first to use the trademark in Ethiopia. Nevertheless, this practice was problematic since the enforcement of IP rights was time--consuming and expensive.

In 2006, the Ethiopian government passed the TradeMark Registration and Protection Proclamation 501/2006, which entered into force in early 2013. Since this date, trademark applications can be filed at the EIPO and the IP legislation makes provision for examination on formal, relative and substantive grounds, advertisement of acceptance and the issuance of registration certificates with a seven-year validity term.

The IP legislation marked an important new phase in Ethiopia's development.

[...]



## Understanding the opposition process in Sao Tome and Principe's IP legislation

Diogo Antunes



Changes in São Tomé and Príncipe's trademark regime – including a detailed opposition process - came into force in 2017. Below are the key points of the system, including all the major deadlines.

#### Refusal grounds

A trademark may be refused in opposition proceedings on the following grounds:

• The reproduction or imitation of a corporate name, establishment insignia or other distinctive signs, or merely characteristics that do not belong to the applicant or that they are not authorised to use, or if they are likely to mislead or confuse the consumer;

• An infringement of copyright;

• Use of references to a specific rural or urban real estate property that does not belong to the applicant;

• If an agent or representative of an owner of a trademark registered in a foreign country but not registered in São Tomé and Príncipe requests the registration of that trademark in their own name, without authorisation from said owner.

In the case of the final point, the National Service of Industrial Property (SENAPI), may grant the trademark in favour of its legitimate owner.

#### **Opposition deadlines**

The opposition period starts from the date of publication of the trademark application in the Intellectual Property Bulletin. The deadline for any third party to object is three months.

#### Deadlines for replying to opposition

The trademark applicant may respond to the opposition's pleadings within three months from the respective notification.

#### Supplementary statements

The legislation also allows that, up to the decision date, supervening pleadings can be presented that clarify the process. This procedure has no special requirements.

#### Deadline extensions

Both opposition and response deadlines can be extended once for another month.

#### Suspension of examination

The opposition process may be suspended under two circumstances:

 by agreement of the parties for a period not exceeding six months; and

• where one of the parties presents a cause that could affect the decision of the opposition process (eg, pending legal action that could affect the legitimacy of the opposition process).

#### Late filing of documents

The late filing of documents is allowed, if authorised by the SENAPI.

#### Inspections

Rules relating to inspections refer to all industrial rights. In this sense, as part of an opposition process, the Patent and Trademark Office may visit a commercial establishment to carry out inspections.

#### Administrative appeals and amendments

A decision issued by the PTO may be challenged within three months. The appeal must contain information on the facts that contradict that specific decision. The appeal will then be decided by a hierarchical superior.



## Cape Verde: a pocket guide to trademark renewals

Diana Pereira



Sharing its place with other phases which make up part of a trademark's life cycle, such as the early stages of branding and filing strategy until the phase of defence of the right, maintenance is important to IP holders, expressly for peculiar systems such as the Cape Verdean one.

The year 2021 marks an important phase in trademark maintenance in Cape Verde, as it establishes the commencement of the payment of renewals in the island country.

The Cape Verdean industrial property system is still newish—the first granted trademarks started only ten years ago, a time distinguished by an effort on substantial examination of pending applications by the trademark office, the IGPQI.

Relying on fundamental features of trademark maintenance in the country, the deadlines are calculated from a trademark's registration date, and involve an intermediary maintenance act—a declaration of intent to use (DIU), and a major maintenance act—the renewal, that is to be filed to keep registrations in force.

As for the statutory non-use period, this also runs from the date of registration and a trademark's lapsed state shall be declared in case this has not been an object of serious use for five consecutive years.

Briefly put, a DIU is to be filed in respect to trademarks every five years, calculated from the date of registration, with a one-year time window, that starts six months before the fifth anniversary of the trademark and ending six months after the registration's fifth anniversary. The DIU is, however, waived in the year of the trademark's renewal. Trademarks must be renewed every ten years, counting from the registration date, which matches the reference date of the DIU.

Per article 165 of Law Decree number 4/2007 of August 20, 2007, if the DIU is not filed, trademarks are unenforceable against third parties and are open to cancellation, which can happen following a request from a third party or if there is a conflict with third party rights.

In the event applicants fail to file the DIU, the trademarks will be deemed fully valid once again if evidence of use in Cape Verde is filed.

#### Trademark use

Regarding a trademark's use, Cape Verde operates a hybrid system that allows the possibility of filing cancellations either for non-use or for non-submission of a DIU.

In the first scenario, the right holder has the opportunity to prove serious use and to keep its trademark in force (per article 178, a trademark's caducity shall be declared in case this has not been object of serious use for five consecutive years, counting from the registration date).

[...]



# Initial guide for registering trademarks internationally

João Francisco Sá

#### Worldwide

At first glance, registering a trademark internationally may appear a simple task for companies seeking to protect their mark in various countries. However, entrepreneurs should have some prior knowledge and take care in defining the strategy for internationalizing their trademark registrations.

#### International Trademark – Madrid Protocol

The simplest way of filing an international application is by submitting an international application under the aegis of the Madrid Protocol, managed by the World Intellectual Property Organization. This international registration system covers 124 countries (August 2021) and has the advantage of being able to encompass all these countries with just one application, whereby reducing bureaucracy and costs typically associated to a process of internationalization. Once 10 years of validity of the mark have expired, the renewal is also handled in a centralized manner.

To file an international trademark application, there must be a base mark in the country of origin of the mark applicant and this country must be signatory to the Madrid Protocol. The form is to be delivered to the National Institute of Industrial Property of the applicant's country of origin. For example, a Mozambican applicant should file the application before the Mozambican Industrial Property Institute (IPI); a Portuguese applicant could file the application before the INPI – Portuguese National Institute of ndustrial Property or before the EUIPO – European Union Intellectual Property Institute, provided that the base trademark is Portuguese or from the European Union.

An applicant from a country that is not signatory to the Madrid Protocol (Angola, for example) may nevertheless resort to the international trademark if said applicant is a resident of a signatory country of the Madrid System or, in the case of a country, if it has an establishment in a country of the Madrid System.

However, businessmen should bear in mind that the international mark is, deep down, a bundle of national registrations, since the examination criteria as defined by the Law of the designated countries are always applied. So, an international mark that designates Canada, China and the USA, may be proved only in Canada and in China and rejected in the USA.

According to data from the USPTO – United States Patent and Trademark Office (Q3 2021), 97.3% of the marks received by the USPTO through the international trademark pathway are the target of at least one provisional refusal, oftentimes for formal questions related to the classification of the products/services. The response to these notices increases the cost of the protection process since it is necessary to have the contribution of a representative authorized by the USPTO.

#### **Regional Trademarks**

One way of simplifying the process of internationalizing a mark is through the resource of regional registrations, that is, a trademark application filed before these regional organizations covers various countries at once. In contrast, the number of trademarks that can potentially come into conflict may raise increased difficulties during the process of examination and mark opposition.

The following regional systems are highlighted:

• EU - European Union (27 countries);



• Benelux (3 countries);

• African Intellectual Property Organization -OAPI (17 countries from West and Central Africa);

• African Regional Intellectual Property Organization - ARIPO (11 countries from East Africa).

#### National Trademarks

Moreover, if a country is not a signatory to the Madrid Protocol or any other regional agreement to register trademarks, then the only possibility will be to register directly before the National Institute where protection is sought. Therefore, in various countries of Latin America or Africa, it will be necessary to file a "national registration", like, for example, Argentina, Angola or Costa Rica, among many others.

Further, depending on the specific circumstances of the mark to be protected, such as, the existence of prior marks in conflict or the need for greater personalization of applications not permitted via the international pathway, it may even be useful to resort directly to the national registries. National registrations are typically more expensive, as it is necessary to resort to representatives authorized by the local agencies or because it may be necessary to legalize documents to submit the mark application.

#### **Cautionary notices**

There are still some countries that have not approved industrial property laws or created national agencies that govern trademark registration.

This group of countries includes East Timor, the Maldives and certain Pacific island territories. To overcome this situation, it is advisable to publish a cautionary notice in a mainstream national newspaper, informing the public of the ownership of the mark and of the consequences arising from unlawful use of the mark. It is also possible that the publications will be used as a way of guaranteeing priority access to the registration system as soon as an Industrial Property Institute is established, as recently occurred in Myanmar.

#### Maintenance, renewals and vigilance

Certain countries require the presentation of intermediary acts to maintain the trademark, normally 5 years after the initial registration. Countries like Cape Verde or Mozambique require the presentation of declarations of intent to use, which despite being a mere formality, may jeopardize the validity of the mark if the act is not complied with. The USA requires the presentation of proof of use for the mark to be kept valid.

After 10 years of validity, it is important to recall that the mark should be renewed so that it remains valid for 10 more years. If internationalization is not carried out through Official Industrial Property Agents, with automated systems, control mechanisms should be created so that the legal deadlines are not overlooked.

Consideration should also be given regarding the hiring of mark surveillance services, which evaluate publications of similar trademarks in official gazettes of countries where the mark has been protected. This is especially important in countries where the National Institutes do not perform a search for prior marks and leave this task up to the mark owners.



# Understanding the singular regulations of opposition proceedings in Cape Verde

João Francisco Sá



As the first national trademarks granted in Cape Verde celebrate 10 years of being in force, the country is in the early stages of strengthening its national system of IP protection.

While Cape Verde does not yet belong to any major IP treaty enabling the registration of IP rights, trademarks filed directly with Cape Verde's IP Office (IGQPI) have provided local and foreign applicants with legal protection.

With increasing numbers of registrations, it is expected that conflicts between new applicants and prior registrants will gradually become more frequent. It is therefore useful to understand the proceedings necessary to file an opposition in Cape Verde.

#### General information on oppositions

Trademarks in Cape Verde are advertised in the Intellectual Property Bulletin, which is usually published three times a year.

The deadline to file oppositions is two months from said publication. If an opposition is filed, the counterstatement can be filed up to two months after notification. Both deadlines can be extended by one month if a request is filed before IGQPI. A further extension can be granted when there are 'justifiable reasons'.

While the decision is pending, both parties can submit additional statements that help to clarify the case. If both parties agree, the review of the opposition can be suspended by up to four months. The review can also be suspended if there are preliminary rulings that need to be addressed first. The opposition statement or further statements should be filed in duplicate. It is possible to file documentation that supports the claims made with the statements. This documentation can be filed late but will be rejected if it proves unnecessary or merely repeats claims that have already been made.

Oppositions or counterstatements filed after the deadline is passed can still be considered if a special authorisation is granted. The criteria for this authorisation are not specified and therefore it should not be relied upon.

### Grounds for opposition

There are several grounds on which opposition can be based, which can be raised during proceedings:

- lack of distinctiveness;
- the application was filed by an unauthorised representative;

 unauthorised use of names, portraits, copyrighted works, other IP rights or company names;

 likelihood of confusion with prior marks filed for related goods/services;

 infringement of well-known or renowned marks; and

unfair competition.

[...]



# The far-reaching influence of African artists in the world of corporate branding strategies

Vera Albino



Collaborations between brands and artists are common in the fashion industry and other sectors where aesthetics play an important role. Examples of this include the 13-year partnership between Louis Vuitton and Takashi Murakami, which is considered the brand's most successful collaboration with an artist, or the BMW Art Car project, which started in 1975 and has involved Andy Warhol among other artists.

In recent years such partnerships have proliferated around the world. And while previously they were reserved almost exclusively for well-known brands and renowned artists, collaborations between emerging artists and independent brands, which have become more and more inventive in their marketing strategies, are now increasingly common.

African art is now playing a major role in this branding technique and is inspiring both artists and brands across the globe – for example, the new Havaianas Axé Boca da Mata designed by the Brazilian artist Isaac Silva, were inspired by Mozambican graphics. More and more, international brands are setting their sights on African artists. The partnerships between the South African illustrator and street artist Karabo Poppy and African and non-African brands including Nike, Nescafé, Google, Netflix, Wikipedia, Russell Hobbs and Soweto Gold, among many others, clearly shows the special place that African art occupies in the world of branding. As Karabo Poppy once said to CNN: "There's a certain way in which we tell stories that I think the world not only will enjoy, but I think the world needs."

In truth these partnerships have enormous value for art, for the artists and for the brands.

For the art, these collaborations bring attention to more niche forms of art (eg, street art), as well as to talented artists who would otherwise go unrecognised. For this reason, brands and trademark owners play an important role in the art world, especially in its promotion.

For artists, the right partnership can propel them to international recognition, transforming them into influential public figures – in the case of Karabo Poppy, not only is she promoting South-African art at the international level, but she is helping to spread an African aesthetic worldwide, inspiring African and non-African women alike.

For brands and trademark owners, the advantages are also numerous. First, by co-creating with artists, trademarks owners make their products more compelling to consumers, increasing their likelihood of commercial success. For example, the Nike Air Force 1 designed by Karabo Poppy, have proved extremely popular among basketball players and sold out in a matter of days. Second, such partnerships give companies access to new audiences, as well as the opportunity to differentiate themselves in the market. Third, they allow brands that are more aware of their social responsibility to position themselves more meaningfully. Fourth, as several studies have shown, the presence of art has a clear positive influence on a brand's image, which, in the end, will add value and increase goodwill.

Trademarks owners are increasingly considering art as a valuable tool in their brand management strategy and nowadays brands and artists, and especially African artists, are working more closely together than ever before.



## Demystifying the types of permissible trademarks in the emerging IP stronghold of Cape Verde

Diana Pereira



As per Article 139 of Cape Verde's Trademark Law, a trademark may consist of a "sign or an arrangement of signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, sounds, the shape of goods or of their packaging, as long as they are capable of distinguishing the products or services of one company from those of other companies".

Marks may also consist of "advertising phrases for the products or services to which they refer, provided that they are distinctive, regardless of the protection granted to it by the copyright law".

Nonetheless, the diversity of elements protected in Cape Verde are similar to those observed in most trademark offices and may be grouped into three major categories.

Word trademarks – composed exclusively of words, combined letters and numbers. Letter style is not protected, only the verbal elements within the trademark.

As such, word marks provide their owners with a wide scope of protection, as the trademark may be represented in any visual style.

"Non - traditional trademarks still play a backstage role in Cape Verde, which may be partly a result of lack of awareness." • Word and device trademarks – these combine visual elements such as symbols, or images with text. In other words, it is the combination of a word trademark and a device trademark and often corresponds to the style of text.

For example, trademark number 4283/2020 - Classes 29 and 30.



Device trademarks - composed of a drawing, image, ideogram and figurative form of text, these can also be formed by numbers or words written in non-Latin characters, for instance Chinese, Arabic or Japanese.



For example, trademark number 4289/2020 - Classes 29 and 30.

Out of 4,417 published trademarks in Cape Verde, 2,038 are word trademarks, 2,106 are word and device trademarks, and 271 are device trademarks.

As well as these three categories, protection is also available for non-traditional trademarks, which allow companies to obtain trademark rights in 3D shapes, colours, scents, sounds, flavours, textures and other non-



-traditional marks that identify and distinguish the source of goods and or services. Not only do distinctive non-traditional trademarks provide source-identifying information but they may also convey special expression and creativity.

### Non-traditional trademarks – Cape Verde's reality

#### • Colour

A single colour does not qualify for protection as a trademark. However, colour combinations or colours combined with graphics, words or other elements in a distinctive or peculiar manner qualify a mark for protection (Article 140).

#### • Sound

Sounds may be protected as trademarks if they are capable of distinguishing a company's products or services from those of others.

Applications of sound trademarks must be accompanied by the graphic representation and the "musical phrases of the sounds that enter into the composition of the trademark" (Article 152).

#### • 3D marks

Product configurations may be protected as a trademark if they are capable of distinguishing a company's products or services, and under the condition that such configurations are not exclusively constituted by the shape that results from the nature of the product, which is necessary to obtain a technical result or which gives substantial value to the product.

Applications for 3D trademarks must be accompanied by their graphic representation (Article 152).

#### • Touch, scent and flavour

Notwithstanding the breadth of Article 139, which refers to the trademark's constitution, there is no provision of registrability of product texture. By using the linguistic element "particularly words, including personal names, designs, letters, numerals, sounds, the shape of goods or of their packaging", Article 139 narrows the scope of possibilities and discards touch trademarks.

The same terms apply to scents and flavours (notwithstanding Article 139).

Although IP law provides for the possibility of protection of some non-traditional trademarks, relying on the public information provided in the Cape Verdean IP Bulletin, such applications are rare.

Non-traditional trademarks still play a backstage role in Cape Verde, which may be partly a result of lack of awareness.

In addition, the law is limiting – instead of giving more freedom to IP holders to use non--traditional trademarks that are capable of distinguishing goods and services it merely lists the permissible types of trademarks.

Cape Verde does not have an established convention for non-traditional trademarks; more awareness of their existence and an IP law more focused on this problem may change this in due time.





### How not to register your sound mark

Júlia Alves Coutinho

### Еигора

This is a new case of applying to register a sound mark which gained notoriety in the news media and, once again, was rejected owing to the absence of a distinctive character – sound marks are eligible for registration, though not all.

Albeit under different arguments, the General Court of the European Union confirmed the decision by the European Union Intellectual Property Office (EUIPO), which rejected the application by the company Ardagh Metal Beverage Holdings GmbH & Co. KG.

This is not the first time that a beverage industry giant has filed an application to register a trademark based on the sound of opening a can of drink. In 2014, the company Anheuser-Busch InBev S.A., owner of the Budweiser mark, filed an application to register the sound mark in this sense, which was rejected by the United States Patent and Trademark Office (USPTO), on the grounds that practically all bottles and cans of beer emit the same sound when opened, regardless of the supplier.

Therefore, the trademark applicant cannot claim exclusive use of a sound that is generic and that, accordingly, does not satisfy the essential role of the trademark which is to differentiate the origin of a good or a service.

In the case under examination, the German company Ardagh Metal Beverage Holdings GmbH & Co. KG filed an application to register a trademark that recalls the sound produced when a can of beverage is opened, followed by a moment of silence lasting about one second and fizzing lasting about nine seconds. The application was filed in June of 2018 and was intended to identify different beverages, as well as metal recipients for transport and storage. Right and wrong arguments by the European Union Intellectual Property Office and the confirmation of the decision by the General Court of the European Union

Upon examining the absolute and relative reasons for rejecting the trademark, the EUIPO rejected European Union trademark application no. 017912475 on grounds of absence of distinctive character, the applicant having replied to the notice sent by the Office, which subsequently upheld its arguments and definitively rejected registration of the sound mark for all the goods. Among the arguments mentioned by the European Union Office was the fact that the sound in question is not sufficiently different from the sounds caused by the opening of a can or bottle coming from any business origin.

Being dissatisfied with the decision by the EUIPO, the German company filed an appeal before the Boards of Appeal of the EUIPO, arguing that the trademark in question had the surprise element of the time interval between the sound of opening the can and the sound of beverage fizzing, that the combination of these elements made the trademark distinctive and different from the usual sound

" (...) register a trademark that recalls the sound produced when a can of beverage is opened, followed by a moment of silence lasting about one second and fizzing lasting about nine seconds. "





of opening sparkling drinks, that the trademark in question also applied to goods that did not contain carbon gas in their composition and that the degree of attention of consumers of these goods was high.

On the decision on appeal R 530/2019-2, the Boards of Appeal upheld the decision as delivered and underscored that a distinctive trademark should first be evaluated in relation to the goods and/or services it is designed to identify and, secondly, in relation to the perception of the sign by the target public as indicative of commercial origin. Additionally, it found that the criteria of distinctiveness of a trademark should be the same regardless of the type of mark to be registered.

However, the Boards of Appeal of the EUIPO laid down the argument that a sound mark should significantly diverge from the norm or from the habits of the good/services sector it seeks to identify, so that it can be considered distinctive.

As stated by the General Court of the European Union (EGC) in the proceeding T-668/19, lodged by the German company against the EUIPO's decision, the argument brought by EUIPO refers to three-dimensional marks, which are composed by the shape of the product itself or its packaging when there is a norm or habits in the sector relating to this shape. Accordingly, in its decision, the EGC emphasized that this precedent relative to three-dimensional marks could not apply to sound marks, since the latter consist of signs independent of the outer appearance or the shape of the goods they identify.

Another erroneous conclusion by the EUIPO, according to the understanding of the EGC, was that in the beverages markets and in the respective packaging, it would be unusual to identify the commercial origin of a good solely by sounds, on the grounds that these goods are soundless until they are consumed. So the sound mark in question would be of no use to guide the consumer's choice for that specific good.

The European General Court highlighted that most goods are soundless in and of themselves and only produce a sound at the moment of consumption.

So, the simple fact that a sound can only be heard when a good is consumed does not mean that the use of sounds to identify the commercial origin of a good in a certain market is unusual.

Although it considered that some of the arguments laid down in the decision on the appeal served by the EUIPO as being mistaken, the General Court underlined that the Office's reasoning was based on the important ground that in the case in question the sound made when a can is opened is considered a purely technical and functional element, since opening a can or a bottle is intrinsic to a technical solution linked to handling beverages with a view to consuming them, so said sound will not be perceived as the indication of the commercial origin of these goods.

Further, both decision-making bodies emphasized that the sound elements and the silence lasting about one second, considered overall, do not have any intrinsic characteristic that



enables them to be perceived by the target public as an indication of the commercial origin of the goods – that is – these elements are not sufficiently characteristic to differentiate them from comparable sounds in the domain of beverages.

Moreover, the General Court found that the lack of grounds of the Boards of Appeal of the EUIPO on the absence of distinctiveness of the trademark in relation to the goods that might not contain carbon gas was not susceptible to implying the reversal of the decision handed down by the EUIPO, insofar as it was sufficiently grounded overall, so the appellant was able to understand the justifications for the measure taken in this regard and the EGC judge was also able to exercise control over the legality of said decision. Consequently, notwithstanding some equivocated reasons by the Boards of Appeal, the General Court found that they did not have a decisive influence on the conclusions of the decision, both bodies having agreed with regards the non-existence of a distinctive character of the sound mark in question.

Therefore, it is concluded that just like any trademark, a sound mark must possess sufficient distinctive capacity to identify the goods and/or services they are intended to identify, and cannot, for example, describe the type, the quality and other characteristics associated to these goods and/or services.

In this case, the sound mark was considered non-distinctive as a result of its descriptive character, but there are also other cases in which a trademark can be considered non-distinctive.

In contrast, sound marks may be considered as such by being comprised of very simple musical pieces, with one or two notes, by sounds that are within the public domain, by sounds that are too long to be considered as an indication of business origin or by sounds typically associated to specific goods and services. " So, the simple fact that a sound can only be heard when a good is consumed does not mean that the use of sounds to identify the commercial origin of a good in a certain market is unusual. "

Among these reasons for rejection, one that stands out is the curious case of the sound mark "TUDUM" created by Netflix, which was the object of a sound mark application in June of 2018 and was refused by the European Union Intellectual Property Office due to absence of distinctive capacity. In this case, Netflix appealed the decision, but ultimately abandoned the case and withdrew the sound mark application, essentially because of the complexity of proving that the trademark in question acquired distinctive capacity by its use – an interesting topic for exploring in a future article!





# How the Global Innovation Index rankings highlights African innovation

João Francisco Sá



WIPO published the 14th Global Innovation Index (GII) in September. This year's edition was dedicated to tracking innovation through the covid-19 crisis and explores several key indicators – including trademark-related information – to identify trends in innovation across 132 countries. One of the objectives of this is to assist policymakers to promote creativity and inventiveness.

### Africa at a glance

This year's most innovative African countries were Mauritius (52nd), South Africa (61st), Tunisia (71st) and Morocco (77th). These top four African countries kept their lead within the continent. Compared to last year's rankings, Mauritius was able to hold its position, while the others fell a few places in the ranking, with South Africa dropping from 60th place, Tunisia from 65th and Morocco from 75th. The GII divides African nations into two main categories, Northern Africa/Western Asia and Sub-Saharan Africa. The highlights for Northern Africa go to Egypt (94th) and Algeria (120th), which have improved their rankings.

In the Sub-Saharan region, Cape Verde climbed 14 places to reach 89th globally, becoming the fourth top innovator in its region. On the other hand, the GII authors also make clear that no countries have been able to constantly improve their ranking. Tanzania and Kenya have gradually improved but only over the past five years.

Sub-Saharan countries are mostly performing above expectations given their level of development, ranking above average on institutions, but lagging in other indicators such as creative outputs.

### Trademarks as an indicator of innovation in Africa

One of the creative outputs that the GII evaluates is the number of trademark applications by origin (class count) – measured by gross domestic product based on purchasing power parity. In this regard, the top-ranking African countries are Mauritius (17th), Madagascar (31st), Morocco (37th), Mozambique (58th), South Africa (77th), Malawi (78th), Kenya (82nd), Cabo Verde (90th), Namibia (94th), Egypt (95th) and Zambia (97th). This indicator is clearly an innovation strength for Mauritius, Madagascar, Morocco and Mozambique.

On the other side, it is a weakness for Zimbabwe, Ethiopia and Burkina Faso. Regarding last year's GII, Mauritius stayed in the first place, while Madagascar, Morocco, Mozambique, South Africa, Malawi, Egypt and Zambia managed to climb up the ranking. On the other hand, Namibia dropped from 26th to 94th and Cape Verde from 73rd to 90th.

This year's takeaway from the GII is that African countries are not yet able to provide for sustained and long-term growth in most innovation indicators. However, these countries do have innovation strengths that put them above expectations considering their level of economic development.

Trademark filings by African countries clearly demonstrate this, with leaders such as Mauritius, Madagascar, Morocco and Mozambique. However, there is still the issue that countries are not always able to sustain growth.

Policymakers should continue to develop national IP systems by better equipping their IP offices and mitigating the level of bureaucracy as a way of promoting the use of trademarks by local entrepreneurs that wish to protect their creative outputs.



# How the military coup in Sudan affects trademark rights

Inês Monteiro Alves



Since the ousting of former President Omar al-Bashir in 2019, Sudan has been ruled by an alliance between military and civilian groups. However, on 25 October 2021, the military took control. dissolving the transitional government and detaining Prime Minister Abdalla Hamdok – although he returned to his residence the next day, according to a source within the Sudanese prime minister's office and a military source.

The international community has not reacted favourably, condemning the coup, particularly United Nations Secretary General António Guterres and President Biden, who have stated that the move was a betrayal of the Sudanese people.

At the time of writing, despite the military coup, government services related to intellectual property appear unaffected and it is still possible to register trademarks, patents and designs.

Sudan has been a member of the Madrid Agreement since 1984, the Madrid Protocol since 2010 and the Paris Convention since 1984. Rights holders can file goods and service trademarks, as well as obtain protection for well-known marks. Further, the Nice Classification system still applies and the single class system is in place.

To file a trademark in Sudan, the applicant must provide:

- a notarised power of attorney;
- a certificate of incorporation legalised up to
- a Sudanese consulate;

contact information (ie, name and address);

 a sample of the mark (not required for word marks);

- a list of goods and/or services; and
- a certified copy of the priority document, with verified English or Arabic translation (if priority is claimed).

The filing procedure is as follows:

- filing of the request before the Intellectual Property Office and issuance of application filing receipt with application filing number;
- formal and substantial exam conducted by the office;
- issuance of report of acceptance by the office;
- publication of the application in the IP Bulletin;

• a six-month period for the filing of oppositions (eight months for non-residents) by third parties who considered themselves to be adversely affected with the registration of the trademark; and

• issuance of a registration certificate.

Although not mandatory, availability searches are recommended, the time frame to completion is seven to 12 business days.

A smooth registration may take approximately two to three years to complete. The mark will be valid for 10 years from the filing date and may be consecutively renewed for equal periods of time. It remains to be seen what, if any, impact the recent military action has on such systems.



# European Union Trademarks: Can abbreviations and acronyms be registered?

João Pereira Cabral

Еигоре

### The distinctive function and distinctive character

Trademarks serve to distinguish the goods or services of one company from those of other companies. This is the trademark's most relevant function for the legal system. Only signs which have the capacity to distinguish, i.e., distinctive capacity, can fulfil that function. For this reason, the rules that regulate trademark law determine that a trademark that does not have distinctive capacity cannot be protected, namely through registration.

In the European Union, both the European Union Trademark Regulation ((EU) 2017/1001) and the Directive approximating the laws of the Member States relating to trademarks ((EU) 2015/2436) include a general rule prohibiting the registration of trademarks "devoid of any distinctive character" (Articles 7(1)(b) of the Regulation and 7(1)(b) of the Directive). Article 7(1)(b) of the Regulation and Article 4(1)(b) of the Directive) and a specific rule prohibiting the registration of descriptive marks, i.e., marks which describe characteristics of the goods or services which they are intended to distinguish (Article 7(1)(c) of the Regulation and Article 4(1)(c) of the Directive).

For abbreviations and acronyms, the prohibition of registration of descriptive trademarks is of particular relevance. This rule has two grounds: first, that only trademarks capable of fulfilling their principal function may be registered, and second, the public interest in preventing the creation of exclusive rights to use terms that other traders may wish to use.

For example, the terms "Orange Juice" cannot be a trademark to identify the product orange

juice, not only because they are not able to distinguish the orange juices of one company from those of others, but also because if they were registered, any competitor of the registrant would be prevented from using these terms to indicate the type of product commercialized.

The rule providing for this prohibition has been interpreted by the Court of Justice of the European Union. The CJEU has established that a "sign must be refused for being descriptive if its meaning is immediately perceptible to the relevant public as a sign providing information on the goods and services for which registration is sought." And that the "relationship between the sign and the goods and services must be sufficiently concrete, direct and understood without further consideration."

In other words, the method of gauging whether a term is descriptive is as follows:

- a) identify the meaning of the trademark;
  b) ascertain whether there is any relationship between the meaning of the trademark and any characteristic of the goods and/or services; and
- c) if so, ascertain whether the relevant public will identify that relationship concretely and directly and understand it without any further reflection.

[...]







Drug patent applications to combat COVID-19

Vítor Sérgio Moreira

Worldwide

The pandemic caused by COVID-19 (SARS-COV--2) is completing a year since the most comprehensive health measures to combat the virus began. Intensive efforts to develop new active ingredients, treatment methods and vaccines have been carried out by the scientific community and pharmaceutical companies.

#### The first vaccines

The technical and scientific effort has led to the development of several vaccines to combat SARS-COV-2, manufactured by various technologies, such as inactivated virus vaccines, such as that developed by Chinese companies Sinovac and Sinopharm; mRNA vaccines, such as products developed by Pfizer / Biotech and Moderna; non-replicating viral vector vaccines, such as the vaccine developed by the University of Oxford / AstraZeneca, the Johnson & Johnson vaccine and the Sputnik V vaccine from the Gamaleya Research Institute; or protein subunit vaccines, such as Novavax.

The results and the launch of new vaccines are observed with great interest by the general public. This study presents the current phase of published patent applications for active ingredients, drugs and vaccines to combat SARS-COV-2, in addition to the main applicants involved.

In order to identify patent applications published from 2020 onwards, we use the Espacenet database with keyword search related to SARS-COV-2 and through patent classifications referring to the technological fields of the types of medicines.

Patent classifications consist of indexing codes assigned by the Patent Offices and specific by technology, which can be used as





search filters in the database. In this study, we applied the patent classifications shown in table 1.

International Patent Classification (IPC) symbol	Description
A61K31	Medical preparations containg organic active ingredients
A61K33	Medical preparations containg organic inorganic active ingredients
A61K35	Medical preparations containg materials or reaction products thereof with undetermined constitution
A61K36	Medical preparations of undetermined constitution containing material from algae, lichens, fungi or plants, or derivates thereof, e.g. traditional herbal medicines
A61K38	Medical preparations containg peptides
A61K39	Medical preparations containg antigens or antibodies

Table 1: Patent classifications searched.

After searching for the IPC classification symbols and the keywords in the Espacenet database, we obtain the results listed in Figure 1. A preponderance of medicinal preparations related to organic chemical active ingredients or to medicinal preparations including antigens and antibodies is visible.

Despite the research fronts with organic chemical compounds appear to have been explored, these technologies have not yet materialized into a medicine effectively approved by public health regulatory agencies. In fact, the main technologies previously mentioned and related to the preparation of vaccines against SARS-COV-2 fall under the symbol of IPC A61K39.

[...]



## A profile of patenting activity in Angola

Vítor Sérgio Moreira



This study aims to display some information regarding the activity of filing patent applications before the Angolan National Patent Office (IAPI), presenting a profile of the main patent applicants and the kinds of technologies for which the applicants seek patent protection in Angola.

Identifying information regarding patent activity in Angola is not an easy task. The IAPI does not publish a bibliography of filed patent applications on its homepage, nor does it provide data to Espacenet, the most comprehensive, free, patent database. As a matter of fact, the country code of Angola (AO) is not even included in the list of countries codes indexed in the Espacenet.Of the 363 patent applications published in the OBIP in 2020, 97% were filed by non-residents. The PCT is the main route used by applicants, far outnumbering those filed via the Paris Convention (CUP) system (Figure 3).

The data gathered from the OBIP confirm those retrieved from the WIPO statistics database, regarding the very limited use of the patent system by Angolan residents. The overall number of publications of patent applications in 2020 is significantly higher than the number of patent applications filed in 2018 (102) and 2019 (111), according to a report published in the OBPI in May 2020. One possible explanation is a delay in publishing patent applications filed before 2020.Fili

Therefore, our source of information for performing this study was the World Intellectual Property Organization's (WIPO) statistics database and the Official Bulletin of Industrial Property (OBIP), which is prepared by IAPI. The OBIP comprises bibliographic data of patent applications, including the patent number, title and applicant name.

### Data on patenting activity in Angola

The WIPO statistics database suffers from a scarcity of historical data regarding patent applications filed at IAPI (Figure 1).

The data regarding filings before the IAPI from 2010 to 2017 are not available and there are no data regarding the number of granted patents. It is possible to observe that a massive share of patent filings in Angola come from non-resident applicants, wherein all of them consist of Patent Cooperation Treaty (PCT) National Phase Applications. Besides that, we can observe that the filing activity by residents is quite limited, including a low number of filings abroad, where the country of origin is Angola.

#### Patent applications filed at IAPI, 2010–2019



[...]



## Three types of patent in the Democratic Republic of the Congo explained

Diogo Antunes



The Democratic Republic of the Congo's Industrial Property Law has been in force since 1982. Article 5 stipulates that there are three kinds of patent:

• 'invention patents', which primarily cover inventions that, on the date of filing or of priority of the related application, have not yet been patented;

• 'import patents', which cover inventions for which, on the date of filing or of priority of the related application, the owner has already obtained an invention patent in a foreign country; and

• 'improvement patents', which cover any improvement of an already patented invention.

However, the law fails to mention whether improvement patents can be filed by several entities.

Article 37 states that the validity period for import and improvement patents ends at the same time as the primary patent period.

The law also imposes a legal obligation to exploit a registered patent, or else risk the loss of rights. This must take place within a period of:

 five years from the filing of the application or three years from the grant of the patent, whichever expires last, in the case of a primary or improvement patent;

• four years from the date of grant for drug--related patents, in the interests of public health; and • three years from the filing of the application, in the case of an import patent.

If the invention covered by an import patent has already been exploited abroad, exploitation in the Democratic Republic of Congo must occur within two years from the filing of the application.

With regard to non-voluntary licences, Article 76 states that "the holder of a nonvoluntary license shall not have any rights in the improvement patents attached to the original patent which is the subject of the nonvoluntary license".

The Democratic Republic of the Congo's patent regime is favourable for those that want to protect their inventions. Applicants have a range of options when it comes to filing, including obtaining a patent with improvements rather than the primary patent or filing a patent granted in another country despite the loss of priorities granted by the Paris Convention and the Patent Cooperation Treaty system.



### Substantive Examination of Patent Applications According to The Angolan Patent Law

Vítor Sérgio Moreira



This study aims to provide an approach of the topics followed by a patent examiner when a patent application is processed by a Patent Office during the substantive examination phase, in the context of the Angolan Patent Law (APL). As a matter of comparison, the same topics are evaluated according to the European Patent Convention (EPC), wherein we focus on the main differences between the two legal frameworks.

Angola is a Member State of the World Intellectual Property Organization (WIPO) since 1985, a member of the Paris Union for the Protection of Industrial Property since 2007, and a member of the Patent Cooperation Treaty (PCT) since 2007. Moreover, Angola is a member of the World Trade Organization, and consequently of the Agreement On Trade-Related Aspects Of Intellectual Property Rights(TRIPS) since 1996.

Angola establishes the provisions regarding the protection of Industrial Property by means of the Industrial Property Law of February 28, 1992. On the other hand, the European Patent Convention (EPC) is in its 16th edition, which is in force since July 1st, 2020.

#### Substantive Examination Steps

#### Identifying the invention

A patent examiner usually starts his work during a substantive examination by studying the claims, in order to identify what subject matter is effectively claimed by the applicant. The EPC explicitly defines a very common principle in its Article 84, wherein "The claims shall define the matter for which protection is sought. They shall be clear and concise and be supported by the description". The APL is silent about this relevant legal matter, and regarding the requisite of "clarity", the only point that a patent examiner in Angola could raise would be based on Article 5 (f) of APL, in accordance with which it is necessary to file "a clear and comprehensive description of the subject of the invention such that it may be carried out by a person having ordinary skill in the art", although this would not be a proper approach because Article 5 (f) of APL is clearly restricted to the description. Therefore, APL comprises a gap regarding clarity of claims, which may limit the power of action of a patent examiner to raise objections regarding broad, ambiguous and unclear claims.

### Exceptions to patentability

The next step followed by a patent examiner refers to the identification of subject matter which is excluded from the patentability. Regarding this topic, APL and EPC have several relevant differences, which may lead to very different conclusions by a patent examiner. APL and EPC share a common exception to patentability when the commercial exploitation of inventions would be contrary to the "ordre public" or morality, although EPC inserts a disclaim in its Article 53 (a), stating that "exploitation shall not be deemed to be so contrary merely because it is prohibited by law or regulation in some or all of the Contracting States". The APL defines in its Article 4(d) a specific subject matter, which is typically protected in several jurisdictions, but it is an exception to patentability in Angola, namely, "food and chemical-pharmaceutical products and medicines intended for human or animal consumption".

[...]



## Protecting inventions in Africa

Marisol Cardoso



When it comes to patenting inventions in Africa, apart from direct filings in the country of interest using the World Intellectual Property Organization (WIPO) Paris Convention for the Protection of Industrial Property, applicants can choose between two regional offices: the Organisation Africaine de la Propriété Intellectuelle (OAPI) and/or the African Regional Intellectual Property Organization (ARIPO).

The filing of a patent application in a regional office has the advantage of encompassing several countries in a single application. However, in a continent with two different regional offices, some points should be considered before choosing one of them to protect your invention.

OAPI and ARIPO do not share common member states, so the first point to be considered by applicants when electing a regional office to file a patent application is the territory where they wish to protect and explore their inventions.

OAPI was created by the Bangui Agreement of 1977 and encompasses 17 member states, most of them being French-speaking countries. Under OAPI, only a regional patent can be obtained for the contracting member states since they do not have national IP laws. Also, all member states are covered by a single application.

ARIPO was established by the Lusaka Agreement of 1976 and encompasses 19 member states (mostly English-speaking countries). With regard to patents, ARIPO follows the dispositions of the Harare Protocol, which was first adopted in 1982 and regulates the procedures and substantive requirements for the protection of inventions among its member states. The Harare Protocol is in force in all the organisation's 19 member states except Somalia. Also, except for Swaziland, all the remainder countries can grant a national patent in addition to, or instead of, a regional patent. At ARIPO, the member states of interest must be designated by the applicant at the time of the filing.

#### Member states

Among OAPI's member states is Niger, the African country with the highest gross domestic product (GDP) in 2019. South Africa and Egypt, the next African countries in the GDP list, are not contracting states of OAPI nor ARIPO. In these countries, applications must be filed directly (via the Paris Convention) or through the Patent Cooperation Treaty (PCT) system.

Morocco and Tunisia are not member states of either OAPI or ARIPO. However, due to agreements concluded between the national offices and the European Patent Office (EPO), applicants may designate their European patent applications and further validate their European patents in these territories.

OAPI and ARIPO are both part of the PCT and are competent receiving offices for nationals and residents of their member states. For the regional phases, the time limit for filing a regional phase application in ARIPO is 31 months and the application must be filed in English. In OAPI, the deadline is 30 months and the application must be filed in English or in French.

For patentability requirements, both offices provide the applicants with a grace period of



six months (for ARIPO) or 12 months (for OAPI) for filing a patent application after an official disclosure is made by the inventor or by an unauthorised third party, without prejudice to the novelty assessment.

Concerning substantive examinations, OAPI is a formality and not a substantive examination office, so all patent applications that meet the formality requirements are granted. OAPI's Bangui Agreement has been revised to improve the quality of its operation procedures, which include the substantive examination for patents, but such provision is not yet in force.

At ARIPO, a substantive examination takes place after the application has met the formal requirements. In cases where the technicalfield or the invention is too complex and the examination capacity may be jeopardised, ARIPO has agreements with other patent offices, as well as with WIPO, for conducting the examination.

#### Criteria

It is important to point out that, since the member states of ARIPO have national IP laws which coexist with the Harare Protocol, the patentability criteria of the designated states are also considered, which may cause conflict, especially relating to the pharmaceutical area.

In this context, after ARIPO's decision to grant a patent application, a designated state may make a written communication informing that the patent shall have no effect in its territory due to inconsistencies with the national IP law.

On the other hand, if ARIPO decides to refuse a patent application, the applicant may request that the ARIPO application be converted into a national application, proceeding under the laws of the designated member states.

Another difference between ARIPO and OAPI relates to amendments.

Under OAPI, for patent applications amendments are allowed solely to correct obvious clerical errors. Under ARIPO, patent applications can be amended during the prosecution and even after the granting decision. Postgrant amendments, however, must fall within the scope of the claims and are allowed only to limit the subject matter.

Even though filing a patent application through a regional office in Africa might seem the easier and faster way to secure protection in several territories at the same time, this decision must be carefully analysed by the applicants.

To guarantee that the applicant benefits the most from the route chosen, different territories (and not all the main marketable territories), different procedures, and the coexistence of national laws in ARIPO's member states must be strategically considered before filing a regional or a national patent application.


# A profile of patent applications filed in Mozambique

Vítor Sérgio Moreira



Inventa has carried out a study on patenting activity in Mozambique, presenting some statistics highlighting a profile of the main patent applicants, and the technologies they relate to in the country.

To be granted in Mozambique, a patent application may be directly filed before the Mozambican national patent office (IPI) or can be filed before the African Regional Intellectual Property Organization (ARIPO), where an applicant requires Mozambique as a designated state.

Identifying information regarding patent activity in Mozambique is not an easily performed task, managed by means of some clicks and an internet search engine.

The IPI does not publish the bibliographic data of filed patent applications. The patent applications filed in Mozambique are not searchable by means of Espacenet, which is the most complete free patent database, because IPI does not provide data to this source.

The internet country code of Mozambique (.mz) does not feature in the list of countries codes indexed in the Espacenet, in which a country code consists of two letters indicating the country or organisation where the patent application was filed or granted.

Our source of information for performing this study was the statistics database of the World Intellectual Property Organization (WIPO) and the Official Bulletin of Industrial Property (OBIP), which is prepared by IPI and may be acquired directly before the office. The OBIP comprises bibliographic data of patent applications and information that refer to the patent numbers, titles, applicants and inventors of patent applications in Mozambique.

#### Historical data

We have identified the patent filing activity before the IPI in Mozambique from 2010 to 2019, from data derived from the WIPO statistics database, as it is presented in Figure 1. It is possible to observe a slight growth trend for the overall quantity of patent applications filed directly before the IPI, and it appears that residents have contributed to a significant share of this set of patent applications.

Patent applications in Mozambique are slightly more numerous than in neighbouring countries, the United Republic of Tanzania, Zambia and Zimbabwe when compared to the number of patent applications (direct and Patent Cooperation Treaty national phase entries), as shown in Table 1, and the number of patent applications filed by residents, as shown in Table 2.

#### Patent applications - Average values 2010--2019 (Table 1)

	Mozambique	United Republic of Tanzania	Zambia	Zimbabwe	South Africa
Total	44	6	29	21	7.200
Resident	18	4	10	9	707
Non-Resident	26	2	19	12	6.493

[...]



# Compulsory licenses in the access of the vaccine of covid-19 by African countries

Inês Monteiro Alves



#### Introduction

By the end of 2019, humanity was confronted by a new infectious disease caused by a new coronavirus, the covid-19 that led, on March 11th, 2020 the Word Health Organization (WHO) to declare the state of a global pandemic.

The fight against this new virus has demanded several technical innovations and, apart from the vaccine, many have been the inventions that required the protection by patent: retroviral medicines, diagnostic tests or medical devices, such as ventilators are some of these examples. Nevertheless, the most visible face of this combat has been the vaccine, which put the pharmaceutical companies in a race for its development.

At the time of writing, the vaccines of Pfizer-BioNTech, Moderna, AstraZeneca, Janssen, Sinovac (CoronaVac) and Sputnik are being administered worldwide and most of the developed countries in Europe and then the United States of America, Russia and China expect to obtain group immunity by the end of the year of 2021.

This is a situation only possible due to the economic power that the countries have, either to develop the vaccines or to buy the same. Unfortunately, none of these possibilities are viable when we speak about underdeveloped countries, which is a situation that is currently taking place across Africa.

Indeed, countries in Africa are being devastated by the pandemic of covid-19, however, the combat to the same is not as fair as the combat that is taking place in developed countries.

#### Covax initiative

The access to the vaccines by these countries is a problem that found a solution in the Covax incentive, an international mechanism co-led by Gavi (The Vaccine Alliance), the Coalition for Epidemic Preparedness Innovations (CEPI) and the World Health Organization with the aim of accelerate the development and manufacture of covid-19 vaccines, and to guarantee fair and equitable access for every country in the world. The international mechanism is planned to distribute two billion doses of vaccines until the end of the year to underdeveloped countries, and it has agreements with AstraZeneca, Pfizer-BioNTech and Moderna.

Ghana was the first African country to receive vaccines under the international mechanism of Covax in February: 600,000 doses of the vaccine developed by AstraZeneca. Since then, Algeria, Malawi and Uganda have also received doses of the vaccine from the same laboratory. In early March, Rwanda was included in the batch of vaccines from Pfizer-BioNTech under Covax. However, this situation is far from ideal, as the percentage of the population that currently has access to the vaccine in Africa is extremely reduced.

Many have been the public declarations by António Guterres, the current secretary-general of the United Nations, where he has criticized the "wildly uneven and unfair" distribution of the vaccines and has been appealing for the solidarity of the countries to adhere to this international mechanism. Accordingly, only a strategic global vaccination plan would avoid future mutations of the virus in the countries where the vaccination does not have advanced and would allow to fight the virus



#### COVID-19 vaccine doses administered, May 10, 2021

Total number of vaccination doses administered. This is counted as a single dose, and may not equal the total number of people vaccinated, depending on the specific dose regime (e.g. people receive multiple doses).





Source: Official data collated by Our World in Data - Last updated 11 May, 10:00 (London time)

OurWorldInData.org/coronavirus • CC BY

efficiently. It is important to note that two mutations of the virus took place in Brazil and South Africa and it is certain that if the pandemic is fought on a global level, it would be possible to avoid future mutations that would only delay the economic recovery of the countries and the regain of some normality.

## Patent system and collision with the right to health

The access to pharmaceutical products, particularly the access to the vaccines for covid-19 may also find a solution through the application of the rules of intellectual property.

The vaccines that are currently being administered are protected by patent. A patent is a right granted by the government, in which the inventor has the exclusive right to explore the invention during the period of 20 years. To be granted, the patent is required to meet certain requirements, particularly, novelty, inventive step, and industrial applicability. Pharmaceutical products that are protected by patent are sold with a higher cost in relation to the production cost, to compensate the investment in I&D. The grant of a patent intends to promote technological and scientific progress by way of offering to the inventor exclusivity in the market.

Nevertheless, the patent system as it is designed collides with a commensurable ethical aspect: the right to health.

For this reason, the patent system is not strict and determines mechanisms that allow access to pharmaceutical products, particularly, vaccines protected by patents.

[...]



# DABUS: the 'natural person' problem

Miguel Bibe



The Device for the Autonomous Bootstrapping of Unified Sentience (DABUS) case dates back to August 2019, when a team of academics from the University of Surrey in the UK filed two patent applications in the UK Intellectual Property Office (UKIPO), the European Property Office (EPO) and the US Patent and Trademark Office (USPTO), for inventions developed by artificial intelligence (AI).

Europe / Africa

According to the applications of these patents, no human being was responsible for the development of the inventions they intended to protect, which instead were formulated by DABUS, created by AI expert Stephen Thaler. It was the world's first AI to invent viable products without human intervention.

DABUS uses its complex and varied interconnected neural networks to create its own "ideas". By varying the connections between the neural networks, and then using a secondary layer to predict the potential critical consequences, it was able to create two different inventions.

The first is a new type of plastic food container that uses fractal geometry to change shape. The second is a type of flashing light device designed to attract attention during an emergency incident, that can be used in search and rescue missions.

The UKIPO and the EPO decided that the patents filed for these two inventions were eligible, meaning that both considered these inventions as new and industrially applicable. However, because they were not developed by a human being, there was no traditional identification of a "natural person" as an inventor. Thus, following arguments that the inventor designated in the patent application must be a natural person, the registration was refused in the EU, the UK and the US, precisely on the ground that the concept of "inventor" is limited to human beings exclusively.

In the reasoning of the refusal decisions, it was stated that the designation of an inventor is mandatory as it has legal consequences. In particular, this is to ensure that the designated inventor is the legitimate one and that he or she may benefit from rights attached to that status. To exercise these rights, the inventor must have a legal personality that AI systems or machines do not enjoy, and the simple fact of giving a name to a machine is not sufficient to satisfy these requirements.

The applications have also been filed under the Patent Cooperation Treaty (PCT), which facilitates the process of obtaining patent protection in over 150 countries; they are currently pending examination in a significant number of patent offices.

The Companies and IP Commission (CIPC), South Africa's patent office, has already set out its position on this issue, becoming the first to grant a patent for an invention conceived by an Al inventor.

The patent is for "a food container based on fractal geometry", and was accepted by the CIPC on June 24, 2021. The notice of issuance was published in the July 2021 "Patent Journal".

South Africa does not have a substantive patent examination system and, instead, requires applicants to merely complete a filing for their inventions. This means that South Africa patent laws do not provide a definition for "inventor" and the office only proceeds with a formal examination in order to confirm if the paperwork was filled correctly.



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#### Victory for DABUS?

Following the South Africa patent decision, a member of the team behind the filings, Professor Adrian Hilton, director of the Centre for Vision, Speech and Signal Processing, said that "modern AI may fundamentally change how research and development takes place".

Also, according to a press release issued by the University of Surrey: "While patent law in many jurisdictions is very specific in how it defines an inventor, the DABUS team is arguing that the status quo is not fit for purpose in the Fourth Industrial Revolution."

On the other hand, this may not be considered as a victory for the DABUS team since several doubts and questions remain as to who should be considered the inventor of the patent. Current IP laws in many jurisdictions follow the traditional term of "inventor" as being a "natural person", and there is no legal precedent in the world for inventions created by a machine.

Al has advanced from being a tool to improve human effort to a level where it is automating innovation and, despite long being regarded as something that could fundamentally change the way we live, there is no legislation on machine-invented patents.

In this regard, it is crucial that IP laws follow the continuous evolution of technological progress, to properly legislate for these developments.

However, while possible solutions are being studied, it seems that the traditional concept of "inventor" will have to be amended to keep up with AI developments and allow machines to receive credit for invention, and owners to protect their rights without problems caused by inventor discussion.



# Patenting Activity before the European Patent Office by Chinese Organizations

Vítor Sérgio Moreira



The Chinese organizations have been investing in several European markets, and an effective protection by means of the patent system is comprised in the strategy of said Regarding protection organizations. of intellectual assets by means of patents, filing a patent application before the European Patent Office is a common approach to have patents in force in several European countries. The EPO is the regional Patent Office, which covers 38 member states, two extension states and 4 validation states, wherein some of this later group is geographically located outside Europe.

After a patent being granted by EPO, it is necessary to validate European patent in the countries where the applicant has interest in protecting its invention.

In this sense, this article will seek to identify the profile of patent applications having origin in China and filed before EPO, in order to reveal the technological fields of the respective patent applications, and the main applicants.

Moreover, we present some results about quality indicators of the European patent applications, which are related to the prosecution before EPO.

#### Filings of patent applications before EPO

We have evaluated the trend of filings of European patent applications before EPO from 2000 to 2018, wherein the applicant/proprietary of a patent application is domiciled in China. For retrieving the related data, we have used the database EP Bulletin Search, provided by EPO. We may observe in figure 1 a remarkable growing trend of patent applications originated from China and filed before the EPO in this period. According to the "Annual Report 2018 -Statistics at a glance", issued by EPO, China is in the sixth position in the ranking of the geographic origin of the European patent applications.



Figure 1

# Identification of the main technological fields related to the European patent applications

We have analyzed the International Patent Classifications (IPC) regarding the patent applications filed in 2000, 2005, 2010 and 2015 by means of the statistics tool incorporated in the database EP Bulletin Search, wherein we have considered all the patent applications filed in 2000 and in 2005, and samples comprising the first 1500 patent applications filed in 2010 and in 2015. The IPC refers to an indexing code, which is related to the technological field of a patent application.

[...]



# Madagascar: biodiversity and patent rights

Marisol Cardoso



Madagascar is an island country in East Africa, located in the Indian Ocean. As a result of the island's long isolation from neighbouring continents, Madagascar is home to various plants and animals found nowhere else on Earth, being therefore considered as a biodiversity hotspot.

Due to its abundant and diverse natural resources, the island's economy has its mainstays in agriculture, mining, fishing, tourism, and textiles. Still, the rapidly growing human population, poor soil management (due to inappropriate traditional agricultural practice), illegal logging and other environmental threats have put Madagascar among the poorest countries in the world.

In this context, several national and international attempts to control and manage the sustainable use and mutual benefit of Madagascar's economically valuable natural resources, as well as to encourage the entry of foreign investments in the country, are being put into practice.

Thus, considering the role of patent activity in overall innovation and economic growth, is it possible to, at the same time, protect Madagascar's biodiversity and grant patent rights?

#### IP rights in Madagascar

Madagascar was a French colony from 1897 until 1960 and due to this fact, the island developed political, economic, and cultural links with the French-speaking countries of West Africa.

After their independence from France, Madagascar and twelve other African States signed the Libreville Agreement (1962), which established a uniform regime for the protection of industrial property and created the Office Africain et Malgache de la Propriété Industrielle (OAMPI). This authority was responsible for common administrative procedures for all the thirteen-member states regarding industrial property rights.

Following the effective termination of this Agreement in 1976, a legal and administrative void existed in the area. Thus, after many legislative drafts, a regime for the protection of industrial property in Madagascar was promulgated in 1989 and, in 1992, the Office Malgache de la Propriété Industrielle (OMAPI) was established and organized.

Today, OMAPI is the authority responsible for the receipt and registration of all acts relating to industrial property rights, including the examination and the granting of patents of invention, inventors' certificates, trademarks, trade names and industrial designs.

As regards authors' rights and copyrights, the Office Malgache des Droits d'Auteurs (OMDA), created in 1984, is the only organization admitted to operating on the island in matters of scientific, literary and artistic property.

#### Patent protection in Madagascar

Madagascar is a member state of the Paris Convention and the Patent Cooperation Treaty (PCT), thus, the protection of an invention is available via a national filing, or a national phase application based on an international application.

[...]



# Patents in Africa: ARIPO vs contracting states' laws

Marisol Cardoso



In Africa, inventions can be protected by patents through a direct filing in the country of interest using the Paris Convention or through a sole filing in a regional office. With regard to the regional offices, the applicant can choose among the Organisation Africaine de la Propriété Intellectuelle (OAPI), the African Regional Intellectual Property Organization (ARIPO), or both, since the OAPI and ARIPO cover different African countries.

When it comes to OAPI, only a regional patent can be obtained for the contracting member states since they do not have national IP laws. With regard to ARIPO, except for Eswatini (formerly Swaziland), all the remaining 18 countries can grant a national patent in addition to, or instead of, a regional patent.

Since the member states of ARIPO have national IP laws which coexist with the legislation adopted by the regional office, the patentability criteria of the designated states are also considered, which may cause conflict when performing the substantive examination of an invention.

#### Patent examination procedure in ARIPO

ARIPO has been following the dispositions of the Harare Protocol, which has regulated the procedures and substantive requirements for the protection of inventions among its member states since it was adopted in 1982.

The patent application is first submitted to an "examination on filing", which aims to determine whether it meets the minimum requirements for according a date of filing, such as the designation of at least one contracting state, the information about the applicant, a description and one or more claims.

As follows, a formal examination is performed

and, when all the formal requirements are acknowledged to be complied with, the application is then submitted to a substantive examination. In case the application under consideration derives from an international application, the international search report is considered and a supplementary ARIPO search is carried out before the issuance of the search report and the examination report.

The inventions must comply with the requirements of absolute novelty, inventive step, and industrial applicability and, as regards the subject matter to be protected, two categories of claims are admissible: product claims and process claims.

Subject matters related to discoveries, scientific theories, mathematical methods, business methods and programs for computers are not regarded as inventions. Further, plant or animal varieties or essentially biological processes for the production of plants or animals, as well as methods for treatment of the human or animal body and diagnostic methods practised on the human or animal body, are not considered to be patentable.

When granted by ARIPO, the patent will be valid for 20 years counted from its filing date and is subject to the provisions of the applicable national law of the designated contracting state on compulsory licences, forfeiture, or the use of patented inventions in the public interest.

[...]



# Africa: patenting against the clock

Vítor Sérgio Moreira



A patent prosecution process carried by a patent office takes a significant time lasting usually from three to six years. The period from filing the patent application to patent granting depends on several factors, for example the work capacity of the patent office, meeting of the patentability criteria, number of necessary substantive examinations, and some time limits set forth by patent laws and regulations.

In certain situations, the necessary regular period to get a patent granted in some specific jurisdiction does not meet the expectations of the applicant, namely when the applicant wishes to have his patent granted as soon as possible in order to quickly enforce it.

This situation can happen when there is an infringement of the patent that harms its scope of protection in a certain jurisdiction or when the technology has a short lifespan and the effects of its related patent must be used timely.

Considering this background, several patent offices offer to the applicant legal provisions that are configurated to provide a faster prosecution of a patent application.

There are several embodiments of accelerated examination procedures, wherein the simplest ones comprise a mere request by an applicant for an accelerated examination for a specific patent application, as the PACE programme, established by the European Patent Office (EPO).

Other embodiments comprise more complex rules and are dependent of bilateral agreements and cooperative examinations between patent offices, for example the Patent Prosecution Highway (PPH). This study aims to display relevant details regarding the legal framework for accelerated substantive examination of patents in a subset of African countries, presenting examples of jurisdictions where is possible to file an application to install an accelerated substantive examination for a patent application.

The jurisdictions explicitly cited in table 1 have received about 92% of the patent applications filed in Africa from 2009 to 2019, according to data retrieved from the World Intellectual Property Organization (WIPO) statistics database, but only Morocco, Tunisia, Egypt and the African Regional Intellectual Property Organization (ARIPO) provide explicit details about embodiments of accelerated examination.

Jurisdiction	Total of patent applications (2009 - 2019)	Share (%)
South Africa	78734	49.8
Egypt	23735	15.0
Могоссо	16170	10.2
Algeria	7787	4.9
ARIPO	7372	4.7
Tunisia	6102	3.9
OAPI	5263	3.3
Others	12855	8.1

Table 1.

[...]

# COPYRIGHT $\bigcirc$ • . 0





# Protecting theatrical works in South Africa

Júlia Alves Coutinho



Copyright refers to the rights that creators have over their literary and artistic works and protects the creators against third parties wishing to take ownership of their work to use it in a different way from the one they proposed originally without their authorisation. This protection, which is embodied in the exclusive right of economic exploitation of the holders of copyright and related rights in relation to their creations, allows the creators to be fairly rewarded for their work.

On the other hand, copyright legislation imposes limits on the exclusive rights of the authors, allowing the diffusion of their works and the development of creativity based on these intellectual expressions, which can serve as inspiration for the creation of other works, which may also be subject to protection by copyright.

The South African legislation is no different, considering that South Africa is a member of the Berne Convention of 1886 and the Rome Convention of 1961. The country's Copyright Act of 1978 (Act no. 98 of 1978) has undergone several changes over the decades, the most recent being the Copyright Amendment Act 2002 and the Performers' Protection Amendment Act 2002.

One of the most recent relevant documents is the Intellectual Property Laws Amendment Act 2013, which changed several laws on various IP matters related to manifestations of indigenous knowledge.

In addition, the Copyright Amendment Law of 2017 intends to introduce some changes to previous legislation and included new themes in the Copyright Act and even established the creation of the Copyright Tribunal, which will be a court of the first instance in the enforcement of copyright infringement matters. This legislation has been under consideration by the National Assembly since August 2020, and must then be transmitted to the National Council of Provinces and finally signed by the President of the country.

The South African Copyright Act states that the literary work includes dramatic works and stage directions, clearly focusing on the textual component of both works. It is important to stress that theatrical work may be considered as a literary expression—literary work—and as a performing art, or artistic work.

As a literary expression, the theatrical work highlights the word and is part of the dramatic literary genre, in which coexists a primary or main text, that presents the speeches of one or more characters - monologues or dialogues - and a secondary text that exposes the scenic indications, that is, the characters' intentions and indications about actions, time and space.

As a performing art, the theatrical work may or may not be inspired by an earlier dramatic text. When inspired by a previous text, it still mostly relies on the creation of a script by the stage director, being the basis on which the theatrical play is composed, so it can present technical indications about the movement and the props of the characters and the composition of the scenarios, for example, as well as the dialogues and emotions of the characters, or only synthetic scene indications.

In Article 3 (2), the Copyright Act states that the term of copyright shall be, in the case of



literary, musical, or artistic works, other than photographs, the life of the author and fifty years from the author's death. But if the work is published or performed in public before the death of the author, the term of copyright shall continue to subsist for a period of fifty years thereafter.

Performing a play inspired by dramatic textual work in the theatre requires obtaining a licence from the copyright owner for the use and, most likely, for the adaptation of this text, which comes with a fair amount of legal responsibility as the onus is on the adapter to ensure due diligence in relation to their adaptation. The adaptation right gives the adapter the legal authority to change, translate or adapt the playwright's work as per the terms and conditions outlined in the licensing agreement.

As established in Article 21 of the South African Copyright Act, the ownership of any copyright on any work shall vest in the author or, in the case of a work of joint authorship, in the co-authors of the work. In the case of theatrical literary works, the main copyright owner is the playwright, but it can also be the publisher, the author's heirs or a third party to whom the rights have been assigned. In addition, if someone creates a work as part of their employment, copyright belongs to the employer. Employer and employee can, however, change this by mutual consent.

According to the Dramatic, Artistic and Literary Rights Organisation (DALRO), a copyright licensing association, once the rights' holders have been determined, the adapter agreement would need to be negotiated and signed by both the adapter and the rights holder or their agent.

Adapter agreements tend to be standard and would need to include certain parameters:

1. The title, author and details pertaining to the source work(s) to be adapted;

2. Clauses pertaining to rights' holder approval of the adapted work once completed and prior to public performance, if desired by the rights' holder;

3. Proposed title of the new adaptation;

4. The ownership and royalty division between the rights holder and the adapter in respect of use and reproduction of the newly adapted work.

The adaptation agreement may form the basis of a series of restrictions imposed by the holder of the literary work on the creative space of the director and, consequently, interfere in the ownership of the copyright of the theatre play. If there was no relevant contribution from the author of the text, the creator of the staging is solely the director, who should be regarded as the only copyright holder. In practice, however, they usually end up sharing ownership with the author of the previous text.

According to DALRO, in a case where the source work is no longer under copyright protection, the adapter would then retain all of the IP rights for the new work. The adaptation would be independent work and copyright would subsist in the adaptation separate from the inspiration work. Under current law, copyright protection in the new work would last for the duration of the adapter's life plus fifty years and would have no bearing on when the copyright has lapsed in the previous source material.

This understanding of the law does not deal with the theatrical work.

According to most interpretations of international doctrine and legislation on the subject, it is understood that creative theatrical work is a new and independent work, and not simply derivative from a literary text.

In the final analysis, the staging of an independent work, which is inspired by an earlier, copyright-protected work, can be argued in the South African courts and, in the future, in the Copyright Tribunal.



# 2020: Nigeria's progress on copyright reform

Inês Monteiro Alves



Despite the COVID-19 pandemic which effectively put much of life on hold, Nigeria enjoyed an extremely productive 2020 with respect to copyright law reforms and court decisions.

In January, the World Intellectual Property Office's (WIPO) Nigeria Office (WNO) was established in Abuja to promote awareness-raising, training, and capacity-building in the field of IP. According to WIPO: "WNO strives to provide an excellent, trusted, and responsive institutional sub-Saharan presence for WIPO in Nigeria, which adds clear value, efficiency, and effectiveness to the organisation's programme delivery, provides timely responses to inquiries and offers support to the organisation's cooperation and services in Nigeria."

WNO is part of a network of WIPO external offices and, together with an office in Algeria, is among the first such offices in Africa. The office was officially opened for operations on January 22, 2020.



#### Law and regulations highlights

WIPO's Beijing Treaty on Audiovisual Performances (Beijing Treaty) adopted on June 24, 2012, finally entered into force on April 28, 2020. The treaty deals with the IP rights of performers in audiovisual performances and grants moral and economic rights to performers, particularly: (i) the right of reproduction; (ii) the right of distribution; (iii) the right of rental; and (iv) the right of making available.

The treaty must now be transposed into countries' national laws. The "Beijing Treaty in Africa" series tracks the implementation of the treaty across Africa. Even though Nigeria has not yet implemented the agreement in its national laws, the Nigerian Copyright Commission is committed to reevaluating the draft of the Copyright Bill of 2015 so that it incorporates the Treaty.

On an additional note, the executive secretary of the Lagos State Film and Video Censors Board (LFVCB) intended to introduce a 5 percent tax on audio and visual content produced, sold, distributed, marketed, exhibited, streamed, downloaded, and shared across all physical and digital platforms in Lagos State. The 5 percent tax on digital platforms was intended to affect digital platforms such as Netflix and IrokoTV, but it was not implemented.

In addition, the Nigerian National Broadcasting Commission (NBC) also released the Amendment to the Sixth Edition of the Nigerian Broadcasting Code. The commission, established in 1992, is responsible for regulating and controlling the broadcast industry in Nigeria, as well as setting standards about the content and quality of materials for broad-



cast. The amendments include the prohibition of broadcasters and licensees in a dominant position to enter any form of contract that has as its object the prevention or restriction of competition in the broadcast media industry in Nigeria. In addition, the amendment also includes provisions regarding the acquisition of sports rights, particularly when the acquisition of rights to sporting events for Nigeria must be reasonable in comparison with other territories of similar economic indices.

NBC must also ratify all sports rights' acquisitions before broadcast, and it has appointed itself as a compulsory arbitral institution to arbitrate regarding commercial disputes arising between licensees and rights' owners. The new edition of the Nigerian Broadcasting Code also includes provisions related to compulsory licensing. Such provisions prohibit broadcasters and licensees from entering any form of broadcasting rights' acquisition in Nigeria to acquire any broadcasting rights that exclude broadcasters in Nigeria from sub-licensing the same.

#### Court cases

2020 was a very productive year in terms of copyright jurisprudence. The year started with a decision from the Federal High Court of Nigeria (Lagos Judicial Division), regarding a copyright infringement dispute between Onyeka Onwenu and digital music distribution company iRoking.

The Nigerian musician and actress have sued the online music distribution platform over alleged copyright infringement, following an expired contract. According to Onwenu, the online platform blatantly disregarded the lapse of their two-year contract and continued to profit from sales of her music. The court ruled that by continuing to display her music, the music company was liable for copyright infringement and has awarded damages to the musician.

In May, the Federal High Court in Abuja ordered the National Universities Commission (NUC)

and telecommunications network Airtel to pay punitive damages to TV Xtra Production, a company that designed a quiz programme named "University Challenge". After the production company contacted the NUC to see if it would endorse the programme, Airtel aired a similar show, "Zain Africa Challenge", with the NUC's endorsement. The judge held that the defendants' actions clearly breached the plaintiff's copyright.

In a different case, the Court of Appeal of Nigeria (Lagos Division) in June awarded punitive damages to the collective management organisation Musical Copyright Society Nigeria (MCSN) against Nigeria's largest cable TV provider Multichoice. The latter sued MCSN, arguing that the collective management organisation was not licensed by a National Certified Counselor (NCC) and, therefore, Multichoice was not obliged to pay royalties for copyright-protected material used in TV programming.

The Federal High Court decided that an NCC licence was not prejudicial to the protection of copyright, with this ruling being upheld by the Court of Appeal last year.

Finally, the Federal High Court of Lagos has prohibited the Copyright Society of Nigeria from distributing royalties to its members as a "general distribution", and considered that such practice was deemed to be contrary to the provisions of the management organisation's memorandum and articles of association.

The court decided that the distribution of a fixed amount to each member as royalties, irrespective of whether such members' works earned any royalties, was illegal.





# The interrelation between NFTs and Copyright

Júlia Alves Coutinho

Europe

NFTs (nonfungible tokens) are the hot topic of 2021 and will possibly remain so throughout this decade, due to their technical properties.

Understood as one of the generators of digital technical scarcity due to their nonfungible, NFTs are digital certificates or digital authenticity seals that grant ownership of an asset represented as an NFT verifiable via blockchain entry.

The creator becomes the owner of the original file and, consequently, of a set of authorizations regarding the use of this NFT. Most NFTs are registered on Ethereum's blockchain, a decentralized platform that supports the recording of extra information that differentiates an ETH (Ether - Ethereum's cryptocurrency) from an NFT (unique asset).

An asset represented by NFT can be an immaterial asset, such as meme, tweet, GIF, digital artwork, music, electronic game prop (gun, clothes, etc.), software, etc. or it can be a virtual representation of a material asset, such as painting, real estate, car, game collectable (a player's card, for example), etc. NFTs are created and made available on various platforms, such as Makerspace, OpenSea, Nifty Gateway, Rarible, SuperRare, among others.

Although anyone can have access to an item associated with an NFT, they will only have a programmable certifiable copy of this item, they will not be the owner of the original version. Moreover, this item may still be available online, for example, visible to everyone, so what you acquire is not the item itself, but rather the digitally authenticated version of this item. The ownership of an NFT allows its owner to use it when listening to the music when exhibiting the artwork, as well as enables it to transfer the ownership of the token to a third party. This digital certificate is securely stored in a digital wallet, while the transaction is carried out and registered in a blockchain. The blockchain transactions are traceable, transparent, immutable and verifiable by anyone. The distributed nature of blockchain platforms, combined with the consensus mechanisms employed, make forging fake transactions unfeasible.

#### How does it relate to copyright?

Despite these characteristics, the identity of the entities carrying out these transactions are not traceable, as it is impractical to identify the authorship of an NFT. Anyone can use the copyrighted content - of which they are not the owner - to create an NFT unduly and market it on various platforms for this purpose, making cases of art fraud in the virtual environment commonplace.

It should be noted that in addition to the ownership of an NFT does not entitle the owner to the ownership of the item associated with an NFT, as previously mentioned, the ownership of an NFT does not confer its owner the intellectual property of the asset represented in the NFT, i.e. the owner of an NFT does not become the author of the artwork. Copyright remains with the creator of the work of art, painting, music, etc., unless the commercialization of NFT includes the transfer of the property right of the author to the purchaser of NFT, it being certain that the personal/moral right of the author remains in the legal sphere of the creator.

[...]





# The rise of amapiano and its appropriation

Inês Sequeira



The worldwide success of African music hits can lead to mixed feelings: happiness over its long-deserved recognition, but also concern that the artists will not get their dues.

By early 2019, amapiano, a style of house music that emerged in South Africa in 2012, had taken over the radio and clubs of South African townships and made stars of artists such as DJ Stokie, Junior Taurus, MFR Souls, Mr JazziQ and Josiah De Disciple, and Kabza De Small.

Producer DJ Maphorisa credits De Small, a 28-year-old DJ and producer from Pretoria, with being one of the first acts to lay vocals over amapiano beats. Amapiano borrows from the South African genre of Kwaito, while the music itself blends elements of Kwaito with jazz and deep house.

"There is a big debate about which township amapiano originated from. The truth of the matter is that amapiano was born in the soil of the streets of South Africa. Therefore, it belongs to all of us," Small said in the documentary "Shaya!".

Amapiano is popular in South Africa, but it has gone beyond borders. On the TikTok social media platform, the #amapiano hashtag stands at more than 570 million views and shares of global streams on the AmaPiano-Grooves playlist on Spotify have increased 116% globally over the past year.

Amapiano is a proudly South African genre that encompasses not just a sound, but also a South African lifestyle—and it may be the next Africa's next global hit.

#### New song brings global interest

In August, British singer Jorja Smith published on social media the popular catchphrase "Piano to the World" used by South African amapiano artists to express their wish to take the genre global. The phrase was related to her latest single "All of This". After an initial enthusiasm, this joy quickly dissipated, and a debate started in social media. Negative comments pointed out a watered-down and "westernised" version of amapiano and that Smith had made a bad call for enlisting the Ghanaian producer, Guilty Beatz.

Maphorisa, one of the most prominent producers in South Africa, commented: "If you don't involve us, it's not amapiano. Trust me, you can't eat alone on amapiano—it's a community movement but we don't mind sharing." The immediate backlash from prominent South African amapiano artists has made it clear that it is unacceptable to co-opt the genre without "paying dues". This means not only crediting its pioneers, but also reaching out and collaborating with its producers and artists who know the genre better than anyone else. It appears that Smith and her team have contacted Maphorisa and that the song has been sent to him and he would be "fixing it", according to an article by The South African.

The situation should serve as both a wake-up call and a call to action for South Africa's amapiano artists, as they must be concerned regarding export and appropriation by overseas artists without their involvement.

For this, it is extremely important that artists are acquainted with the copyright system in South Africa.

#### Copyright in South Africa

Copyright refers to the rights that creators have over their literary and artistic works and



protects the creators against third parties wanting to take ownership of their work or use it in a different way from the one they proposed originally, without their authorisation. This protection, which is embodied in the exclusive right of economic exploitation of the holders of copyright and related rights in relation to their creations, allows the creators to be fairly rewarded for their work. On the other hand, copyright legislation imposes limits on the exclusive rights of the authors, allowing the diffusion of their works and the development of creativity based on these intellectual expressions, which can serve as inspiration for the creation of other works, that may also be subject to protection by copyright.

South Africa is a member of the Berne Convention of 1886 (an international agreement on copyright by which member countries grant each other copyright protection) and the Rome Convention of 1961. The country's Copyright Act of 1978 (Act no. 98 of 1978) has undergone several changes over the decades. The Copyright Act protects certain classes or categories of works. For a work to be eligible for copyright protection, it must be original and in a material form. The following works are eligible for copyright in South Africa:

• Literary works (eg, books and written composition novels).

• Musical works (eg, songs).

• Artistic works (eg, paintings and drawings).

• Cinematograph films (eg, a programme-carrying signal that has been transmitted by satellite).

• Sound recordings.

• Broadcasts (eg, broadcasting of films or music).

• Programme-carrying signals (eg, signals embodying a programme).

• Published editions (eg, first print by whate-ver process).

• Computer programs.

Generally, in respect of written material, the following guidelines apply:

• Wherever possible, the author's permission should be sought to reproduce his/her work.

• If in an article, paper, or speech, when referring to the work of another, it is required that details of the reference be provided in the form of the name of the author and details of his/her publication.

• If only a small portion of the work is used, say a few sentences or a paragraph, and provided that an acknowledgement is made, permission is not needed.

• If a "significant" section is reproduced, such as a chapter, then permission should be obtained.

• It is generally accepted that work that is being used in academic institutions, research or for private use may be reproduced.

The lifespan of copyright depends on the type of work protected. For sound recordings, the copyright lasts for 50 years from the day the work was first broadcast. Generally, a person who has written, printed, published, performed, sculpted, painted, filmed, or recorded a work, is automatically the owner of the copyright to that work. Sometimes, when a person has been commissioned and paid to do a particular piece of work, the copyright belongs to the employer.

For most works (except films) it is not necessary to apply for copyright protection as it automatically exists.

Copyright is referred by way of placing the words "copyright" or "copyright reserved" or "copyright Smith 2011" (ie, copyright, followed by name and the year), or the copyright symbol, name and year (eg, "© Meati 2011"). It is possible to obtain copyright protection in South Africa when the applicant is South African or if the work was produced in South Africa. When the applicant is not South African, it is possible to obtain copyright protection provided the applicant's home country is part of the Berne Convention.





# 50 years of Intellectual Property in Africa

Inês Alves Monteiro; Inês Sequeira; Inês Tavares; Diogo Antunes

Africa

In relation to the 50th anniversary of Inventa, we have been given the challenge to analyze certain intellectual property data over the past 50 years on the African continent.

As it is impossible to cover a panoramic view of the various events, we chose just a few topics we found interesting for this minor-scale study. At the outset, it seems important for us to outline a short introduction about the African continent and the protection of industrial property in the countries of which it is made up.

Since the start of the new millennium, Africa's economic growth has accelerated its pace and the GDP has been rising by around 5% per year, with salaries per capita has risen by 2.1% a year. The infrastructure in the countries is more developed and resources such as water, electricity and internet are increasingly accessible to a large part of the population, even in predominantly rural areas, which contributes to the prosperity and development of the economy.

The poverty rate has been falling, for the reasons set out above. Since the year 2005, about eight million people have ceased to be in poverty and the ratio of people living in extreme poverty (under US\$1.25/day), especially in Burkina Faso, Ghana, Malawi, Mali, Mozambique, Rwanda, Senegal and Uganda has fallen by about 50%.

Without any doubt, human capital is the key to the good conduct of the growth of the African continent at all levels. Over the last twenty years, the population of Africa has increased by about 2.5% per year and, in 2011, the number of people living on the continent has surpassed the one billion mark. It is estimated that by 2050 some African countries will have doubled and tripled their population, making Africa the region with the highest population growth today.

In 2020, in view of the global pandemic that has ravaged the world, Africa, like all other continents, has slowed and seen a slight downturn in its economic growth.

Yet Africa is still a very rich continent in terms of natural resources, though its countries continue to be highly dependent on imports, a factor that turns out to be very attractive for investors and companies.

In this context, we know that registering and protecting industrial property is fundamental for operations in each and every country on the African continent.

Many countries here are still developing and despite all progress, remain particularly problematic with regard to infringement of intellectual property rights and counterfeiting thereof. In addition to the registration at National Offices, it is also extremely advisable to proceed to register the rights at Customs Houses, whenever possible and in countries where this service is available.

Registering industrial property rights in Africa can be a lengthy process and at times complicated so it is important for companies to seek good advice in this area. Some local professionals are unreliable and can leave cases pending and clients unanswered, and it is extremely important to look for trusted firms.



The registration process for trademarks, patents and industrial designs may vary, but on average the minimum and maximum time varies between nine months and a year and a half. Most countries do not require a power-of-attorney and legalized or notarized documents, which greatly facilitates the streamlining of registration processes, but other countries such as Angola, Rwanda, Cape Verde, Egypt, Ethiopia, Liberia, Libya, Madagascar, Mauritius, Mozambique, Sao Tome and Principe, Seychelles, South Sudan and Sudan still require the notarization and legalization of documents for registration of IP rights.

Having set out this short introduction on the African continent and the protection of intellectual property rights in the countries of the continent, we will now make a brief analysis of the evolution of industrial property laws in the last 50 years.

### The current Industrial Property laws on the African Continent

In drawing up this study, data were compiled on the latest Intellectual Property Laws in the various countries that make up the African continent. If we go back in time, precisely 50 years, to the year 1971 we notice that many countries had just become independent or some countries were in the process of becoming independent.

It is therefore natural to find IP laws enacted after the independence of some countries that have crystallized in time. In various countries, such as Angola, independence did not bring immediate peace to the country and the pacification processes lasted several years. It is therefore normal to see that the countries with the highest political stability appear in the list below with the most recent IP laws. Perhaps, because there needs to be social and political peace in order to design and update IP protection systems.

In the following table, is it possible to see is a listing of the year of introduction of the national laws on the protection of trademarks, patents and designs, followed by the year they

Jurisdiction	Law	Joined WIPO	Joined Madrid Protocol	
Algeria				
Angola	1992	1985		
ARIPO				
Botswana				
Burundi				
Cape Verde				
Congo (D.R.)				
Djibouti				
Egypt				
Eritrea				
Eswatini				
Ethiopia				
Gambia				
Ghana				
Kenya				
Lesotho				
Liberia				
Libya		1976		
Madagascar				
Malawi		1970	2018	
Mauritius				
Morocco		1971		
Mozambique				
Namibia			2004	
Nigeria				
OAPI			2015	
Rwanda			2013	
Sao Tome			2008	
Seychelles				
Sierra Leone				
Somalia				
Somaliland				
South Africa		1975		
South Sudan	1969 (still no actual law)			
St. Helena				
Sudan			2010	
Tanzania				
Tunisia			2013	
Uganda				
Zambia				
Zanzibar				
Zimbabwe	1974			

joined the World Intellectual Property Organization and, lastly, the year they signed up to the Madrid Protocol for all the countries on African soil.

In the first place, we can see those various countries whose national laws accompanied human and technological evolution and chose to harmonize them in accordance with existing international and regional treaties. It can therefore be said that the countries most developed today in the African socio-economic context are those that opted to update their intellectual property laws.

It is therefore not strange to see countries in North Africa, such as Algeria, Egypt, Tunisia, Libya, Liberia and Morocco, with laws more current than other countries on the African continent. On the other hand, we also see countries such as Liberia, Libya, Madagascar, Malawi, Mozambique, Namibia, Rwanda, Sao Tome and Principe, Seychelles and Sierra Leone with relatively up-to-date for the international scene, which is, of course, to be praised. On the other side of the coin, we find countries that curiously are great economic



powers on the Continent, but which have extremely backward laws, and this has had repercussions on the absence of effective legal mechanisms for combatting infringements of intellectual property rights. Examples of such countries are Angola, the Congo and Nigeria.

Secondly, it seems important to praise the efforts made by some African countries in creating and signing up to regional agreements relative to intellectual property protection. Thus we have the African Intellectual Property Organization (Organisation Africaine de la Propriété Intellectuelle), created through the Bangui Agreement, signed in 1977, in the capital of the Central African Republic, from where it gets its name. This organization, which currently has 17 member states, all mostly French-speaking, provides a centralized registry at the organization which automatically extends to all member states, namely Benin, Burkina Faso, Cameroon, the Central African Republic, Chad, the Congo, Ivory Coast, Equatorial Guinea, Gabon, Guinea, Guinea-Bissau, Mali, Mauritania, Niger, Senegal, Togo and the Comoro Islands. Moreover, it is possible to find ARIPO (The African Regional Intellectual Property Organization), created through the Lusaka Agreement, signed in the year 1976, which enabled the creation of a regional African organization for the protection of intellectual property, providing a centralized body for registering IP rights, not unlike the International Registry of Madrid, that is, through the designation of states.

ARIPO has various different agreements for each of the rights, the Banjul agreement being related to the protection of trademarks comprised of the following members: Botswana, Lesotho, Liberia, Malawi, Mozambique, Namibia, Sao Tome and Principe, Swaziland (e-Swatini), Tanzania, Uganda and Zimbabwe. In contrast, the Harare Agreement refers to the protection of patents and comprises the following member states: Botswana, Gambia, Ghana, Kenya, Lesotho, Liberia, Malawi, Mozambique, Namibia, Rwanda, Sao Tome and Principe, Sierra Leone, Sudan, Swaziland, Tanzania, Uganda, Zambia and Zimbabwe. Naturally, this effort by countries to integrate these regional organizations, thus harmonizing their intellectual property laws, allows for greater effectiveness of the intellectual property rights and also contributes to the legal security thereof.

Thirdly, a final remark on African countries joining the Madrid system. As known, the Madrid system refers to an international trademark registry mechanism, administered by the World Intellectual Property Organization (WIPO).

This system provides for the centralization of applications before WIPO, followed by a process of grant and registration by each one of the designated countries. In this regard, just as in most countries of the world, it is also possible to find several African countries that are part of the Madrid system (either the Agreement or the Madrid Protocol). It can be seen a large proportion of African countries that are part of the Madrid system are those which curiously have opted to update their laws protecting intellectual property over the years. In contrast, it is possible to find countries that occupy top places as veritable African economic powers which do not update their intellectual property laws, or sign up to major international agreements, as is the case of the Madrid system.

Unfortunately, as mentioned previously, an outdated system for protecting intellectual property only allows the system to find flaws and is vulnerable to infringement by offenders who find the loopholes needed in the system to profit from it.



## What has changed in the IP over the last 50 years? The accelerated synchronization of the world

João Pereira Cabral

Worldwide

#### Intellectual property

The intellectual property (IP) firm Inventa completed 50 years. With regard to this celebration, we set out to observe what has changed in the IP in the last five decades. Intellectual property is a field of the legal system that regulates the use of intellectual assets. IP rules provide that various intellectual assets may be subject to intellectual property rights. Artistic work can be the object of copyright, a mark can be the object of a trademark right, an invention can be the object of a patent right and the design of a product can be the object of design rights. These rights essentially consist in the holder being able to use those assets exclusively, for a period of time.

The legal system regulates almost all situations with legal relevance. However, as situations evolve, the legal system sometimes needs to adapt. The world has changed a lot in the last 50 years, so the legal system and, in particular, IP rules, have also changed.

#### Globalization and the evolution of supranational IP rules

Globalization and international trade have intensified. This fact collided with one of the IP principles, which is territoriality. In almost

every country, IP rights are territorial. This means, for example, that a patent granted for an invention in a certain country gives its holder a right to exclusively use that invention only in that country. If that holder is interested in marketing the product with exclusivity in other countries, a patent will have to be obtained in each of those other countries. It is evident that this principle of territoriality, which still exists, is an obstacle to the internationalization of protection. So were the differences in national legislation. Consequently, international treaties emerged with the purpose of facilitating internationalization and bringing national legislation closer together.

According to the World Intellectual Property Organization (WIPO) database, there are 208 international treaties that regulate matters related to IP. Of these 208 treaties, 48 were adopted before 1970, and the remaining 160 were adopted after that date.

The chart below shows that the growth in the number of treaties was accentuated in recent



#### Treaties with some relation to IP





Fonte: Inventa ©

decades, especially in 1990 and 2000. This growth is also verified in relation to IP treaties, that is, treaties whose main object is IP. According to the aforementioned WIPO database, these treaties are 77, with 27 having been adopted until 1969 and 50 since 1970. In other words, since 1970 almost twice as many IP treaties were adopted as had been adopted until that date.

The analysis by decade shows that the 2010's was the one with the highest production of IP treaties, followed by those of 90's and 70's. This shows an increasing trend.

Although some of the most important IP treaties are more than a century old, such as the Paris Convention for the Protection of Industrial Property (1883), the Berne Convention for the Protection of Literary and Artistic Works, (1886), and the Madrid Agreement Concerning the International Registration of Marks (1891), or almost a century, like the Hague Agreement Concerning the International Registration of Industrial Designs (1925), the intensification of global trade in recent decades has led to the intensification of the approximation of national laws on IP matters

#### Number of treaties directly related to IP



Fonte: Inventa ©



and the facilitation of internationalization through new treaties and other supranational sources of Law.

Some of the most important IP treaties have been adopted over the past 50 years. In 1970, the Patent Cooperation Treaty was adopted, with the purpose of, among others, according to its preamble, "simplifying and making it more economical to obtain protection for inventions when requested in several countries."

In 1989, the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks was adopted, aiming to make the Madrid system more flexible and more compatible with the domestic legislation of some countries or intergovernmental organizations that had not been able to access the Agreement. It is this Protocol that currently allows the international registration of trademarks, enabling, with a single application, a trademark to be registered in several countries, reducing procedures and costs. In 1994, the Agreement on Trade-Related Aspects of Intellectual Property Rights was adopted, with the desire to, among others, "reduce distortions and impediments to international trade", recognizing that for this it is necessary to establish "adequate standards and principles concerning the availability, scope and use of trade-related intellectual property rights".

Evolution also took place at the regional level. In 1973, the European Patent Convention was adopted, which established the European Patent Organization (EPO) and the possibility of obtaining a European patent.

Also in Europe, with the European Community, the community trademark and the registered community design emerged, which allowed the protection of marks and product designs in the territory of the now European Union (EU), with just one application and one procedure. In recent decades, EU harmonization laws have made the IP law of Member States very close, and in many respects identical. In Africa, in 1976 the Lusaka Agreement for the creation of the African Regional Intellectual Property Organization (ARIPO) was adopted, and in 1977 the Bangui Agreement Relating to the Creation of an African Intellectual Property Organization (OAPI) was adopted. In 1994 the Eurasian Patent Convention was adopted, which established the Eurasian Patent Organization (OEAP).

In Asia, in 1995 the ASEAN Framework Agreement on Intellectual Property Cooperation was adopted.

"These intellectual assets, not being works, not being inventions, not being distinctive signs of trade, nor being the appearance of a product determined for aesthetic reasons, could not be protected by existing intellectual property rights. The solution, in some countries like Portugal, was the creation of a specific right."

#### New realities and updating IP law

But the changes to IP rules were not exclusively due to the objectives of global and regional harmonization of IP rules and the facilitation of international and regional protection. Other changes, in addition to the intensification of international trade, forced the adaptation of IP law.

The changes were mostly technological. As a general rule, existing IP law is able to provide adequate protection for new technologies. If a patent, a design registration and a copyright can only be attributed to an invention, a design and an artistic work that are new, the novelty is a presupposition of the IP system, so the system is prepared for the innovation because it exists precisely for it.



However, the system is prepared for assets like these that are new and not for other kinds of assets. In other words, it is prepared for artistic works, inventions and designs that are new, but it is not prepared for new assets that are not works, inventions and designs.

Computer programs, for example, were one of the main assets that IP law had to come to terms with. However, it was not necessary to create a new right.

Software was equated with artistic works and protected by copyright. In situations where they consist of technical inventions, they are cumulatively protected by patent.

However, new technologies consisted of intellectual assets that could not be equated to assets susceptible to protection by existing IP rights. An example is the topographies of semiconductor products. These intellectual assets, not being works, not being inventions, not being distinctive signs of trade, nor being the appearance of a product determined for aesthetic reasons, could not be protected by existing intellectual property rights. The solution, in some countries like Portugal, was the creation of a specific right.

But technological innovation didn't just result in new intellectual assets that needed protection. Technological innovation resulted, above all, in new ways of using intellectual assets. If television and radio made possible new ways of using works, through broadcasting, the internet did the same, later, but in a more intense and extensive way. In the last decades of these last 50 years, the most important adaptations of the IP rules were due to the use of intellectual assets on the internet.

If a company from a particular country sets up an online store using its EU registered trademark, it will, in principle, be using its trademark in any country with access to the online store. If in another country there is the same registered trademark, there will potentially be trademark infringement. The internet has also made it possible to make available to the public works protected by copyright. Consequently, it enabled not only new ways of retribution to copyright holders <u>but also new ways of infring</u>ing those rights.

In recent years, it has been mainly the online use of copyrighted works, also a global problem, which has been at the origin of new IP rules.

ΕU directives Examples of this are 2014/26/EU, of 26 February 2014, on "collective management of copyright and related rights and multi-territorial licensing of rights in musical works for online uses in the internal market" and No. 2019/790, of April 17, 2019 "copyright and related rights in the Digital Single Market and amending Directives 96/9/EC and 2001/29/EC", adopted due, according to its preamble, to the "Rapid technological developments [which] continue to transform the way works and other subject matter are created, produced, distributed and exploited", and by continuing to emerge "new business models and new actors".

#### The next 50 years

It is not possible to predict what will happen to the IP in the next 50 years, as the speed of change is increasing. This increase in speed is reflected in IP rules, changing them, and is reflected by the increasing volume of supranational and regional IP rules. With legal scientists increasingly in contact and the legal problems of IP being increasingly global, the trend should be towards accelerating the harmonization of IP rules, although, the some ideological porosity to which this area is subject, may delay that harmonization or even maintain some differences.





# IP as a tool for economic growth in Nigeria

Oyebola Coker



Over the years, concrete efforts have been made to develop Nigeria's indigenous IP regime. The earliest attempt at developing Nigeria's IP dates to post-independence Nigeria. However, these various attempts have not been fruitful as Nigeria has failed to fully exploit the benefits that could be accrued from proper management and protection of Intellectual Property Rights in the country. The current economic and trade conditions in the world is susceptible to change, therefore requiring constant improvement to ensure economic development. These conditions will stimulate innovation and improvements in Nigeria's technology, designs, and other tangible and intangible assets. It will also create incentives for Nigerians to invent continuously by providing some form of compensation and guarantee that innovations will be credited to the true inventors. This can only be achievable through the promotion of intellectual property rights and provisions of competent IP policies to promote economic development in Nigeria.

## IP can benefit the Nigerian economy in numerous ways:

One of the most intriguing benefits of Intellectual Property is its ability to influence investment. IP can attract foreign direct investment and provide the necessary conditions for the transfer of technology. This is evident in the number of investors from Europe and America that invest directly in tech startups in Nigeria. IP also facilitates the transfer of technology such as patent licensing through an active use of patent information. There is no doubt that IP protection plays a catalytic role in inspiring research and development in a country. Therefore, the effective commercialization of IP is indeed a significant stimulus to the economic growth of Nigeria, if properly managed and adequately protected.

#### IP Challenges in the Nigerian Economy

The IP regime in Nigeria has a lot of challenges. These challenges have hindered the growth and development of IP in Nigeria and caused a setback in the various attempts to fully commercialize IP in Nigeria. One of the dominating challenges of IP in Nigeria is the lack of proper sensitization on the various benefits that could be gotten from IP. Also, most Nigerians are ignorant about their IP rights due to the absence of educative IP seminars for potential IP owners, non-incorporation of courses on IP in the curriculum of Nigerian Universities, amongst other inherent challenges.

Another challenge with IP in Nigeria is the passive involvement of the Government in Intellectual Property Law. It is apparent that most Nigerian IP laws are archaic and outdated. For instance, the Trade Marks Act was enacted in 1967 (which is a re-enactment of the UK's 1938 Trade Marks Act).

[...]



# Intellectual Property - A story of two SMEs

João Pereira Cabral

#### Worldwide

Every year, since the year 2000, World Intellectual Property Day is celebrated on April 26. Every year, the World Intellectual Property Organization chooses a theme for this celebration. In 2021, the chosen theme was the importance of intellectual property (IP) for small and medium-sized enterprises (SMEs), when they bring their ideas to the market.

IP is not necessarily decisive in the success of an SME. It is possible for an SME to have business success without protecting its products, and it is also possible for an SME to protect its products and not have business success. However, when an SME introduces a product to the market, its behaviour in relation to IP can be decisive. The cautionary story of two fictional SMEs told below, tries to highlight this importance.

#### Intellectual property rights

Two SMEs, SME-A and SME-B invest, separately, a few thousand euros in the development of a footwear product. The products of the two SMEs are innovative sneakers.

SME-A's sneakers allow the user to receive information about their activity during use, such as distance travelled and speed. This and other information is received by the user in an app created by SME-A. The SME-B's sneakers have a technical solution that allows the user to have information about their way of walking and running, also in an app created for this purpose.

In addition to these technical innovations, unique designs are created for both shoes. Finally, the two SMEs create a brand for their new product. The products are ready to be sold. SME-B, impatient to cover the costs it had with the development of the product and perhaps start to make a profit, introduces the product to the market. The product is an immediate success and SME-B is satisfied.

On the other hand, SME-A, before introducing the product to the market, seeks assistance from a trademark and patent attorney (TPA) to protect its product. The TPA informs SME-A that its product includes several intellectual assets that may be subject to intellectual property protection. The technical solution that allows the user to be informed of his activity with the sneakers through the app is an invention, so it can be patented if it is new and sufficiently inventive in relation to the inventions already known in the world. The design of the sneakers (their appearance) can be protected by registering a design, as long as it is new and has individual character in relation to any design already known. The texts, music and other content created for the app and the app itself, in part, will be protected by copyright, as long as they are new and original. Finally, the TPA indicates that the brand may be protected through trademark registration, insofar as there is no registered trademark similar to the point that the two are confusing for consumers.

Upon hearing all this information, SME-A doubts whether to use more financial resources on this product. The investment in its development was high and it has not yet introduced the product to the market, so it has not yet recovered any part of the investment. These additional expenses may be unbearable. Meanwhile, SME-B continues to market its innovative product successfully and to profit, without having had any IP costs.



#### Obtaining intellectual property rights

SME-A ends up accepting the TPA recommendations and learns how to obtain intellectual property rights on the identified intellectual assets. With the exception of copyright, which exists from the moment of creation of the works, the remaining intellectual property rights will only exist with the granting, by an administrative entity, of a patent for the invention (technical solution) and of registrations for the design and for the brand. TPA also recommends the registration of works already protected by copyright because, despite the fact that the right already exists, proof of its authorship may be difficult without registration.

SME-A also learns that intellectual property rights are territorial, that is, that a patent granted in a country, only takes effect in that country, so if protection is needed in other countries, different procedures will be necessary for those countries. Design and trademark registrations and patents will be required in these countries.

The costs will be high. However, SME-A is satisfied with the information that the internationalization of the protection may be delayed over time. SME-A may start by submitting applications only in its country, after which it has one year to apply for patents and six months to apply for design and trademark registrations in other countries. International and regional applications will lower costs and procedures times.

SME-A decides to proceed with the services proposed by the TPA. They begin by conducting searches to assess whether the patent and the design and trademark registrations will be accepted. The patent and the design registration will, in principle, be granted. However, they discover that there is already a similar trademark, so the trademark registration shall be refused. SME-A creates a new mark that can be registered. Fortunately, SME-A had not yet had marketing costs in relation to the non-registable mark. Applications are submitted and, with the provisional protection they provide, SME-A finally introduces the product to the market.

# The exercise of intellectual property rights

The two SMEs market their products which, although competing, are both successful. The SME-B product has a larger market share, as it has been on the market for a longer time. SME-A, in addition to having a lower market share, continues to have costs with the maintenance of the intellectual property. Every year it must pay the patent maintenance fee, every five years the design registration fee and every ten years the trademark maintenance fee will have to be paid. SME-A continues to doubt whether the costs with IP are worth it.

However, an international company in the footwear sector, observing the success of the two SME products, intends to introduce a similar product on the market, preferably by combining the two technologies, choosing one of the sneaker design and using its prestigious international brand.

The international company conducts audits of the intellectual property of the two SMEs and discovers that it will be able to freely use the non-patented technology and the unregistered design of the SME-B. On the contrary, it will not be able to use, without the authorization of SME-A, its patented technology and its registered design.

The international company presents a proposal to SME-A to acquire its patent on the technology of the sneakers and the registration of the design or, for a lower price, an exclusive license to explore the invention and design. With the transfer, the patent and registered design rights would definitively be transferred to the international company. With the license, the rights would continue to be SME-A's, which would receive royalties in exchange for permission to the internatio-



nal company to use these intellectual assets. Considering the proposed values, SME-A accepts the transfer proposal. Also, the copyrights on the app and its contents are transferred (economic rights), and they are for a higher value than they would be if they were not registered.

SME-A uses the money received to reinvest in the creation of new innovative products. Additionally, it maintains its registered trademark, which has acquired some notoriety in the market and which SME-A will be able to use in the new products it will create.

SME-B observes its market share decreasing very rapidly, with the entry of the international company's product in the market, which combines SME-B's technology with the technology acquired from SME-A. SME-B also realizes that other companies sell sneakers with a design similar to its own.

SME-B finally uses an IP lawyer to act against the imitation of the invention and design. To SME-B's shock, the lawyer informs that the probability of being able to prevent those uses is practically nil. The use of the invention by the international company cannot be prevented because the invention has not been patented and can no longer be, as it has already been disclosed. Similarly, the use of the design by several companies cannot be prevented either, because it has not been registered, and the SME-B does not have any exclusive use rights over it. It was for this reason that the international company was not interested in using the SME-B design: any company will be able to use it. Due to the dissemination and commercialization, the design can no longer be considered new, so it can no longer be registered.

When sales are almost no longer enough to pay expenses, SME-B receives a letter. The letter is from a company that has learned that SME-B has used a trademark identical to its registered trademark during the past three years. For having infringed its trademark right, the company seeks compensation from SME-B. SME-B never registered the brand or even checked if there was already an identical registered trademark before starting to use it. The company is entitled to compensation from SME-B. SME-B declares itself insolvent.

The managers of the defunct SME-B, after some indignation, understand, finally, that the general rule is the freedom of imitation and that this freedom is only excused when there are intellectual property rights (or in some very specific situations of unfair competition). Meanwhile, SME-A is no longer an SME.





# The essential role of IP to SMEs in Nigeria

Oyebola Coker



A successful IP system is crucial to the growth of small and medium enterprises in Nigeria, however, there are some major challenges hindering its development.

Small and Medium-scale enterprises (SMEs) are the result of continuous human innovation and creativity, which serves as the running engine through which the economy survives. They contribute immensely to the development of entrepreneurial skills amongst the population, employment generation, poverty elevation, structural transformation of rural areas, industrial spread, amongst others and therefore there is a need for these to be promoted and protected.

After Nigeria's independence from the British colonial rule in 1960, SMEs were radically promoted by the Federal Government as a means of reducing the incidence of poverty and unemployment in the country with the reform several economic adoption of programs like the establishment of the Nigerian Industrial Development Bank in 1962 with a special unit that focused on SMEs financial requirements, the Small Scale Industries Credit Scheme, the World Bank SME I Loan Scheme and the World Bank SME II Loan Scheme in the 80s and 90s.

More recent programs like the establishment of the Bank of Industry to provide credit facilities to SMEs at an interest rate of 10 percent, the Small and Medium Enterprises Credit Guarantee Scheme in 2010, the Central Bank of Nigeria's Real Sector Support Facility in 2014 and finally the establishment of the Entrepreneurship Development Centers in various parts of the country, were aimed to develop strong SMEs that can compete globally and contribute to the national growth and development.

"According to the Nigerian Bureau of Statistics, small and medium scale enterprises (SMEs) in Nigeria have contributed about 48% of the national GDP in the last five years. With a total number of about 17.4 million, they account for about 50% of industrial jobs and nearly 90% of the manufacturing sector", as PWC Nigeria PME survey states.

The Statistician-General of the Federation and CEO of the National Bureau of Statistics (NBS), Dr Yemi Kale, also revealed that 41.5 million Micro, Small and Medium Enterprises (MSMEs) were registered in 2017, which is a testament to the immense growth of SMEs and a crucial step towards building a flourishing and diversified economy.

However, instead of a slow chain of progress through many decades, IP can significantly accelerate the progress of SMEs, in order for Nigeria to attain a decent level of desired economic development, in line with its vision to be among the leading economies in the world by 2030.

#### How IP Can Benefit SMEs

 IP rights protect inventions and promote exclusivity to control and exploit their creations;

[...]



# The African Continental Free Trade Area: what's the role for IP?

Vítor Palmela Fidalgo



The African Continental Free Trade Area (AfCF-TA) came into effect on January 1, 2021 and is the largest trade area in the world by number of participating countries since the formation of the World Trade Organization (WTO).

The objectives outlined in article 3 of the treaty include the establishment of a common market for products and services, a regional customs authority, enhancing the competitiveness of member states' economies both in Africa and globally, and promoting industrial development.

Considering these objectives, one wonders where the role of IP figures in this agreement, which promises to be a powerful instrument for the economic development of the African continent.

#### IP objectives

IP rights feature prominently in the treaty establishing AfCFTA. First, in article 4 of the agreement, it is established that one of the specific objectives of the agreement will be to make the member states cooperate, among other areas, in the field of IP.

IP features seven more times throughout the text, which underlines the importance of establishing a set of IP rules which are clear, transparent, predictable, and mutually advantageous to the member states. The most relevant provision is article 6: "This Agreement shall cover trade in goods, trade in services, investment, IP rights and competition policy."

Article 7 detailed this matter further and obliges member states to include IP rights in phase II of the negotiations in order to implement the treaty's objectives. In view of the above, I think it can be said that IP occupies a central role in the agreement underpinning the AfCFTA.

There remains, however, some uncertainty as to how the integration of IP rights will be achieved in practice. As we know, IP rights, despite being ubiquitous, immaterial goods are, to a large extent, subject to the principle of territoriality. This means that it remains up to the states to decide whether or not to grant protection, which would not necessarily apply beyond the borders of the state in question.

However, we have already seen the development of regional agreements that complement or supplant the power of states in these matters, granting IP rights that have legal effects in several territories.

In Africa, the two most relevant are the African Intellectual Property Organization and the African Regional Intellectual Property Organization, which have enabled a continental approach to IP matters.

It is legitimate to ask whether the AfCFTA will aim towards the integration of national IP systems or whether this integration will take place at a political level. We believe the latter is more likely and would be a welcome step.

Given our experience of working on IP issues in Africa, we believe that the AfCFTA should focus on the following issues:

(i) Harmonisation of the formal and material protection requirements for IP rights; reduction of the bureaucracy required for the registration application of patents, trademarks or designs;

(ii) The establishment of joint mechanisms to fight counterfeiting;



(iii) Promotion of intellectual assets originating from the African continent, where we can highlight geographical indications and denominations of origin, music, and intellectual assets derived from traditional knowledge;

(iv) Adaptation of civil law mechanisms taking into account the nature of this type of rights; and

(v) The promotion of African research and design structures, producing knowledge that can be protected and exported throughout the world and allowing the parties to the agreement to receive royalties for this transfer of technology. Taking into account the different national interests at play, it is not expected that these matters will be resolved in a short period of time. However, the economic effects of the COVID-19 pandemic may encourage African countries to prioritise the integration of their IP systems as part of a wider programme of economic development.





# Is Mauritius the right choice for holding intellectual property rights?

Vera Albino

Africa Mauritius

**Trademark** 

In a globalized world, driven by the information technologies revolution and the service economy, the tangible assets are less and less valuable, while intangible assets, increasingly valuable, are emerging as the key to success, leading the companies to seek how to best use their intangible assets.

Companies legally protect their intangible assets by acquiring and maintaining IP (Intellectual Property) rights, which turns them into valuable exclusive assets. Robust IP rights and protection are vital for a company to have a strong market position, competitive advantage, higher profit or returns on investments and additional income (from licensing for instance).

It is important to note that brands such as "Apple", which is ranked 1st in Forbes World's Most Valuable Brands - is valued at \$241.2 billion and its revenue is estimated to be \$260.2 billion. Another example would be "Amazon", 4th in the ranking, which is valued at \$135.4 billion, and its revenue is estimated to be \$260.5 billion, the double of its value. In both cases, the brand revenue is higher than the brand value.

Notably, an IP strategy is an essential business tool to protect, monitor and exploit the IP assets, including trademarks, and ensure that the companies derive maximum benefit in a safe environment.

To further secure their IP assets, companies, essentially multinationals and businesses with plans for internationalization, may create a separate company - an IP holding company with the purpose of owning their IP rights. Within this IP holding corporate structure, the parent company's IP assets are assigned to the subsidiary - the IP holding company - which is a non-trading entity, with no contractual or other relationship with customers. Simultaneously, licensing agreements are celebrated between both companies, wherein the parent company, which is an operating company, agrees to pay royalties to the IP holding company, for the right to use its IP. This structure may be composed by many other operating companies or subsidiaries which will also sign licensing agreements with the IP holding company and pay royalties for the right to use its IP.

There are many advantages in separating the ownership of IP rights from the parent company and the other operating companies and bring them under the aegis of an IP holding company. Some of the advantages are:

• Allowing a management centralization of all IP assets of the Group;

• Protecting the IP from claims against the operating companies. Simultaneously, it also prevents the parent company and other operating companies of the group from getting involved in lawsuits concerning their IP;

• Enabling the revenue to be generated in low-tax jurisdictions or jurisdictions that do not tax income received from licensing royalties;

• Enabling the IP to be effectively separated from other assets, thus becoming available to be used as security or to be sold;

• Protecting the IP from hostile takeovers of the parent company;

Attracting investment.



Many multinational corporations that use the IP holding corporate structure, establish their IP holding companies in tax-friendly countries so that the revenues paid by the operating companies to the IP holders (which can be very high in some countries) are taxed at a lower rate.

#### In this context, is Mauritius a possible choice to establish an Intellectual Property holding company?

Mauritius ranks 1st among the 26 Sub-Saharan African economies and 9th among the 37 upper middle-income group economies featured in the Global Innovation Index (GII). Mauritius has multiple bilateral trade agreements with African countries, which shall permit the foreign companies to have preferential access to key African markets.

It is politically and economically stable and it has a very friendly tax regime given that there are no foreign exchange controls and foreign companies enjoy free repatriation of profits. Mauritius also eliminated double taxation with several countries.

As a result, it attracted more than 32,000 offshore companies, emerging 1st for the domiciliation of international companies investing in the African continent. Accordingly, there are strong indications that Mauritius is a great choice to establish an IP holding company, essentially when companies are planning to invest in Africa.

However, besides the political, financial and tax considerations, it is also primordial to consider the level of IP assets protection available in a jurisdiction before transferring any IP to a subsidiary domiciliated there.

In 2019, Mauritius enacted a new IP legislation - the Industrial Property Act 2019 - in order to promote innovation, strengthen the protection of IP rights and, also, to create better conditions to attract high-quality investment. The new legislation shall come into force on a date to be fixed by proclamation. Among many important measures implemented by the new Act, mention shall be made to the extension of legal protection to utility models, new plant varieties, geographical indications and layout-design of integrated circuits.

The fact that the new Act makes provision for Mauritius to adhere to WIPO administered Treaties, namely the Madrid Protocol, as far as trademarks rights are concerned, shall also be highlighted.

There is no doubt, the new law will draw the attention and Mauritius will convince many corporations to create IP holding companies in the country. Thus, we are longing that the new law, adopted already two years ago, will finally enter into force.



# The sugarloaf pineapple: GIs as a development tool in action

Inês Sequeira



The west African nation of Benin has registered its first protected geographical indication at the African Intellectual Property Organisation on 28 October. The honour goes to the sugarloaf pineapple from the Allada Plateau, which has juicy and sweet white flesh, and the distinction of remaining green when fully ripe.

According to the Pan-African Geographical Indications Information Hub website, this registration is the result of several years of collaboration between the government of Benin, industry stakeholders, the European Union (providing technical and financial support) and the French Development Agency (through the Private Sector Stakeholder Support Project) – with additional guidance from the Food and Agriculture Organisation of the United Nations.

The government of Benin is investing in the transformation of its agricultural sector, following an approach that combines the territorial and value chains in homogeneous areas or poles of agricultural development to value its local potential. The government has paid special attention to the development of value chains with high value-added potential, such as the pineapple industry – pineapples are one of the main crops with export potential after cotton and cashew nuts.

The sustainable development of production, efficiency and competitiveness of the pineapple industry has been promoted by a government programme since 2016.

The fruit is grown mainly in the southern and central regions of the country, and 83% of the national production is concentrated around the Allada Plateau in the Atlantic Department. As well as the aforementioned development projects, the European Union is supporting Benin's agricultural sector through a private sector development project, the Projet d'Appui au Développement du Secteur Privé.

The European Commission published a report on Pineapple Value Chain Analysis in Benin, which stated that the cooperation contributes both to fostering a favourable environment for value-chain development, and to promote efficient business models that generate sustainable and inclusive value for the actors involved.

Additionally, it is intended to encourage the establishment of agricultural and industrial clusters and to make the agricultural sector, which employs around 70% of the working population in Benin, a lever for economic development. New areas of production are also progressively emerging.

Since the launch of the African Union Geographical Indications strategy in 2017, a committee has been established with the Commission's Directorate-General for agriculture to guide the implementation of the plan. It is organised by the African Union Commission, the two African Intellectual Property Offices (the African Intellectual Property Organisation and the African Regional Intellectual Property Organisation) and the European Commission. The Food and Agriculture Organisation of the European Union, WIPO and EUIPO are also invited members.

The strategy recognises the limitations of international protection of Geographical Indications and is implementing convergent rules and practices at a continental level. This change will certainly encourage trade and



improve the positioning of African products on regional, continental and international markets.

This first certification for Benin is of utmost importance since a Protected Geographical Indication signifies the quality and authenticity of a product, which has qualities that are specific to a geographical region. This incentivises producers to preserve local knowledge and techniques, and ultimately protects the product. With this certification, Benin gains international recognition of one of its main agricultural products.

The country's entire agricultural sector stands to benefit from the reputational and marketing advantages of the Protect Geographical Indication, which will bring increased revenue for producers.

"It is a very long process, but Geographical Indications represent a real tool for development and, if they are successful, they can bring value to the whole food value chain, including smallholders" refers Sibylle Slattery, project coordinator in the Food and Nutrition division at the Food and Agriculture Organisation of the United Nations.

Furthermore, the protection of Geographical Indications could help preserve and promote Africa's rich agricultural tradition, creating a legal framework based on intellectual property and at the same time contributing to rural development in African countries, since these traditional products might disappear without the added boost given by this form of protection. "The west African nation of Benin has registered its first protected geographical indication at the African Intellectual Property Organisation on 28 October.

The honour goes to the sugarloaf pineapple from the Allada Plateau, which has juicy and sweet white flesh, and the distinction of remaining green when fully ripe."





# Power of attorney: Angolan Court establishes new deadlines

Miguel Bibe



One of the requirements in Angola for the registration of any IP right through a legal representative is a power of attorney on behalf of the applicant.

In cases where the applicants are foreign persons or entities, this document is even mandatory, as they are required to be represented by a local attorney at law, according to article 67 of the Angolan Industrial Property Law (IP Law).

Additionally, for these applicants, it will be required that the power of attorney will be certified at an Angolan consulate or embassy.

However, taking into account that the process of the legalisation and also the time in transit to receive the original document in Angola can take a considerable period of time, there are situations in which it is not possible to wait for the conclusion of the legalisation process, either to guarantee the priority claim deadlines, formal deadlines, or simply for reasons of urgency to move forward to an immediate filing according to the applicant's business strategy.

Although the IP law is silent regarding the possibility of late filing the power of attorney, it is common practice at the Angolan Institute of Industrial Property (AIIP), but in the absence of regulation on this matter, the applicable deadline for late filing is uncertain, especially considering that the different departments of the AIIP apply different deadlines for the late filing of documents, including the power of attorney.

It is accepted that there is no formal deadline for the late filing of the power of attorney until formal examination by the office. Upon examination, in case this document is missing, the office notifies the applicant to submit it. It is in the formal notifications from the office requesting the filing of the missing documents that the departments applies different deadlines.

For example, the patent department usually gives a period of 90 days to file the missing documents; the trademark department usually sets a period of 30 days to file them; and the department responsible for dealing with oppositions and other litigation processes requires the filing of the power of attorney within 15 or 30 days.

#### Case study

It is precisely the question of the number of days assigned to a foreign opposition applicant to submit the power of attorney, following a formal notification, that is the basis for a decision from the Angolan Court, published in the Angolan IP Bulletin No. 7 of 2021.

In this case, the office issued a notification requesting the filing of the power of attorney within 15 days counting from the notification reception date under the penalty of the opposition refusal.

As the 15-day period was clearly insufficient to meet the requirements of legalisation, the opposition applicant submitted a 60-day extension request.

The 60-day extension was refused by the office without explanation; instead it provided a 30-day extension, leaving the applicant with 45 days to submit the original legalised power of attorney.



It was eventually verified that the deadline established by the office was insufficient, since the applicant could submit the power of attorney nine days after the corresponding 45 days deadline.

Based on the fact that the power of attorney was filed after the deadline, the opposition was refused. The respective appeals to the director of the office and to the Ministry of Industry were also refused and an appeal was submitted to the administrative court.

On June 1, 2021, the court decided that the deadline set by the AIIP was not acceptable, mainly due to the incoherence in the establishment of deadlines, where in some cases it was set a deadline of 15 days and in others 30 days, and also due to the time that the legalisation procedure usually takes. In this regard, the opposition refusal decision was revoked.

This decision has already had practical effects on the Angolan registration procedure, with the office issuing Notice no 4/2021 informing that as from July 30, 2021, any act that requires the filing of a power of attorney will have 30 days to file it counting from the filing date, and that it is extendable only once for other 30 days, leaving a total of 60 days for the late filing of the power of attorney.

However, this notice contradicts the possibility of filing 60-day extension requests introduced in March 2020 by the publication of the fees in the Official Gazette (Diário da República).

Conversely, it is also noted that the maximum time frame of 60 days may not be sufficient to finalise the legalisation process and send the original document to Angola since this process can take a long time and be subject to circumstances beyond the control of the applicants.

With the precedent set for filing appeals based on the late filing of the power of attorney after the deadline, following this court decision, it seems clear that the late filing of power of attorney should be within 30 days, with the possibility of extend to 60 days at least, leaving the applicants with a maximum deadline of 90 days to file it in order to have the office requirements consistent with the official fees published in the Official Gazette, which foresees the extension for 60 days, which also seems to be the understanding of the Angolan Court.

#### Other formalities

Given this notice only mentions the power of attorney, it seems that it does not solve the intended issue, namely, avoiding the accumulation of cases awaiting the filing of the necessary documents. This is because in many cases it will not only be the filing of the power of attorney that is necessary to comply with the required formalities.

For example, as well as the power of attorney, for the registration of trademarks, the filing of the applicant's commercial certificate, or for patents, the deed of assignment from the inventor(s) or the Portuguese translation of the specifications, will be required. This means that, although the power of attorney was already filed in the process, the requirements are not fulfilled yet because necessary documents could still be missing.

Presumably Notice no 4/2021 is intended to regulate the late filing of the power of attorney only for opposition matters (where the power of attorney will be the only document required). However, in the absence of a clear mention of these procedures, this notice will be applied to all acts that require a power of attorney, which will certainly create several situations of non-compliance by the applicants and possibly more appeals.



# Nigeria: will franchising your business jeopardise your brand?

Inês Tavares; Oyebola Coker



The Nigerian International Franchise Association defines a franchise as "a business arrangement" where "the franchisor grants the franchise operator (the franchisee) the right to distribute certain products or services in a particular way, at a particular location, and for specified periods of time. In return, the franchisee pays the franchisor fees and royalties." The association states that there are two types of franchise arrangements: business and product franchises. Where the former, and most widely known, has a business as its main object, the latter is centred on the product. where the "franchisor manufactures and distributes a physical product offered to consumers through retail dealerships".

A franchising contract can be very advantageous for the franchisor and the franchisee. When beginning a business there are many factors to be considered: potential success and growth margin, and possibility for creating a profit as well as money invested, location, brand strength and risk assessment. Starting a business can be dauting for many reasons—the risk of failure being the ultimate. In this sense, a franchise can be a very attractive option. If a company decides to take the franchising route for its business, it is because the same is successful and well established. It is often easier to obtain finance aid given that investors can trust in a business model that has been tested and proven successful, with a network and support structure to help it thrive.

The support system is one of the many advantages in choosing a franchise when compared to creating a business from scratch. Franchisees will benefit from the know-how, guidance, and experience of the franchisor, following guidelines and taking advantage of the marketing, accounts and strategy already put in place by the franchisor. Like everything else, this contract model also has disadvantages, of course, such as lack of control, being tied up to a supplier network that might not be the most beneficial in terms of cost/quality and necessary cuts in profit, to name a few.

There is also one clear factor that is beneficial for the franchisee at the start point but might pose a liability for the franchisor: the brand's reputation. A strong brand is essential for a successful franchise business. If the franchise contract was a house, the brand would be the façade. It is what people recognise to be of value and what will turn strangers familiar with the brand into costumers: people tend to trust a brand that they know sooner than a brand they are not familiar with. For example, when in a foreign country we can always count on the fact that a hamburger sold at McDonald's will taste the same as it does in our hometown. This type of consistency of the brand makes people eat at a McDonald's anywhere in the world. Of course, the ability of a franchise to maintain customers will depend on how the franchisee operates.

#### Brand jeopardy

Will selling franchises leave your brand in jeopardy?

A franchisor must measure the pros and cons of allowing a franchisee to take on a parcel of the market by sharing the business model it has so carefully curated. One of the biggest risks is damage to the brand's reputation. For a franchising deal to work it is essential that the franchisor knows how to protect the brand.



Strong brands are built on consistency, reliability, and a solid ability to stay true to the original concept. Franchisees that take on the challenge of buying into a franchise must mirror the efforts of the counterpart to maintain a strong brand and good reputation, otherwise, they might do more harm than good. Focusing on Nigeria, it is important to state that there is no specific law that regulates the offer and sale of franchises, which makes the franchise contract of utmost importance for the protection of both parties.

#### Legal framework

There is no specific regulatory agency or legislation regulating franchise arrangements in Nigeria. To ensure the adequate protection of the IP rights covered in a franchise arrangement, recourse is made to other existing laws and regulatory agencies. For example, the National Office for Technology Acquisition and Promotion (NOTAP) Act requires that all agreements for the transfer of foreign technology to Nigerian parties should be registered with NOTAP not later than 60 days from the execution of the agreement. Section 4 of the NOTAP states that such agreements are registrable if their purpose or intent is, in whole or partially, for or in connection with the use of trademarks and/or patents, supply of technical expertise in the form of technical assistance of any description, supply of detailed engineering drawings, supply of machinery and plant and provision of operating staff, managerial assistance, and the training of personnel.

In franchising, and especially if there is the transfer of IP rights in a business, it is important that the necessary steps and measures are taken to protect IP rights from unauthorised usage and exploitation by potential franchisees. The franchisors have a general duty of brand reputation management of their franchise especially as it relates to the way the franchise business is run, using the trademark, inventions and confidential information, and promotional materials. There should be written clauses between parties to regulate the IP use within the franchise agreement.





It is important to note that, as opposed to some jurisdictions, there is no statutory requirement, aside from those that may be implied from persuasive foreign case laws, for a trademark licensor/franchisor to ensure that specific standards are met by the licensee/franchisee in Nigeria.

Likewise, there is no requirement that a trademark must be transferred along with the goodwill in the business. It is also important that the franchisor obtains legal protection for the trademark of its franchise in the franchisee jurisdiction since trademark registrations are territorial in nature.

Trademarks in Nigeria are filed at the Nigerian Trademark Registry. The time frame of a trademark registration until completion may take 12 to 18 months and trademarks are valid for seven years counting from the filing date and may be consecutively renewed for periods of 14 years. Applications must be filed by registered trademark agents and the required documents include a signed power of attorney, full name and address of the applicant, complete list of goods and services and a sample of the mark (for word and device and device trademarks).

Trademark registration will give the franchisor exclusive rights and protection of its trademark in the jurisdiction of the franchisee. Trademark registration is very important in a franchise agreement as it prevents the unauthorised usage of the trademark, which then ensures the franchisor takes control over the brand by protecting it and ensuring its consistency, and in doing so maintains the high value of the original trademark.

Furthermore, apart from the registration of the franchisor's trademark in Nigeria, there is a need for the franchisor to grant a right of use (ie, a licence) to the franchisee to use its brand name in Nigeria. Such a licence must be recorded at the Nigerian Trademark Registry to avoid objections by interested parties seeking a declaration of abandonment of trademark for non-use. The required documents to file a trademark licence in Nigeria include a power of attorney from the proprietor and the licensee, a declaration and statement of case, and a licence agreement, both with verified English translation.

#### IP risks

There are essentially two main risks when it comes to brands in franchising agreements: (i) getting a bad brand reputation; and (ii) violation of trademark rights.

The franchisor, especially in jurisdictions such as Nigeria where the law is absent, must ensure that the intellectual property assets of the brand are protected before allowing a third party to operate their business in a new market or in a different market share.

Brand reputation is the public's perception of a company, and it will be affected based on their personal experience with the brand. When you franchise your business, you are allowing branches to grow from the tree trunk that is the original outlet.

If one of those branches begins to rot it might be difficult to protect the whole tree from contamination. It is essential to ensure that guidelines and regulations imposed by the franchisor to protect the brand's reputation are not only written down but fulfilled in a manner where non-compliance should lead to the franchise licence being withdrawn.

The violation of trademarks is an imminent risk in franchising deals and the franchisor must ensure the complete control and protection of the trademark before selling franchises in a jurisdiction. The trademark should be owned by the franchisor and licensed to the franchisee—this will ensure control of the IP assets and avoid registrations in bad faith and trademark violations. We also advise incorporating strong IP clauses in the franchising agreement.



# 5 minutes reading about

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**Portugal** In 2020, the Portuguese IP Office (INPI) received 20.105 national Trademark applications, representing an increase of 1,9% when compared to 2019. Concerning national patents, 391 applications were filed, which generated an increase of 72,2%, the highest in the last 10 years. On the other hand, national Design applications stood at 257 cases, decreasing 4,1% when compared to the previous year. [+]



Macau The Intellectual Property Department of the Economy Services Directorate of Macau, SAR, announced through Administrative Regulation No. 45/2020, published in the Official Gazette of the Macau Special Administrative Region No. 52, Series I, of December 28, 2020, the change of its official name to *Economic and Technological Development Bureau*. This change took effect in 1 February 2021 and all documents presented (including the name of the Directorate in the powers of attorney, assignment contracts and other documents signed as of that date) must contain the updated name. [+]

Kenva The amendments introduced through The Statute Law (Miscellaneous Amendments) Act Number 18 of 2018, which come into effect in January 2019, have provided significant changes in intellectual property rights (IPRs), as this Act involves amendments in several laws of the Industrial Property Act (2001), the Copyright Act (2001), the Protection of Traditional Knowledge and Cultural Expressions Act (2016) and The Anti-Counterfeit Act (2018) ("the ACA Act"). On 23rd July 2021, the Anti-counterfeit (Amendment) Regulations, 2021 (Legal Notice 117) and the Anti-Counterfeit (Recordation) Regulations, 2021 (Legal Notice 118) were published in the Kenya Gazette Supplement No. 143. These regulations introduce new policies to guide the implementation of a new customs recordal system in Kenya. [+]

Seychelles Starting January 2022, applicants of the ARIPO system will be able to designate Seychelles in their patent and design applications. The President of Seychelles, Wavel Ramkalawan, signed the instrument of accession to the Harare Protocol on 26th August 2021. The Harare Protocol on Patents, Utility Models and Industrial Designs governs the regional procedures and substantive requirements for the protection of IP rights amongst its member-states, within the ARIPO framework. The other ARIPO Member States that are Contracting Parties to the Harare Protocol are: Botswana, Kingdom of Eswatini, The Gambia, Ghana, Kenya, Kingdom of Lesotho, Liberia, Malawi, Mozambique, Namibia, Rwanda, Sao Tome and Principe, Sierra Leone, Sudan, Tanzania,

Uganda, Zambia, and Zimbabwe. [+]



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